

**DEPARTMENT OF COMMERCE**

**United States Patent and Trademark Office**

**37 CFR Part 1**

**[Docket No.: PTO-P-2012-0015]**

**RIN 0651-AC77**

**Changes to Implement the First Inventor to File Provisions of the Leahy-Smith  
America Invents Act**

**AGENCY:** United States Patent and Trademark Office, Commerce.

**ACTION:** Notice of proposed rulemaking.

**SUMMARY:** The Leahy-Smith America Invents Act (AIA) amends the patent laws pertaining to the conditions of patentability to convert the United States patent system from a “first to invent” system to a “first inventor to file” system; treats United States patents and United States patent application publications as prior art as of their earliest effective United States, foreign, or international filing date; eliminates the requirement that a prior public use or sale be “in this country” to be a prior art activity; and treats

commonly owned or joint research agreement patents and patent application publications as being by the same inventive entity for purposes of novelty, as well as nonobviousness. The AIA also repeals the provisions pertaining to statutory invention registrations. The current rules of practice in patent cases have a number of provisions based on the conditions of patentability of a “first to invent” patent system. The United States Patent and Trademark Office (Office) is proposing to amend the rules of practice in patent cases to implement the changes to the conditions of patentability in the AIA, and to eliminate the provisions pertaining to statutory invention registrations.

**DATES:** Written comments must be received on or before October 5, 2012.

**ADDRESSES:** Comments should be sent by electronic mail message over the Internet addressed to: [fitf\\_rules@uspto.gov](mailto:fitf_rules@uspto.gov). Comments may also be submitted by postal mail addressed to: Mail Stop Comments--Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, marked to the attention of Susy Tsang-Foster, Legal Advisor, Office of Patent Legal Administration.

Comments may also be sent by electronic mail message over the Internet via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site (<http://www.regulations.gov>) for additional instructions on providing comments via the Federal eRulemaking Portal.

Although comments may be submitted by postal mail, the Office prefers to receive comments by electronic mail message over the Internet because sharing comments with the public is more easily accomplished. Electronic comments are preferred to be submitted in plain text, but also may be submitted in ADOBE® portable document format or MICROSOFT WORD® format. Comments not submitted electronically should be submitted on paper in a format that facilitates convenient digital scanning into ADOBE® portable document format.

The comments will be available for public inspection at the Office of the Commissioner for Patents, currently located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia. Comments also will be available for viewing via the Office's Internet Web site (<http://www.uspto.gov>). Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

**FOR FURTHER INFORMATION CONTACT:** Susy Tsang-Foster, Legal Advisor ((571) 272-7711), Pinchus M. Laufer, Senior Legal Advisor ((571) 272-7726), or Eugenia A. Jones, Senior Legal Advisor ((571) 272-7727), Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy.

## **SUPPLEMENTARY INFORMATION:**

**Executive Summary:** Purpose: Section 3 of the AIA, inter alia, amends the patent laws to: (1) convert the United States patent system from a “first to invent” system to a “first inventor to file” system; (2) treat U.S. patents and U.S. patent application publications as prior art as of their earliest effective filing date, regardless of whether the earliest effective filing date is based upon an application filed in the U.S. or in another country; (3) eliminate the requirement that a prior public use or sale be “in this country” to be a prior art activity; and (4) treat commonly owned or joint research agreement patents and patent application publications as being by the same inventive entity for purposes of 35 U.S.C. 102, as well as 35 U.S.C. 103. These changes in section 3 of the AIA are effective on March 16, 2013, but apply only to certain applications filed on or after March 16, 2013. The Office sets out the conditions of patentability in 35 U.S.C. 102 and 103 as interpreted by the case law in the Manual of Patent Examining Procedure (MPEP). See MPEP §§ 2121 through 2143 (8<sup>th</sup> ed. 2001) (Rev. 8, July 2010). The Office plans to issue guidelines and train the Patent Examining Corps on how the changes to 35 U.S.C. 102 and 103 in section 3 of the AIA impact the provisions of the MPEP pertaining to 35 U.S.C. 102 and 103.

The rules of practice for patent cases in title 37 of the Code of Federal Regulations (CFR) are currently drafted for examination under the “first to invent” system in effect prior to March 16, 2013. Thus, this notice proposes changes to the rules of practice in title 37,

CFR, for consistency with, and to address the examination issues raised by, the changes in section 3 of the AIA.

Summary of Major Provisions: The Office is specifically proposing to provide the following changes:

The Office is proposing to add the definitions provided in the AIA to the rules of practice for the terms commonly used in the rules of practice.

The Office is providing for the submission of affidavits or declarations showing that: (1) a disclosure upon which a claim rejection is based was by the inventor or joint inventor or by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or (2) there was a prior public disclosure 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.

The Office is proposing to provide for the situation in which a U.S. patent or U.S. patent application publication has a prior art effect as of the filing date of a foreign priority application by requiring that the certified copy of the foreign application be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application.

The Office is eliminating the provisions directed to statutory invention registrations.

Finally, the Office is proposing additional requirements for nonprovisional applications filed on or after March 16, 2013, that claim the benefit of the filing date of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013. If such a nonprovisional application contains at any time a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage in an international application, sixteen months from the filing date of the prior-filed application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the application. In addition, if such a nonprovisional application does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign, provisional, or nonprovisional application, the applicant must provide a statement that the application includes subject matter not disclosed in the foreign, provisional, or nonprovisional application within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage in an international application, or sixteen months from the filing date of the prior-filed application. This will permit the Office to readily determine whether the nonprovisional application is subject to the changes to 35 U.S.C. 102 and 103 in the AIA.

Costs and Benefits: This rulemaking is not economically significant as that term is defined in Executive Order 12866 (Sept. 30, 1993).

**Specific Changes to title 35, United States Code:** The AIA was enacted into law on September 16, 2011. See Pub. L. 112-29, 125 Stat. 284 (2011). Section 3 of the AIA specifically amends 35 U.S.C. 102 to provide in 35 U.S.C. 102(a) that a person shall be entitled to a patent unless: (1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or (2) the claimed invention was described in a patent issued under 35 U.S.C. 151, or in an application for patent published or deemed published under 35 U.S.C. 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention. See 125 Stat. at 285-86. The publication of an international application designating the United States by the World Intellectual Property Organization (WIPO) is deemed a publication under 35 U.S.C. 122(b) (except as provided in 35 U.S.C. 154(d)). See 35 U.S.C. 374.

35 U.S.C. 102(b) as amended by section 3 of the AIA provides for exceptions to the provisions of 35 U.S.C. 102(a). The exceptions in 35 U.S.C. 102(b)(1) provide that a disclosure made one year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under 35 U.S.C. 102(a)(1) if: (1) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or (2) the subject matter disclosed had, before such disclosure, 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. See 125 Stat. at 286. The exceptions in 35 U.S.C. 102(b)(2) provide that a disclosure shall not be prior art to a claimed invention under 35 U.S.C. 102(a)(2) if: (1) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor; (2) the subject matter disclosed had, before such subject matter was effectively filed under 35 U.S.C. 102(a)(2), 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; or (3) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person. See id.

35 U.S.C. 102(c) as amended by section 3 of the AIA provides for common ownership under joint research agreements. 35 U.S.C. 102(c) specifically provides that subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of 35 U.S.C. 102(b)(2)(C) if: (1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, one or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention; (2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and (3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement. See id. The AIA also provides that the enactment of 35 U.S.C. 102(c) is done with the same intent to promote joint research activities that was



expressed, including in the legislative history, through the enactment of the Cooperative Research and Technology Enhancement Act of 2004 (the “CREATE Act”; Pub. L. 108-453, 118 Stat. 3596 (2004)), and that the Office shall administer 35 U.S.C. 102(c) in a manner consistent with the legislative history of the CREATE Act that was relevant to its administration. See 125 Stat. at 287.

35 U.S.C. 102(d) as amended by section 3 of the AIA provides a definition for “effectively filed” for purposes of determining whether a patent or application for patent is prior art to a claimed invention. 35 U.S.C. 102(d) provides that for purposes of determining whether a patent or application for patent is prior art to a claimed invention under 35 U.S.C. 102(a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application on the earliest of: (1) the actual filing date of the patent or the application for patent; or (2) if the patent or application for patent is entitled to claim a right of priority or the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, or 365 based upon one or more prior filed applications for patent, the filing date of the earliest such application that describes the subject matter. See 125 Stat. at 286-87.

The AIA provides a number of definitions for terms used in title 35 of the United States Code. See 125 Stat. at 285. The term “inventor” means the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention, and the terms “joint inventor” and “coinventor” mean any one of the individuals who invented or discovered the subject matter of a joint invention. 35 U.S.C.

100(f) and (g). The term “joint research agreement” means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention. 35 U.S.C. 100(h). The term “effective filing date” for a claimed invention in a patent or application for patent (other than a reissue application or a reissued patent) means the earliest of: (1) the actual filing date of the patent or the application for the patent containing a claim to the invention; or (2) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority or the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, or 365. 35 U.S.C. 100(i)(1). The “effective filing date” for a claimed invention in a reissued patent or an application for reissue shall be determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought. 35 U.S.C. 100(i)(2). The term “claimed invention” means the subject matter defined by a claim in a patent or an application for a patent. 35 U.S.C. 100(j).

The AIA amends 35 U.S.C. 103 to provide that a patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in 35 U.S.C. 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. See 125 Stat. at 287. 35 U.S.C. 103 also provides that patentability shall not be negated by the manner in which the invention was made. See id.

The AIA eliminates the provisions in 35 U.S.C. 135 for patent interference proceedings and replaces them with patent derivation proceedings. See 125 Stat. at 289-90. The Office is implementing the patent derivation proceedings provided for in the AIA in a separate rulemaking (RIN 0651-AC74). The AIA also replaces the interference provisions of 35 U.S.C. 291 with derivation provisions. See 125 Stat. at 288-89.

The AIA repeals the provisions of 35 U.S.C. 104 (special provisions for inventions made abroad) and 157 (statutory invention registrations). See 125 Stat. at 287. The AIA also makes conforming changes to 35 U.S.C. 111, 119, 120, 134, 145, 146, 154, 172, 202(c), 282, 287, 305, 363, 374, and 375(a). See 125 Stat. at 287-88, and 90-91.

The AIA provides that the changes (other than the repeal of 35 U.S.C. 157) in section 3 which are being implemented in this rulemaking take effect on March 16, 2013, and 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, such a claim. See 125 Stat. at 293.

The AIA also provides that the provisions of 35 U.S.C. 102(g), 135, and 291 in effect on March 15, 2013, shall apply to each claim of an application for patent, and any patent issued thereon, for which the amendments made by this section also apply, if such

application or patent contains, or contained at any time: (1) a claim to an invention having an effective filing date as defined in 35 U.S.C. 100(i) that occurs 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, such a claim. See id.

### **Discussion of Specific Rules:**

The following is a discussion of the amendments to Title 37 of the Code of Federal Regulations, part 1, that are being proposed in this notice of proposed rulemaking.

Section 1.9: Section 1.9 is proposed to be amended to add the definition of the terms used throughout the rules.

Section 1.9(d)(1) as proposed provides that the term “inventor” or “inventorship” as used in this chapter means the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention. See 35 U.S.C. 100(f). While the term “inventorship” is not used in 35 U.S.C. 100(f), the term “inventorship” is currently used throughout the rules of practice to mean the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention. Section 1.9(d)(2) provides that the term “joint inventor” or “coinventor” as used in this chapter means any one of the individuals who invented or discovered the subject matter of a joint invention. See 35 U.S.C. 100(g).

Section 1.9(e) as proposed provides that the term “joint research agreement” as used in this chapter means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention. See 35 U.S.C. 100(h).

Section 1.9(f) as proposed provides that the term “claimed invention” as used in this chapter means the subject matter defined by a claim in a patent or an application for a patent. See 35 U.S.C. 100(j).

Section 1.53: Section 1.53(j) is proposed to be amended to delete the phrase “except as provided in 35 U.S.C. 102(e)” to be consistent with the changes to 35 U.S.C. 102 in the AIA.

Section 1.55: Section 1.55(a)(1) is proposed to be amended to include the requirement in 35 U.S.C. 119(a) that the nonprovisional application must be filed not later than twelve months after the date on which the foreign application was filed, and that this twelve-month period is subject to 35 U.S.C. 21(b) and § 1.7(a). 35 U.S.C. 21(b) and § 1.7(a) provide that when the day, or the last day, for taking any action (e.g., filing a nonprovisional application within twelve months of the date on which the foreign priority application was filed) or paying any fee in the Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken, or fee paid, on the next succeeding secular or business day.

Section 1.55(a)(2) is proposed to be amended to include provisions in current § 1.55(a)(1)(i) and to require that the claim for priority and a certified copy of the foreign application be filed in an application under 35 U.S.C. 111(a) (other than a design application) within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. Section 1.55(a)(2) as proposed also requires the claim for priority to be presented in an application data sheet. See Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act, 77 FR 982, 989-90 (Jan. 6, 2012).

Section 1.55(a)(3) is proposed to be amended to include provisions in current § 1.55(a)(1)(ii) and to require that the claim for priority be made and a certified copy of the foreign application filed within the time limit set forth in the Patent Cooperation Treaty (PCT) and the Regulations under the PCT in an application that entered the national stage from an international application after compliance with 35 U.S.C. 371. Since patent application publications will have a prior art effect as of the earliest priority date (for subject matter disclosed in the priority application) with respect to applications subject to 35 U.S.C. 102, as amended by the AIA, the Office needs to ensure that it has a copy of the priority application by the time of publication. The proposed time period of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application is consistent with the international norm for when the certified copy of the foreign application needs to be filed in an application. See PCT Rule 17.1(a).

Section 1.55(a)(4) is proposed to be amended to require that if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior foreign application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the application. Section 1.55(a)(4) is also proposed to be amended to require that if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign application, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, or sixteen months from the filing date of the prior foreign application.

Proposed § 1.55(a)(4) would not require that the applicant identify how many or which claims in the nonprovisional application have an effective filing date on or after March 16, 2013, or that the applicant identify the subject matter in the nonprovisional application not also disclosed in the foreign application. Proposed § 1.55(a)(4) would

require only that the applicant state that there is a claim in the nonprovisional application that has an effective filing date on or after March 16, 2013 (e.g., “upon reasonable belief, this application contains at least one claim that has an effective filing date on or after March 16, 2013”), or the applicant state that there is subject matter in the nonprovisional application not also disclosed in the foreign application (e.g., “upon reasonable belief, this application contains subject matter not also disclosed in the foreign application).

If an applicant fails to timely provide such a statement and then later indicates that the nonprovisional application contains a claim having an effective filing date on or after March 16, 2013, or subject matter not also disclosed in the foreign application, the Office may issue a requirement for information under § 1.105 requiring the applicant to identify where (by page and line or paragraph number) there is written description support under AIA 35 U.S.C. 112(a) in the foreign application for the remaining claims in the nonprovisional application. Likewise, if the applicant later seeks to retract a previous statement that the nonprovisional application contains a claim having an effective filing date on or after March 16, 2013, or subject matter not also disclosed in the foreign application, the Office may issue a requirement for information under § 1.105 requiring the applicant to identify where (by page and line or paragraph number) there is written description support under AIA 35 U.S.C. 112(a) in the foreign application for each claim in the nonprovisional application.

This information is needed to assist the Office in determining whether the application is subject to 35 U.S.C. 102 and 103 as amended by the AIA or 35 U.S.C. 102 and 103 in



effect on March 15, 2013. If the Office must determine on its own the effective filing date of every claim ever presented in an application filed on or after March 16, 2013, that claims priority to or the benefit of a foreign application filed prior to March 16, 2013, examination costs will significantly increase. This proposed provision is tailored to the transition to 35 U.S.C. 102 and 103 under the AIA. Thus, for a nonprovisional application filed on or after March 16, 2013, that claims the benefit of the filing date of a foreign application, the applicant would not be required to provide any statement if: (1) the nonprovisional application discloses only subject matter also disclosed in a foreign application filed prior to March 16, 2013; or (2) the nonprovisional application claims only the benefit of the filing date of a foreign application filed on or after March 16, 2013.

Section 1.55(c) as proposed contains the provisions regarding waiver of claims for priority and acceptance of unintentionally delayed claims. Section 1.55(c) is proposed to be amended to reference claims for priority under 35 U.S.C. 119(a) through (d) or (f), or 365(a) or 365(b). Section 1.55(c) is proposed to be amended to require a petition to accept a delayed claim to be accompanied by a certified copy of the foreign application, unless previously submitted. In view of the time period for submitting a certified copy in proposed § 1.55(a), a petition to accept a delayed claim after this time period needs to be accompanied by a certified copy (unless previously submitted).

Section 1.55(d) as proposed contains provisions for the priority document exchange program. See [Changes to Implement Priority Document Exchange Between Intellectual](#)

Property Offices, 72 FR 1664 (Jan. 16, 2007). Sections 1.55(d)(1)(i) and (d)(1)(ii) contain the provisions of current §§ 1.55(d)(1)(i) and (d)(1)(ii), except to also require the claim for priority to be presented in an application data sheet and that the copy of the foreign application is received by the Office within the period set forth in § 1.55(a) or by such later time as may be set by the Office. Section 1.55(d)(1)(iii) is proposed to be amended to remove the sentence that the request should be made within the later of four months from the filing date of the application or sixteen months from the filing date of the foreign application. This sentence is no longer needed since proposed § 1.55(a) requires the certified copy to be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application.

Section 1.55(e) as proposed contains the provisions of current § 1.55(a)(2)-(4). In view of the time period in proposed § 1.55(a), the provisions in current § 1.55(a)(2) and (a)(3) are less relevant, but these provisions are still needed to cover situations where the Office is examining an application within four months from the filing date of the application such as an application examined under the Office's Track I prioritized examination program. See Changes to Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures Under the Leahy-Smith America Invents Act, 76 FR 59050 (Sept. 23, 2011), and Changes to Implement the Prioritized Examination for Requests for Continued Examination, 76 FR 78566 (Dec. 19, 2011). Furthermore, even if a petition to accept a delayed claim for priority is filed under § 1.55(c), the claim for priority and the certified copy of the foreign application must still

be filed within the pendency of the application and before the patent is granted. Thus, § 1.55(e)(1) as proposed contains the provisions of current § 1.55(a)(2). In addition, § 1.55(e)(2) as proposed continues to permit the Office to require the claim for priority and the certified copy to be submitted earlier than the time period provided in § 1.55(a). Furthermore, § 1.55(e)(3) as proposed continues to permit the Office to require an English language translation of a non-English language foreign application. Finally, §§ 1.55(e)(2)(i) and (e)(3)(i) as proposed also reference a derivation proceeding (in addition to an interference) as a situation in which the Office may require the claim for priority and the certified copy, as well as an English language translation, of the foreign application to be submitted earlier.

Section 1.55(f) is proposed to be added to provide that the time periods set forth in § 1.55 are not extendable. The time periods set forth in § 1.55 are currently not extendable. This provision simply avoids the need to separate that the time period is not extendable with respect to each time period set in in § 1.55.

Section 1.71: Section 1.71(g)(1) is proposed to be amended to change 35 U.S.C. 103(c)(2)(C) to 35 U.S.C. 102(c)(3) to be consistent with the changes to 35 U.S.C. 102 and 103 in the AIA, which are described previously in the summary of major changes.

Section 1.77: Section 1.77(b) is proposed to be amended to provide for any statement regarding prior disclosures by the inventor or a joint inventor. Section 1.77(a) sets out a preferred arrangement for a patent application, and § 1.77(b) sets out the preferred

arrangement of the specification of a patent application. If the information provided by the applicant in this section of the specification is sufficient to comply with what is required in a § 1.130 affidavit or declaration regarding a prior disclosure (discussed below), then applicant would not need to provide anything further. If, however, the information provided by the applicant in this section of the specification is not sufficient to comply with what is required in such a § 1.130 affidavit or declaration, then the applicant would need to submit the required information in an affidavit or declaration under § 1.130. An applicant is not required to use the format specified in § 1.77 or identify any prior disclosures by the inventor or a joint inventor (unless necessary to overcome a rejection), but identifying any prior disclosures by the inventor or a joint inventor may save applicants (and the Office) the costs related to an Office action and reply and expedite examination of the application.

Section 1.78: Section 1.78 is proposed to be reorganized as follows: (1) § 1.78(a) as proposed contains provisions relating to claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application; (2) § 1.78(b) as proposed contains provisions relating to delayed claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application; (3) § 1.78(c) as proposed contains provisions relating to claims under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional or international application; (4) § 1.78(d) as proposed contains provisions relating to delayed claims under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional or international application; (5) § 1.78(e) as proposed contains provisions relating to applications containing conflicting claims; (6) § 1.78(f) as proposed contains

provisions relating to applications or patents under reexamination naming different inventors and containing patentably indistinct claims; and (7) § 1.78(g) as proposed provides that the time periods set forth in § 1.78 are not extendable.

Section 1.78(a) as proposed addresses claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application. Under 35 U.S.C. 119(e)(1), a provisional application must disclose the invention claimed in at least one claim of the later-filed application in the manner provided by 35 U.S.C. 112(a) (except for the requirement to disclose the best mode) for the later-filed application to receive the benefit of the filing date of the provisional application. See New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co., 298 F.3d 1290, 1294 (Fed. Cir. 2002) (for a nonprovisional application to actually receive the benefit of the filing date of the provisional application, “the specification of the provisional [application] must ‘contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms,’ 35 U.S.C. 112 ¶ 1, to enable an ordinarily skilled artisan to practice the invention claimed in the nonprovisional application”). Section 1.78(a), however, as proposed does not also state (as does current § 1.78(a)(4)) that the provisional application must disclose the invention claimed in at least one claim of the later-filed application in the manner provided by 35 U.S.C. 112(a) (except for the requirement to disclose the best mode) because § 1.78 pertains to claims to the benefit of a prior-filed application and the AIA draws a distinction between being entitled to the benefit of a prior-filed application and being entitled to claim the benefit of a prior-filed application. See 157 Cong. Rec. S1370 (2011) (explaining the distinction between being entitled to actual priority or benefit for

purposes of 35 U.S.C. 100(i) and being entitled only to claim priority or benefit for purposes of 35 U.S.C. 102(d)). Nevertheless, the prior-filed application must disclose an invention in the manner provided by 35 U.S.C. 112(a) (except for the requirement to disclose the best mode) for the later-filed application to receive the benefit of the filing date of the prior-filed application under 35 U.S.C. 119(e) (or 35 U.S.C. 120) as to such invention, and the prior-filed application must describe the subject matter for the later-filed application to be considered effectively filed under 35 U.S.C. 102(d) on the filing date of the prior-filed application with respect to that subject matter.

Section 1.78(a)(1) as proposed provides that the nonprovisional application or international application designating the United States of America must be filed not later than twelve months after the date on which the provisional application was filed, and that this twelve-month period is subject to 35 U.S.C. 21(b) and § 1.7(a). As discussed previously, 35 U.S.C. 21(b) and § 1.7(a) provide that when the day, or the last day, for taking any action (e.g., filing a nonprovisional application within twelve months of the date on which the provisional application was filed) or paying any fee in the Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken, or fee paid, on the next succeeding secular or business day.

Section 1.78(a)(3) is proposed to be amended to require that if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a provisional application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after

March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior-filed provisional application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the application. Section 1.78(a)(3) is also proposed to be amended to require that if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a provisional application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the provisional application, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, or sixteen months from the filing date of the prior-filed provisional application.

Proposed § 1.78(a)(3) would not require that the applicant identify how many or which claims in the nonprovisional application have an effective filing date on or after March 16, 2013, or that the applicant identify the subject matter in the nonprovisional application not also disclosed in the provisional application. Proposed § 1.78(a)(3) would require only that the applicant state that there is a claim in the nonprovisional application that has an effective filing date on or after March 16, 2013 (e.g., “upon reasonable belief, this application contains at least one claim that has an effective filing date on or after March 16, 2013”), or the applicant state that there is subject matter in the nonprovisional

application not also disclosed in the provisional application (e.g., “upon reasonable belief, this application contains subject matter not also disclosed in provisional application No. XX/XXX,XXX”).

If an applicant fails to timely provide such a statement and then later indicates that the nonprovisional application contains a claim having an effective filing date on or after March 16, 2013, or subject matter not also disclosed in the provisional application, the Office may issue a requirement for information under § 1.105 requiring the applicant to identify where (by page and line or paragraph number) there is written description support under AIA 35 U.S.C. 112(a) in the provisional application for the remaining claims in the nonprovisional application. Likewise, if the applicant later seeks to retract a previous statement that the nonprovisional application contains a claim having an effective filing date on or after March 16, 2013, or subject matter not also disclosed in the provisional application, the Office may issue a requirement for information under § 1.105 requiring the applicant to identify where (by page and line or paragraph number) there is written description support under AIA 35 U.S.C. 112(a) in the provisional application for each claim in the nonprovisional application.

This information is needed to assist the Office in determining whether the application is subject to 35 U.S.C. 102 and 103 as amended by the AIA or 35 U.S.C. 102 and 103 in effect on March 15, 2013. As discussed previously, if the Office must determine on its own the effective filing date of every claim ever presented in an application filed on or after March 16, 2013, that claims priority to or the benefit of a provisional application



filed prior to March 16, 2013, examination costs will significantly increase. This proposed provision is tailored to the transition to 35 U.S.C. 102 and 103 under the AIA. Thus, for a nonprovisional application filed on or after March 16, 2013, that claims the benefit of the filing date of a provisional application, the applicant would not be required to provide any statement if: (1) the nonprovisional application discloses only subject matter also disclosed in a provisional application filed prior to March 16, 2013; or (2) the nonprovisional application claims only the benefit of the filing date of a provisional application filed on or after March 16, 2013.

Sections 1.78(a) and (c) as proposed require the reference to each prior-filed application to be included in an application data sheet. See Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act, 77 FR 982, 993 (Jan. 6, 2012).

Section 1.78(a) as proposed otherwise contains the provisions of current § 1.78(a)(4) and (a)(5).

Section 1.78(b) as proposed contains provisions relating to delayed claims under 35 U.S.C. 119(e) for the benefit of prior-filed provisional applications. Section 1.78(b) contains the provisions of current § 1.78(a)(6).

Section 1.78(c) as proposed contains provisions relating to claims under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional or international application.

Section 1.78(c)(1) as proposed provides that each prior-filed application must name as the inventor or a joint inventor an inventor named in the later-filed application. In addition, each prior-filed application must either be: (1) an international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or (2) a nonprovisional application under 35 U.S.C. 111(a) that is entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) for which the basic filing fee set forth in § 1.16 has been paid within the pendency of the application (provisions from current § 1.78(a)(1)).

Section 1.78(c) as proposed does not contain a provision that the prior-filed application disclose the invention claimed in at least one claim of the later-filed application in the manner provided by 35 U.S.C. 112(a). For a later-filed application to receive the benefit of the filing date of a prior-filed application, 35 U.S.C. 120 requires that the prior-filed application disclose the invention claimed in at least one claim of the later-filed application in the manner provided by 35 U.S.C. 112(a) (except for the requirement to disclose the best mode). As discussed previously, § 1.78 as proposed pertains to claims to the benefit of a prior-filed application and the AIA draws a distinction between being entitled to the benefit of a prior-filed application and being entitled to claim the benefit of a prior-filed application.

Section 1.78(c)(2) is proposed to be amended to clarify that identifying the relationship of the applications means identifying whether the later-filed application is a continuation,

divisional, or continuation-in-part of the prior-filed nonprovisional application or international application. See MPEP § 201.11.

Section 1.78(c)(2) is also proposed to be amended to require that if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a nonprovisional application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior-filed nonprovisional application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the application. Section 1.78(c)(2) is also proposed to be amended to require that if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a nonprovisional application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the prior-filed nonprovisional application, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, or sixteen months from the filing date of the prior-filed nonprovisional application.

Proposed § 1.78(c)(2) would not require that the applicant identify how many or which claims in the later-filed nonprovisional application have an effective filing date on or after March 16, 2013, or that the applicant identify the subject matter in the later-filed nonprovisional application not also disclosed in the prior-filed nonprovisional application. Proposed § 1.78(c)(2) would require only that the applicant state that there is a claim in the later-filed nonprovisional application that has an effective filing date on or after March 16, 2013 (e.g., “upon reasonable belief, this application contains at least one claim that has an effective filing date on or after March 16, 2013”), or the applicant state that there is subject matter in the later-filed nonprovisional application not also disclosed in the prior-filed nonprovisional application (e.g., “upon reasonable belief, this application contains subject matter not also disclosed in application No. XX/XXX,XXX”).

If an applicant fails to timely provide such a statement and then later indicates that the later-filed nonprovisional application contains a claim having an effective filing date on or after March 16, 2013, or subject matter not also disclosed in the prior-filed nonprovisional application, the Office may issue a requirement for information under § 1.105 requiring the applicant to identify where (by page and line or paragraph number) there is written description support under AIA 35 U.S.C. 112(a) in the prior-filed nonprovisional application for the remaining claims in the later-filed nonprovisional application. Likewise, if the applicant later seeks to retract a previous statement that the later-filed nonprovisional application contains a claim having an effective filing date on or after March 16, 2013, or subject matter not also disclosed in the prior-filed

nonprovisional application, the Office may issue a requirement for information under § 1.105 requiring the applicant to identify where (by page and line or paragraph number) there is written description support under AIA 35 U.S.C. 112(a) in the prior-filed nonprovisional application for each claim in the later-filed nonprovisional application.

This information is needed to assist the Office in determining whether the application is subject to 35 U.S.C. 102 and 103 as amended by the AIA or 35 U.S.C. 102 and 103 in effect on March 15, 2013. As discussed previously, if the Office must determine on its own the effective filing date of every claim ever presented in an application filed on or after March 16, 2013, that claims priority to or the benefit of a nonprovisional application filed prior to March 16, 2013, examination costs will significantly increase. This proposed provision is tailored to the transition to 35 U.S.C. 102 and 103 under the AIA. Thus, for a nonprovisional application filed on or after March 16, 2013, that claims the benefit of the filing date of a nonprovisional application, the applicant would not be required to provide any statement if: (1) the nonprovisional application discloses only subject matter also disclosed in a prior-filed nonprovisional application filed prior to March 16, 2013; or (2) the nonprovisional application claims only the benefit of the filing date of a nonprovisional application filed on or after March 16, 2013.

Sections 1.78(c)(3) through (c)(5) as proposed contain the provisions of current § 1.78(a)(2). Section 1.78(c)(5) as proposed also provides that cross-references to applications for which a benefit is not claimed must not be included in an application data sheet (§ 1.76(b)(5)). Including cross-references to applications for which a benefit is **not**

claimed in the application data sheet may lead the Office to inadvertently schedule the application for publication under 35 U.S.C. 122(b) and § 1.211 et seq. on the basis of the cross-referenced applications having the earliest filing date.

Section 1.78(d) as proposed contains provisions relating to delayed claims under 35 U.S.C. 120, 121, or 365(c) for the benefit of prior-filed nonprovisional or international applications. Section 1.78(d) as proposed contains the provisions of current § 1.78(a)(3).

Section 1.78(e) as proposed contains the provisions of current § 1.78(b) pertaining to applications containing conflicting claims.

Section 1.78(f) as proposed addresses applications or patents under reexamination that name different inventors and contain patentably indistinct claims. The provisions are similar to the provisions of current § 1.78(c), but the language has been amended to refer to “the effective filing date of the later claimed invention” in place of “at the time the later invention was made” in view of the change to a first inventor to file system.

Section 1.78(g) as proposed provides that the time periods set forth in § 1.78 are not extendable.

Sections 1.53 and 1.76 would be amended for consistency with the reorganization of § 1.78.

Section 1.104: Section 1.104(c)(4) is proposed to be amended to include the provisions that pertain to commonly owned or joint research agreement subject matter for applications subject to 35 U.S.C. 102 and 103 as amended by the AIA. Specifically, § 1.104(c)(4) as proposed implements the provisions of 35 U.S.C. 102(b)(2)(C) and 35 U.S.C. 102(c) in the AIA. Thus, § 1.104(c)(4) as proposed is applicable to applications that are subject to 35 U.S.C. 102 and 103 as amended by the AIA.

Section 1.104(c)(4)(i) as proposed provides that subject matter that qualifies as prior art under 35 U.S.C. 102(a)(2) and a claimed invention will be treated as commonly owned for purposes of 35 U.S.C. 102(b)(2)(C) if the applicant provides a statement that the prior art and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

Section 1.104(c)(4)(ii) as proposed addresses joint research agreements and provides that subject matter that qualifies as prior art under 35 U.S.C. 102(a)(2) and a claimed invention will be treated as commonly owned for purposes of 35 U.S.C. 102(b)(2)(C) on the basis of a joint research agreement under 35 U.S.C. 102(c) if: (1) the applicant provides a statement that the prior art was developed and the claimed invention was made by or on behalf of one or more parties to a joint research agreement, within the meaning of 35 U.S.C. 100(h) and § 1.9(e), that was in effect on or before the effective filing date of the claimed invention, and the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and (2) the application for

patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

Section 1.104(c)(5) is proposed to be amended to include the provisions that pertain to commonly owned or joint research agreement subject matter for applications subject to 35 U.S.C. 102 and 103 in effect prior to the effective date of section 3 of the AIA. Thus, § 1.104(c)(5) as proposed is applicable to applications that are subject to 35 U.S.C. 102 and 103 in effect prior to March 16, 2013.

Section 1.104(c)(5)(i) as proposed provides that subject matter which qualifies as prior art under 35 U.S.C. 102(e), (f), or (g) in effect prior to March 16, 2013, and a claimed invention in an application or a patent granted on or after December 10, 2004, will be treated as commonly owned for purposes of 35 U.S.C. 103(c) in effect prior to March 16, 2013, if the applicant provides a statement to the effect that the prior art and the claimed invention, at the time the claimed invention was made, were owned by the same person or subject to an obligation of assignment to the same person.

Section 1.104(c)(5)(ii) as proposed addresses joint research agreements and provides that subject matter which qualifies as prior art under 35 U.S.C. 102(e), (f), or (g) in effect prior to March 16, 2013, and a claimed invention in an application or a patent granted on or after December 10, 2004, will be treated as commonly owned for purposes of 35 U.S.C. 103(c) in effect prior to March 16, 2013, on the basis of a joint research agreement under 35 U.S.C. 103(c)(2) in effect prior to March 16, 2013 if: (1) the



applicant provides a statement to the effect that the prior art and the claimed invention were made by or on behalf of the parties to a joint research agreement, within the meaning of 35 U.S.C. 100(h) and § 1.9(e), that was in effect on or before the date the claimed invention was made, and that the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and (2) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement. Section 1.104(c)(5)(ii) as proposed makes reference to the definition of joint research agreement contained in 35 U.S.C. 100(h) and § 1.9(e). The AIA did not change the definition of a joint research agreement, but merely moved the definition from 35 U.S.C. 103(c)(3) to 35 U.S.C. 100(h). Thus, the Office proposes to reference the definition of joint research agreement in 35 U.S.C. 100(h) in § 1.104(c)(5)(ii) for simplicity.

Section 1.104(c)(6) is proposed to be added to clarify that patents issued prior to December 10, 2004, from applications filed prior to November 29, 1999, are subject to 35 U.S.C. 103(c) in effect on November 28, 1999. See MPEP § 706.02(l).

The provisions of current § 1.104(c)(5) pertain to statutory invention registrations and are thus proposed to be removed. See discussion of the provisions of §§ 1.293 through 1.297.

Section 1.109: Section 1.109 is proposed to be added to specify the effective filing date of a claimed invention. Section 1.109(a) as proposed provides that the effective filing

date of a claimed invention in a patent or an application for patent, other than in a reissue application or reissued patent, is the earliest of: (1) the actual filing date of the patent or the application for the patent containing a claim to the invention; or (2) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to priority to or the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, or 365. See 35 U.S.C. 100(i)(1). Section 1.109(b) as proposed provides that the effective filing date for a claimed invention in a reissue application or a reissued patent is determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought. See 35 U.S.C. 100(i)(2).

Section 1.110: Section 1.110 as proposed provides that the Office may require information concerning the inventorship and ownership of the subject matter of each claim when necessary for an Office proceeding. Section 1.110 is proposed to be amended to: (1) change the ownership inquiry to ownership on the effective filing date rather than ownership on the date of invention; and (2) eliminate the provision concerning inquiring into the date of invention of the subject matter of the claims.

Section 1.110 as proposed to be amended provides that when more than one inventor is named in an application or patent, the Office may require an applicant or patentee to identify the inventor, and ownership on the effective filing date, of each claimed invention in the application or patent, when necessary for purposes of an Office proceeding.

Section 1.130: Section 1.130 is proposed to be amended to replace its existing provisions (which are proposed to be moved to § 1.131) with provisions for showing attribution of a disclosure to an inventor or joint inventor, prior disclosure, or derivation under 35 U.S.C. 102(b) as amended by the AIA. Thus, § 1.130 as proposed would apply to applications for patent (and patents issuing thereon) that are subject to 35 U.S.C. 102 as amended by the AIA, and § 1.131 would apply to applications for patent (and patents issuing thereon) that are subject to 35 U.S.C. 102 in effect on March 15, 2013 (prior to the effective date of section 3 of the AIA).

Section 1.130(a) as proposed provides a mechanism for filing an affidavit or declaration to establish that a disclosure is not prior art in accordance with 35 U.S.C. 102(b) as amended by the AIA. Proposed § 1.130, like §§ 1.131 and 1.132, provides a mechanism for the submission of evidence to disqualify a disclosure as prior art or otherwise traverse a rejection. An applicant's or patent owner's compliance with § 1.130 means that the applicant or patent owner is entitled to have the evidence considered in determining the patentability of the claim(s) at issue. It does not mean that the applicant or patent owner is entitled as a matter of right to have the rejection of or objection to the claim(s) withdrawn. See Changes to Implement the Patent Business Goals, 65 FR 54603, 54640 (Sept. 8, 2000) (discussing procedural nature of §§ 1.131 and 1.132).

Section 1.130(a)(1) as proposed provides for the situation in which: (1) the disclosure on which the rejection is based was by the inventor or joint inventor; or (2) there was a public disclosure of the subject matter on which the rejection is based by the inventor or a

joint inventor prior to the disclosure of the subject matter on which the rejection is based or the date the patent or application on which the rejection is based was effectively filed.

Section 1.130(a)(2) as proposed provides for the situation in which: (1) the disclosure on which the rejection is based was by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or (2) the subject matter disclosed had been publicly disclosed by a party who obtained the subject matter disclosed directly or indirectly from the inventor prior to the disclosure of the subject matter on which the rejection is based or the date the patent or application on which the rejection is based was effectively filed.

Section 1.130(b) as proposed pertains to affidavits or declarations under § 1.130(a)(1) in the situation in which the disclosure on which the rejection is based was by the inventor or joint inventor. Section 1.130(b) as proposed provides that if the disclosure on which the rejection is based is by the inventor or a joint inventor, the affidavit or declaration under § 1.130(a)(1) must provide a satisfactory showing that the inventor or a joint inventor is in fact the inventor of the subject matter of the disclosure. The applicant or patent owner must provide a satisfactory showing that the inventor or a joint inventor is the actual inventor of the subject matter of the disclosure. See *In re Katz*, 687 F.2d 450, 455 (CCPA 1982). Where the authorship of the reference disclosure includes the inventor or a joint inventor named in the application, 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. See In re DeBaun, 687 F.2d 459, 463 (CCPA 1982). However, a mere statement from the inventor or a joint inventor may not be sufficient where there is evidence to the contrary. See Ex parte Kroger, 218 USPQ 370 (Bd. App. 1982) (rejection affirmed notwithstanding declarations by the alleged actual inventors as to their inventorship in view of a nonapplicant author submitting a letter declaring the nonapplicant author's inventorship). This is similar to the current process for disqualifying a publication as not being by "others" discussed in MPEP § 2132.01, except that 35 U.S.C. 102(b)(1) requires only that the disclosure be by the inventor or a joint inventor.

Section 1.130(c) as proposed pertains to affidavits or declarations under § 1.130(a)(1) in the situation in which the disclosure on which the rejection is based is not by the inventor or a joint inventor, and thus the applicant or patent owner is attempting to overcome the rejection by showing an earlier public disclosure of the subject matter on which the rejection is based by the inventor or a joint inventor. Section 1.130(c) as proposed provides that in this situation the affidavit or declaration must identify and provide the date of the earlier disclosure of the subject matter by the inventor or a joint inventor and provide a satisfactory showing that the inventor or a joint inventor is the inventor of the subject matter of the earlier disclosure. Section 1.130(c) as proposed also provides that if the earlier disclosure was a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication. Section 1.130(c) as proposed further provides that if the earlier disclosure was not a printed publication, the affidavit or

declaration must describe the disclosure with sufficient detail and particularity to determine that the disclosure is a public disclosure of the subject matter on which the rejection is based. The Office needs these details to determine not only whether the inventor is entitled to disqualify the disclosure under 35 U.S.C. 102(b), but also because if the rejection is based upon a U.S. patent application publication or WIPO published application of another application and such other application is also pending before the Office, this prior disclosure may be prior art under 35 U.S.C. 102(a) to the other application and the Office may need this information to avoid granting two patents on the same invention.

Section 1.130(d) as proposed pertains to affidavits or declarations under § 1.130(a)(2) in the situation in which the disclosure on which the rejection is based was by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. Section 1.130(d) as proposed provides that if the disclosure on which the rejection is based is by a party who obtained the subject matter disclosed directly or indirectly from the inventor, an affidavit or declaration under § 1.130(a)(2) (alleging derivation) must provide a satisfactory showing that the inventor or a joint inventor is the inventor of the subject matter of the disclosure and directly or indirectly communicated the subject matter of the disclosure to the party. Specifically, the applicant or patent owner must show that a named inventor actually invented the subject matter of the disclosure. See In re Facius, 408 F.2d 1396, 1407 (CCPA 1969). The applicant or patent owner must also show a direct or indirect communication of the subject matter of the disclosure to the party sufficient to enable one of ordinary skill in the art to make the

subject matter of the claimed invention. See *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1577 (Fed. Cir. 1997). This is similar to the current process for disqualifying a publication as being derived from the inventor discussed in MPEP § 2137.

Section 1.130(e) as proposed pertains to affidavits or declarations under § 1.130(a)(2) in the situation in which the disclosure on which the rejection is based is not by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor, and thus the applicant or patent owner is attempting to overcome the rejection by showing an earlier public disclosure of the subject matter on which the rejection is based by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. Section 1.130(e) as proposed provides that in this situation an affidavit or declaration under § 1.130(a)(2) must identify and provide the date of the earlier disclosure of the subject matter by the party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor and must also provide a satisfactory showing that the inventor or a joint inventor is the inventor of the subject matter of the earlier disclosure and directly or indirectly communicated the subject matter of the disclosure to the party. Section 1.130(e) as proposed also provides that if the earlier disclosure was a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication. Section 1.130(c) as proposed further provides that if the earlier disclosure was not a printed publication, the affidavit or declaration must describe the disclosure with sufficient detail and particularity to determine that the disclosure is a public disclosure of the subject matter on which the rejection is based. This is the same requirement as in § 1.130(c).

Section 1.130 as proposed does not contain a provision that “[o]riginal exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained” (cf. § 1.131(b)), because in some situations an affidavit or declaration under § 1.130 does not necessarily need to be accompanied by such exhibits (e.g., a statement by the inventor may be sufficient). However, in situations where evidence is required, such exhibits must accompany an affidavit or declaration under § 1.130. In addition, an affidavit or declaration under § 1.130 must be accompanied by any exhibits that the applicant or patent owner wishes to rely upon.

Section 1.130(f) as proposed provides that the provisions of § 1.130 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. This provision is because a disclosure made more than one year before the effective filing date of the claimed invention is prior art under 35 U.S.C. 102(a)(1), and may not be disqualified under 35 U.S.C. 102(b)(1). Note that the provisions of § 1.130 are available to establish that a rejection under 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 application 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. As stated previously, if the application or patent was published more than one year before the



effective filing date of the application under examination, the applicant would not be able to remove the reference as prior art under 35 U.S.C. 102(a)(1).

Section 1.130(f) as proposed also provides that the Office may require the applicant to file a petition for a derivation proceeding pursuant to § 42.401 et seq. of this title 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 and the patent or pending application claims an invention that is the same or substantially the same as the applicant's claimed invention. Thus, the Office would not require the applicant to file a petition for a derivation proceeding if the rejection is based upon a disclosure other than a U.S. patent or U.S. patent application publication (such as nonpatent literature or a foreign patent document), and would not require the applicant to file a petition for a derivation proceeding if the rejection is based upon a U.S. patent or U.S. patent application and the patent or pending application did not claim an invention that is the same or substantially the same as the applicant's claimed invention.

Section 1.130(g) as proposed provides that the provisions of § 1.130 apply to applications for patent, and to any patent issuing thereon, that is subject to 35 U.S.C. 102 as amended by the AIA.

Section 1.131: The title of § 1.131 is proposed to be amended to also cover the provisions of current § 1.130.

Section 1.131(a) is proposed to be amended to refer to 35 U.S.C. 102(e) as 35 U.S.C. 102(e) in effect on March 15, 2013.

Section 1.131(b) is proposed to be amended to provide that the showing of facts provided for in § 1.131(b) is applicable to an oath or declaration under § 1.131(a).

Section 1.131(c) is proposed to be added to include the current provisions of § 1.130, but revised to refer to 35 U.S.C. 102(b) as 35 U.S.C. 102(b) in effect on March 15, 2013, and to refer to 35 U.S.C. 104 as 35 U.S.C. 104 in effect on March 15, 2013.

Section 1.131(d) is proposed to be added to provide that the provisions of § 1.131 apply to applications 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 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 a claimed invention that has an effective filing date as defined in 35 U.S.C. 100(i) that is before March 16, 2013.

Section 1.131(e) is proposed to be 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) in effect on March 15, 2013. Section 1.130(g) as proposed provides that the provisions of § 1.130 apply to applications for patent, and to any patent issuing thereon, that is subject to 35

U.S.C. 102 as amended by the AIA. The date of invention is not relevant under the 35 U.S.C. 102 as amended by the AIA. Thus, in an application for patent to which the provisions of § 1.130 apply, and to any patent issuing thereon, a prior art disclosure under 35 U.S.C. 102 as amended by the AIA could not be disqualified or antedated under the provisions of § 1.131 by showing that the inventor previously invented the claimed subject matter.

Sections 1.293 through 1.297: The AIA repeals the provisions of 35 U.S.C. 157 pertaining to statutory invention registrations. Thus, the statutory invention registration provisions of §§ 1.293 through 1.297 are proposed to be removed. The Office would also amend the rules of practice (e.g., §§ 1.17, 1.53, 1.84, 1.103, and 1.104) to delete any reference to a statutory invention registration.

Section 1.321: Section 1.321(d) is proposed to be amended to change 35 U.S.C. 103(c) to 35 U.S.C. 102(c) to be consistent with the changes to 35 U.S.C. 102 and 103 as amended by the AIA.

### **Rulemaking Considerations:**

**A. Administrative Procedure Act:** The changes being proposed in this notice do not change the substantive criteria of patentability. These proposed changes involve rules of agency practice and procedure and/or interpretive rules. See *Bachow Commc'ns Inc. v. FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are

procedural under the Administrative Procedure Act); Inova Alexandria Hosp. v. Shalala, 244 F.3d 342, 350 (4<sup>th</sup> Cir. 2001) (rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims); Nat'l Org. of Veterans' Advocates v. Sec'y of Veterans Affairs, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (rule that clarifies interpretation of a statute is interpretive).

Accordingly, prior notice and opportunity for public comment are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law). See Cooper Techs. Co. v. Dudas, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice”) (quoting 5 U.S.C. 553(b)(A)). The Office, however, is publishing these proposed changes as it seeks the benefit of the public’s views on the Office’s proposed implementation of these provisions of the AIA.

**B. Regulatory Flexibility Act:** As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 or any other law, neither a regulatory flexibility analysis nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601 et seq.) is required. See 5 U.S.C. 603.

Nevertheless, for the reasons set forth herein, the Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that changes proposed in this notice

will not have a significant economic impact on a substantial number of small entities. See 5 U.S.C. 605(b). As discussed previously, the Office is proposing the following changes to address the examination issues raised by the changes in section 3 of the AIA.

The Office is providing for the submission of affidavits or declarations showing that: (1) a disclosure upon which a claim rejection is based was by the inventor or joint inventor or by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or (2) there was a prior public disclosure 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 of an application. The requirements of these proposed provisions are comparable to the current requirements for affidavits and declarations under 37 CFR 1.131 and 1.132 for an applicant to show that a prior art disclosure is the applicant's own work (see case law cited in MPEP § 2132.01) or that a disclosure was derived from the applicant (see case law cited in MPEP § 2137). In addition, the changes proposed in this notice would not result in additional small entities being subject to the need to submit such an affidavit or declaration.

The Office is also proposing to require that the certified copy of the foreign application be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. An applicant is currently required to file the certified copy of the foreign application when deemed necessary by the examiner, but no later than the date the patent is granted (37 CFR 1.55(a)). The proposed time period of four months from the actual filing date of the

application or sixteen months from the filing date of the prior foreign application should not have a significant economic impact as sixteen months from the filing date of the prior foreign application is the international norm for when the certified copy of the foreign application needs to be filed in an application (PCT Rule 17). Based upon the data in the Office's Patent Application Locating and Monitoring (PALM) system, 354,248 (98,902 small entity) nonprovisional applications were filed in FY 2011. Of these, 69,733 (7,943 small entity) nonprovisional applications claimed the benefit of a foreign priority application, and 65,900 (15,031 small entity) nonprovisional applications resulted from the entry of an international application into the national stage.

The Office is also proposing the following requirements for nonprovisional applications filed on or after March 16, 2013, that claim the benefit of the filing date of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013: (1) if such a nonprovisional application contains at any time a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage in an international application, sixteen months from the filing date of the prior-filed application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the application; and (2) if such a nonprovisional application does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign, provisional, or nonprovisional application, the applicant must provide a

statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage in an international application, or sixteen months from the filing date of the prior-filed application.

Based upon the data in the Office's PALM system, of the 354,248 (98,902 small entity) nonprovisional applications filed in FY 2011, 11,557 (6,833 small entity) nonprovisional applications were identified as continuation-in-part applications, 47,380 (12,444 small entity) nonprovisional applications were identified as continuation applications, 21,943 (4,934 small entity) nonprovisional applications were identified as divisional applications, and 55,492 (27,367 small entity) nonprovisional applications claimed the benefit of provisional application. As discussed above, 69,733 (7,943 small entity) nonprovisional applications claimed the benefit of a foreign priority application, and 65,900 (15,031 small entity) nonprovisional applications resulted from the entry of an international application into the national stage. The Office's experience is that the majority of nonprovisional applications that claim the benefit of the filing date of a foreign, provisional, or nonprovisional application do not disclose or claim subject matter not also disclosed in the foreign, provisional, or nonprovisional application, but the Office generally makes such determinations only when necessary to the examination of the nonprovisional application. See, e.g., MPEP § 201.08 ("Unless the filing date of the earlier nonprovisional application is actually needed, for example, in the case of an interference or to overcome a reference, there is no need for the Office to make a determination as to whether the requirement of 35 U.S.C. 120, that the earlier

nonprovisional application discloses the invention of the second application in the manner provided by the first paragraph of 35 U.S.C. 112, is met and whether a substantial portion of all of the earlier nonprovisional application is repeated in the second application in a continuation-in-part situation”). In any event, Office staff with experience and expertise in a wide range of patent prosecution matters as patent practitioners estimate that this will require, on average, an additional two hours for a practitioner who drafted the later-filed application (including the claims) and is familiar with the prior foreign, provisional, or nonprovisional application.

Accordingly, the changes proposed in this notice will not have a significant economic impact on a substantial number of small entities.

**C. Executive Order 12866 (Regulatory Planning and Review):** This rulemaking has been determined to be significant for purposes of Executive Order 12866 (Sept. 30, 1993).

**D. Executive Order 13563 (Improving Regulation and Regulatory Review):** The Office has complied with Executive Order 13563. Specifically, the Office has, to the extent feasible and applicable: (1) made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and



perspectives among experts in relevant disciplines, affected stakeholders in the private sector, and the public as a whole, and provided on-line access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

**E. Executive Order 13132 (Federalism):** This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

**F. Executive Order 13175 (Tribal Consultation):** This rulemaking will not: (1) have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal governments; or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (Nov. 6, 2000).

**G. Executive Order 13211 (Energy Effects):** This rulemaking is not a significant energy action under Executive Order 13211 because this rulemaking is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

**H. Executive Order 12988 (Civil Justice Reform):** This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (Feb. 5, 1996).

**I. Executive Order 13045 (Protection of Children):** This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

**J. Executive Order 12630 (Taking of Private Property):** This rulemaking will not effect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

**K. Congressional Review Act:** Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 et seq.), prior to issuing any final rule, the United States Patent and Trademark Office will submit a report containing the final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this notice are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with

foreign-based enterprises in domestic and export markets. Therefore, this notice is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2).

**L. Unfunded Mandates Reform Act of 1995:** The changes set forth in this notice do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 et seq.

**M. National Environmental Policy Act:** This rulemaking will not have any effect on the quality of the environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. See 42 U.S.C. 4321 et seq.

**N. National Technology Transfer and Advancement Act:** The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rulemaking does not contain provisions which involve the use of technical standards.

**O. Paperwork Reduction Act:** The Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.) requires that the Office consider the impact of paperwork and other information

collection burdens imposed on the public. This rulemaking involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501-3549). The collection of information involved in this notice has been submitted to OMB under OMB control number 0651-00xx. The collection of information submitted to OMB under OMB control number 0651-00xx also includes information collections (e.g., affidavits and declarations under 37 CFR 1.130, 1.131, and 1.132) previously approved and currently being reviewed under OMB control number 0651-0031. The proposed collection will be available at OMB's Information Collection Review Web site ([www.reginfo.gov/public/do/PRAMain](http://www.reginfo.gov/public/do/PRAMain)).

Title of Collection: Matters Related to First Inventor to File.

OMB Control Number: 0651-00xx.

Needs and Uses: This information collection is necessary so that patent applicants and/or patentees may: (1) provide a statement if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013; (2) provide a statement if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013, does not contain a claim to a

claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign, provisional, or nonprovisional application; (3) identify the inventor, and ownership on the effective filing date, of each claimed invention in an application or patent with more than one named inventor, when necessary for purposes of an Office proceeding; and (4) show that a disclosure was by the inventor or joint inventor, or was by a party who obtained the subject matter from the inventor or a joint inventor, or that there was a prior public disclosure by the inventor or a joint inventor, or by a party who obtained the subject matter from the inventor or a joint inventor.

The Office will use the statement that a nonprovisional application filed on or after March 16, 2013, that claims the benefit of the filing date of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013, contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, to readily determine whether the nonprovisional application is subject to the changes to 35 U.S.C. 102 and 103 in the AIA. The Office will also use the statement that a nonprovisional application filed on or after March 16, 2013, that claims the benefit of the filing date of a foreign, provisional, or nonprovisional application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign, provisional, or nonprovisional application (or lack of such a statement) to readily determine whether the nonprovisional application is subject to the changes to 35 U.S.C. 102 and 103 in the AIA. The Office will use the identification of the inventor,

and ownership on the effective filing date, when it is necessary to determine whether a U.S. patent or U.S. patent application publication resulting from another nonprovisional application qualifies as prior art under 35 U.S.C. 102(a)(2). The Office will use information concerning whether a disclosure was by the inventor or joint inventor, or was by a party who obtained the subject matter from the inventor or a joint inventor, or that there was a prior public disclosure by the inventor or a joint inventor, or by a party who obtained the subject matter from the inventor or a joint inventor, to determine whether the disclosure qualifies as prior art under 35 U.S.C. 102(a)(1) or (a)(2).

Method of Collection: By mail, facsimile, hand delivery, or electronically to the Office.

Affected Public: Individuals or households; businesses or other for-profits; and not-for-profit institutions.

Estimated Number of Respondents: 189,150 responses per year.

Estimated Time Per Response: The Office estimates that the responses in this collection

will take the public from 1 to 10 hours. Specifically, the Office estimates that:

(1) preparing an affidavit or declaration under 37 CFR 1.130, 1.131, or 1.132 will require, on average, 10 hours; (2) identifying under 37 CFR 1.55(a)(4), 1.78(a)(3), or 1.78(c)(2) whether there is any claim or subject matter not disclosed in the prior foreign, provisional, or nonprovisional application will require, on average, 2 hours; and

(3) identifying under 37 CFR 1.110 inventorship and ownership of the subject matter of claims will require, on average, 2 hours.

Estimated Total Annual Respondent Burden Hours: 778,300 hours per year.

Estimated Total Annual Respondent Cost Burden: \$288,749,300 per year.

The Office is soliciting comments to: (1) evaluate whether the proposed information requirement is necessary for the proper performance of the functions of the Office, including whether the information will have practical utility; (2) evaluate the accuracy of the Office's estimate of the burden; (3) enhance the quality, utility, and clarity of the information to be collected; and (4) minimize the burden of collecting the information on those who are to respond, including by using appropriate automated, electronic, mechanical, or other technological collection techniques or other forms of information technology.

Please send comments on or before [Insert date 60 days after publication in the FEDERAL REGISTER] to Mail Stop Comments--Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, marked to the attention of Raul Tamayo, Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy. Comments should also be submitted to the Office of Information and Regulatory Affairs, Office of Management and Budget, New

Executive Office Building, Room 10202, 725 17th Street, N.W., Washington, DC 20503,  
Attention: Desk Officer for the Patent and Trademark Office.

Notwithstanding any other provision of law, no person is required to respond to, nor shall a person be subject to a penalty for failure to comply with, a collection of information subject to the requirements of the Paperwork Reduction Act, unless that collection of information displays a currently valid OMB control number.

## **List of Subjects**

### **37 CFR Part 1**

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and record keeping requirements, Small Businesses.

For the reasons set forth in the preamble, 37 CFR part 1 is proposed to be amended as follows:

## **PART 1 - RULES OF PRACTICE IN PATENT CASES**

1. The authority citation for 37 CFR Part 1 continues to read as follows:

**Authority:** 35 U.S.C. 2(b)(2).



2. Section 1.9 is amended by adding paragraphs (d), (e) and (f) to read as follows:

**§ 1.9 Definitions.**

\* \* \* \* \*

(d)(1) The term inventor or inventorship as used in this chapter means the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.

(2) The term joint inventor or coinventor as used in this chapter means any one of the individuals who invented or discovered the subject matter of a joint invention.

(e) The term joint research agreement as used in this chapter means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

(f) The term claimed invention as used in this chapter means the subject matter defined by a claim in a patent or an application for a patent.

\* \* \* \* \*

3. Section 1.53 is amended by revising paragraph (j) to read as follows:

**§ 1.53 Application number, filing date, and completion of application.**

\* \* \* \* \*

(j) Filing date of international application. The filing date of an international application designating the United States of America is treated as the filing date in the United States of America under PCT Article 11(3).

4. Section 1.55 is amended by revising paragraphs (a), (c), and (d), and by adding paragraphs (e) and (f) to read as follows:

**§ 1.55 Claim for foreign priority.**

(a) An applicant in a nonprovisional application may claim the benefit of the filing date of one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and (f), 172, and 365(a) and (b).

(1) The nonprovisional application must be filed not later than twelve months after the date on which the foreign application was filed. This twelve-month period is subject to 35 U.S.C. 21(b) and § 1.7(a).

(2) In an original application filed under 35 U.S.C. 111(a), the claim for priority as well as a certified copy of the foreign application must both be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. The claim for priority must be presented in an application data sheet (§ 1.76(b)(6)). The claim must identify the foreign application for which priority is claimed, as well as any foreign application for the same subject matter having a filing date before that of the application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day,

month, and year of its filing. The time periods in this paragraph do not apply in an application under 35 U.S.C. 111(a) if the application is:

- (i) A design application; or
- (ii) An application filed before November 29, 2000.

(3) In an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made and a certified copy of the foreign application filed within the time limit set forth in the PCT and the Regulations under the PCT.

(4) If a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior foreign application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the application. In addition, if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign application, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national

stage as set forth in § 1.491 in an international application, or sixteen months from the filing date of the prior foreign application.

\* \* \* \* \*

(c) Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a) through (d) or (f), or 365(a) or (b), not presented in an application data sheet (§ 1.76(b)(6)) within the time period provided by paragraph (a)(2) of this section is considered to have been waived. If a claim for priority under 35 U.S.C. 119(a) through (d) or (f), or 365(a) or (b) is presented after the time period provided by paragraph (a)(2) of this section, the claim may be accepted if the claim identifying the prior foreign application by specifying its application number, country (or intellectual property authority), and the day, month, and year of its filing was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a) through (d) or (f), or 365(a) or (b), must be accompanied by:

(1) The claim under 35 U.S.C. 119(a) through (d) or (f), or 365(a) or (b), and this section to the prior foreign application, unless previously submitted;

(2) A certified copy of the foreign application, unless previously submitted;

(3) The surcharge set forth in § 1.17(t); and

(4) A statement that the entire delay between the date the claim was due under paragraph (a) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(d)(1) The requirement in this section for the certified copy of the foreign application will be considered satisfied if:

(i) The applicant files a request, in a separate document, that the Office obtain a copy of the foreign application from a foreign intellectual property office participating with the Office in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office (see § 1.14 (h)(1)));

(ii) The foreign application is identified in an application data sheet (§ 1.76(a)(6));  
and

(iii) The copy of the foreign application is received by the Office within the period set forth in paragraph (a) of this section or by such later time as may be set by the Office.

(2) If the foreign application was filed at a foreign intellectual property office that is not participating with the Office in a priority document exchange agreement, but a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office, the request under paragraph (d)(1)(i) of this section must identify the participating foreign intellectual property office and the application number of the subsequent application in which a copy of the foreign application was filed.

(e)(1) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed within the pendency of the application and before the patent is granted. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.

(2) The Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than provided in paragraph (a) or (e)(1) of this section:

(i) When the application is involved in an interference (see § 41.202 of this title) or derivation (see part 42 of this title) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When deemed necessary by the examiner.

(3) An English language translation of a non-English language foreign application is not required except:

(i) When the application is involved in an interference (see § 41.202 of this title) or derivation (see part 42 of this title) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When specifically required by the examiner.

(4) If an English language translation of a non-English language foreign application is required, it must be filed together with a statement that the translation of the certified copy is accurate.

(f) The time periods set forth in this section are not extendable.

5. Section 1.71 is amended by revising paragraph (g)(1) to read as follows:

**§ 1.71 Detailed description and specification of the invention.**

\* \* \* \* \*

(g)(1) The specification may disclose or be amended to disclose the names of the parties to a joint research agreement (35 U.S.C. 102(c)(3)).

\* \* \* \* \*

6. Section 1.77 is amended by redesignating paragraphs (b)(6) through (b)(12) as paragraphs (b)(7) through (b)(13) and adding a new paragraph (b)(6) to read as follows:

**§ 1.77 Arrangement of application elements.**

\* \* \* \* \*

(b) \* \* \*

(6) Statement regarding prior disclosures by the inventor or a joint inventor.

\* \* \* \* \*

7. Section 1.78 is revised to read as follows:

**§ 1.78 Claiming benefit of earlier filing date and cross-references to other applications.**

(a) Claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application. A nonprovisional application, other than for a design patent, or an international application designating the United States of America may claim the benefit of one or more prior-filed provisional applications under the conditions set forth in 35 U.S.C. 119(e) and paragraph (a) of this section.

(1) The nonprovisional application or international application designating the United States of America must be filed not later than twelve months after the date on which the provisional application was filed. This twelve-month period is subject to 35 U.S.C. 21(b) and § 1.7(a).

(2) Each prior-filed provisional application must name as the inventor or a joint inventor an inventor named in the later-filed application. In addition, each prior-filed provisional application must be entitled to a filing date as set forth in § 1.53(c) and the basic filing fee set forth in § 1.16(d) must have been paid for such provisional application within the time period set forth in § 1.53(g).

(3) Any nonprovisional application or international application designating the United States of America that claims the benefit of one or more prior-filed provisional applications must contain, or be amended to contain, a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number). If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)). If a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a provisional application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior-filed provisional application, or the date that a first claim to a claimed



invention that has an effective filing date on or after March 16, 2013, is presented in the application. In addition, if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a provisional application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the provisional application, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, or sixteen months from the filing date of the prior-filed provisional application.

(4) The reference required by paragraph (a)(3) of this section must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed provisional application. If the later-filed application is a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed provisional application. Except as provided in paragraph (b) of this section, failure to timely submit the reference is considered a waiver of any benefit under 35 U.S.C. 119(e) of the prior-filed provisional application. The time periods in this paragraph do not apply if the later-filed application is:

(i) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or

(ii) An international application filed under 35 U.S.C. 363 before November 29, 2000.

(5) If the prior-filed provisional application was filed in a language other than English and both an English-language translation of the prior-filed provisional application and a statement that the translation is accurate were not previously filed in the prior-filed provisional application, applicant will be notified and given a period of time within which to file the translation and the statement in the prior-filed provisional application. If the notice is mailed in a pending nonprovisional application, a timely reply to such a notice must include either a confirmation that the translation and statement were filed in the provisional application or an application data sheet withdrawing the benefit claim to avoid abandonment of the nonprovisional application. The translation and statement may be filed in the provisional application, even if the provisional application has become abandoned.

(b) Delayed claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application. If the reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(4) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application may be accepted if submitted during the pendency of the later-filed application and if the reference identifying the prior-filed application by provisional application number was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application must be accompanied by:

(1) The reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section to the prior-filed provisional application, unless previously submitted;

(2) The surcharge set forth in § 1.17(t); and

(3) A statement that the entire delay between the date the claim was due under paragraph (a)(4) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(c) Claims under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional or international application. A nonprovisional application (including an international application entering the national stage under 35 U.S.C. 371) may claim the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America under the conditions set forth in 35 U.S.C. 120 and paragraph (c) of this section.

(1) Each prior-filed application must name as the inventor or a joint inventor an inventor named in the later-filed application. In addition, each prior-filed application must either be:

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or

(ii) A nonprovisional application under 35 U.S.C. 111(a) that is entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) for which the basic filing fee set forth in § 1.16 has been paid within the pendency of the application.

(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application, or international application designating the United States of

America, that claims the benefit of one or more prior-filed nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date. If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)). The reference must also identify the relationship of the applications, namely, whether the later-filed application is a continuation, divisional, or continuation-in-part of the prior-filed nonprovisional application or international application. If a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a nonprovisional application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior-filed nonprovisional application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the application. In addition, if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a nonprovisional application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the prior-filed nonprovisional application, the applicant must provide a

statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, or sixteen months from the filing date of the prior-filed nonprovisional application.

(3) The reference required by 35 U.S.C. 120 and paragraph (c)(2) of this section must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. Except as provided in paragraph (d) of this section, failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (c)(2) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to the prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

- (i) An application for a design patent;
- (ii) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or
- (iii) An international application filed under 35 U.S.C. 363 before November 29, 2000.

(4) The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number.

(5) Cross-references to other related applications may be made when appropriate (see § 1.14), but cross-references to applications for which a benefit is not claimed under title 35, United States Code, must not be included in an application data sheet (§ 1.76(b)(5)).

(d) Delayed claims under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional application or international application. If the reference required by 35 U.S.C. 120 and paragraph (c)(2) of this section is presented after the time period provided by paragraph (c)(3) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

(1) The reference required by 35 U.S.C. 120 and paragraph (c)(2) of this section to the prior-filed application, unless previously submitted;

(2) The surcharge set forth in § 1.17(t); and

(3) A statement that the entire delay between the date the claim was due under paragraph (c)(3) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(e) Applications containing conflicting claims. Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

(f) Applications or patents under reexamination naming different inventors and containing patentably indistinct claims. If an application or a patent under reexamination and at least one other application naming different inventors are owned by the same person and contain conflicting claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to the same person on the effective filing date of the later claimed invention, the Office may require the assignee to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person on the effective filing date of the later claimed invention. Even if the claimed inventions were commonly owned, or subject to an obligation of assignment to the same person, on the effective filing date of the later claimed invention, the conflicting claims may be rejected under the doctrine of double patenting in view of such commonly owned or assigned applications or patents under reexamination.

(g) Time periods not extendable. The time periods set forth in this section are not extendable.

8. Section 1.104 is amended by revising paragraphs (c)(4) and (c)(5) and adding a new paragraph (c)(6) to read as follows:

**§ 1.104 Nature of examination.**

(c) \* \* \*

(4)(i) Subject matter that qualifies as prior art under 35 U.S.C. 102(a)(2) and a claimed invention will be treated as commonly owned for purposes of 35 U.S.C. 102(b)(2)(C) if the applicant provides a statement that the prior art and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

(ii) Subject matter that qualifies as prior art under 35 U.S.C. 102(a)(2) and a claimed invention will be treated as commonly owned for purposes of 35 U.S.C. 102(b)(2)(C) on the basis of a joint research agreement under 35 U.S.C. 102(c) if:

(A) The applicant provides a statement that the prior art was developed and the claimed invention was made by or on behalf of one or more parties to a joint research agreement, within the meaning of 35 U.S.C. 100(h) and § 1.9(e), that was in effect on or before the effective filing date of the claimed invention, and the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(B) The application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.



(5)(i) Subject matter which qualifies as prior art under 35 U.S.C. 102(e), (f), or (g) in effect prior to March 16, 2013, and a claimed invention in an application or a patent granted on or after December 10, 2004, will be treated as commonly owned for purposes of 35 U.S.C. 103(c) in effect prior to March 16, 2013, if the applicant provides a statement that the prior art and the claimed invention, at the time the claimed invention was made, were owned by the same person or subject to an obligation of assignment to the same person.

(ii) Subject matter which qualifies as prior art under 35 U.S.C. 102(e), (f), or (g) in effect prior to March 16, 2013, and a claimed invention in an application or a patent granted on or after December 10, 2004, will be treated as commonly owned for purposes of 35 U.S.C. 103(c) in effect prior to March 16, 2013, on the basis of a joint research agreement under 35 U.S.C. 103(c)(2) in effect prior to March 16, 2013 if:

(A) The applicant provides a statement to the effect that the prior art and the claimed invention were made by or on behalf of the parties to a joint research agreement, within the meaning of 35 U.S.C. 100(h) and § 1.9(e), which was in effect on or before the date the claimed invention was made, and that the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(B) The application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(6) Patents issued prior to December 10, 2004, from applications filed prior to November 29, 1999, are subject to 35 U.S.C. 103(c) in effect on November 28, 1999.

\* \* \* \* \*

9. Section 1.109 is added to read as follows:

**§ 1.109 Effective filing date of a claimed invention.**

(a) The effective filing date for a claimed invention in a patent or application for patent, other than in a reissue application or reissued patent, is the earliest of:

(1) The actual filing date of the patent or the application for the patent containing a claim to the invention; or

(2) The filing date of the earliest application for which the patent or application is entitled, as to such invention, to priority to or the benefit of an earlier filing date under 35 USC 119, 120, 121, or 365.

(b) The effective filing date for a claimed invention in a reissue application or a reissued patent is determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought.

10. Section 1.110 is revised to read as follows:

**§ 1.110 Inventorship and ownership of the subject matter of individual claims.**

When more than one inventor is named in an application or patent, the Office may require an applicant or patentee to identify the inventor, and ownership on the effective filing date, of each claimed invention in the application or patent, when necessary for purposes of an Office proceeding.

11. Section 1.130 is revised to read as follows:

**§ 1.130 Affidavit or declaration of attribution, prior disclosure, or derivation under the Leahy-Smith America Invents Act.**

(a) 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 establish that:

(1) The disclosure on which the rejection is based was by the inventor or joint inventor, the subject matter disclosed had been publicly disclosed by the inventor or a joint inventor before the disclosure of the subject matter on which the rejection is based, or the subject matter disclosed had been publicly disclosed by the inventor or a joint inventor before the date the subject matter in the patent or application on which the rejection is based was effectively filed; or

(2) The disclosure on which the rejection is based was by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor, the subject matter disclosed had been publicly disclosed by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor before the disclosure of the subject matter on which the rejection is based, or the subject matter disclosed had been publicly disclosed by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor before the date the subject matter in the patent or application on which the rejection is based was effectively filed.

(b) If the disclosure on which the rejection is based is by the inventor or a joint inventor, the affidavit or declaration under paragraph (a)(1) of this section must provide a satisfactory showing that the inventor or a joint inventor is in fact the inventor of the subject matter of the disclosure.

(c) If the disclosure on which the rejection is based is not by the inventor or a joint inventor, the affidavit or declaration under paragraph (a)(1) of this section must identify and provide the date of the earlier disclosure of the subject matter by the inventor or a joint inventor and provide a satisfactory showing that the inventor or a joint inventor is the inventor of the subject matter of the earlier disclosure. If the earlier disclosure was a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication. If the earlier disclosure was not a printed publication, the affidavit or declaration must describe the disclosure with sufficient detail and particularity to determine that the disclosure is a public disclosure of the subject matter on which the rejection is based.

(d) If the disclosure on which the rejection is based is by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor, an affidavit or declaration under paragraph (a)(2) of this section must provide a satisfactory showing that the inventor or a joint inventor is the inventor of the subject matter of the disclosure and directly or indirectly communicated the subject matter of the disclosure to the party.

(e) If the disclosure on which the rejection is based is not by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor, an affidavit or declaration under paragraph (a)(2) of this section must identify and provide

the date of the earlier disclosure of the subject matter by the party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor and also provide a satisfactory showing that the inventor or a joint inventor is the inventor of the subject matter of the earlier disclosure and directly or indirectly communicated the subject matter of the disclosure to the party. If the earlier disclosure was a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication. If the earlier disclosure was not a printed publication, the affidavit or declaration must describe the disclosure with sufficient detail and particularity to determine that the disclosure is a public disclosure of the subject matter on which the rejection is based.

(f) 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 Office may require the applicant to file a petition for a derivation proceeding pursuant to § 42.401 et seq. of this title 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 and the patent or pending application claims an invention that is the same or substantially the same as the applicant's claimed invention.

(g) The provisions of this section apply to applications for patent, and to any patent issuing thereon, that contain, 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.

12. Section 1.131 is revised to read as follows:

**§ 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 1.47, 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) in effect on March 15, 2013. Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. 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 to another or others which claims the

same patentable invention 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.

(b) The showing of facts for an oath or declaration under paragraph (a) of this section shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

(c) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 on a U.S. patent or U.S. patent application publication which is not prior art under 35 U.S.C. 102(b) 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 in effect on March 15, 2013.

(d) The provisions of this section apply to applications 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 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 a claimed invention that has an effective filing date as defined in 35 U.S.C. 100(i) that is before March 16, 2013.

(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) in effect on March 15, 2013.

13. Sections 1.293 through 1.297 are removed.

14. Section 1.321 is amended by revising the introductory text of paragraph (d) to read as follows:

**§ 1.321 Statutory disclaimers, including terminal disclaimers.**

\* \* \* \* \*

(d) A terminal disclaimer, when filed in a patent application or in a reexamination proceeding to obviate double patenting based upon a patent or application that is not



commonly owned but resulted from activities undertaken within the scope of a joint research agreement under 35 U.S.C. 102(c), must:

\* \* \* \* \*

Date: July 17, 2012

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David J. Kappos  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office

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