

**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:** Final rule.

**SUMMARY:** The Leahy-Smith America Invents Act (AIA) amends the patent laws pertaining to the conditions of patentability to convert the U.S. patent system from a “first to invent” system to a “first inventor to file” system; treats U.S. patents and U.S. patent application publications as prior art as of their earliest effective U.S., 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 United States Patent and Trademark Office (Office or USPTO) is revising the rules of practice in patent cases for consistency with, and to address the examination issues raised by, the changes in section 3 of the AIA.

**DATES:** Effective date: The changes in this final rule are effective on March 16, 2013.

Applicability date: The changes to 37 CFR 1.55 and 1.78 apply to any application filed under 35 U.S.C. 111 or 363 on or after March 16, 2013. The provisions of 1.17 and 37 CFR 1.293 through 1.297 as in effect on March 15, 2013, apply to any request for a statutory invention registration filed prior to March 16, 2013. New 37 CFR 1.109 applies to any application for patent, and to any patent issuing thereon, 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, and to any application for patent, and to any patent issuing thereon, that contains, or contained at any time, 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.

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electronic mail message (linda.therkorn@uspto.gov)), of the 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 U.S. 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 United States 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. This final rule revises the rules of practice in title 37 of the Code of Federal Regulations (CFR) for consistency with, and to address the examination issues raised by, the changes in section 3 of the AIA.

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 sections 2121 through 2146 (8<sup>th</sup> ed. 2001) (Rev. 9, Aug. 2012) (MPEP). The Office is also issuing guidelines and will be training the Patent Examining Corps on how the

changes to 35 U.S.C. 102 and 103 in section 3 of the AIA impact examination procedure and the provisions of the MPEP pertaining to 35 U.S.C. 102 and 103.

Summary of Major Provisions: The Office is specifically adopting the following changes:

The Office is adding definitions provided in the AIA to 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 a joint inventor or by another 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. In response to public comment, the Office has provided a more flexible approach for submission of an affidavit or declaration with evidence of a prior public disclosure. In response to similar comments regarding the prior public disclosure exception provisions, the Office wants to highlight that there is no requirement that the mode of disclosure by an inventor or joint inventor be the same as the mode of disclosure of an intervening disclosure (e.g., inventor discloses his invention at a trade show and the intervening disclosure is in a peer-reviewed journal), as explained in more detail in the examination guidelines.

Additionally, there is no requirement that the disclosure by the inventor or a joint inventor be a verbatim or ipsissimis verbis disclosure of an intervening disclosure in

order for the exception based on a prior public disclosure of subject matter by the inventor or a joint inventor to apply. The guidelines also clarify that the exception applies to subject matter of the intervening disclosure that is simply a more general description of the subject matter previously publicly disclosed by the inventor or a joint inventor.

The Office is providing 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 or an interim copy of the foreign application be filed within the later of four months from the actual filing date of the application filed under 35 U.S.C. 111(a) or sixteen months from the filing date of the prior foreign application. This requirement does not apply if: (1) the foreign application was filed in a foreign intellectual property office participating with the Office in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office); or (2) a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy, and the applicant timely requests in a separate document that the Office retrieve such copy from the participating intellectual property office. The priority document exchange program provides for the electronic transmission of priority documents to and from participating foreign Intellectual Property Offices (if applicant files a request and an authorization) without payment of a fee. The current participating offices are the European Patent Office (EPO), the Japan Patent Office

(JPO), the Korean Intellectual Property Office (KIPO), and the World Intellectual Property Organization (WIPO).

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

Finally, the Office is adopting additional requirements for nonprovisional applications filed on or after March 16, 2013, that claim priority to or the benefit of the filing date of an earlier application (i.e., foreign, provisional, or nonprovisional application, or international application designating the United States of America) that was filed prior to March 16, 2013. If such a nonprovisional application 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 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. This procedure 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 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 (35 U.S.C. 102(a)(1)); 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 (35 U.S.C. 102(a)(2)). See 125 Stat. at 285-86. The publication of an international application designating the United States of America 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: (A) 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 (35 U.S.C. 102(b)(1)(A)); or (B) 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

(35 U.S.C. 102(b)(1)(B)). 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: (A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor (35 U.S.C. 102(b)(2)(A)); (B) 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 (35 U.S.C. 102(b)(2)(B)); or (C) 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 (35 U.S.C. 102(b)(2)(C)). 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 under 35 U.S.C. 102(a)(2). 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).

AIA 35 U.S.C. 103 provides 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. AIA 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 has implemented the patent derivation proceedings provided for in the AIA in a separate rulemaking. See Changes To Implement Derivation Proceedings, 77 FR 56068 (Sept. 11, 2012). 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), 287, 305, 363, 374, and 375(a). See 125 Stat. at 287-88, and 290-91.

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

The AIA also provides that the provisions of 35 U.S.C. 102(g), 135, and 291 as 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.

**General Discussion of the Changes from Proposed Rules:** The Office published a notice of proposed rulemaking and a notice of proposed examination guidelines on July 26, 2012, to implement the first inventor to file provisions of section 3 of the AIA. See Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act, 77 FR 43742 (July 26, 2012) (notice of proposed rulemaking), and Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act, 77 FR 43759 (July 26, 2012) (notice of proposed examination guidelines). The Office also conducted a roundtable discussion with the public on September 6, 2012, to obtain public input from organizations and individuals on issues relating to the Office's proposed implementation of the first inventor to file provisions of the AIA. See Notice of Roundtable on the Implementation of the First Inventor To File Provisions of the Leahy-Smith America Invents Act, 77 FR 49427 (Aug. 16, 2012). The Office also conducted a number of roadshow presentations in September of 2012 that included a discussion of the first inventor to file provisions of the AIA. In

view of the input from the public, the Office is making the following changes to the proposed rules of practice pertaining to the first inventor to file provisions in section 3 of the AIA in this final rule:

Changes to the Time Period for Submitting a Certified Copy of the Foreign Priority

Application: The Office proposed 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. See Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act, 77 FR at 43743, 43745, and 43754. The Office received a number of comments indicating that the Office should consider alternative means of ensuring that a copy of any priority application is available. The Office is requiring in this final rule that a 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, but is also providing that this requirement does not apply if: (1) the priority application was filed in a participating foreign intellectual property office, or if a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy, and the Office either receives a copy of the foreign application from the participating foreign intellectual property office or a certified copy of the foreign application within the pendency of the application and before the patent is granted; or (2) the applicant provides an interim copy of the original foreign 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, and files a certified copy of the foreign application within the pendency of the application and before the patent is granted. The Office is additionally providing a “good cause” exception in the rule for a belated certified copy of the foreign application.

Changes To the Statements Required For Nonprovisional Applications Claiming Priority to or the Benefit of an Application filed Prior to March 16, 2013: The Office proposed two requirements for nonprovisional applications filed on or after March 16, 2013, that claim priority to or the benefit of the filing date of an earlier application (i.e., foreign, provisional, nonprovisional application, or international application designating the United States of America) that was filed prior to March 16, 2013 (transition application). First, the Office proposed to require that if a transition application 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 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. See Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act, 77 FR at 43743, 43745, 43747-48, and 43755-57. Second, the Office proposed that if a transition 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 prior-filed foreign, provisional,

nonprovisional application, or international application designating the United States of America, the applicant must provide a statement that the later filed application includes subject matter not disclosed in the prior-filed foreign, provisional, nonprovisional application, or international application designating the United States of America 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. See id. The Office received a number of comments expressing various concerns with a requirement that an applicant determine the effective filing date of the claims in his or her application, and questioning the need for any such statement in an application that never contained a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

The Office is providing in this final rule that a statement is required only if a transition application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013. Thus, no statement is required if a transition application discloses subject matter not also disclosed in the prior-filed foreign, provisional, nonprovisional application, or international application designating the United States of America but does not ever contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013. The Office is also providing that an applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated as having a duty of disclosure with respect to the application that the transition application does not, and did not at any time, contain a claim to a claimed invention that has an

effective filing date on or after March 16, 2013. Thus, an applicant in this situation is not required to conduct any additional investigation or analysis to determine the effective filing date of the claims in their applications.

Changes To Affidavits or Declarations Showing a Prior Disclosure by an Inventor or Another Who Obtained the Subject Matter From an Inventor: The Office proposed setting out the standard for a successful affidavit or declaration where the disclosure is the inventor's own work (i.e., a satisfactory showing that the inventor or a joint inventor is in fact the inventor of the subject matter of the disclosure) and where the disclosure was by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor (i.e., showing that the inventor or a joint inventor is the inventor of the subject matter disclosed and directly or indirectly communicated the subject matter disclosed to another) in the rules of practice. See Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act, 77 FR at 43743, 43749-51, and 43758-59. The Office also proposed to require the applicant to file a petition for a derivation proceeding if a 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. See Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act, 77 FR at 43751 and 43759. The Office received a number of comments suggesting that a procedural provision should not set out the standard for a successful affidavit or declaration and suggesting that the Office should not require an applicant to file a petition



for a derivation proceeding. The Office is revising the provision in this final rule to simply specify: (1) when an affidavit or declaration of attribution or prior public disclosure may be used to disqualify a disclosure as prior art; and (2) the procedural requirements for such an affidavit or declaration. The Office is also replacing the provision that the Office may require the applicant to file a petition for a derivation proceeding with a provision indicating that such an affidavit or declaration may not be available to overcome a rejection when the affidavit or declaration contends that an inventor named in the U.S. patent or U.S. patent application publication derived the claimed invention from the inventor or a joint inventor named in the application or patent, and that in such a case, an applicant or a patent owner may file a petition for a derivation proceeding.

The Office has sought to address the concerns of its stakeholders as expressed in the public comment, and plans to seek additional public comment on the rules of practice pertaining to the first inventor to file provisions of section 3 of the AIA after the Office and the public have gained experience with the rules of practice pertaining to the first inventor to file provisions in operation.

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

The following is a discussion of the amendments to Title 37 of the Code of Federal Regulations, part 1, in this final rule.

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

Section 1.9(d)(1) 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) 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) 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 1.14: Section 1.14(f) is amended to correct the spelling of the word “proprietary.”

Section 1.17: Section 1.17 is amended to eliminate the provisions pertaining to statutory invention registrations in § 1.17(g), (n), and (o). See discussion of the provisions of §§ 1.293 through 1.297.

Sections 1.17(g) and (i) are also amended for consistency with the changes to § 1.55. See discussion of § 1.55.

Section 1.53: Section 1.53(b) is amended for consistency with the reorganization of § 1.78. See discussion of § 1.78.

Section 1.53(c) is amended to eliminate the provisions pertaining to statutory invention registrations. See discussion of the provisions of §§ 1.293 through 1.297.

Section 1.53(j) is removed as the provisions of § 1.53 pertain to applications filed under 35 U.S.C. 111 and the discussion of former § 1.53(j) pertained to applications filed under the Patent Cooperation Treaty (PCT).

Section 1.55: Section 1.55 is reorganized into paragraphs (a) through (l) for clarity.

Section 1.55(a) provides generally that an applicant in a nonprovisional application may claim priority to 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) and § 1.55.

Section 1.55(b) provides that the nonprovisional application must be filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed, or that the nonprovisional application is entitled to claim the benefit under 35 U.S.C. 120, 121, or 365(c) of an application that was filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed. See MPEP § 201.13. While section 3(g)(1) of the AIA amended 35 U.S.C. 172 to eliminate the reference to “the time specified in section 102(d)” in view of the elimination of the premature foreign patenting provisions of pre-AIA 35 U.S.C. 102(d), the AIA did not otherwise change the provision in 35 U.S.C. 172 that the right of priority provided for by 35 U.S.C. 119(a) through (d) shall be six months in the case of designs. See MPEP § 1504.10. Section 1.55(b) also provides that this twelve-month period is subject to 35 U.S.C. 21(b) (and § 1.7(a)) and PCT Rule 80.5, and the six-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 an action (e.g., filing a nonprovisional application within twelve months of the date on which the foreign application was filed) or paying a 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. PCT Rule 80.5 has similar provisions relating to the expiration of any period during which any document or fee in

an international application must reach a national Office or intergovernmental organization.

Section 1.55(c) pertains to the time for filing a priority claim and certified copy of a foreign application in an international application entering the national stage under 35 U.S.C., which corresponds to former § 1.55(a)(1)(ii). Section 1.55(c) provides that in an international application entering the national stage under 35 U.S.C., the claim for priority must be made and a certified copy of the foreign application must be filed within the time limit set forth in the PCT and the Regulations under the PCT. Note that it is permissible, but not required under § 1.55(c), to present the claim for priority in an application data sheet in an international application entering the national stage under 35 U.S.C.

Section 1.55(d) pertains to the time for filing a priority claim in an application filed under 35 U.S.C. 111(a).

Section 1.55(d) 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 48776, 48818 (Aug. 14, 2012). Section 1.55(d) does not include the requirement of former § 1.55(a)(1)(i) for an identification of any foreign application for the same subject matter having a filing date before that of the application for which priority is claimed, but otherwise contains the provisions of former § 1.55(a)(1)(i).

Section 1.55(d) does not provide for an application under 35 U.S.C. 111(b) because an application under 35 U.S.C. 111(b) may not claim priority to or the benefit of an earlier filed application. See 35 U.S.C. 111(b)(7).

Section 1.55(e) pertains to a waiver of claims for priority and acceptance of unintentionally delayed claims for priority under 35 U.S.C. 119(a) through (d) or (f), or 365(a) in an application filed under 35 U.S.C. 111(a). Section 1.55(e) also requires that a petition to accept a delayed claim for priority be accompanied by a certified copy of the foreign application if required by § 1.55(f), unless previously submitted. Section 1.55(h)(4) permits applicants to request in a separate document that the Office obtain a copy of the foreign application that was filed in a nonparticipating intellectual property office from a participating intellectual property office that permits the Office to obtain such a copy to be filed with a petition under § 1.55(e), and § 1.55(i)(1) permits an interim copy to be filed with a petition under § 1.55(e). Section 1.55(e) otherwise contains the provisions of former § 1.55(c).

Section 1.55(f) pertains to the time for filing a certified copy of the foreign application in an application filed under 35 U.S.C. 111(a). Section 1.55(f) provides that in an original application filed under 35 U.S.C. 111(a), a certified copy of the foreign application must 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, except as provided in § 1.55(h) or (i). Section 1.55(f) also provides that the time period in § 1.55(f) does not

apply in a design application. Since U.S. patent application publications (as well as U.S. patents) 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 AIA 35 U.S.C. 102, the Office needs to ensure that it has a copy of the priority application by the time of publication. The 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(f) further provides that if a certified copy of the foreign application is not 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, and the exceptions in § 1.55(h) and (i) are not applicable, the certified copy of the foreign application must be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in § 1.17(g). The Office is including a provision in § 1.55(f) to provide for the belated filing of a certified copy of the foreign application to provide a lower standard (good and sufficient cause versus an extraordinary situation) and lower fee (\$200 petition fee set forth in § 1.17(g) versus the \$400 petition fee set forth in § 1.17(f)) than would otherwise be applicable for a petition under § 1.183 to waive or suspend a requirement of the regulations in such a situation.

Section 1.55(g) provides requirements for filing a priority claim, certified copy of foreign application, and translation that are applicable in all applications.

Section 1.55(g)(1) corresponds to the provisions of former § 1.55(a)(2). Section 1.55(g)(1) provides that 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 in or received by the Office within the pendency of the application and before the patent is granted. Section 1.55(g) does not in any way supersede the timing requirements of § 1.55(c) through (f) for a claim for priority and the certified copy of the foreign application. Section 1.55(g)(1) simply indicates that the claim for priority and the certified copy of the foreign application must be filed in or received by the Office within the pendency of the application and before the patent is granted in all situations. For example, if a petition to accept a delayed claim for priority is filed under § 1.55(e), 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. Section 1.55(g)(1) also provides that 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 also 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.

Section 1.55(g)(2) corresponds to the provisions of former § 1.55(a)(3). Section 1.55(g)(2) provides that the Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than otherwise provided in § 1.55:

- (1) when the application is involved in an interference (see § 41.202 of this title) or derivation (see part 42 of this title) proceeding;
- (2) when necessary to overcome the date



of a reference relied upon by the examiner; or (3) when deemed necessary by the examiner. Notwithstanding the time period requirement of 1.55(f), this provision is still needed to provide for 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).

Section 1.55(g)(3) corresponds to the provisions of former § 1.55(a)(4)(i). Section 1.55(g)(3) provides that an English language translation of a non-English language foreign application is not required except: (1) when the application is involved in an interference (see § 41.202 of this title) or derivation (see part 42 of this title) proceeding; (2) when necessary to overcome the date of a reference relied upon by the examiner; or (3) when specifically required by the examiner.

Section 1.55(g)(4) corresponds to the provisions of former § 1.55(a)(4)(ii). Section 1.55(g)(4) provides that 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.

Section 1.55(h) provides that the requirement in § 1.55(c), (f), and (g) for a certified copy of the foreign application to be filed within the time limit set forth in § 1.55(c), (f), and (g) will be considered satisfied if the Office receives a copy of the priority document through the priority document exchange program within the period specified in § 1.55(g)(1). See Changes To Implement Priority Document Exchange Between Intellectual Property Offices, 72 FR 1664 (Jan. 16, 2007). Section 1.55(h) specifically provides that this requirement for a timely filed certified copy of the foreign application will be considered satisfied if: (1) the foreign application was filed in a foreign intellectual property office participating with the Office in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office); (2) the claim for priority is presented in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and including the information necessary for the participating foreign intellectual property office to provide the Office with access to the foreign application; and (3) the copy of the foreign application is received by the Office from the participating foreign intellectual property office, or a certified copy of the foreign application is filed, within the pendency of the application and before the patent is granted (as set forth in § 1.55(g)(1)).

Section 1.55 no longer requires that a request that the Office obtain a copy of the foreign application 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 if the foreign application

was filed in a participating foreign intellectual property office. This is because the Office treats a priority claim (presented in an application data sheet) to an application filed in a participating foreign intellectual property office as such a request, and any priority claim must be filed within the later of four months from the filing date of the application filed under 35 U.S.C. 111(a) or sixteen months from the filing date of the foreign application (except as provided in § 1.55(e)).

Section 1.55(h) also provides that if the foreign application was not filed in a participating foreign intellectual property office, but a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy, the applicant must also file a request in a separate document that the Office obtain a copy of the foreign application from the participating intellectual property office. This request must identify the participating intellectual property office and the application number and filing date of the subsequent application in which a copy of the foreign application was filed, and be filed within the later of sixteen months from the filing date of the prior foreign application or four months from the actual filing date of an application under 35 U.S.C. 111(a), within four months from the later of the date of commencement (§ 1.491(a)) or the date of the initial submission under 35 U.S.C. 371 in an application entering the national stage under 35 U.S.C. 371, or with a petition under § 1.55(e). Applicants can use Form PTO/SB/38 (Request to Retrieve Electronic Priority Application(s)) to file such a request.

The Office has provided information concerning the priority document exchange program on its Internet Web site ([www.uspto.gov](http://www.uspto.gov)). This information includes the intellectual property offices that participate in the priority document exchange program, as well as the information necessary for each participating foreign intellectual property office to provide the Office with access to the foreign application.

The Office appreciates that an applicant may discover that the Office will not receive a copy of a foreign application through the priority document exchange program until after the expiration of the time frame specified in § 1.55(f). In this situation, an applicant who otherwise meets the conditions of § 1.55(h) may satisfy the requirement of § 1.55(h)(3) by filing a certified copy of the foreign application in the Office within the pendency of the application and before the patent is granted.

Note that the Office cannot obtain a copy of a design application to which priority is claimed, or a foreign application to which priority is claimed in a design application, through the priority document exchange program. In addition, note that the Office can obtain a PCT application to which priority is claimed through the priority document exchange program for PCT applications filed in a limited number of PCT Receiving Offices (currently, RO/DK (Denmark), RO/FI (Finland), RO/IB (International Bureau), and RO/SE (Sweden)).

Applicants continue to bear the ultimate responsibility for ensuring that the priority document is filed by the time required under § 1.55(g)(1). Accordingly, applicants are

encouraged to check as necessary to confirm receipt by the Office of appropriate documents. Priority documents retrieved from a participating foreign intellectual property office will bear the document description: “Priority documents electronically retrieved by USPTO from a participating IP Office.”

Section 1.55(i) permits an applicant to provide an “interim copy” of the original foreign application from the applicant’s own records to provide for the situation in which the applicant cannot obtain a certified copy of the foreign application within the time limit set forth in § 1.55(f), although there is no requirement that an applicant be unable to obtain a certified copy of the foreign application within the time limit set forth in § 1.55(f) to use § 1.55(i). Section 1.55(i) provides that the requirement in § 1.55(f) for a certified copy of the foreign application to be filed within the time limit set forth in § 1.55(f) will be considered satisfied if the applicant files a copy of the original foreign application clearly labeled as “Interim Copy,” including the specification, and any drawings or claims upon which it is based. Section 1.55(i) also provides that the interim copy of the foreign application must be filed together with a separate cover sheet identifying the foreign application by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and stating that the copy filed in the Office is a true copy of the original application as filed in the foreign country (or intellectual property authority). Section 1.55(i) also provides that the interim copy of the foreign application and cover sheet must be filed within the later of sixteen months from the filing date of the prior foreign application or four months from the actual filing date of an application under 35 U.S.C. 111(a), or with a petition under § 1.55(e). Section 1.55(i)

finally provides that a certified copy of the foreign application ultimately must be filed within the period specified in § 1.55(g)(1). Thus, providing an interim copy of a foreign application under § 1.55(i) satisfies the requirement for a certified copy of the foreign application to be filed within the time limit set forth in § 1.55(f), but a certified copy of the foreign application must still be filed before a patent is granted.

Section 1.55(j) pertains to applications filed on or after March 16, 2013, that claim priority to a foreign application filed prior to March 16, 2013. Section 1.55(j) provides that if a nonprovisional application filed on or after March 16, 2013, claims priority to 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 nonprovisional 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 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 nonprovisional application. Section 1.55(j) further provides that an applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

This information is needed to assist the Office in determining whether the nonprovisional application is subject to AIA 35 U.S.C. 102 and 103 or pre-AIA 35 U.S.C. 102 and 103. If the Office must determine on its own the effective filing date of every claim ever presented in a nonprovisional 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, the time required to examine an application will significantly increase. This in turn would result in an inefficient examination process that leads to increased examination costs, higher patent pendency, and/or reduced patent quality. The applicant, on the other hand, should be far more familiar with the contents of both the transition application and its priority or benefit application(s) than the examiner. Therefore, the Office is requiring the applicant, who is in the best position to know the effective filing date of each claimed invention, to indicate whether application contains, or contained at any time, a claimed invention that has an effective filing date on or after March 16, 2013.

This provision is tailored to the transition to 35 U.S.C. 102 and 103 under the AIA. For a nonprovisional application filed on or after March 16, 2013, that claims priority to a foreign application, the applicant would not be required to provide any statement if: (1) the nonprovisional application claims only subject matter disclosed in a foreign application filed prior to March 16, 2013; or (2) the nonprovisional application claims only priority to a foreign application filed on or after March 16, 2013. Section 1.55(j) also does 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. Section 1.55(j) requires 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.

The Office may issue a requirement for information under § 1.105 if an applicant takes conflicting positions on whether an application contains, or contained at any time, a claim to a claimed invention having an effective filing date on or after March 16, 2013. For example, the Office may require the applicant to identify where there is written description support under 35 U.S.C. 112(a) in the pre-AIA application for each claim if an applicant provides the statement under § 1.55(j) but later argues that the application should have been examined as a pre-AIA application because the application does not actually contain a claim to a claimed invention having an effective filing date on or after March 16, 2013. The Office would not issue a requirement for information under § 1.105 simply because of a disagreement with the applicant's statement under § 1.55(j) or the lack of such a statement.

Section 1.55(k) contains the provisions of former § 1.55(b).

Section 1.55(l) provides that the time periods set forth in § 1.55 are not extendable. This is not a change from former practice, under which the time periods set forth in § 1.55 are not extendable. This provision simply avoids the need to separately state that a time period is not extendable with respect to each time period set forth in § 1.55.



As it is now more than a decade since the implementation of eighteen-month publication in November of 2000, and as the changes in this final rule to § 1.55 do not apply to applications filed before March 16, 2013, the language in former § 1.55 itself that certain time periods therein do not apply to an application filed under 35 U.S.C. 111(a) before November 29, 2000, or to an international application filed under 35 U.S.C. 363 before November 29, 2000, has been deleted.

Section 1.71: Section 1.71(g)(1) is amended to remove reference to pre-AIA 35 U.S.C. 103(c)(2)(C) which provided for the names of the parties to a joint research agreement in the application for patent and is replaced by a reference to the definition of a joint research agreement (JRA) as set forth in § 1.9(e) in order to provide for both pre-AIA and AIA applications and patents.

Section 1.76: Sections 1.76(b)(5) and (b)(6) are amended for consistency with the changes to and reorganization of §§ 1.55 and 1.78. See discussion of §§ 1.55 and 1.78.

Section 1.77: Section 1.77(b) is 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 a preferred arrangement of the specification of a patent application. An applicant is not required to use the format specified in § 1.77 or identify in the specification any prior disclosures by the inventor or a joint inventor, 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 1.77(b)(2) is amended to delete the parenthetical “(unless included in the application data sheet)” for consistency with § 1.78(c)(5).

Section 1.78: Section 1.78 is reorganized as follows: (1) § 1.78(a) 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) 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) 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) 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) contains provisions relating to applications containing patentably indistinct claims; (6) § 1.78(f) contains provisions relating to applications or patents under reexamination naming different inventors and containing patentably indistinct claims; and (7) § 1.78(g) provides that the time periods set forth in § 1.78 are not extendable. In addition, as it is now more than a decade since the implementation of eighteen-month publication in November of 2000, and as the changes in this final rule to § 1.78 do not apply to applications filed before March 16, 2013, the language in former § 1.78 that certain time periods therein do not apply to an application filed under 35 U.S.C. 111(a) before November 29, 2000, or to an

international application filed under 35 U.S.C. 363 before November 29, 2000, has been deleted.

Section 1.78(a) addresses claims under 35 U.S.C. 119(e) for the benefit of one or more prior-filed provisional applications. Section 1.78(a) contains the provisions of former § 1.78(a)(4) and (a)(5) except as otherwise discussed in this final rule.

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 as to such invention. 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, does not require (as did former § 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. 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 AIA 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. In contrast, the prior-filed application must describe the subject matter for the later-filed application to be considered effectively filed under AIA 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) provides that a nonprovisional application (other than a design 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, or that the nonprovisional application or international application designating the United States of America be entitled to claim the benefit under 35 U.S.C. 120, 121, or 365(c) of an application that was filed not later than twelve months after the date on which the provisional application was filed. Section 1.78(a)(1) also provides 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)(2) provides that each prior-filed provisional application must name the inventor or a joint inventor named in the later-filed application as the inventor or a joint inventor.

Section 1.78(a)(2) and (c)(2) 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 at 48820.

Section 1.78(a)(6) requires 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 nonprovisional 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 nonprovisional application. Section 1.78(a)(6) further provides that an applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that

the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

This information is needed to assist the Office in determining whether the nonprovisional application is subject to AIA 35 U.S.C. 102 and 103 or pre-AIA 35 U.S.C. 102 and 103.

As discussed previously, if the Office must determine on its own the effective filing date of every claim ever presented in a nonprovisional 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, the time required to examine an application will significantly increase.

This in turn would result in an inefficient examination process that leads to increased examination costs, higher patent pendency, and/or reduced patent quality. The applicant, on the other hand, should be far more familiar with the contents of both the transition application and its priority or benefit application(s) than the examiner. Therefore, the Office is requiring the applicant, who is in the best position to know the effective filing date of each claimed invention, to indicate whether application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

This 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. Section 1.78(a)(6) also does 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. Section 1.78(a)(6) requires 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.

The Office may issue a requirement for information under § 1.105 if an applicant takes conflicting positions on whether an application contains, or contained at any time, a claim to a claimed invention having an effective filing date on or after March 16, 2013. For example, the Office may require the applicant to identify where there is written description support under 35 U.S.C. 112(a) in the pre-AIA application for each claim to a claimed invention if an applicant provides the statement under § 1.78(a)(6), but later argues that the application should have been examined as a pre-AIA application because the application does not actually contain a claim to a claimed invention having an effective filing date on or after March 16, 2013.

Section 1.78(b) 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 former § 1.78(a)(6).

Section 1.78(c) 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 designating the United States of America. Section 1.78(c)(1) provides that each prior-filed application must name the inventor or a joint inventor named in the later-filed application as the inventor or a joint inventor. 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 former § 1.78(a)(1)).

Section 1.78(c) does not contain a provision (as did former § 1.78(a)(1)) 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 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 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 section 201.11.

Section 1.78(c)(3) through (5) contain the provisions of former § 1.78(a)(2). Section 1.78(c)(5) 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(c)(6) requires that if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a nonprovisional application or an international application designating the United States of America 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 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 later-filed

application. Section 1.78(c)(6) further provides that an applicant is not required to provide such a statement if the application claims the benefit of a nonprovisional application in which a statement under § 1.55(j), § 1.78(a)(6), or § 1.78(c)(6) that the application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, has been filed (as an application that contains, or contained at any time, a specific reference under 35 U.S.C. 120, 121, or 365(c) to any patent or an application that is subject to AIA 35 U.S.C. 102 and 103 is itself subject to AIA 35 U.S.C. 102 and 103). Section 1.78(c)(6) also further provides that an applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the later filed application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

This information is needed to assist the Office in determining whether the nonprovisional application is subject to AIA 35 U.S.C. 102 and 103 or pre-AIA 35 U.S.C. 102 and 103. As discussed previously, if the Office must determine on its own the effective filing date of every claim ever presented in a nonprovisional application filed on or after March 16, 2013, that claims priority to or the benefit of a nonprovisional application or an international application designating the United States of America filed prior to March 16, 2013, the time required to examine an application will significantly increase. This in turn would result in an inefficient examination process that leads to increased examination costs, higher patent pendency, and/or reduced patent quality. The applicant, on the other hand, should be far more familiar with the contents of both the transition

application and its priority or benefit application(s) than the examiner. Therefore, the Office is requiring the applicant, who is in the best position to know the effective filing date of each claimed invention, to indicate whether application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

This 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 or an international application designating the United States of America, 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 or international application designating the United States of America filed prior to March 16, 2013; or (2) the nonprovisional application claims only the benefit of the filing date of a nonprovisional application or an international application designating the United States of America filed on or after March 16, 2013. Section 1.78(c)(6) also does 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 or international application designating the United States of America. Section 1.78(c)(6) requires 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.

The Office may issue a requirement for information under § 1.105 if an applicant takes conflicting positions on whether a nonprovisional application contains, or contained at any time, a claim to a claimed invention having an effective filing date on or after March 16, 2013. For example, the Office may require the applicant to identify where there is written description support under 35 U.S.C. 112(a) in the pre-AIA application for each claim to a claimed invention if an applicant provides the statement under § 1.78(c)(6) but later argues that the application should have been examined as a pre-AIA application because the application does not actually contain a claim to a claimed invention having an effective filing date on or after March 16, 2013. The Office would not issue a requirement for information under § 1.105 simply because of a disagreement with the applicant's statement under § 1.78(c)(6) or the lack of such a statement.

Section 1.78(d) 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) contains the provisions of former § 1.78(a)(3).

Section 1.78(e) contains the provisions of former § 1.78(b) pertaining to applications containing "conflicting" claims. Section 1.78(e), however, uses the term "patentably indistinct" rather than "conflicting" for clarity as the term "conflicting" is not otherwise employed in the rules of practice. See Changes To Implement Derivation Proceedings, 77 FR at 56070, 56071-72, and 56090 (adding new § 42.401, which includes defining same or substantially the same as meaning patentably indistinct).

Section 1.78(f) addresses applications or patents under reexamination that name different inventors and contain patentably indistinct claims. The provisions are similar to the provisions of former § 1.78(c), but the language has been amended to refer to “on its effective filing date (as defined in § 1.109) or on its date of invention, as applicable” in place of “at the time the later invention was made” to provide for both AIA applications (under the “first inventor to file” system) and pre-AIA applications. Section 1.78(f) likewise uses the term “patentably indistinct” rather than “conflicting” for clarity.

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

Section 1.84: Section 1.84(a) is amended to eliminate the provisions pertaining to statutory invention registrations. See discussion of the provisions of §§ 1.293 through 1.297.

Section 1.103: Section 1.103(g) is removed to eliminate the provisions pertaining to statutory invention registrations. See discussion of the provisions of §§ 1.293 through 1.297.

Section 1.104: Section 1.104(c)(4) is amended to include the provisions that pertain to commonly owned or joint research agreement subject matter for applications and patents subject to AIA 35 U.S.C. 102 and 103. Specifically, § 1.104(c)(4) 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) is applicable to applications and patents that are subject to AIA 35 U.S.C. 102 and 103.

Section 1.104(c)(4)(i) provides that subject matter which would otherwise qualify as prior art under AIA 35 U.S.C. 102(a)(2) and a claimed invention will be treated as commonly owned for purposes of AIA 35 U.S.C. 102(b)(2)(C) if the applicant or patent owner provides a statement to the effect that the subject matter 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) addresses joint research agreements and provides that subject matter which would otherwise qualify as prior art under AIA 35 U.S.C. 102(a)(2) and a claimed invention will be treated as commonly owned for purposes of AIA 35 U.S.C. 102(b)(2)(C) on the basis of a joint research agreement under AIA 35 U.S.C. 102(c) if:

- (1) the applicant or patent owner provides a statement to the effect that the subject matter 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 amended to include the provisions that pertain to commonly owned or joint research agreement subject matter for applications and patents 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) is applicable to applications and patents that are subject to 35 U.S.C. 102 and 103 in effect prior to March 16, 2013.

Section 1.104(c)(5)(i) 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 filed on or after November 29, 1999, or any patent issuing thereon, in an application filed before November 29, 1999, but pending on December 10, 2004, or any patent issuing thereon, or in any 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 or patent owner provides a statement to the effect that the subject matter 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) 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 pending on or after December 10, 2004, or in any 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 or patent owner provides a statement to the effect

that the subject matter 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 (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.

Sections 1.104(c)(4)(ii) and 1.104(c)(5)(ii) make 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 is referencing the definition of joint research agreement in 35 U.S.C. 100(h) in § 1.104(c)(4)(ii) and (c)(5)(ii) for simplicity.

Section 1.104(c)(6) is 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(1).

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

Section 1.109: Section 1.109 is added to specify the effective filing date of a claimed invention under the AIA. Section 1.109(a) 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 a right of priority 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) 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 1.109 applies to any application for patent, and to any patent issuing thereon, 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, and to any application for patent, and to any patent issuing thereon, that contains, or contained at any time, 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.

Section 1.110: Section 1.110 is revised to provide for both AIA applications and pre-AIA applications. Section 1.110 specifically provides that when one or more joint inventors are named in an application or patent, the Office may require an applicant or patentee to identify the inventorship and ownership or obligation to assign ownership, of each claimed invention on its effective filing date (as defined in § 1.109) or on its date of invention, as applicable, when necessary for purposes of an Office proceeding. Section

1.110 is amended to change the ownership inquiry to ownership: (1) on its effective filing date (as defined in § 1.109), which would be applicable to AIA applications; or (2) on its date of invention, which would be applicable to pre-AIA applications. Section 1.110 further provides that the Office may also require an applicant or patentee to identify the invention dates of the subject matter of each claim when necessary for purposes of an Office proceeding, which would be applicable to pre-AIA applications.

Section 1.130: Section 1.130 is amended to implement the exceptions provided under AIA 35 U.S.C. 102(b) by replacing its existing provisions (which are relocated to § 1.131) with provisions for: (1) disqualifying a disclosure as prior art by establishing that the disclosure was by the inventor or a joint inventor or is a disclosure of the inventor's or a joint inventor's own work (affidavit or declaration of attribution); and (2) disqualifying a disclosure as prior art by establishing that there was a prior public disclosure of the subject matter disclosed by the inventor or a joint inventor or that there was a prior public disclosure by another of the inventor's or a joint inventor's own work (affidavit or declaration of prior public disclosure). Thus, § 1.130 applies to applications for patent (and patents issuing thereon) that are subject to AIA 35 U.S.C. 102 and 103, and § 1.131 would apply to applications for patent (and patents issuing thereon) that are subject to pre-AIA 35 U.S.C. 102 and 103 (35 U.S.C. 102 and 103 as in effect on March 15, 2013, prior to the effective date of section 3 of the AIA). In an application for patent to which the provisions of § 1.130 apply, and to any patent issuing thereon, the provisions of § 1.131 are applicable only with respect to a rejection under 35 U.S.C. 102(g) as in effect on March 15, 2013.

Section 1.130 provides a mechanism for filing an affidavit or declaration to establish that a disclosure is not prior art in accordance with AIA 35 U.S.C. 102(b). Section 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 54604, 54640 (Sept. 8, 2000) (discussing procedural nature of §§ 1.131 and 1.132). The examination guidelines will discuss the standard for evaluating the sufficiency of an affidavit or declaration attributing the disclosure or subject matter disclosed as the inventor's or a joint inventor's own work and the sufficiency of an affidavit or declaration of a prior public disclosure of the subject matter disclosed as the inventor's or a joint inventor's own work.

Section 1.130(a) provides that when any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the disclosure was made by the inventor or a joint inventor, or the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor. Section 1.130(a) pertains to the provisions of subparagraph (A) of AIA 35 U.S.C. 102(b)(1) and (b)(2). AIA 35 U.S.C. 102(b)(1)(A) provides 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 AIA 35 U.S.C. 102(a)(1) if 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, and AIA 35 U.S.C. 102(b)(2)(A) provides that a disclosure shall not be prior art to a claimed invention under AIA 35 U.S.C. 102(a)(2) if the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor. In these situations, the applicant or patent owner is attempting to show that: (1) the disclosure was made by the inventor or a joint inventor; or (2) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor.

Affidavits or declarations seeking to attribute an activity, a reference, or part of a reference to the applicant to show that the activity or reference is not available as prior art under pre-AIA 35 U.S.C. 102(a) have been treated as affidavits or declarations under § 1.132. See MPEP § 716.10. Affidavits or declarations of attribution in pre-AIA applications remain as affidavits or declarations under § 1.132. Thus, the Office will treat affidavits or declarations of attribution in AIA applications as affidavits or declarations under § 1.130, and affidavits or declarations of attribution in pre-AIA applications as affidavits or declarations under § 1.132, regardless of whether the affidavit or declaration is designated as an affidavit or declaration under § 1.130, 1.131, or 1.132.

Section 1.130(b) provides that when any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate

affidavit or declaration to disqualify a disclosure as prior art by establishing that the subject matter disclosed had, before such disclosure was made or before such subject matter was effectively filed, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. Section 1.130(b) pertains to the provisions of subparagraph (B) of AIA 35 U.S.C. 102(b)(1) and (b)(2). AIA 35 U.S.C. 102(b)(1)(B) provides 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 AIA 35 U.S.C. 102(a)(1) if 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. AIA 35 U.S.C. 102(b)(2)(B) provides that a disclosure shall not be prior art to a claimed invention under AIA 35 U.S.C. 102(a)(2) if the subject matter disclosed had, before such subject matter was effectively filed under AIA 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. In these situations, the disclosure on which the rejection is based is not by the inventor or a joint inventor, or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor, and the applicant or patent owner is attempting to show that the subject matter disclosed had, before such disclosure was made or before such subject matter was effectively filed, been publicly disclosed by: (1) the inventor or a joint inventor; or (2) another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. As pointed out in the examination guidelines, in response to public comments, the Office

is clarifying that there is no requirement that the mode of disclosure by an inventor or joint inventor be the same as the mode of disclosure of an intervening disclosure (e.g., inventor discloses his invention at a trade show and the intervening disclosure is in a peer-reviewed journal). Additionally, there is no requirement that the disclosure by the inventor or a joint inventor be a verbatim or ipsissimis verbis disclosure of an intervening disclosure in order for the exception based on a previous public disclosure of subject matter by the inventor or a joint inventor to apply. The examination guidelines also clarify that the exception applies to subject matter of the intervening disclosure that is simply a more general description of the subject matter previously publicly disclosed by the inventor or a joint inventor.

Section 1.130(b) further provides that an affidavit or declaration under § 1.130(b) must identify the subject matter publicly disclosed and provide the date of the public disclosure of such subject matter 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.

Section 1.130(b)(1) provides that if the subject matter publicly disclosed on the earlier date by the inventor or a joint inventor, or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor, was in a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication. Section 1.130(b)(2) provides that if the subject matter publicly disclosed on the earlier date was not in a printed publication, the affidavit or declaration must describe the subject matter with sufficient detail and particularity to determine what subject matter had been publicly disclosed on the earlier date by the inventor or a joint inventor or

another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. The Office needs these details to determine not only whether the inventor is entitled to disqualify the disclosure under AIA 35 U.S.C. 102(b), but also because if the rejection is based on a U.S. patent application publication or WIPO publication of an international application to another and such application is also pending before the Office, this prior disclosure may be prior art under AIA 35 U.S.C. 102(a) to the other earlier filed application, and the Office may need this information to avoid granting two patents on the same invention.

Section 1.130 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” in contrast to the requirement for such exhibits in § 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 or a joint 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(c) 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. A disclosure made more than one year before the effective filing date of the claimed invention is prior art under AIA 35 U.S.C. 102(a)(1), and may not be

disqualified under AIA 35 U.S.C. 102(b)(1). Note that the provisions of § 1.130 are available to establish that a rejection under AIA 35 U.S.C. 102(a)(2) is based on an application or patent that was effectively filed more than one year before the effective filing date of the claimed invention under examination, but not publicly disclosed more than one year before such effective filing date, where the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor.

Section 1.130(c) also provides that the provisions of § 1.130 may not be available if the rejection is based upon a U.S. patent or U.S. patent application publication of a patented or pending application naming another inventor, the patent or pending application claims an invention that is the same or substantially the same as the applicant's or patent owner's claimed invention, and the affidavit or declaration contends that an inventor named in the U.S. patent or U.S. patent application publication derived the claimed invention from the inventor or a joint inventor named in the application or patent, in which case an applicant or patent owner may file a petition for a derivation proceeding pursuant to § 42.401 et seq. of this title. Permitting two different applicants to each aver or declare that an inventor named in the other application derived the claimed invention without a derivation proceeding to resolve who the true inventor is could result in the Office issuing two patents containing patentably indistinct claims to two different parties. Thus, the Office needs to provide that the provisions of § 1.130 are not available in certain situations to avoid the issuance of two patents containing patentably indistinct claims to two different parties. See In re Deckler, 977 F.2d 1449, 1451-52 (Fed. Cir. 1992) (35 U.S.C. 102, 103, and 135 “clearly contemplate--where different inventive



entities are concerned--that only one patent should issue for inventions which are either identical to or not patentably distinct from each other”) (quoting Aelony v. Arni, 547 F.2d 566, 570 (CCPA 1977)). The provisions of § 1.130, however, would be available if:

- (1) 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);
- (2) 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; or (3) the rejection is based upon a U.S. patent or U.S. patent application and the patent or pending application that does claim an invention that is the same or substantially the same as the applicant’s claimed invention, but the affidavit or declaration under § 1.130 does not contend that an inventor named in the U.S. patent or U.S. patent application publication derived the claimed invention from the inventor or a joint inventor named in the application or patent (e.g., the affidavit or declaration under § 1.130 contends that the subject matter disclosed had, before such disclosure was made or before such subject matter was effectively filed, been publicly disclosed by the inventor or a joint inventor).

Section 1.130(d) provides that the provisions of § 1.130 apply to any application for patent, and to any patent issuing thereon, that is subject to AIA 35 U.S.C. 102 and 103.

Section 1.131: The title of § 1.131 is amended to include the provisions of former § 1.130.

Section 1.131(a) is amended to refer to a party qualified under § 1.42 or § 1.46 for consistency with the changes to § 1.42 et seq. See Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act, 77 FR at 48778-79. Section 1.131(a) is amended to refer to pre-AIA 35 U.S.C. 102(e) as 35 U.S.C. 102(e) as in effect on March 15, 2013. Section 1.131(a)(1) is amended to refer to an “application naming another inventor which claims interfering subject matter as defined in § 41.203(a)” rather than an “application to another or others which claims the same patentable invention as defined in § 41.203(a)” in view of the changes to 35 U.S.C. 102 in the AIA and the current provisions of § 41.203(a).

Section 1.131(b) is 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 added to include the provisions of former § 1.130, but is revised to refer to 35 U.S.C. 103 as 35 U.S.C. 103 as in effect on March 15, 2013, to refer to pre-AIA 35 U.S.C. 102(b) as 35 U.S.C. 102(b) as in effect on March 15, 2013, and to refer to 35 U.S.C. 104 as 35 U.S.C. 104 as in effect on March 15, 2013.

Section 1.131(d) is added to provide that the provisions of § 1.131 apply to any application for patent, and to any patent issuing thereon, that contains, or contained at any time: (1) a claim to an invention that has an effective filing date as defined in 35 U.S.C. 100(i) that is before March 16, 2013; or (2) a specific reference under 35 U.S.C. 120, 121, or 365(c) to any patent or application that contains, or contained at any time, a claim

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

Section 1.131(e) is added to provide that, in an application for patent to which the provisions of § 1.130 apply, and to any patent issuing thereon, the provisions of § 1.131 are applicable only with respect to a rejection under 35 U.S.C. 102(g) as in effect on March 15, 2013. Section 1.130(d) provides that the provisions of § 1.130 apply to applications for patent, and to any patent issuing thereon, that is subject to AIA 35 U.S.C. 102 and 103. The date of invention is not relevant under AIA 35 U.S.C. 102 and 103. Thus, in an application for patent to which the provisions of § 1.130 apply, and to any patent issuing thereon, a prior art disclosure could not be antedated under AIA 35 U.S.C. 102 and 103 by way of an affidavit or declaration under § 1.131(a) 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 removed.

Section 1.321: Section 1.321(d) is amended to remove reference to 35 U.S.C. 103(c) and to provide a reference to the provisions of § 1.104(c)(4)(ii) and § 1.104(c)(5)(ii) in order provide for both AIA and pre-AIA applications.

**Comments and Responses to Comments:** As discussed previously, the Office published a notice of proposed rulemaking and a notice of proposed examination guidelines on July 26, 2012, to implement the first inventor to file provisions of section 3 of the AIA, and conducted a roundtable on September 6, 2012, to obtain public input from organizations and individuals on issues relating to the Office's proposed implementation of the first inventor to file provisions of the AIA. See [Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act](#), 77 FR at 43742-59, [Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act](#), 77 FR at 43759-73, and [Notice of Roundtable on the Implementation of the First Inventor To File Provisions of the Leahy-Smith America Invents Act](#), 77 FR at 49427-28. The Office received approximately seventy written comments (from intellectual property organizations, industry, law firms, individual patent practitioners, and the general public) in response to these notices. The comments germane to the proposed changes to the rules of practice and the Office's responses to the comments follow.

A. Foreign Priority Claim and Certified Copy:

Comment 1: Numerous comments either opposed or suggested revising the requirement for submission of a certified copy of the foreign priority document within the later of four months from the actual filing date of the application or sixteen months from the filing of the prior foreign application as set forth in proposed § 1.55. The majority of these comments stated that such filing deadlines for the certified copy are unrealistic because

many delays can be beyond the control of the applicant, such as delays by the foreign intellectual property office, mailing and courier delays, and even delays by the Office in requesting delivery under the priority document exchange program. One comment suggested revising the timing requirement for filing the certified copy of the foreign priority document to no later than payment of the issue fee.

Response: Section 1.55(f) as adopted in this final rule requires that a certified copy of the foreign application must 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(f) as adopted in this final rule, however, also provides that this requirement does not apply if: (1) the priority application was filed in a participating foreign intellectual property office, or if a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy, and the Office receives either a copy of the foreign application from the participating foreign intellectual property office or a certified copy of the foreign application within the pendency of the application and before the patent is granted; or (2) the applicant provides an interim copy of the original foreign 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, and files a certified copy of the foreign application within the pendency of the application and before issuance of the patent.

Comment 2: Several comments asserted that there is no need for a certified copy of the foreign priority application because the Office can readily obtain priority documents through its exchange mechanisms (e.g., Digital Access Service (DAS) and Priority Document Exchange (PDX)) with other intellectual property offices. The comments suggested that the Office revise proposed § 1.55 to specifically exempt the time period for filing the certified copy of the priority document if the applicant has timely requested a certified copy or electronic transfer of that copy. One comment suggested that in such circumstances, the rule should not include the requirement for actual receipt of the foreign application by the Office.

Response: Section 1.55(h) as adopted in this final rule provides an exception for filing a certified copy of the foreign priority application when the priority application was filed in a participating foreign intellectual property office, or if a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy, and the Office receives a copy of the foreign application from the participating foreign intellectual property office within the pendency of the application and before the patent is granted. Otherwise, the Office continues to require a certified copy of a foreign priority application pursuant to its authority in 35 U.S.C. 119(b). The requirement for a certified copy where a copy was not received from a participating intellectual property office is necessary to ensure that a true copy of the earlier filed application is of record before the patent is granted. The Office needs a copy of the foreign priority application for situations 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.

Comment 3: One comment noted that the electronic transmittal of priority documents by participating foreign intellectual property offices is not always available as an alternative to submitting a certified paper copy of the priority application, and further observed that several large patent offices (e.g., the German Patent and Trade Mark Office (DPMA)) do not participate in electronic priority document exchange programs with the Office.

Response: Section 1.55(i) as adopted in this final rule permits an applicant to provide an “interim copy” of the original foreign application from the applicant’s own records to provide for the situation in which the applicant cannot obtain a certified copy of the foreign application within the time limit set forth in § 1.55(f). While providing an interim copy of a foreign application under § 1.55(i) satisfies the requirement for a certified copy of the foreign application to be filed within the time limit set forth in § 1.55(f), a certified copy of the foreign application ultimately must still be filed before a patent is granted as set forth in § 1.55(g).

Furthermore, § 1.55(h)(4) as adopted in this final rule provides that, under specified conditions, if the foreign application was not filed in a participating foreign intellectual property office, the applicant can file a request in a separate document that the Office obtain a copy of the foreign application from a participating intellectual property office that permits the Office to obtain such a copy. Applicants can use Form PTO/SB/38

(Request to Retrieve Electronic Priority Application(s)) to file such a request. If the Office receives a copy of the foreign application from the participating foreign intellectual property office within the pendency of the application and before the patent is granted, the applicant need not file a certified paper copy of the foreign application. As a specific example, an application filed in the DPMA (which is not currently a participating foreign intellectual property office) may be retrieved via the priority document exchange program if it is identified in the claim for priority on the application data sheet, a subsequent application filed in the European Patent Office (EPO) or the Japan Patent Office (JPO) contains a certified copy of the DPMA application, and the applicant timely files a separate request for the Office to obtain from the EPO (or JPO) a copy of the certified copy of the DPMA application, wherein the request identifies the DPMA application and the subsequent application by their application number, country (EPO, JPO, or DE), day, month, and year of their filing.

Comment 4: Several comments suggested that where a priority application was published and available to the public by the time of publication of the U.S. application there is no need for a certified copy of the foreign application for the purpose of establishing an earlier effective prior art date under AIA 35 U.S.C. 102(d). One comment suggested that the Office waive the certified copy requirement for foreign priority applications filed in foreign intellectual property offices that publish at eighteen months. One comment argued that the requirement for the certified copy of the foreign priority document is obsolete because a certified copy is not required by statute. Another comment asserted that the filing of the certified copy of the foreign application is



burdensome, costly, and not required unless an applicant relies on the foreign priority date to eliminate a prior art rejection.

Response: AIA 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 AIA 35 U.S.C. 102(a)(2), the patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application, as of the earliest of the actual filing date of the patent or the application for patent, or the filing date of the earliest application for which the patent or application for patent is entitled to claim a right of priority under 35 U.S.C. 119, 365(a), or 365(b), or to claim the benefit of an earlier filing date under 35 U.S.C. 120, 121, or 365(c), that describes the subject matter. It is thus necessary for a copy of any foreign application to which a patent or application for patent claims a right of priority under 35 U.S.C. 119 or 365(a) to be available for review in order to determine the date that the patent or application for patent was effectively filed with respect to subject matter described in the patent or application for patent. The requirement in § 1.55 for a certified copy of the foreign application is specifically authorized by 35 U.S.C. 119(b) and is consistent with international requirements (see, e.g., PCT Rule 17).

Comment 5: Several comments requested that a provision be added to proposed § 1.55 to allow for late submission of the certified copy of the foreign priority application. One comment observed that if a remedy for late submission of the certified copy is provided for in the rule, an applicant would not need to file a petition for waiver of the applicable

rule for late filing of the certified copy of the foreign application that is due to actions beyond the control of the applicant. The comment further suggested that the Office consider following the approach set forth in PCT Rule 17.1 to address delays attributable to the actions of the patent offices.

Response: Section 1.55(f) as adopted in this final rule provides for the belated filing of a certified copy of the foreign application. Section 1.55(f) specifically provides that a certified copy of the foreign application filed after the time period set forth therein must be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in § 1.17(g). As compared to a petition to seek the suspension or waiver under § 1.183 of the requirement to submit a certified copy of the foreign application within the specified time frame, § 1.55(f) provides a lower standard (good and sufficient cause versus an extraordinary situation) and fee (\$200 petition fee set forth in § 1.17(g) versus the \$400 petition fee set forth in § 1.17(f)).

Comment 6: Several comments questioned whether an applicant is required to repeatedly check to see if the Office has received a copy of the foreign application under the priority document exchange program. Two comments questioned whether the Office will mail a notice setting a due date for compliance to file the certified copy of the foreign application.

Response: The Office will not send a notice setting a time period for filing a certified copy of the priority document. Upon receipt of a Notice of Allowance, applicants should

check to see whether the Office has received a copy of the foreign application under the priority document exchange program. To be entitled to priority, the Office must receive a copy of the foreign application from the participating foreign intellectual property office within the pendency of the application and before the patent is granted, or receive a certified copy of the foreign application within that time period. If a 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.

Comment 7: One comment noted that the Office automatically retrieves foreign applications from participating foreign intellectual property offices and questioned whether this practice will continue or whether an applicant must file a separate document requesting that the Office retrieve a copy of the foreign application. One comment suggested modifying proposed § 1.55(d)(2) to indicate that if the foreign application was not filed in a participating foreign intellectual property office, the request that the Office obtain a copy of the foreign application from a participating intellectual property office may be provided in an application data sheet instead of a separate request.

Response: The Office is continuing the practice of treating a priority claim to an application filed in a participating foreign intellectual property office as a request that the Office obtain a copy of the foreign application from the participating intellectual property office. A separate written request may be used when the applicant wishes the Office to retrieve a foreign application from a foreign intellectual property office that becomes a

participating foreign intellectual property office after the foreign priority has been claimed, so long as the time period set in § 1.55(f) has not expired. A separate written request is required in the situation where the foreign application is not originally filed in a participating office, but a certified copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office. The suggestion to include the request that the Office obtain a copy of the foreign application from the participating intellectual property office in the application data sheet is not adopted in this final rule. Including information regarding the subsequent application for which priority is not claimed in an application data sheet, instead of in a separate request, could lead to incorrect processing of the subsequent application as the foreign priority document.

Comment 8: One comment asserted that the late filing of a certified copy of a priority document due to circumstances beyond the control of the applicant should not result in a reduction of patent term adjustment.

Response: There are no provisions in the patent term adjustment regulations (i.e., §§ 1.702 et seq.) for a reduction of patent term adjustment due to the late filing of a certified priority document.

Comment 9: One comment suggested that proposed § 1.55 is unclear with respect to the deadline for submission of certified copies and priority claims for applications that claim priority to multiple prior filed foreign applications. The comment suggested that either

the rule specify that the deadline is sixteen months from the earliest priority application to which a claim for priority is made, or sixteen months from the filing date of any priority application to which a claim of priority is made.

Response: Section 1.55(f) provides that in an original application filed under 35 U.S.C. 111(a), a certified copy of the foreign application must 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, except as provided in § 1.55(h) and (i). The sixteen-month time frame in § 1.55 for filing a certified copy of a foreign priority application is measured from the filing date of any foreign application for which priority is claimed.

Comment 10: One comment suggested that the Office clarify whether an applicant who files a 35 U.S.C. 111(a) application claiming the benefit of a PCT application (i.e., a “bypass” application) may establish compliance with § 1.55 either by complying with § 1.55(a)(2) (applicable to “original applications”) or by establishing compliance with § 1.55(a)(3) (applicable to PCT national stage applications) during the international phase of the parent PCT application to provide applicants the greatest flexibility to choose the path of entry into the U.S. for an application filed under the PCT. The comment further requested clarification that the requirement in § 1.55 pertaining to 35 U.S.C. 371 applications refers to the filing of a certified copy of the foreign priority document during the international phase and not during the national phase.

Response: An application filed under 35 U.S.C. 111(a) (including a “bypass” application claiming the benefit of a PCT application, which PCT application claims priority to a foreign application) must comply with the time for filing a priority claim and a certified copy of a priority document set forth in § 1.55(d) and (f) as adopted in this final rule. Section 1.55(d) requires that in an application under 35 U.S.C. 111(a), a claim for priority must 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(f) requires that in an application under 35 U.S.C. 111(a), a certified copy of the foreign application must 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, except as provided in § 1.55(h) and (i). This timing differs from that for an international application entering the national stage under 35 U.S.C. 371, wherein the claim for priority must be made and a certified copy of the foreign application must be filed within the time limit set forth in the PCT and the Regulations under the PCT.

With respect to the requirements of § 1.55 as they pertain to applications entering the national stage under 35 U.S.C. 371, if the applicant submitted a certified copy of the foreign priority document in compliance with PCT Rule 17 during the international phase, the International Bureau will forward a copy of the certified priority document to each Designated Office that has requested a copy of the foreign priority document and the copy received from the International Bureau is acceptable to establish that applicant has filed a certified copy of the priority document. See MPEP § 1893.03(c). If, however, the International Bureau is unable to forward a copy of the certified priority document

because the applicant failed to submit a certified copy of the foreign priority document during the international phase, the applicant will need to provide a certified copy of the priority document or have the document furnished in accordance with the priority document exchange program during the national stage to fulfill the requirements of § 1.55. See id.

Comment 11: One comment asked whether the requirement for the certified copy of the foreign application of proposed § 1.55(a)(2) would be met if a certified copy of the foreign application is submitted in a U.S. parent application within the time period specified in the proposed rule. The comment further asked if it would be necessary for the applicant to indicate that the certified copy of the foreign application was submitted in the U.S. parent application.

Response: Consistent with current practice, it is not necessary to file a certified copy of a foreign application in a later-filed application that claims the benefit of an earlier nonprovisional application where: (1) priority to the foreign application is claimed in the later-filed application (i.e., continuation, continuation-in-part, division) or in a reissue application; and (2) a certified copy of the foreign application has been filed in the earlier nonprovisional application. When making such claim for priority, the applicant must identify the earlier nonprovisional application containing the certified copy. See MPEP § 201.14(b).

Comment 12: One comment requested clarification as to whether an applicant may obtain an extension of time to file an English-language translation when filing the English-language translation in response to an Office action, notwithstanding that proposed § 1.55(f) indicates that time periods under that section are not extendable.

Response: The time period for filing a translation is not set forth in § 1.55, which only sets time periods for filing a foreign priority claim and a certified copy of the priority application. The provisions of § 1.55(l) as adopted in this final rule apply to time periods actually set in § 1.55, and not to time periods that are set in an Office action. Thus, an applicant may obtain an extension of time to file an English-language translation when filing the English-language translation in response to an Office action, unless the Office action indicates that extensions of time are not available.

Comment 13: One comment suggested that the Office should not require applicants to file a translation of a non-English language provisional application as currently required by § 1.78(a)(5) because applicants are not required to file an English translation of foreign language priority documents except in limited circumstances.

Response: The Office will take this suggestion under consideration. The Office did not propose any change to this practice, and thus has not had the benefit of public comment on the issue. Furthermore, the Office would need to gain greater experience with examination under the AIA to determine how often it is necessary to obtain translations of priority documents for the purposes of examination under AIA 35 U.S.C. 102 and 103.



As discussed previously, the Office plans to seek additional public comment on the rules of practice pertaining to the first inventor to file provisions of section 3 of the AIA after the Office and the public have gained experience with the rules of practice pertaining to the first inventor to file provisions in operation.

Comment 14: One comment requested that the Office provide a rationale or statutory basis for the proposed requirement of a “statement that the entire delay between the date the claim was due under paragraph (a) and the date the claim was filed was unintentional” in a petition filed under proposed § 1.55(c)(4) for late presentation of a priority claim. The comment further asserted that requirement of proof of the subjective intent of the applicant runs counter to many statutory changes in the AIA, and suggested that the Office could impose the loss of patent term adjustment to dissuade applicants from intentionally delaying the presentation of the priority claim.

Response: The provisions for setting time periods for the filing of priority and benefit claims, and for accepting unintentionally delayed priority and benefit claims, were added by amendments to 35 U.S.C. 119(b), 119(e), and 120 in the American Inventors Protection Act of 1999 (AIPA). See Pub. L. 106-113, 113 Stat. 1501, 1501A-563 and 1501A-564 (1999); see also Changes To Implement Eighteen-Month Publication of Patent Applications, 65 FR 57024, 57024-25, 57030-31, 57054-55 (Sept. 20, 2000). The AIA did not revise these provisions for setting time periods for the filing of priority and benefit claims, and for accepting unintentionally delayed priority and benefit claims in 35 U.S.C. 119(b), 119(e), and 120.

## B. Required Statements in Transition Applications:

Comment 15: A number of comments opposed or expressed concerns with the statement requirements proposed in §§ 1.55 and 1.78 that an applicant must provide one of two alternative statements to assist the Office’s determination of whether a nonprovisional application filed on or after March 16, 2013 (“transition date”) that claims priority/benefit to one or more pre-transition patent filings is subject to AIA 35 U.S.C. 102 and 103 or pre-AIA 35 U.S.C. 102 and 103. Several comments opined that it is the examiner’s burden to determine whether post-AIA provisions are applicable, and that the statement requirements are inconsistent with the prima facie case requirement of 35 U.S.C. 102, 131, and 132, as well as costly, burdensome, unnecessary, and unjustified. One comment also stated that the number of applicants who will file applications of different scope that contain both pre-AIA and post-AIA disclosure will be miniscule.

One comment stated that the statement requirements were similar to an examination support document requirement that was at issue in the Tafas litigation. See Tafas v. Kappos, 586 F.3d 1369 (Fed. Cir. 2009) (Tafas IV); Tafas v. Doll, 559 F.3d 1345 (Fed. Cir. 2009) (Tafas III); Tafas v. Dudas, 541 F. Supp. 2d 805 (E.D. Va. 2008) (Tafas II).

Response: Sections 1.55 and 1.78 as adopted in this final rule require a statement from the applicant in a “transition” application (a nonprovisional application filed on or after March 16, 2013, that claims priority to, or the benefit of the filing date of an earlier

application (i.e., foreign, provisional, or nonprovisional application, or an international application designating the United States) filed prior to March 16, 2013) only if the application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013. As discussed in the notice of proposed rulemaking, this statement is needed to assist the Office in determining whether the application is subject to AIA 35 U.S.C. 102 and 103 (an AIA application) or pre-AIA 35 U.S.C. 102 and 103 (a pre-AIA application). See [Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act](#), 77 FR at 43745, 43747, and 43748. The Office is not requiring the applicant to indicate which particular claim or claims have a post March 16, 2013 effective filing date, or the effective filing date of each claim, as the Office does not need this information to determine whether the application is an AIA application or a pre-AIA application. See [id.](#) As also discussed in the notice of proposed rulemaking, 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 an application filed prior to March 16, 2013, examination costs will significantly increase. See [id.](#)

The changes to §§ 1.55 and 1.78 as adopted in this final rule do not implicate the prima facie case requirement. The prima facie case requirement pertains to the making of rejections and objections under 35 U.S.C. 131 and 132. See [In re Jung](#), 637 F.3d 1356, 1362 (Fed. Cir. 2012). While 35 U.S.C. 131 provides that the “Director shall cause an examination to be made of the application,” it does not preclude the Office from requiring the applicant to provide information that is reasonably necessary to the

examination of the application. See Star Fruits S.N.C. v. United States, 393 F.3d 1277, 1283 (Fed. Cir. 2005). Sections 1.55 and 1.78 as adopted in this final rule do not require an applicant to engage in a “self-examination” of an application or make a prima facie case of entitlement to a patent. Rather, the requirement for a statement for certain transition applications in §§ 1.55 and 1.78 as adopted in this final rule simply requires the applicant to provide information that will be used by the Office as an aid in determining whether to examine the application under AIA 35 U.S.C. 102 and 103 or pre-AIA 35 U.S.C. 102 and 103.

With respect to the suggestion that the changes proposed to §§ 1.55 and 1.78 would add costs and burdens to the patent application process, the Office has revised §§ 1.55 and 1.78 in this final rule to: (1) require the statement in a transition application only if the application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, (i.e., and not require a statement simply because the transition application discloses subject matter not also disclosed in the prior-filed application); and (2) indicate that no statement is required if the applicant reasonably believes on the basis of information already known to the individuals identified in § 1.56(c) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013. Therefore, the changes to §§ 1.55 and 1.78 adopted in this final rule should not require additional investigation on the part of the applicant and thus should not be costly or burdensome. In any event, the applicant will have prepared both the transition application and its priority or benefit application(s) and thus should be far more

familiar with the contents thereof than an examiner who was not involved in the preparation of any of the applications. Patent applicants would need to pay higher filing fees to recover the significantly higher examination costs if Office personnel were required to independently determine the effective filing date of each claim ever presented in an application. As a result of the statement requirement, the Office and the public will have greater certainty as to whether any resulting patent is an AIA or pre-AIA patent. See Star Fruits, 393 F.3d at 1284. Therefore, the patent examination process will operate more effectively if this information (whether the application ever contained a claim to a claimed invention that has an effective filing date on or after March 16, 2013) is provided at the outset by the party having the best access to the information.

The requirement for a statement for certain transition applications in §§ 1.55 and 1.78 as adopted in this final rule bears no relationship to the examination support document at issue in the Tafas litigation. The requirement for a statement for certain transition applications in §§ 1.55 and 1.78 as adopted in this final rule involves a determination and statement that is comparable to determinations and statements required under pre-existing rules of practice regarding the absence of new matter. See § 1.57(f) (requires amendment inserting material incorporated by reference to be accompanied by a statement that the amendment contains no new matter), § 1.125(b) (requires a substitute specification to be accompanied by a statement that the substitute specification includes no new matter), and former § 1.63(d)(1)(iii) (permits use of an oath or declaration from a prior application in a continuation or divisional application that contains no matter that would have been new matter in the prior application). The concern with the examination support document in

the Tafas litigation, meanwhile, was that it required a prior art search by the applicant and was viewed as shifting the burden of proving patentability onto the applicant. See Tafas III, 559 F.3d at 1373-74 (dissent), and Tafas II, 541 F. Supp. 2d at 817. Sections 1.55 and 1.78 as adopted in this final rule do not require an extensive investigation or search of the prior art, but instead simply require a statement for certain transition applications based upon information that is already in the applicant's possession.

With respect to the suggestion that the number of applicants who will file applications of different scope that contain both pre-AIA and post-AIA disclosure will be miniscule, an applicant who avoids filing serial applications of different scope that contain both pre-AIA and post-AIA disclosure is not required to provide any statement under §§ 1.55 and 1.78 as adopted in this final rule. Thus, if the number of serial applications of different scope that contain both pre-AIA and post-AIA disclosure is miniscule as suggested by the comment, then only the few patent applicants who engage in this atypical application filing practice will need to provide a statement under § 1.55 or 1.78 as adopted in this final rule.

Comment 16: A number of comments suggested removing the requirement for a statement when a transition application adds, but does not claim, subject matter that is not supported in a benefit or priority application filed before March 16, 2013. Several comments indicated that such a statement is burdensome and of limited use, with one comment noting that the statutory language makes clear that the determination of whether an application is subject to AIA or pre-AIA 35 U.S.C. 102 and 103 is governed solely by

claims. Several comments stated that it is difficult to determine whether certain changes to the disclosure would be considered “added” subject matter. Several comments asked whether a statement would be required if only editorial or other minor changes were made to an application before it is filed.

Response: Sections 1.55 and 1.78 as adopted in this final rule do not require a statement if a transition application discloses, but does not claim, subject matter that is not supported in a benefit or priority application filed before March 16, 2013.

Comment 17: Several comments asserted that the required statements in proposed § 1.55 and 1.78 are unnecessary since an examiner can address in a rejection that certain subject matter or claims are not supported by the priority application, giving an applicant the opportunity to respond to either the prior art rejection or a rejection under 35 U.S.C. 112 for claim amendments that add subject matter. Several comments suggested deferring the determination of whether the application is an AIA application or a pre-AIA application until and unless a rejection is addressed with a pre-AIA § 1.131 affidavit or declaration. Several comments asserted that by dealing with this issue in the context of a rejection, the dispute of whether the application ever contained a claim having an effective filing date that is on or after March 16, 2013, can be resolved through appeal.

Response: The suggested alternative of having the examiner address the issue of entitlement to priority or the benefit of an earlier filing date, and allowing the applicant to address the issue in a response to the Office action, would entail the same examination

costs that the Office would incur to determine on its own whether an application is an AIA application or a pre-AIA application prior to issuing an Office action. Moreover, a claim is not subject to a rejection under AIA 35 U.S.C. 102 or 103 (unless there is intervening prior art) or under 35 U.S.C. 112(a) simply because the claim is to a claimed invention that has an effective filing date on or after March 16, 2013. Lastly, the differences between AIA 35 U.S.C. 102 and 103 and pre-AIA 35 U.S.C. 102 and 103 are not limited to the ability to antedate prior art by showing prior invention under § 1.131.

Comment 18: One comment questioned whether the statement requirement under §§ 1.55 and 1.78 is part of the applicant's duty of disclosure. Several comments were concerned that the requirement to make these statements would increase the likelihood of charges of inequitable conduct. Two comments requested clarification of the Office's suggestion to include the "reasonable belief" language in the required statements. Another comment suggested that the Office include in the rules that the required statements made by applicant would not impact the validity of the patent.

Response: The Office is providing in this final rule that an applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated as having a duty of disclosure with respect to the application that the transition application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013. However, § 1.56 also includes a general duty of candor and good faith in dealing with the Office, which could be implicated if an applicant is aware that a transition application



contains a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but nonetheless chooses not to provide the statement when required under § 1.55 or 1.78.

Comment 19: One comment questioned how long the statement requirement would be applicable, noting that an application may claim the benefit under 35 U.S.C. 120 and § 1.78 of an application filed many years earlier.

Response: The requirement for a statement for certain transition applications in §§ 1.55 and 1.78 as adopted in this final rule is implicated whenever an application filed on or after March 16, 2013, claims a right of priority to or the benefit of the filing date of an application filed prior to March 16, 2013. This requirement, however, should not affect continuation or divisional applications because a continuation or divisional application discloses and claims only subject matter also disclosed in the prior-filed application. See MPEP § 201.06 (defines divisional application), and § 201.07 (defines continuation application). In addition, an application claiming a right of priority to a foreign application or the benefit of a provisional application must be filed within one year of the filing date of the foreign or provisional application. See 35 U.S.C. 119(a) and 119(e). In view of the one-year filing period requirement in 35 U.S.C. 119(a) and 119(e), this requirement should not affect applications filed after May 16, 2014, that claim only a right of priority to one or more foreign applications, or that only claim the benefit of one or more provisional applications (the critical date is May 16, 2014, rather than March 16, 2014, in view of the changes to 35 U.S.C. 119 in section 201(c) of the the Patent Law

Treaties Implementation Act of 2012, Pub. L. 112-211 (2012)). Therefore, after March 16, 2014, (or May 16, 2014, the statement required by §§ 1.55 and 1.78 as adopted in this final rule for certain transition applications should be necessary only in certain continuation-in-part applications.

Comment 20: One comment suggested that the Office extend the four-month deadline for making the statements required under §§ 1.55 and 1.78 because it is burdensome on applicants to identify the existence of claims having an effective filing date after March 16, 2013, and missing the deadline would trigger a requirement for information under § 1.105 that the applicant identify where there is written description support for the remaining claims in the nonprovisional application. One comment asserted that this requirement for information under § 1.105 is punitive, arbitrary, and capricious. One comment asserted that a request for admission (with sanctions for failure to be accurate) is inappropriate, especially where it is unclear whether a statement is necessary. One comment questioned whether the Office would require a statement under §§ 1.55 or 1.78 if no statement is made prior to examination, but it is later determined that a statement should be made regarding either new subject matter or new claims not supported by a pre-AIA application for which priority or benefit is claimed. One comment raised concerns that a practitioner may be forced to choose between violating state bar rules by making a statement adverse to a client's interests or violating the Office's rules of practice.

Response: This final rule does not provide that the Office will issue a requirement for information under § 1.105 as a sanction or penalty for non-compliance with the statement requirement under §§ 1.55 and 1.78. Rather, the Office is simply indicating that the Office may issue a requirement for information under § 1.105 if an applicant takes conflicting positions on whether an application contains, or contained at any time, a claim to a claimed invention having an effective filing date on or after March 16, 2013. For example, the Office may require the applicant to identify where there is written description support under 35 U.S.C. 112(a) in the pre-AIA application for each claim to a claimed invention if an applicant provides a statement under § 1.55 or § 1.78, but later argues that the application should have been examined as a pre-AIA application because the application does not actually contain a claim to a claimed invention having an effective filing date on or after March 16, 2013. The Office would not issue a requirement for information under § 1.105 simply because of a disagreement with the applicant's statement under § 1.55 or § 1.78 or the lack of such a statement.

Comment 21: Several comments suggested that the Office provide a mechanism (e.g., a check box) on the application data sheet to enable applicants to make the required statements. One comment stated that stakeholders should be able to identify which law applies with ease and transparency, and further suggested putting notice on the face of the patent to indicate whether the patent was issued under pre-AIA law or AIA law.

Response: The Office is revising the application data sheet to include a check box to allow applicants to easily indicate whether a transition application contains or ever

contained a claim to a claimed invention having an effective filing date that is on or after March 16, 2013. The Office plans to indicate in the Office's Patent Application Locating and Monitoring (PALM) system whether the Office is treating an application as subject to pre-AIA 35 U.S.C. 102 and 103 (a pre-AIA application) or AIA 35 U.S.C. 102 and 103 (an AIA application). Members of the public may access this information via the Patent Application Information Retrieval (PAIR) system. Furthermore, form paragraphs for use in Office actions will be developed which will identify whether the provisions of pre-AIA 35 U.S.C. 102 and 103 or AIA 35 U.S.C. 102 and 103 apply if there is a rejection based upon 35 U.S.C. 102 or 103.

Comment 22: Several comments proposed that the Office initially examine all applications filed on or after March 16, 2013, as if they were subject to the post-AIA provisions. Specifically, if an application is subject to a prior art rejection based on post-AIA provisions, applicants would have the opportunity to provide evidence that the application is subject to pre-AIA provisions. One comment noted that a prior art search conducted under AIA 35 U.S.C. 102 and 103 is broader than a search conducted under pre-AIA 35 U.S.C. 102 and 103, and therefore would encompass substantially all prior art under pre-AIA 35 U.S.C. 102 and 103, with two possible limited exceptions for commonly owned or joint research agreement patents and patent application publications and certain grace period disclosures measured from the filing date of a foreign priority application (instead of from the earliest effective U.S. filing). One comment noted that conducting searches under a single standard would minimize the training burden on

examiners and the confusion that would arise if searches are conducted under different standards for different applications.

Response: The suggested alternative of treating all applications filed on or after March 16, 2013, as subject to AIA 35 U.S.C. 102 and 103 (e.g., as AIA applications) entails the risk of issuing patents containing unpatentable claims. For example, the provision in pre-AIA 35 U.S.C. 103(c) concerning the availability of commonly owned prior art applies only to pre-AIA 35 U.S.C. 103 for a pre-AIA application, and thus a claimed invention in a pre-AIA application examined under AIA 35 U.S.C. 102 and 103 could appear to be patentable where a rejection under pre-AIA 35 U.S.C. 102(e) on the basis of commonly owned prior art might be appropriate. In addition, such a practice would also shift the burden of determining whether an issued patent is really an AIA patent or a pre-AIA patent to the public.

Comment 23: One comment requested clarification regarding whether a continuation or a divisional application filed after March 16, 2013, and having a claim not presented in the prior pre-AIA application, but not containing new matter, would require a statement to that effect. Another comment requested clarification as to whether subject matter not claimed, but fully supported, in a pre-AIA application that is later claimed in a continuation or divisional filed after March 16, 2013, would make the application subject to AIA 35 U.S.C. 102 and 103.

Response: The addition of a claim in a transition application that is directed to subject matter fully supported in a pre-AIA benefit or priority application would not itself trigger the statement requirement under § 1.55 or § 1.78 and would not make the application subject to AIA 35 U.S.C. 102 and 103.

Comment 24: Several comments suggested that the Office should clarify that an amendment to the claims that lacks support under 35 U.S.C. 112(a) does not convert that application into an AIA application.

Response: For an application filed on or after March 16, 2013, that discloses and claims only subject matter also disclosed in a previously filed pre-AIA application to which the application filed on or after March 16, 2013, is entitled to priority or benefit under 35 U.S.C. 119, 120, 121, or 365, an amendment (other than a preliminary amendment filed on the same day as such application) seeking to add a claim to a claimed invention that is directed to new matter would not convert the application into an AIA application. 35 U.S.C. 132(a) prohibits the introduction of new matter into the disclosure and thus an application may not actually “contain” a claim to a claimed invention that is directed to new matter. The Office notes that the MPEP sets forth the following process for treating amendments that are believed to contain new matter: (1) a new drawing should not be entered if the examiner discovers that the drawing contains new matter (MPEP § 608.02); and (2) amendments to the written description or claims involving new matter are ordinarily entered, but the new matter is required to be cancelled from the written description and the claims directed to the new matter are rejected under 35 U.S.C. 112(a)

(MPEP § 608.04). This process for treating amendments containing new matter is purely an administrative process for handling an amendment seeking to introduce new matter into the disclosure of the invention in violation of 35 U.S.C. 132(a) and resolving disputes between the applicant and an examiner as to whether a new drawing or amendment to the written description or claims would actually introduce new matter.

Comment 25: One comment suggested that the rules should provide recourse in the situation where there has been an inadvertent addition of a claim, or a specific reference to a prior-filed application, that causes the application to be subject to AIA 35 U.S.C. 102 and 103. The comment suggested that the applicant be permitted to file an oath or declaration asserting such inadvertence, such that the application may be examined under pre-AIA 35 U.S.C. 102 and 103.

Response: There is no provision in the AIA for an application (or any patent issuing thereon) that contains, or contained at any time, such a claim or specific reference to be subject to pre-AIA 35 U.S.C. 102 and 103 instead of AIA 35 U.S.C. 102 and 103 on the basis of the claim or specific reference being submitted by inadvertence or on the basis of an oath or declaration asserting that the claim or specific reference was submitted by inadvertence. As discussed previously, however, for an application filed on or after March 16, 2013, that discloses and claims only subject matter also disclosed in a previously filed pre-AIA application to which the application filed on or after March 16, 2013, is entitled to priority or benefit under 35 U.S.C. 119, 120, 121, or 365, an amendment (other than a preliminary amendment filed on the same day as such

application) seeking to add a claim to a claimed invention that is directed to new matter would not convert the application into an AIA application.

Comment 26: One comment suggested that the Office provide an applicant with the opportunity to: (1) cancel any claims to a claimed invention having an effective filing date before March 16, 2013, from the application; and/or (2) file a divisional application directed to the cancelled subject matter to enable applicants to have the claims in the divisional application examined under pre-AIA 35 U.S.C 102 and 103.

Response: If an application on filing contains at least one claim having an effective filing date before March 16, 2013, and at least one claim having an effective filing date on or after March 16, 2013, the application will be examined under AIA even if the latter claims are cancelled. However, if a pre-AIA parent application is pending and an applicant inadvertently files a continuing application with claims having an effective filing date on or after March 16, 2013, the applicant could file a continuation or divisional application from the pre-AIA parent application without any claim to the benefit of the AIA application and without any claim to a claimed invention having an effective filing date on or after March 16, 2013. In this situation, the continuation or divisional application would be examined as a pre-AIA application under pre-AIA 35 U.S.C. 102 and 103.

Comment 27: One comment suggested that the statements required under § 1.55 or 1.78 for transition applications containing a claim having an effective filing date that is on or



after March 16, 2013, that was first presented after the four-month deadline could be made in an amendment or response during prosecution. One comment questioned whether the statement could be submitted during the period set in § 1.53 for reply to a notice to file missing parts of an application.

Response: Sections 1.55(j), 1.78(a)(6), and (c)(6) set out the time period within which such a statement (when required) must be submitted. Such a statement (when required) must be submitted within the later of four months from the actual filing date of the nonprovisional 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 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 nonprovisional application. The time frame specified in § 1.55 or 1.78 is not affected by the issuance of a notice to file missing parts of an application under § 1.53. In addition, the Office has enlarged the time period for filing the inventor's oath or declaration, which should reduce the situations in which it is necessary to issue a notice to file missing parts of an application under § 1.53. See Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act, 77 FR 48776, 48779-80 (Aug. 14, 2012). Permitting the statement required by § 1.55 or 1.78 for certain transition applications to be submitted during the period set in § 1.53 for reply to a notice to file missing parts of an application would encourage applicants to file applications that are not in condition for examination.

C. Prior Inventor Disclosures (Sections 1.130 and 1.77):

Comment 28: One comment suggested that the organization of § 1.130 be improved to clarify the different requirements for a declaration depending on the applicable circumstances. One comment suggested that proposed § 1.130 should be revised to remove the requirement that the “subject matter disclosed” be shown to have been “invented” by one of the coinventors of the application because such subject matter may not necessarily correspond to the claimed invention. The comment further suggested that the rule be revised to conform to the statute and require instead that the declaration establish that the subject matter that is disclosed was obtained directly or indirectly from an inventor of the invention that is claimed. One comment expressed concern that the language “subject matter of the disclosure” used in proposed § 1.130 did not track the statutory language of “subject matter disclosed.” Another comment suggested that the Office take a general approach, similar to that taken in current affidavit practice under §§ 1.131 and 1.132 regarding the submission of evidence under proposed § 1.130, leaving out the details regarding the sufficiency of the evidence which will develop on a case-by-case basis.

Response: Section 1.130 as adopted in this final rule has been revised to more closely track the language of the statute and has been streamlined to set forth only the procedural requirements for submitting a declaration or affidavit of attribution under § 1.130(a) and a declaration or affidavit of prior public disclosure by the inventor or a joint inventor under § 1.130(b). The rule only requires the information necessary for the Office to

make a decision (i.e., a copy or description of the prior disclosure where applicable). The showing required for establishing sufficiency of a declaration or affidavit under § 1.130 is discussed in the Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act.

Comment 29: One comment suggested that proposed § 1.130 reallocates the burden of proof to show derivation to the inventor and is thus substantive.

Response: As discussed above, § 1.130 as adopted in this final rule simply sets forth the procedural requirements for an affidavit or declaration under § 1.130.

Comment 30: One comment questioned the requirement in proposed § 1.130 that a declaration be accompanied by evidence and requested that the Office clarify whether a later submission of evidence which supports, but does not initially accompany, a § 1.130 affidavit or declaration would be rejected.

Response: The submission of evidence with a declaration must be timely or seasonably filed to be entered and entitled to consideration. This is the current standard for declaration/affidavit practice under pre-existing §§ 1.131 and 1.132 as set forth in MPEP §§ 715.09 and 716.01, respectively. Specifically, affidavits and declarations and other evidence traversing rejections are considered timely if submitted: (1) prior to a final rejection; (2) before appeal in an application not having a final rejection; (3) after final rejection, but before or on the same date of filing an appeal, upon a showing of good and

sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with § 1.116(e); or (4) after the prosecution is closed (e.g., after a final rejection, after appeal, or after allowance) if applicant files the affidavit or other evidence with a request for continued examination (RCE) under § 1.114 in a utility or plant application filed on or after June 8, 1995, or a continued prosecution application (CPA) under § 1.53(d) in a design application. See MPEP section 715.09 and 716.01.

Comment 31: One comment requested that declarations submitted under proposed § 1.130(b) for a Katz-type declaration (an affidavit or declaration of attribution as discussed in MPEP § 716.10) and under proposed § 1.130(d) for a showing of derivation be permitted to be filed confidentially.

Response: Declarations or affidavits filed by an applicant or patent owner to overcome a rejection or an objection cannot be filed confidentially because the public needs to know what evidence the examiner relied upon in determining the patentability of the claims. Current practice does not provide for the confidential filing of an affidavit or declaration of attribution or an affidavit or declaration to show derivation. However, applicants may submit proprietary information with a petition to expunge under limited circumstances as explained in MPEP § 724.

Comment 32: One comment suggested that the Office instruct patent applicants to come forward with any disclosures of which they are aware that may qualify as a prior art exception under AIA 35 U.S.C. 102(b). Another comment suggested that the final rules

require an applicant's disclosure of prior secret commercial use of the claimed invention for more than one year prior to the original filing date given the ambiguities in the statute.

Response: Section 1.77 permits, but does not require, an applicant to provide a statement regarding prior disclosures by the inventor or a joint inventor. An applicant is not "required" to identify any prior disclosures by the inventor or a joint inventor unless the prior disclosure is not a grace period disclosure and is "material to patentability" or the prior disclosure is a grace period disclosure and the applicant is seeking to rely upon the prior disclosure to overcome a rejection. However, 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.

Comment 33: One comment suggested that the Office should not permit the mere listing of prior disclosures in an application under proposed § 1.77 but rather by way of affidavit or declaration, unless it is readily apparent that these prior disclosures originated with the inventor because the inventor's oath or declaration only attests to the claims of the application and not to the origin of the prior disclosures listed in the application.

Response: Sections 1.63(c) and 1.64(c) state that a person may not execute an inventor's oath or declaration for an application unless that person has reviewed and understands the contents of the application, including the claims, and is aware of the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56. See Changes To Implement the Inventor's Oath or Declaration Provisions of

the Leahy-Smith America Invents Act, 77 FR at 48818-19. Therefore, it is not necessary to have a person executing an inventor's oath or declaration under § 1.63 or 1.64 provide a separate affidavit or declaration attesting to the statements in the application as filed.

Comment 34: One comment suggested that the Office add a corroboration requirement to proposed §§ 1.130 and 1.131.

Response: The Office does not consider a per se requirement for corroboration to be necessary in ex parte examination (i.e., application examination or ex parte patent reexamination) proceedings. The need for corroboration in ex parte proceedings is a case-by-case determination based upon the specific facts of the case.

Comment 35: One comment asserted that there is a difference between a “disclosure” and a “public disclosure” from the provision set forth in proposed § 1.130(c) (which stated that if an 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) and requested clarification in the MPEP or other materials on what facts are needed to establish a public disclosure.

Response: The term “disclosure” includes disclosures that are not public. For example, prior filed, later published U.S. patent applications are considered disclosures on their earliest effective filing dates, which is not the date on which the disclosure was made

publicly available. The showing required to establish a public disclosure is discussed in the Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act.

Comment 36: One comment suggested revising the last sentences of proposed § 1.130(c) and (e) to make the standard for evaluating both non-publications and publications the same and to eliminate the potentially confusing reference to the language “the subject matter on which the rejection is based.”

Response: Section 1.130 as adopted in this final rule does not include the standard for evaluating the sufficiency of a declaration or attribution or refer to “the subject matter on which the rejection is based.” The details regarding the showing needed to establish a successful declaration or affidavit under § 1.130 are discussed in the Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act.

Comment 37: One comment suggested amending proposed §§ 1.130 and 1.131 to indicate that a disclosure on which the rejection is based is not prior art when the disclosure is based on the public disclosure or subject matter published by the inventor or joint inventor.

Response: As discussed previously, § 1.130 has been streamlined to set forth only the procedural requirements for submitting a declaration or affidavit of attribution under this

section. The showing required for establishing sufficiency of a declaration or affidavit under § 1.130 as adopted in this final rule is discussed in the Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act.

Comment 38: One comment requested an explanation of how the Office would use statements made in a declaration under proposed § 1.130 in the examination of other applications. The comment further asked whether the Office would provide a way for the examiners and the public to search the contents of the declarations.

Response: The Office plans to include information on the cover sheet of U.S. patents if an affidavit or declaration containing evidence of a prior public disclosure under § 1.130(b) was filed during the prosecution of the application for that patent in order to facilitate search by examiners and the public of prior public disclosures brought to the Office's attention under § 1.130(b).

D. Proposed Requirement in § 1.130 to Initiate Derivation Proceedings:

Comment 39: Several comments opposed the Office requiring a petition for a derivation proceeding in proposed § 1.130(f). One comment asserted that such a requirement would be unduly burdensome and premature if based on the published claims of an unexamined application which may not be patentable to the earlier applicant. One comment stated that there was no basis for requiring the filing of a derivation petition when an applicant



may avoid a rejection in another way such as by amending the claims. One comment asserted that since derivation requests are statutorily permissive, the Office should suggest or recommend, but not require a derivation proceeding. One comment stated that applicants, not the Office, are in the best position to decide if a derivation proceeding should be instituted. One comment requested that the Office establish standards for determining whether an applicant is required to file a petition for a derivation proceeding.

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

Comment 40: One comment suggested that instead of requiring the initiation of a derivation proceeding, the Office should implement a rule that would allow an AIA 35 U.S.C. 102(b)(2)(A) exception from prior art to extend only to disclosed but unclaimed subject matter in an earlier patent filing, and that a patent be permitted to issue on a claimed invention only if the claims with the earlier effective filing date are cancelled via a derivation proceeding or post-grant review proceeding. Another comment questioned whether there are any cases where the Office would not require the applicant to file a petition for a derivation proceeding even if the claims are the same and the inventors are different.

Response: Section 1.130 as adopted in this final rule does not include a requirement to file a petition for a derivation proceeding. An applicant or patent owner has the discretion to file a petition for a derivation proceeding pursuant to § 42.401 et seq. of this title. In the event that a patent is issued on a later filed application claiming subject matter disclosed in an earlier filed application, the applicant in the earlier filed application may request early publication of the application under § 1.219 and may cite the resulting patent application publication in the file of the patent on the later filed application under 35 U.S.C. 301 and § 1.501.

E. Miscellaneous:

Comment 41: One comment suggested that the Office implement a rule wherein claiming in a U.S. application priority to, or the benefit of, an earlier application is considered an express consent by the applicant to provide anyone the right to obtain a copy of the priority document from the applicable patent office upon providing evidence of the U.S. application and the priority claim to the earlier application at issue.

Response: The Office does not have jurisdiction to grant or deny access to patent applications filed in other intellectual property offices. Access to any patent application is determined by the national law of each country and cannot be governed by the regulations of another intellectual property office.

Comment 42: One comment suggested that the proposed rules would be clearer if the Office consistently used the terms “benefit claim” or “priority claim” when using the term “claim” in the context of the applicant asserting the benefit of an earlier priority date for a given claimed invention in order to differentiate the exact same term for two different purposes.

Response: The Office will endeavor to be consistent with the use of the terms benefit claim and priority claim where it is necessary for clarity in the rule.

Comment 43: One comment suggested retaining the provisions pertaining to pre-AIA applications in the regulations so that the public is not required to keep old copies of title 37 CFR for the next twenty years. The comment also suggested changes to the structure of § 1.55 and § 1.78.

Response: The Office is retaining in the regulations the provisions pertaining to pre-AIA applications (e.g., § 1.131) or modifying provisions in the regulations such that they pertain to both or either AIA or pre-AIA applications (e.g., §§ 1.104 and 1.110). Certain provisions apply to any application filed on or after March 16, 2013, regardless of whether the application is an AIA or pre-AIA application (e.g., §§ 1.55 and 1.78 apply to any application filed on or after March 16, 2013). In this situation, the regulations generally do not include provisions that apply only to applications filed prior to March 16, 2013. The Office has simplified the structure of §§ 1.55 and 1.78 and included paragraph headings for clarity.

Comment 44: Two comments requested that the Office take the opportunity to clarify what is meant by “conflicting claims” in proposed § 1.78(e) as the rule does not explicitly recite the standard. One comment suggested that the standard should be that the claims are drawn to the same or substantially the same invention (as required in a derivation proceeding under the AIA or the pre-AIA interference provisions).

Response: The term “conflicting claims” in § 1.78 has been changed to “patentably indistinct claims” in this final rule for clarity.

Comment 45: One comment suggested deleting the requirement set forth in proposed § 1.55 to “identify foreign applications with the same subject matter having a filing date before that of the application for which priority is claimed” because this requirement appears unnecessarily burdensome and there does not appear to be a need for this information to determine foreign priority. One comment asserted that there is an inconsistency between proposed § 1.78(c)(5), which does not permit cross references to applications for which benefit is not claimed in an application data sheet, and proposed § 1.55(a)(3), which permits the identification of 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.

Response: The requirement to “identify foreign applications with the same subject matter having a filing date before that of the application for which priority is claimed” has been

removed from § 1.55 in this final rule. The Office also revised § 1.77 to indicate that cross-references to related applications should appear in the specification (rather than in an application data sheet).

Comment 46: One comment requested that the Office exercise its regulatory authority to clarify what kind of grant qualifies as a joint research agreement and what type of cooperative agreement which is not a written contract qualifies as a joint research agreement for the purpose of disqualifying prior art under AIA 35 U.S.C. 102(b)(2)(C) and (c). Another comment suggested that the Office confirm an expansive or liberal interpretation of what constitutes a joint research agreement, so that entities who enter into collaborative agreements without formal written contracts drafted by legal experts can still rely on the provisions of AIA 35 U.S.C. 102(b)(2)(C).

Response: AIA 35 U.S.C. 100(h) defines what constitutes a joint research agreement for purposes of AIA 35 U.S.C. 102. There was no substantive change to the definition of joint research agreement under the AIA.

Comment 47: One comment requested that the Office provide a means for an applicant to confidentially make of record any joint research agreement, and require that only minimal disclosure of the parties involved in the joint research agreement in the specification in accordance with proposed § 1.104. The comment further requested that the Office permit the amendment of the specification pursuant to § 1.71(g)(1) regarding the parties involved in the joint research agreement throughout examination and without a

fee because inventorship is necessarily an on-going determination throughout examination.

Response: AIA 35 U.S.C. 102(c) does not require that a joint research agreement be made of record in the application, but does require the application to disclose or be amended to disclose the names of the parties to the joint research agreement. The Office will not enter an amendment to the specification regarding the parties involved in the joint research agreement throughout examination without a fee because the fee simply recovers the Office's costs of updating the record of the application.

Comment 48: One comment suggested that a listing of parties to a joint research agreement be provided for in § 1.77, which concerns arrangement of application elements.

Response: Section 1.77(b)(4) provides for the disclosure of names of parties to a joint research agreement.

Comment 49: One comment requested that proposed § 1.104(c)(5)(i) and (ii) specify that those sections apply to a claimed invention in an application "pending" on or after December 10, 2004.

Response: Section 1.104 has been revised in this final rule to clearly specify which applications and patents are entitled to the provisions of § 1.104(c)(5)(i) and (ii).

Comment 50: One comment suggested that references to a joint inventor be added in proposed §§ 1.78(a)(2) and 1.110 when the term inventor is not intended to apply to the entire inventive entity.

Response: Sections 1.78 and 1.110 as adopted in this final rule refer to the inventor or a joint inventor as appropriate.

Comment 51: One comment requested that the Office explain why the request for information regarding inventorship and ownership of the subject matter of individual claims set forth in proposed § 1.110 is not provided for in current § 1.105 (Requirements for Information).

Response: This specific provision was provided for in § 1.110 before § 1.105 was implemented and was retained for examination purposes.

Comment 52: One comment suggested that proposed § 1.78(e) would give the Office the authority to require cancellation of claims and that the cancellation of claims is substantive.

Response: Section 1.78(e) as adopted in this final rule does not represent a change in Office practice. See former § 1.78(b) (“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”).

Comment 53: One comment suggested amending proposed § 1.131(b) to provide an appropriate example to show conception of an invention with due diligence.

Response: MPEP § 715 et seq. and the case law cited therein provide guidance regarding conception of an invention and due diligence.

Comment 54: One comment suggested that the Office take the opportunity to revise § 1.77(b) to separate out those items of information currently required under separate headings in a patent application that are now going to be tracked by the application data sheet (such as name, citizenship and residence of applicant, related applications, federally sponsored joint research, joint research agreements, and the proposed rule for prior disclosures by or for an inventor under § 1.130). The comment further suggested that since the timeline for filing the information required by proposed § 1.77(b)(6) is not coextensive with the filing of the application, the requirement to include this information in the patent application seems out of place. The comment also suggested that keeping all of this information tracked and published as part of the application data sheet available on PAIR, or as part of the cover page of a patent or published application, would keep the public informed in a more efficient manner.



Response: The arrangement of the specification as set out in § 1.77 is a suggested and preferred arrangement, but is not an arrangement that an applicant is required to follow. In addition, information such as related applications, federally sponsored joint research, joint research agreements, and prior inventor disclosures are not provided for in an application data sheet.

Comment 55: One comment suggested that the Office should avoid using old rule numbers for new rules.

Response: In general, the Office avoids using old rule numbers. The Office also prefers to group related rules together. In this instance, there are no rule numbers available in the vicinity of §§ 1.130, 1.131, and 1.132. Furthermore, former § 1.130 has been rarely invoked. Thus, the potential confusion from relocating the provisions of former § 1.130 to § 1.131 and using § 1.130 for AIA applications is minimal.

Comment 56: One comment requested that the Office provide a clear definition in § 1.9 regarding what constitutes a divisional application.

Response: MPEP § 201.06 indicates that a divisional application is an application for an independent or distinct invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in the earlier or parent application. This definition of divisional application located in the MPEP is adequate for current Office proceedings.

Comment 57: One comment suggested that § 1.110 be revised to include the phrase “or obligation to assign ownership” for completeness.

Response: Section 1.110 as adopted in this final rule includes the phrase “or obligation to assign ownership.”

### **Rulemaking Considerations:**

**A. Administrative Procedure Act:** The changes in this final rule do not change the substantive criteria of patentability. These changes in this final rule 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, published proposed changes and a Regulatory Flexibility Act certification as it sought the benefit of the public's views on the Office's proposed implementation of this provision of the AIA.

One comment suggested that the Office's reliance upon Cooper Technologies is misplaced and that the Federal Circuit's decision in Tafas v. Kappos, 586 F.3d 1369 (Fed. Cir. 2009) (Tafas IV) requires notice and comment for all Office rulemakings. The Federal Circuit in Tafas IV granted the parties' request to dismiss the appeal in the Tafas litigation as moot and denied GlaxoSmithKline's and the Office's request to vacate the district court's decision in Tafas v. Dudas, 541 F. Supp. 2d 805 (E.D. Va. 2008) (Tafas II). The Federal Circuit in Tafas IV did not reach the merits of the district court's decision in Tafas II and thus is not an "affirmance" of that decision. Moreover, the Federal Circuit in Tafas IV did not discuss its previous decision in Cooper Technologies. Thus, the Federal Circuit's decision in Tafas IV cannot reasonably be viewed as casting doubt on its prior statement in Cooper Technologies 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." See Cooper Techs., 536 F.3d at 1336-37; see also Mikkilineni v. Stoll, 410 Fed. Appx. 311, 313 (Fed. Cir. 2010) (Office's 2009 guidelines concerning 35 U.S.C. 101 are interpretive, rather than substantive, and are thus exempt from the notice and comment requirements of 5 U.S.C. 553). However, as discussed previously, the Office published the proposed changes for comment as it sought the benefit of the public's views on the Office's proposed implementation of this provision of the AIA.

The comment also stated that the Office did not make the data (statistics, mathematical or computer models, and assumptions, including spreadsheets or other models that the Office uses to project growth and future filing rates) relied upon in the notice of proposed rulemaking publicly available in a rulemaking docket at the time of the notice of proposed rulemaking so that the public had fair notice and a meaningful opportunity to comment and challenge the data forming the basis for the proposed changes in the notice of proposed rulemaking. The notice of proposed rulemaking specified the legal authority under which the changes were proposed, the basis and purpose of the proposed changes, the terms and substance of the proposed rule changes, and a description of the subjects and issues involved in the proposed changes. See Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act, 77 FR at 43742-51. The Office relied upon the changes to the patent laws in section 3 of the AIA as opposed to scientific or technical information or data as the basis or reason for the proposed rule changes. The data pertaining to the Regulatory Flexibility Act and Paperwork Reduction Act discussion were from the Office's PALM system and the basis for the Office estimates was stated in the Regulatory Flexibility Act and the Information Collection Review submission to OMB (which was made available to the public). See Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act, 77 FR at 43752, and the proposed information collection posted on OMB's Information Collection Review Web page on July 27, 2012, at [http://www.reginfo.gov/public/do/PRAViewICR?ref\\_nbr=201207-0651-008](http://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=201207-0651-008). The Office relied predominately upon the changes to the patent laws in section 3 of the AIA, and not

these data and estimates published pursuant to the Regulatory Flexibility Act and Paperwork Reduction Act, as the basis or reason for the proposed changes or changes being adopted in this final rule. The public was not deprived of fair notice or a meaningful opportunity to comment and challenge any data forming the basis for the proposed changes. Also, the issue of a meaningful opportunity to comment and challenge data forming the basis for the proposed changes is relevant only where there is a requirement for prior notice and opportunity for public comment. As discussed previously, prior notice and opportunity for public comment are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law).

**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 the changes in this final rule 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 adopting 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 another 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 provisions are comparable to requirements for affidavits and declarations under 37 CFR 1.132 for an applicant to show that a prior art disclosure is the applicant's own work (see case law cited in MPEP sections 716.10 and 2132.01) or that a disclosure was derived from the applicant (see case law cited in MPEP section 2137). The changes in this final rule will not result in additional small entities being subject to the need to submit such an affidavit or declaration.

The Office is also 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, except if: (1) the priority application was filed in a participating foreign intellectual property office (or a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office) and the Office either receives a copy of the foreign application from the participating foreign intellectual property office or a certified copy of the foreign application within the pendency of the application and before the patent is granted; or (2) the applicant provides an interim copy of the original foreign 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, and files a certified copy of the foreign application within the pendency of the application and before the patent is granted.

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 (see former 37 CFR 1.55(a)). The 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). In addition, this final rule permits applicants to provide an interim copy of the original foreign application in the event that the applicant cannot obtain a certified copy of the foreign application from the foreign patent authority in time to file it within four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. Based upon the data in the Office's PALM system, 375,484 (103,976 small entity) nonprovisional applications were filed in fiscal year (FY) 2012. Of these, 67,790 (8,371 small entity) nonprovisional applications claimed priority to a foreign priority application, and 68,769 (15,541 small entity) nonprovisional applications resulted from the entry of an international application into the national stage.

The Office is also adopting the following requirement for a nonprovisional application filed on or after March 16, 2013, that claims priority to or the benefit of the filing date of

an earlier application (i.e., foreign, provisional, or nonprovisional application, or international application designating the United States) filed prior to March 16, 2013 (a transition application): if a transition application 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 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. The Office, however, is also providing that an applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated as having a duty of disclosure with respect to the application that the transition application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013. Thus, an applicant is not required to conduct any additional investigation or analysis to determine the effective filing date of the claims in their applications.

Based upon the data in the Office's PALM system, of the 375,484 (103,976 small entity) nonprovisional applications filed in FY 2012, 12,246 (7,079 small entity) nonprovisional applications were identified as continuation-in-part applications; 59,819 (15,024 small entity) nonprovisional applications were identified as continuation applications; 22,162 (5,246 small entity) nonprovisional applications were identified as divisional applications; and 57,591 (28,200 small entity) nonprovisional applications claimed the



benefit of provisional application. As discussed above, 67,790 (8,371 small entity) nonprovisional applications claimed priority to a foreign priority application, and 68,769 (15,541 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 priority to or the benefit of the filing date of an earlier application do not disclose or claim subject matter not also disclosed in the earlier 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 addition, one comment indicated that the number of applicants who file applications with claims directed to both pre-AIA and AIA subject matter would be miniscule. 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.

Several comments questioned the statement in the notice of proposed rulemaking that the changes proposed in the rulemaking will not have a significant economic impact on a substantial number of small entities. One comment questioned this statement on the basis that the conversion of the U.S. patent system from a “first to invent” to a “first inventor to file” system is arguably one of the most comprehensive overhauls of the U.S. patent system since its inception. Another comment also cited statements by the AIA’s legislative sponsors and Administration officials and several articles concerning the first inventor to file system, and argued that the Office in its implementation of the first inventor to file system has ignored a number of economic effects, such as: (1) loss of access to investment capital; (2) diversion of inventor time into patent applications; (3) weaker patent protection due to hasty filing; (4) higher patent prosecution costs due to a hastily-prepared initial application; (5) higher abandonment rates; and (6) changes in ways of doing business. One comment questioned this statement on the basis of the translation costs that will result from the statement required by 37 CFR 1.55.

Section 3 of the AIA amends the patent laws pertaining to the conditions of patentability to convert the U.S. patent system from a “first to invent” system to a “first inventor to file” system. This final rule does not convert the U.S. patent system from a “first to invent” to a “first inventor to file” system (i.e., the U.S. patent system converts from a “first to invent” to a “first inventor to file” system by operation of section 3 of the AIA, regardless of the changes that are adopted in this final rule) or even introduce the conditions of patentability as provided for in section 3 of the AIA into the rules of practice. This final rule merely revises the rules of practice in patent cases for

consistency with, and to address the examination issues raised by, the changes in section 3 of the AIA. Thus, the discussions of the significance or impacts of section 3 of the AIA by the AIA's legislative sponsors and Administration officials, in articles concerning the first inventor to file system, and in the discussions in the comment relating to the impacts of the adoption of a first inventor to file system pertain to the changes to the conditions of patentability provided for in section 3 of the AIA and are not pertinent to the changes being adopted in this final rule. This final rule: (1) requires applicants to provide a statement if a nonprovisional application filed on or after March 16, 2013, claims priority to or the benefit of the filing date of an earlier application (i.e., foreign, provisional, or nonprovisional application, or an international application designating the United States of America), 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) provides that an applicant may be required to identify the inventorship and ownership or obligation to assign ownership, of each claimed invention on its effective filing date or on its date of invention, as applicable, in an application or patent with more than one named joint inventor, when necessary for purposes of an Office proceeding; and (3) provides a mechanism for an applicant to show that a disclosure was by the inventor or joint inventor, or was by another 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 another who obtained the subject matter from the inventor or a joint inventor. For the reasons discussed previously, the changes that are being adopted in this final rule will not have a significant economic impact on a substantial number of small entities.

The change to 37 CFR 1.55 will not result in translation costs for applicants that would not otherwise exist for applicants claiming priority to a non-English-language application. Initially, a nonprovisional application claiming priority to a foreign application could not be competently prepared without an understanding of the subject matter disclosed in the foreign application, as a claim in a nonprovisional is entitled to the benefit of a foreign priority date only if the foreign application supports the claims in the manner required by 35 U.S.C. 112(a). See In re Gosteli, 872 F.2d 1008 (Fed. Cir. 1989). Thus, it is not clear how this requirement would result in the need for translations not otherwise necessary to competently prepare a nonprovisional application that claims priority to a foreign application. Nevertheless, the changes to 37 CFR 1.55 will not increase translation costs over what these costs would be in the absence of such a requirement. Pre-existing 35 U.S.C. 119(b)(3) and 37 CFR 1.55 provide that the Office may require a translation of any non-English-language priority application when deemed necessary by the examiner. The examiner would need to require a translation in all nonprovisional applications filed on or after March 16, 2013, that claim priority to a non-English-language application that was filed prior to March 16, 2013, to determine whether AIA or pre-AIA 35 U.S.C. 102 and 103 apply to the application in the absence of information from the applicant.

In addition, it should be noted that a small business concern for purposes of Regulatory Flexibility Act analysis is a business or other concern that: (1) meets the SBA's definition of a "business concern or concern" set forth in 13 CFR 121.105; and (2) meets

the size standards set forth in 13 CFR 121.802 for the purpose of paying reduced patent fees. See Business Size Standard for Purposes of United States Patent and Trademark Office Regulatory Flexibility Analysis for Patent-Related Regulations, 71 FR 67109, 67112 (Nov. 20, 2006). 13 CFR 121.105 defines a business or other concern as a business entity organized for profit, with a place of business located in the United States, and which operates primarily within the United States or which makes a significant contribution to the U.S. economy through payment of taxes or use of American products, materials, or labor. See 37 CFR 121.105(a)(1).

Accordingly, the changes in this final rule 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). Several comments suggested that this rulemaking should be designated as “economically significant” under Executive Order 12866. The comments argued that the notice of proposed rulemaking indicates that the paperwork burden alone would be over \$100,000,000 per year. One comment (discussed previously) also cited statements by the AIA’s legislative sponsors and Administration officials and several articles concerning the first inventor to file system, and argued that the first inventor to file system will result in: (1) loss of access to investment capital; (2) diversion of inventor time into patent applications; (3) weaker patent protection due to hasty filing; (4) higher

patent prosecution costs due to a hastily prepared initial application; (5) higher abandonment rates; and (6) changes in ways of doing business.

The notice of proposed rulemaking indicated that this rulemaking has been determined to be significant for purposes of Executive Order 12866, but that this rulemaking is not economically significant as that term is defined in Executive Order 12866. See Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act, 77 FR at 43743 (“This rulemaking is not economically significant as that term is defined in Executive Order 12866”), and 43752 (“This rulemaking has been determined to be significant for purposes of Executive Order 12866”).

The Paperwork Reduction Act information provided with the notice of proposed rulemaking indicated that the majority of the burden hour costs pertain to affidavits and declarations under 37 CFR 1.131 and 1.132, which are provided for in pre-existing regulations to overcome rejections under pre-AIA 35 U.S.C. 102 and 103. See Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act, 77 FR at 43753 (“[t]he 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”). While the Office is providing for the filing of affidavits and declarations under AIA 35 U.S.C. 102(b) in new 37 CFR 1.130, the change from pre-AIA 35 U.S.C. 102 to AIA 35 U.S.C. 102 will not result in an increase in affidavits and declarations under 37 CFR 1.130, 1.131 and 1.132.

Rather, the change from pre-AIA 35 U.S.C. 102 to AIA 35 U.S.C. 102 should result in a decrease in such affidavits and declarations as well as a decrease in the burden hours associated with such affidavits and declarations. In any event, there are no instances in which an applicant needs to file an affidavit and declaration under 37 CFR 1.130 in an AIA application where the applicant would not have needed to file an affidavit and declaration under 37 CFR 1.131 or under 37 CFR 1.132 in the same situation in a pre-AIA application. Moreover, the information required for an affidavit and declaration under 37 CFR 1.130 in an AIA application to show that a disclosure is the inventor's own work or a prior disclosure of inventor's own work is significantly less than the proofs required to show prior invention in a pre-AIA application. Also, the requirement for a statement in certain applications claiming priority to or the benefit of a prior foreign, provisional, or nonprovisional application, or international application designating the United States of America, will not be an "annual" impact. A nonprovisional application claiming priority to or the benefit of a foreign or provisional application must be filed not later than twelve months from the filing date of the foreign or provisional application. See 35 U.S.C. 119(a) and (e). Thus, a statement should not be required in any application filed after March 16, 2014, unless the application is itself a continuation-in-part application. In any event, to avoid underestimating the respondent estimate for this requirement, the Paperwork Reduction Act estimate is based upon all applications filed in a fiscal year that claim priority to or the benefit of a prior foreign, provisional, or nonprovisional application, or international application designating the United States of America. The statement, however, is not required unless the application actually claims an invention with an effective filing date on or after March 16, 2013. Thus, the

Paperwork Reduction Act burden hour cost estimates pertaining to these statements overestimate the actual impact of this requirement.

Finally, as discussed previously, this final rule does not convert the U.S. patent system from a “first to invent” to a “first inventor to file” system. The U.S. patent system converts from a “first to invent” to a “first inventor to file” system by operation of section 3 of the AIA regardless of the changes that are adopted in this final rule. This final rule merely revises the rules of practice in patent cases for consistency with, and to address the examination issues raised by, the changes in section 3 of the AIA. Thus, the discussions of the significance or impact of section 3 of the AIA by the AIA’s legislative sponsors and Administration officials, in articles concerning the first inventor to file system, and in the discussion in the comment relating to the impacts of the adoption of a first inventor to file system pertain to the changes in section 3 of the AIA per se and not to the changes being adopted in this final rule.

**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 was submitted to OMB for its review and approval when the notice of proposed rulemaking was published, and was reviewed and preapproved by OMB under OMB control number 0651-0071 on September 12, 2012. The collection of information submitted to OMB also included an information collection (i.e., 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 is available at OMB's Information Collection Review Web site ([www.reginfo.gov/public/do/PRAMain](http://www.reginfo.gov/public/do/PRAMain)).

The Office also published the title, description, and respondent description of the information collection, with an estimate of the annual reporting burdens, in the notice of proposed rulemaking, and indicated that any comments on this information must be submitted by September 24, 2012. See [Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act](#), 77 FR at 43753-54. The Office received a comment on the proposed information collection suggesting that the notice of proposed rulemaking fails to comply with numerous provisions of the Paperwork Reduction Act. The comment specifically suggested that: (1) the Office did not submit a proposed information collection for the notice of proposed rulemaking and the information provided in the notice of proposed rulemaking does not supply transparent specific burden estimates (e.g., number of responses, hours per response, hourly rate, and the underlying objective support), to permit public comment; (2) the notice of proposed rulemaking has immense ripple effects in the information to be collected under OMB

control numbers 0651-0031 (patent processing, updating) and 0651-0032 (initial applications) as the number of newly filed patent applications is almost certain to increase due to the ripple effects of the AIA, and requires “extensive” “adjusting [of] the existing ways to comply with any previously applicable instructions and requirements;” and (3) the Office is creating new collections of information rather than updating existing OMB information collections under control numbers OMB 0651-0031 and 0651-0032.

The Office submitted a proposed information collection for the notice of proposed rulemaking providing the specific burden estimates (e.g., number of responses, hours per response, hourly rate) for each individual information collection item and the Office’s basis for these estimates. The proposed information collection was posted on OMB’s Information Collection Review Web page on July 27, 2012 (at [http://www.reginfo.gov/public/do/PRAViewICR?ref\\_nbr=201207-0651-008](http://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=201207-0651-008)).

The collection of information submitted to OMB with the notice of proposed rulemaking pertains to the impact resulting from the changes being proposed by the Office in this rulemaking. The changes in this rulemaking have no impact on the information to be collected under OMB control numbers 0651-0031 (patent processing, updating) and 0651-0032 (initial applications). As discussed previously, this final rule does not convert the U.S. patent system from a “first to invent” to a “first inventor to file” system. The U.S. patent system converts from a “first to invent” to a “first inventor to file” system by operation of section 3 of the AIA regardless of the changes that are adopted in this final rule. Section 3 of the AIA amends the patent laws pertaining to the conditions of

patentability to convert the U.S. patent system from a “first to invent” system to a “first inventor to file” system. This final rule merely revises the rules of practice in patent cases for consistency with, and to address the examination issues raised by, the changes in section 3 of the AIA. The changes being adopted in this final rule do not require any “extensive” “adjusting [of] the existing ways to comply with any previously applicable instructions and requirements.”

Finally, the Paperwork Reduction Act does not prohibit the creation of a new collection of information (rather than updating existing OMB information collections) to implement a new program. Creation of a new collection of information for review and approval by OMB when implementing a new program having Paperwork Reduction Act implications is an option for agencies to use at their discretion.

This final rule contains provisions for applicants to: (1) provide a statement if a nonprovisional application filed on or after March 16, 2013, claims priority to or the benefit of the filing date of an earlier application (i.e., foreign, provisional, or nonprovisional application, or an international application designating the United States of America), 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) identify the inventorship and ownership or obligation to assign ownership, of each claimed invention on its effective filing date or on its date of invention, as applicable, in an application or patent with more than one named joint inventor, when necessary for purposes of an Office proceeding; and (3) show that a disclosure was by the inventor or

joint inventor, or was by another 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 another 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 priority to or the benefit of the filing date of an earlier application (i.e., foreign, provisional, or nonprovisional application, or international application designating the United States of America), 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 use the identification of the inventorship and ownership or obligation to assign ownership, of each claimed invention on its effective filing date (as defined in 37 CFR 1.109), or on its date of invention, as applicable, 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 AIA 35 U.S.C. 102(a)(2) or pre-AIA 35 U.S.C. 102(e). The Office will use information concerning whether a disclosure was by the inventor or joint inventor, or was by another 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 another who obtained the subject matter from the inventor or a joint inventor, to determine whether the disclosure qualifies as prior art under AIA 35 U.S.C. 102(a)(1) or (a)(2).

The Office is not resubmitting the proposed information collection requirements under 0651-0071 to OMB. The Office will accept OMB's September 12, 2012 preapproval. The proposed information collection requirements under 0651-0071 remain available at the OMB's Information Collection Review Web site ([www.reginfo.gov/public/do/PRAMain](http://www.reginfo.gov/public/do/PRAMain)).

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 in 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 stated in the preamble, the 37 CFR part 1 is 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 1.14 is amended by revising paragraph (f) to read as follows:

**§ 1.14 Patent applications preserved in confidence.**

\* \* \* \* \*

(f) Notice to inventor of the filing of an application. The Office may publish notice in the Official Gazette as to the filing of an application on behalf of an inventor by a person who otherwise shows sufficient proprietary interest in the matter.

\* \* \* \* \*

4. Section 1.17 is amended by revising paragraphs (g) and (i) and removing and reserving paragraphs (n) and (o).

The revisions read as follows:

**§ 1.17 Patent application and reexamination processing fees.**

\* \* \* \* \*

(g) For filing a petition under one of the following sections which refers to this paragraph: ..... \$200.00

§ 1.12—for access to an assignment record.

§ 1.14—for access to an application.

§ 1.46—for filing an application on behalf of an inventor by a person who otherwise shows sufficient proprietary interest in the matter.

§ 1.55(f)—for filing a belated certified copy of a foreign application.

§ 1.59—for expungement of information.

§ 1.103(a)—to suspend action in an application.

§ 1.136(b)—for review of a request for extension of time when the provisions of § 1.136(a) are not available.

§ 1.377—for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.

§ 1.550(c)—for patent owner requests for extension of time in ex parte reexamination proceedings.

§ 1.956—for patent owner requests for extension of time in inter partes reexamination proceedings.

§ 5.12—for expedited handling of a foreign filing license.

§ 5.15—for changing the scope of a license.

§ 5.25—for retroactive license.

\* \* \* \* \*

(i) Processing fee for taking action under one of the following sections which refers to this paragraph: ..... \$130.00

§ 1.28(c)(3)—for processing a non-itemized fee deficiency based on an error in small entity status.

§ 1.41(b)—for supplying the name or names of the inventor or joint inventors in an application without either an application data sheet or the inventor’s oath or declaration, except in provisional applications.

§ 1.48—for correcting inventorship, except in provisional applications.

§ 1.52(d)—for processing a nonprovisional application filed with a specification in a language other than English.

§ 1.53(c)(3)—to convert a provisional application filed under § 1.53(c) into a nonprovisional application under § 1.53(b).

§ 1.55—for entry of a priority claim or certified copy of a foreign application after payment of the issue fee.

§ 1.71(g)(2)—for processing a belated amendment under § 1.71(g).

§ 1.103(b)—for requesting limited suspension of action, continued prosecution application for a design patent (§ 1.53(d)).

§ 1.103(c)—for requesting limited suspension of action, request for continued examination (§ 1.114).

§ 1.103(d)—for requesting deferred examination of an application.

§ 1.217—for processing a redacted copy of a paper submitted in the file of an application in which a redacted copy was submitted for the patent application publication.

§ 1.221—for requesting voluntary publication or republication of an application.

§ 1.291(c)(5)—for processing a second or subsequent protest by the same real party in interest.

§ 3.81—for a patent to issue to assignee, assignment submitted after payment of the issue fee.

\* \* \* \* \*

5. Section 1.53 is amended by:

- a. Revising paragraphs (b) introductory text and (c)(2)(ii) and (iii);
- b. Removing paragraph (c)(2)(iv);
- c. Revising paragraph (c)(4); and
- d. Removing paragraph (j).

The revisions read as follows:

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

\* \* \* \* \*

(b) Application filing requirements—Nonprovisional application. The filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121, or 365(c) and § 1.78(c) and (d).

\* \* \* \* \*

(c) \* \* \*

(2) \* \* \*

(ii) Payment of the issue fee on the application filed under paragraph (b) of this section; or

(iii) Expiration of twelve months after the filing date of the application filed under paragraph (b) of this section.

\* \* \* \* \*

(4) A provisional application is not entitled to the right of priority under 35 U.S.C. 119 or 365(a) or § 1.55, or to the benefit of an earlier filing date under 35 U.S.C. 120,

121, or 365(c) or § 1.78 of any other application. No claim for priority under 35 U.S.C. 119(e) or § 1.78(a) may be made in a design application based on a provisional application. The requirements of §§ 1.821 through 1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.

\* \* \* \* \*

6. Section 1.55 is revised to read as follows:

**§ 1.55 Claim for foreign priority.**

(a) In general. An applicant in a nonprovisional application may claim priority to 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) and this section.

(b) Time for filing subsequent application. The nonprovisional application must be filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed, or be entitled to claim the benefit under 35 U.S.C. 120, 121, or 365(c) of an application that was filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed. The twelve-month period is subject to 35 U.S.C. 21(b) (and § 1.7(a)) and PCT Rule 80.5, and the six-month period is subject to 35 U.S.C. 21(b) (and § 1.7(a)).

(c) Time for filing priority claim and certified copy of foreign application in an application entering the national stage under 35 U.S.C. 371. In an international

application entering the national stage under 35 U.S.C., the claim for priority must be made and a certified copy of the foreign application must be filed within the time limit set forth in the PCT and the Regulations under the PCT.

(d) Time for filing priority claim in an application filed under 35 U.S.C. 111(a).

In an original application filed under 35 U.S.C. 111(a), the claim for priority must 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)), and must identify the foreign 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 period in this paragraph does not apply in a design application.

(e) Delayed priority claim in an application filed under 35 U.S.C. 111(a). 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) in an original application filed under 35 U.S.C. 111(a) not presented in an application data sheet (§ 1.76(b)(6)) within the time period provided by paragraph (d) of this section is considered to have been waived. If a claim for priority is presented after the time period provided by paragraph (d) of this section, the claim may be accepted if the priority claim 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) must be accompanied by:

(1) The priority claim under 35 U.S.C. 119(a) through (d) or (f) or 365(a) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority

is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(2) A certified copy of the foreign application if required by paragraph (f) of this section, unless previously submitted;

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

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

(f) Time for filing certified copy of foreign application in an application filed under 35 U.S.C. 111(a). In an original application filed under 35 U.S.C. 111(a), a certified copy of the foreign application must 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, except as provided in paragraphs (h) and (i) of this section. If a certified copy of the foreign application is not 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, and the exceptions in paragraphs (h) and (i) of this section are not applicable, the certified copy of the foreign application must be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in § 1.17(g). The time period in this paragraph does not apply in a design application.

(g) Requirement for filing priority claim, certified copy of foreign application, and translation in any application. (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 also 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 otherwise provided in 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.

(h) Foreign intellectual property office participating in a priority document exchange agreement. The requirement in paragraphs (c), (f), and (g) for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

(1) The foreign application was filed in a foreign intellectual property office participating with the Office in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office), or a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy;

(2) The claim for priority is presented in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and the applicant provides the information necessary for the participating foreign intellectual property office to provide the Office with access to the foreign application;

(3) The copy of the foreign application is received by the Office from the participating foreign intellectual property office, or a certified copy of the foreign application is filed, within the period specified in paragraph (g)(1) of this section; and

(4) The applicant files a request in a separate document that the Office obtain a copy of the foreign application from a participating intellectual property office that permits the Office to obtain such a copy if the foreign application was not filed in a participating foreign intellectual property office but a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property

office that permits the Office to obtain such a copy. The request must identify the participating intellectual property office and the subsequent application by the application number, day, month, and year of its filing in which a copy of the foreign application was filed. The request must be filed within the later of sixteen months from the filing date of the prior foreign application or four months from the actual filing date of an application under 35 U.S.C. 111(a), within four months from the later of the date of commencement (§ 1.491(a)) or the date of the initial submission under 35 U.S.C. 371 in an application entering the national stage under 35 U.S.C. 371, or with a petition under paragraph (e) of this section.

(i) Interim copy. The requirement in paragraph (f) for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

(1) A copy of the original foreign application clearly labeled as “Interim Copy,” including the specification, and any drawings or claims upon which it is based, is filed in the Office together with a separate cover sheet identifying the foreign application by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and stating that the copy filed in the Office is a true copy of the original application as filed in the foreign country (or intellectual property authority);

(2) The copy of the foreign application and separate cover sheet is filed within the later of sixteen months from the filing date of the prior foreign application or four months from the actual filing date of an application under 35 U.S.C. 111(a), or with a petition under paragraph (e) of this section; and

(3) A certified copy of the foreign application is filed within the period specified in paragraph (g)(1) of this section.

(j) Requirements for certain applications filed on or after March 16, 2013. If a nonprovisional application filed on or after March 16, 2013, claims priority to 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 nonprovisional 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 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 nonprovisional application. An applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(k) Inventor's certificates. An applicant in a nonprovisional application may under certain circumstances claim priority on the basis of one or more applications for an inventor's certificate in a country granting both inventor's certificates and patents. To claim the right of priority on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119(d), the applicant when submitting a claim for such right as specified in this section, must include an affidavit or declaration. The affidavit or declaration must include a specific statement that, upon an investigation, he or she is

satisfied that to the best of his or her knowledge, the applicant, when filing the application for the inventor's certificate, had the option to file an application for either a patent or an inventor's certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

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

7. 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 as defined in § 1.9(e).

\* \* \* \* \*

8. Section 1.76 is amended by revising paragraphs (b)(5) and (6) to read as follows:

**§ 1.76 Application data sheet.**

\* \* \* \* \*

(b) \* \* \*

(5) Domestic benefit information. This information includes the application number, the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under 35 U.S.C. 119(e), 120, 121, or

365(c). Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and § 1.78.

(6) Foreign priority information. This information includes the application number, country, and filing date of each foreign application for which priority is claimed. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and § 1.55.

\* \* \* \* \*

9. Section 1.77 is amended by revising paragraph (b)(2), redesignating paragraphs (b)(6) through (12) as paragraphs (b)(7) through (13), and adding a new paragraph (b)(6) to read as follows:

**§ 1.77 Arrangement of application elements.**

\* \* \* \* \*

(b) \* \* \*

(2) Cross-reference to related applications.

\* \* \* \* \*

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

\* \* \* \* \*

10. 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. An applicant in 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 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, or be entitled to claim the benefit under 35 U.S.C. 120, 121, or 365(c) of an application that was 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 the inventor or a joint inventor named in the later--filed application as the inventor or a joint inventor. 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)).

(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.

(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, the applicant will be notified and given a period of time within which to file, in the prior-filed provisional application, the translation and the statement. If the notice is mailed in a pending nonprovisional application, a timely reply to such a notice must include the filing in the nonprovisional application of either a confirmation that the translation and statement were filed in the provisional application, or an application data sheet eliminating the reference under paragraph (a)(3) of this



section to the prior-filed provisional application, or the nonprovisional application will be abandoned. The translation and statement may be filed in the provisional application, even if the provisional application has become abandoned.

(6) 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 nonprovisional 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 nonprovisional application. An applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(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 benefit claim was due under paragraph (a)(4) of this section and the date the benefit 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. An applicant in a nonprovisional application (including an international application entering the national stage under 35 U.S.C. 371) or an international application designating the United States of America 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, 121, or 365(c) and this section.

(1) Each prior-filed application must name the inventor or a joint inventor named in the later-filed application as the inventor or a joint inventor. 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 (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 also must 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.

(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 in a design application.

(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)).

(6) If a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a nonprovisional application or an international application designating the United States of America 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 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 later-filed application. An applicant is not required to provide such a statement if either:

(i) The application claims the benefit of a nonprovisional application in which a statement under § 1.55(j), paragraph (a)(6) of this section, or this paragraph that the application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013 has been filed; or

(ii) The applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the later filed application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

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

(e) Applications containing patentably indistinct claims. Where two or more applications filed by the same applicant contain patentably indistinct 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 patentably indistinct 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 (as defined in § 1.109), or on the date of the invention, as applicable, of the later claimed invention, the Office may require the applicant to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person on such date. Even if the claimed inventions were commonly owned, or subject to an obligation of assignment to the same person on the effective filing date (as defined in § 1.109), or on the date of the invention, as applicable, of the later claimed invention, the patentably indistinct 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.

11. Section 1.84 is amended by revising paragraph (a)(2) introductory text to read as follows.

**§ 1.84 Standards for drawings.**

(a) \* \* \*

(2) Color. On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility or design patent application. The color drawings must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color drawings are not permitted in international applications (see PCT Rule 11.13), or in an application, or copy thereof, submitted under the Office electronic filing system. The Office will accept color drawings in utility or design patent applications only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:

\* \* \* \* \*

**§ 1.103 [Amended]**

12. Section 1.103 is amended by removing paragraph (g).

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

**§ 1.104 Nature of examination.**

(c) \* \* \*

(4)(i) Subject matter which would otherwise qualify 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 or patent owner provides a statement to the effect that the subject matter 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 which would otherwise qualify 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 or patent owner provides a statement to the effect that the subject matter 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 filed on or after November 29, 1999, or any patent issuing thereon, in an application filed before November 29, 1999, but pending on December 10, 2004, or any patent issuing thereon, or in any 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 or patent owner provides a statement to the effect that the subject matter 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 pending on or after December 10, 2004, or in any 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 or patent owner provides a statement to the effect that the subject matter 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.

\* \* \* \* \*

14. Section 1.109 is added to read as follows:

**§ 1.109 Effective filing date of a claimed invention under the Leahy-Smith America Invents Act.**

(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 a right of priority or the benefit of an earlier filing date under 35 U.S.C. 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.

15. Section 1.110 is revised to read as follows:

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

When one or more joint inventors are named in an application or patent, the Office may require an applicant or patentee to identify the inventorship and ownership or obligation to assign ownership, of each claimed invention on its effective filing date (as defined in § 1.109) or on its date of invention, as applicable, when necessary for purposes of an Office proceeding. The Office may also require an applicant or patentee to identify the invention dates of the subject matter of each claim when necessary for purposes of an Office proceeding.

16. Section 1.130 is revised to read as follows:

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

(a) Affidavit or declaration of attribution. When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the disclosure was made by the inventor or a joint inventor, or the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor.

(b) Affidavit or declaration of prior public disclosure. When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the subject matter disclosed had, before such disclosure was made or before such subject matter was effectively filed, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or

indirectly from the inventor or a joint inventor. An affidavit or declaration under this paragraph must identify the subject matter publicly disclosed and provide the date such subject matter was publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(1) If the subject matter publicly disclosed on that date was in a printed publication, the affidavit or declaration must be accompanied by a copy of the printed publication.

(2) If the subject matter publicly disclosed on that date was not in a printed publication, the affidavit or declaration must describe the subject matter with sufficient detail and particularity to determine what subject matter had been publicly disclosed on that date by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(c) When this section is not available. The provisions of this section are not available if the rejection is based upon a disclosure made more than one year before the effective filing date of the claimed invention. The provisions of this section may not be available if the rejection is based upon a U.S. patent or U.S. patent application publication of a patented or pending application naming another inventor, the patent or pending application claims an invention that is the same or substantially the same as the applicant's or patent owner's claimed invention, and the affidavit or declaration contends that an inventor named in the U.S. patent or U.S. patent application publication derived the claimed invention from the inventor or a joint inventor named in the application or

patent, in which case an applicant or a patent owner may file a petition for a derivation proceeding pursuant to § 42.401 et seq. of this title.

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

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

(2) A specific reference under 35 U.S.C. 120, 121, or 365(c) to any patent or application that contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in 35 U.S.C. 100(i) that is on or after March 16, 2013.

17. 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 § 1.46, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or the date that it is effective as a reference under 35 U.S.C. 102(e) as in effect on March 15,

2013. Prior invention may not be established under this section 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 naming another inventor which claims interfering subject matter as defined in § 41.203(a) of this title, in which case an applicant may suggest an interference pursuant to § 41.202(a) of this title; or

(2) The rejection is based upon a statutory bar.

(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 as in effect on March 15, 2013, on a U.S. patent or U.S. patent application publication which is not prior art under 35 U.S.C. 102(b) as in effect on March 15, 2013, and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent or published application are not

identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent or patent application publication as prior art. The patent or patent application publication can be disqualified as prior art by submission of:

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

(2) An oath or declaration stating that the application or patent under reexamination and patent or published application are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104 as in effect on March 15, 2013.

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

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

(2) A specific reference under 35 U.S.C. 120, 121, or 365(c) to any patent or application that contains, or contained at any time, a claim to an invention that has an effective filing date as defined in 35 U.S.C. 100(i) that is before March 16, 2013.

(e) In an application for patent to which the provisions of § 1.130 apply, and to any patent issuing thereon, the provisions of this section are applicable only with respect to a rejection under 35 U.S.C. 102(g) as in effect on March 15, 2013.

**§§ 1.293 through 1.297 [Removed and Reserved]**

18. Sections 1.293 through 1.297 are removed and reserved.

19. Section 1.321 is amended by revising paragraph (d) introductory text 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 was disqualified as prior art as set forth in either § 1.104(c)(4)(ii) or (c)(5)(ii) as the result of activities undertaken within the scope of a joint research agreement , must:

\* \* \* \* \*

Date: February 11, 2013 \_\_\_\_\_  
Teresa Stanek Rea  
Acting Under Secretary of Commerce for Intellectual Property and  
Acting Director of the United States Patent and Trademark Office

[FR Doc. 2013-03453 Filed 02/13/2013 at 8:45 am; Publication Date: 02/14/2013]