

37 CFR § 1.131

- The Rule: When any claim of an application or a patent under reexamination is rejected [a party as described in 1.131] 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.
- Used to establish a date of invention before the effective date of a cited reference a/k/a swearing back or antedating a reference

Comparing and Contrasting Affidavits and Declarations

- Legal Effect – Little difference between the two. Both affidavits and declarations assert factual information.

Documentary Differences

- Affidavit - A statement based on personal first hand knowledge, signed and notarized.

Documentary Differences (cont.)

- Declaration – A statement based on personal first hand knowledge and signed, but not notarized. There is *no* presumption of authenticity regarding the declarant's signature. A declaration must include:
 - A warning that willful false statements and the like are punishable by fine or imprisonment, or both. 35 USC § 25(b), 37 CFR § 1.68.
 - A statement that all remarks made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

Practical Considerations When Using Declarations

- If the declarant later becomes hostile to the patentee/owner, ill, or dies it may be more difficult to prove the authenticity of the declarant's signature.
- Note: Declaration and Affidavit will be used interchangeably herein.

When to file 131/132 Declarations

- Prior to Final Rejection
 - Generally, all declarations and affidavits are considered if submitted prior to final rejection.
- Prior to the First Office Action with Petition to Make Special
 - Any declarations or affidavits must be submitted prior to the first office action and in any case, no later than one month after the petition to make special where the Applicant requests accelerated examination according to 37 CFR § 1.102, MPEP § 708.02.

When to file 131/132 Declarations (cont.)

- Declarations after Final Rejection
 - Only considered with showing of good and sufficient reasons why they are necessary and were not earlier presented. 37 CFR § 1.116(c).
- After Appeal
 - Affidavits are not considered without a showing of good and sufficient reason why they were not earlier presented. 37 CFR § 1.195.

When to file 131/132 Declarations (cont.)

- Continuation and Divisional Practice
 - Affidavits filed during prosecution of non-provisional applications under 37 CFR § 1.53(b) or former § 1.60 (non-provisional applications) do not automatically become of record with related continuation and divisional applications.

Who May File 1.131 Affidavits or Declarations

In other words, who can be an affiant or declarant?

- All of the inventors of the claimed subject matter.
- Less than all of the inventors where it is shown the invention of the claims under rejection was made by less than all of the inventors.
- The assignee or other party of interest (owner, coinventor, legal representative) where it is not possible to produce an affidavit from an inventor (e.g. hostile or deceased inventors). See CFR §§ 1.42, 1.43 and 1.47.

Restrictions On Proving Prior Invention in the US and NAFTA countries

- United States – Generally any evidence of invention from within the U.S. may be asserted in a 131 affidavit.
- NAFTA Countries – Where conception, diligence and/or actual reduction to practice are done in a NAFTA country, such evidence can only be relied upon to show prior invention on or after December 8, 1993.

Restrictions On Proving Prior Invention in WTO Countries

- WTO Countries – Evidence of conception, diligence and/or actual reduction to practice done in a WTO country can be relied upon on or after January 1, 1996.
- New WTO Countries – If a country became a WTO member after January 1, 1996, evidence of prior invention within that country may only be relied upon on or after the date of membership in the WTO.
- See www.WTO.org for a list of the 146 WTO countries and when they were admitted.

Restrictions On Proving Prior Invention

- Implications to Antedating in 131 Declarations and Affidavits
 - Evidence of Invention in a NAFTA or WTO country on or after the respective effective dates – Such evidence is used in the same manner as in the U.S. to antedate a reference.
 - Evidence of Invention in a NAFTA or WTO country prior to the respective effective date – Such evidence is only useful to establish completion of the invention (actual reduction to practice) on or after the effective date of NAFTA or WTO.

Where & When Does Evidence of Prior Invention Count

<p><u>US</u> Generally all evidence is useable.</p>	<p><u>NAFTA Countries</u> Evidence of prior invention is useable on or after December 8, 1993.</p>	<p><u>WTO Countries</u> Evidence of prior invention is useable on or after January 1, 1996.</p>
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