Training Slides on the Changes to 35 U.S.C. § 103(c) made by the AIPA

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Post-AIPA 35 U.S.C. § 103(c)  

For Applications Filed on or after November 29, 1999:

“(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”
Exclusion of commonly owned or assigned prior art under 35 U.S.C. § 103(c)

• Applies to all applications filed on or after November 29, 1999

• The AIPA amended 35 U.S.C. § 103(c) to add that subject matter that only qualifies as prior art under 35 U.S.C. § 102(c) (in addition to § 102(f) or (g)) and that is commonly owned, or subject to an obligation of assignment to the same person, at the time the invention was made cannot be applied in a rejection under 35 U.S.C. § 103(a).

• Does not affect use of a reference in an anticipatory rejection, or double patenting rejection
Exclusion of commonly owned or assigned prior art under 35 U.S.C. § 103(c)

- Applicant(s) must supply evidence of common ownership, or an obligation of assignment to the same person, at the time the invention was made

- A second OGC Notice, 1241 OGC 96 (Dec. 26, 2000), sets forth the following revised policy:

  applications and references (whether patents, patent applications, patent application publications, etc.) will be considered to be owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made, if the applicant(s) or the attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

- Thus, a statement, by itself, will be sufficient evidence
Exclusion of commonly owned or assigned prior art under 35 U.S.C. § 103(c)/102(e)

- The first O.G. Notice, 1233 OG 54 (Apr 11, 2000), indicated:
  - Filing of a continuing application or a continued prosecution application (CPA) on or after Nov. 29, 1999 would qualify the application for the benefit of new § 103(c)/102(e) exclusion of common assignee type prior art
  - but the filing of a request for continued examination (RCE) would not qualify the application for the exclusion if the application was filed prior to Nov. 29, 1999
  - Filing of a reissue application on or after Nov. 29, 1999 would qualify the reissue application for the benefit of the new § 103(c)/102(e) exclusion of common assignee type prior art
  - but recapture may be a bar
Example: Proper Prior Art Exclusion under 35 U.S.C. § 103(c)


Reference A filed as a § 111(a) patent application

Application X filed as a § 111(a) patent application

Reference A issues as a U.S. Patent

- The Examiner rejects (1) claims 1-10 of Application X under 35 U.S.C. § 102(e) as being anticipated by Reference A and (2) claims 11-20 of Application X under 35 U.S.C. § 103(a) as being obvious by Reference A in view of Reference B (not shown above).

- The Applicant replies to the Office action by filing proper evidence of common ownership of Reference A and Application X at the time the invention described in Application X was made.

- In the next Office action, the Examiner should:
  1. Maintain the rejection of claims 1-10 because the prior art exclusion of 35 U.S.C. § 103(c) does not apply to a rejection made under 35 U.S.C. § 102(e).
  2. Withdraw the rejection of claims 11-20. If the Examiner makes a new grounds of rejection, the Office Action must not be made Final unless Applicant’s reply otherwise necessitated the new ground(s) of rejection (e.g. amended claims 11-20, filed an IDS under 37 CFR 1.97(c), etc.).

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Example: Improper Prior Art Exclusions under 35 U.S.C. § 103(c)

Check to see if the reference that is being excluded only qualifies as prior art under 35 U.S.C. § 102(e), (f) or (g) (cont.)

In this example, Reference A is prior art under 35 U.S.C. § 102(a) (issued on 02/01/2000) and § 102(e) (filed on 11/01/1998). Therefore, applicant’s attempt to exclude Reference A by just the exclusion under 35 U.S.C. § 103(c) will not be sufficient to overcome the prior art rejection. Applicant will need to take further action such as swearing behind the issue date of Reference A by using a rule 131 declaration or affidavit to disqualify the reference as prior art under § 102(a).