35 USC § 103(c) & CREATE Act of 2004


E1. Under the amended 35 U.S.C. 103(c), what type of evidence will provide proof that the inventions were commonly owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made?

To disqualify a reference under 35 U.S.C. 103(c), applicant needs to supply evidence that the invention described in the application for patent and the invention described in the "prior art" reference applied against the application were commonly owed by, or subject to an obligation of assignment to, the same person, at the time the invention in the application for patent was made. The time requirement "at the time the invention was made" is required by statute. See 35 U.S.C. 103(c).

Applications and references will be considered by the examiner 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 an 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. For a more detailed explanation, see the "Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c)," 1241 OG 96 (Dec. 26, 2000).

E2. How did the CREATE Act amend 35 U.S.C. 103(c)?

Former 35 U.S.C. 103(c) was redesignated as 35 U.S.C. 103(c)(1) with no substantial change to the text. In addition, new subsections 35 U.S.C. 103(c)(2) and (3) were established to create provisions to allow certain prior art to be disqualified under 35 U.S.C. 103(c)(1) based on a joint research agreement.

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CREATE Act of 2004

E3. What is the effective date of the amendment to 35 U.S.C. 103(c) by the Cooperative Research and Technology Enhancement Act of 2004 (CREATE Act)?

The CREATE Act was enacted on December 10, 2004, and is effective for all patents, including reissued patents, granted on or after the enactment date. In other words, it is effective for all patent applications pending on or after December 10, 2004. The CREATE Act also effectively makes the 1999 amendment to 35
U.S.C. 103(c) applicable to any applications filed prior to November 29, 1999 and were pending on December 10, 2004. The 1999 amendment to 35 U.S.C. 103(c) added certain commonly owned or assigned prior art under 35 U.S.C. 102(e) to the prior art under 35 U.S.C. 102(f) and (g) that can be disqualified under 35 U.S.C. 103(c). For the 1999 amendment, see § 4807 of the American Inventors Protection Act of 1999 (see Pub. L. 106-113, 113 Stat. 1501, 1501A-591 (1999)).

Because the CREATE Act applies only to patents granted on or after December 10, 2004, the recapture doctrine may prevent the presentation of claims in reissue applications that had been amended or cancelled (e.g., to avoid a rejection under 35 U.S.C. 103(a) based upon subject matter that may now be disqualified under the CREATE Act) during the prosecution of the application which resulted in the patent being issued. See H.R. Rep. No. 108-425, at 6-7 (2003). The CREATE Act also applies to all reexamination proceedings in which the patent being reexamined was granted on or after December 10, 2004.

E4. What is a joint research agreement (JRA)?


E5. What type of prior art can be disqualified in view of a joint research agreement?

35 U.S.C. 103(c), as amended by the CREATE Act, continues to apply to subject matter (whether a patent document, publication, or other evidence) which qualifies as prior art only under 35 U.S.C. 102(e), (f) or (g), and which is being relied upon in a rejection under 35 U.S.C. 103(a).

If the subject matter also qualifies as a reference under 35 U.S.C. 102(a) or (b) and which is being relied upon in a rejection under 35 U.S.C. 103(a), 35 U.S.C. 103(c) cannot be relied upon to disqualify such subject matter until the applicant has shown that the subject matter is not prior art under 35 U.S.C. 102(a) or (b). For example, if the reference is a U.S. patent or U.S. patent application publication which is prior art under 35 U.S.C. 102(a) and (e), applicant could swear behind the reference’s publication date pursuant to 37 CFR 1.131 to disqualify the reference as prior art under 35 U.S.C. 102(a), and then use 35 U.S.C. 103(c) to disqualify the reference, if appropriate.

If the rejection is anticipation under 35 U.S.C. 102(e), (f), or (g), 35 U.S.C. 103(c) cannot be relied upon to disqualify the subject matter in order to overcome the anticipation rejection. Likewise, 35 U.S.C. 103(c) cannot be relied upon to disqualify the subject matter in order to overcome any double patenting rejection.

E6. Must the subject matter that is sought to be disqualified under 35 U.S.C. 103(c) be made on or after the execution of the joint research agreement or within the scope of the joint research agreement?

No, only the claimed invention that is seeking benefit of the CREATE Act must be made on or after the execution of the joint research agreement and within the scope of the joint research agreement. The subject matter, which is sought to be disqualified, may have a prior art date prior to the execution of the joint research agreement or may not be within the scope of the joint research agreement.

E7. Must the subject matter that is sought to be disqualified under 35 U.S.C. 103(c) be made by or on behalf of the parties to the joint research agreement?
Yes, the subject matter that is sought to be disqualified must be made by, or on behalf of, at least one of the parties to the joint research agreement.

**E8. What are the requirements for the statement pursuant to 35 U.S.C. 103(c)(2) to disqualify a reference based on a joint research agreement?**

To overcome a rejection under 35 U.S.C. 103(a) via the CREATE Act, the applicant must provide a statement to the effect that the disqualified subject matter and the claimed invention were made by or on the behalf of parties to a joint research agreement within the meaning of 35 U.S.C. 103(c)(3), that the joint research agreement was in effect on or before 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. The statement should be or begin on a separate sheet and must not be directed to other matters (37 CFR 1.4(c)). Evidence to support the statement is not required, except in the very rare circumstance that a patent examiner has independent evidence that casts doubt on the accuracy of the statement. Patent examiners should review the statement to make sure all the requirements are present.

**E9. Who can sign the statement required by the CREATE Act to disqualify a reference due to a joint research agreement?**

The requirement for signature for the statement is now the same as for any other correspondence as set forth in § 1.33(b). Therefore, a registered practitioner will be allowed to sign the statement in accordance with § 1.33.

**E10. What amendments are required to the specification in order to seek disqualification of a prior art reference based on a joint research agreement?**

In addition to providing a statement, the applicant must also amend the specification to disclose the names of the parties to the joint research agreement. See 35 U.S.C. 103(c)(2)(C) and 37 CFR 1.71(g).

**E11. After the applicant disqualifies a reference based on a joint research agreement, can the patent examiner make the next Office action final if it contains a subsequent new double patenting rejection based upon the disqualified prior art?**

Yes, the Office action can be made final (provided that no other new ground of rejection that was not necessitated by amendment is introduced) regardless of whether the claims themselves have been amended.

**E12. What are the content requirements for a terminal disclaimer under 37 CFR 1.321(d) to overcome a double patenting rejection based on a joint research agreement?**

The terminal disclaimer must include a provision that the owner of the application or patent waives the right to separately enforce any patent granted on that application or any patent subject to the reexamination proceeding and the disqualified patent or any patent granted on the disqualified application. The terminal disclaimer must also provide that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent and the disqualified patent, or any patent granted on the disqualified application are not separately enforced. Section 1.321(d) does not include a provision that the applicant or patentee agrees that such waiver and agreement shall be binding upon the owner of the rejected application or patent, its successors, or assigns because this is provided for in § 1.321(b).

**E13. Who must sign the terminal disclaimer under 37 CFR 1.321(d) to overcome a double patenting
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rejection based on a joint research agreement?

If filed in a patent application, the terminal disclaimer must be signed by the applicant, assignee, or an attorney or agent of record, in accordance with 37 CFR 1.321(b)(1). If filed in a reexamination proceeding, the terminal disclaimer must be signed by the patentee, or an attorney or agent of record, in accordance with 37 CFR 1.321(a)(1).

E14. If a party to a joint research agreement (JRA) made an invention after the effective date of the JRA and within the scope of a JRA, must applicant amend the application claiming that invention to disclose the JRA if benefit under the CREATE Act is not invoked?

Applicant need not provide a disclosure of the JRA (e.g., by making an amendment to the specification as set forth in 1.71(g)(1)) if the applicant is not invoking the benefit of the CREATE Act. Even though the disclosure of the JRA itself is not required, applicant must still disclosure material prior art in compliance with 37 CFR 1.56, including prior art that could be avoided by invoking the CREATE Act.

E15. Why is the Cooperative Research and Technology Enhancement Act of 2004 called the “CREATE” Act?

The shortened named “CREATE” is from the first initial of each word in the title of the Act with the second word “Research” contributing the second letter in addition to the first letter. See the underlined letters as follows: The Cooperative Research and Technology Enhancement Act of 2004.

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KEY: =online business system =fees =forms =help =laws/regulations =definition (glossary)

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