37 CFR § 1.131 Practice

Rule 131 Exercises
For Instructors
With Answers

USPTO Training Academy
Curriculum Committee
Which of the following references can be overcome by a suitable Rule 131 declaration? Assume for all parts of Exercise 1 that the rejected claim appears in an application filed by Davis on June 15, 2004, and is not entitled to the benefit of the filing date of any earlier application.
Exercise 1a

A magazine article by Jones, published 4-5-03

6-15-04
Davis appl’n filed
Exercise 1a (answer)

Answer:

Cannot be overcome. Jones is a § 102(b) statutory bar.

Magazine article
by Jones, published
4-5-03

more than 1 year

6-15-04

Davis appl’n filed
Exercise 1b

The rejection is based on U.S. patent to Yost, which does not claim the same patentable invention as the rejected claim.

Yost § 102(e) date
1-3-03

Yost patent issued
9-25-04

6-15-04
Davis appl’n filed
Answer:

May be overcome; reference is not a statutory bar and does not claim the same patentable invention as the rejected claim. Also, no question of admitted subject matter.
Rejection based on U.S. patent to Miles, which includes a claim that is identical to the rejected claim.

Miles § 102(e)

date | Miles patent issued
---|---
3-3-02 | 6-25-03

6-15-04
Davis appl’n filed
Exercise 1c (answer)

Answer:

Cannot be overcome under Rule 131, because Miles claims the “same patentable invention” as the rejected claim. Applicant may wish to consider a Rule 130 declaration (if common ownership condition satisfied) or requesting an interference.
**Exercise 1d**

Reference U.S. patent to Washington, which is described in the Davis application as depicting the basic device of which applicant’s invention is described as being an improvement.

<table>
<thead>
<tr>
<th>Washington’s § 102(e) date</th>
<th>Washington patent issued</th>
</tr>
</thead>
<tbody>
<tr>
<td>5-6-01</td>
<td>12-5-03</td>
</tr>
</tbody>
</table>

6-15-04

Davis appl’n filed
Answer:

Cannot be overcome. Subject matter relied on in the reference (i.e., Washington’s device) is admitted prior art.
Exercise 2

• The following includes a statement of facts:
  – A Rule 131 affidavit signed by all of the named inventors in the application asserting, “On March 25, 2001, which is prior to the date of the reference relied by the examiner, we built and successfully tested a first prototype of the invention recited in rejected claim 5.”

  a) Is this statement trying to show conception, reduction to practice or diligence?
  b) Would this statement be persuasive for what it is trying to show and if not, why?
Exercise 2 (answer)

a) Reduction to practice.

b) No, this affidavit presents conclusions and fails to recite sufficient facts for the examiner to determine:
   (a) which of the claim limitations are satisfied by the prototype;
   (b) whether the test conditions represented actual conditions or realistically simulated conditions;
   (c) whether the test results demonstrate that the test was in fact successful; and
   (d) whether the test results, if successful, were also reproducible.
Claims of an application filed by Cook on June 6, 2004, have been rejected under 35 U.S.C. § 102(a) for anticipation by a publication to Byrd published August 29, 2003.

Which of the following Rule 131 showings will be sufficient to antedate the Byrd reference?
Exercise 3a

Cook’s Rule 131 affidavit is accompanied by a copy of a laboratory notebook page which includes a sketch showing every feature recited in the rejected claims. His affidavit states that the sketch was made on March 29, 2003.

Sketch
3-29-03

Reference date
8-29-03

Cook’s filing date
6-6-04
Answer:

Rule 131 showing is insufficient -- no evidence of diligence during critical period.
Exercise 3a (answer - cont’d)

Sketch

3-29-03

Diligence needed

critical period

Conception

8-29-03
Reference date

6-6-04
Cook’s filing date
Exercise 3b

Assume in addition to the facts recited in part 3(a), that Cook’s affidavit explains that on August 25, 2003, he ordered the parts for the claimed invention, and that between that date and January 12, 2004, he also:

(1) received the parts;
(2) assembled them to make the claimed invention; and
(3) successfully tested the invention.

Assume the affidavit and supporting evidence establish that the test conditions were appropriate and demonstrated that the invention would work for its intended purpose.
Answer:

The showing is still not sufficient because it is not clear when the acts of receiving, assembling and testing occurred, how long they took, or how much time passed between these acts. Note, all that is said is that these acts are “between that date and January 12, 2004”. Acts asserted as having occurred during a specified time period are assumed to have occurred on the last day of that period. Thus there is no accounting for the entire critical period.
Exercise 3b (answer – cont’d)

<table>
<thead>
<tr>
<th>Sketch</th>
<th>Ordered parts</th>
<th>Received and assembled parts; tested invention</th>
<th>(actual red. to prac.)</th>
</tr>
</thead>
<tbody>
<tr>
<td>3-29-03</td>
<td>7-25-03</td>
<td>?</td>
<td>1-12-04</td>
</tr>
</tbody>
</table>

8-29-03 Reference filing date

6-6-04 Cook’s date

critical period
Exercise 3c

Additionally assume that the Cook gives the following dates for the acts of receiving, assembling and testing recited in Exercise 3b:

(1) the parts were received on November 2, 2003,
(2) the parts were assembled to make the invention during the period of January 5 to 10, 2004, and
(3) the successful testing occurred on January 12, 2004.
Answer:

Affidavit is still insufficient, because of 2-month period of unexplained inactivity from November 3, 2003, right after the parts were received, to January 4, 2004, right before the device was constructed.

The period of inactivity while waiting for parts is excused.
Exercise 3c (answer- cont’d)

<table>
<thead>
<tr>
<th>Sketch (conc)</th>
<th>Ordered parts</th>
<th>Rec’d parts</th>
<th>Constructed device</th>
<th>Successfully tested (R to P)</th>
</tr>
</thead>
<tbody>
<tr>
<td>3-29-03</td>
<td>7-25-03</td>
<td>11-2-03</td>
<td>1-5 to 1-10-04</td>
<td>1-12-04</td>
</tr>
</tbody>
</table>

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---GAP---

8-29-03

8-29-03 Reference date

6-6-04

Cook’s filing date

Reference date

4/19/07

131 Affidavits Exercises
critical period

22
Exercise 4

A generic claim to a chemical compound stands rejected under 35 USC § 102(a) as anticipated by a magazine publication which shows a single species of the claimed genus.

Applicant's Rule 131 evidence shows that prior to the reference date she made and successfully tested the reference species but no other species falling within the claimed genus. Should the rejection be withdrawn?
Answer:

Yes. When a generic claim is rejected under § 102 over a reference showing one or more species of the claimed genus, it is enough for the applicant to show a prior reduction to practice of merely what the reference shows. See, MPEP 715.03 (I)(B.) and In re Stempel, 113 USPQ 77 (CCPA 1957).
Exercise 5

When a claim has been rejected under § 103 for obviousness over a single reference, is it enough for applicant to show that prior to the reference date he or she achieved an actual reduction to practice of only the subject matter relied on in the reference?
Answer:

Yes. “Possession” of the claimed invention includes obvious variations and adaptations of what applicant actually made. See MPEP 715.02, and In re Spiller, 182 USPQ 614 (CCPA 1974).
Exercise 6(a) – 6(b)

For exercises 6(a) and 6(b), consider the following facts:

- A patent application was filed on October 20, 2003 claiming:
  1. A system for treatment of flue gas from a coal fired circulating fluidized bed reactor, comprising a wet scrubber operatively connected to the circulating fluidized bed reactor and configured for treating the flue gas, said wet scrubber being a flue gas desulphurization unit.
  2. The system of claim 1 wherein the system for treatment of flue gas is adapted to reduce sulfur oxide emissions by from about 95% to about 100%.

- The application was rejected under 35 USC 103 using a reference with an effective filing date of March 12, 2002. The reference only qualifies as prior art under 35 USC 102(e).
Exercise 6(a)

The following is the substance of a 131 declaration filed by the inventor to support conception:

“The invention as described and claimed in the above-referenced patent application was conceived prior to March 12, 2002 and was followed by diligence until constructive reduction to practice of filing the above patent application. I participated in the conception and development of the claimed scrubbing system and contributed to the disclosures which were subsequently used in preparation of the application. Exhibit 1 contains a redacted version of evidence of conception, which describes, in part, the invention and which was prepared prior to March 12, 2002.”
Exhibit 1 is a letter to an engineering company from the inventor that states in relevant part:

“I also wanted to ask if you know where I could get a good design engineer for the power plant. I can get a real good deal on some dirty coal. I think that I could still meet the air quality guidelines by using a fluidized bed. If it still isn’t clean enough I could add a wet scrubber and SCR to it and still save a lot of money. The coal is so cheap that it would still be cheaper than using compliance coal. My problem is that I don’t think that it’s been done before. I need someone who knows how to tie the wet scrubber and SCR to a fluidized bed plant and help with a cost analysis.

Is this sufficient to show conception? If not, why?
Exercise 6(a) (answer)

Answer: No. To establish conception, the Cox declaration states that exhibit 1 "contains a redacted version of evidence of conception, which describes in part the invention and which was prepared prior to March 12, 2002".

This statement does not even rise to the level of a "vague and general statement which describes in broad terms what the exhibits show". It is no more than a general statement that the exhibit supports the conception without any explanation of what the exhibits show and what portions are relied upon to support the conception of the claimed invention. This amounts to mere pleading. Thus applicant has not met his burden of clearly showing how the submitted evidence supports conception of the invention.
Answer (cont’d):

Further, the examiner has reviewed the submitted evidence in its entirety and does not find that it would support conception of the claimed invention even with a proper declaration. For example, it is not obvious to examiner where the claimed "wet scrubber being a flue gas desulphurization unit" or where the ranges of claim 2 are supported by the exhibits. As such it appears that Applicant has not shown a conception of the invention.
The following is the substance of the 131 declaration by the inventor concerning diligence that was provided in the rejected application:

“Exhibit 2 contains a summary and identification of activities which occurred between conception and constructive reduction to practice which illustrate that the invention was diligently developed through business and engineering activities.”
Exercise 6(b) (cont’d)

Exhibit 2 is a statement by applicant himself. The following is the substance of the exhibit:

“Immediately preceding March 12, 2002 until the date of filing the present application, Applicant engaged in activities directed toward reducing the invention to practice in a diligent manner. Specifically the inventors considered alternate designs as an improvement over the present invention. Engineering specifications were developed in order to verify feasibility of the invention. Further, consulting engineers were engaged for design implementation. Performance and economic comparisons with competing technologies were made. Strategies were also pursued during this time to evaluate logistics and marketability.

All of the above activities occurred simultaneously over the time period of early 2002 to late 2003. Applicant disclosed the present invention to legal counsel in May 2003 and the present application was duly filed on October 20, 2003.”

Is this sufficient to show diligence? If not, why?
Answer:

No. The period where diligence must be shown is from just before 3/12/02 (the effective date of the reference) until 10/20/03, the effective filing date of the instant application.

It appears that the evidence submitted is insufficient to establish diligence for this period. As proof of diligence, applicant states "exhibit 2 contains a summary and identification of activities which occurred between conception and constructive reduction to practice...". The mere allegation is not sufficient to establish diligence. (cont’d…)
Answer (cont’d): Further, exhibit 2 reveals major shortcomings:

There are no original exhibits supporting any of the allegations. Exhibit 2 is merely a statement, unsupported by any original documentation.

There are no dates alleged anywhere in the exhibit or the declaration. The only dates alleged are in the final sentence of exhibit 2: "Applicants disclosed the present invention to legal counsel in May 2003 and the present invention was filed October 20, 2003". "May 2003" is not specific enough.

Even if it were specific enough, the first date alleged is more than a year after the beginning of the critical period (March 12, 2002).

It also appears that applicant may want to rely on attorney diligence for some portion of the period (May to October 20, 2003) but no information is given regarding attorney diligence.

Therefore the entire period is not accounted for, it is not clear whether all the activities referred to can be used to support diligence to reduction to practice or to filing of the application.
Please consult with others when you have a 131 affidavit
- Thank you -