

Design Patent ProGuide – Declarations Under 1.130(a)
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Quick Reference Guide

DO:

Treat a § 1.130(a) declaration as an evidentiary document, not an extension of attorney remarks

Explain how the design moved from the inventor to public disclosure

Identify the specific reference being removed as prior art

Explicitly state the publication date and relate it to the effective filing date

Incorporate and explain supporting exhibits within the declaration itself

Explain authorization or control where the disclosure involves third parties or commercial listings

Assume the examiner will not infer missing facts from the record

DON'T:

Don't rely on attorney argument to supply facts missing from the declaration

Don't assume common ownership or inventorship alone establishes inventor-originated disclosure

Don't attach exhibits without identifying and explaining them in the declaration

Don't use conclusory statements such as "derived from the inventor" without factual explanation

Don't assume favorable allowance posture cures declaration deficiencies

Don't expect the examiner to infer authorization, timing, or disclosure context
Treat § 1.130(a) as a procedural formality

1. Introduction and Theory

Declarations under 37 C.F.R. § 1.130(a) serve a narrow but critical function in design patent prosecution. They provide a statutory mechanism for removing certain disclosures from the prior art where those disclosures originated with the inventor and fall within the applicable grace period. Unlike attorney argument, a declaration under § 1.130(a) operates as evidence and must independently establish the factual basis for the claimed exception.

This ProGuide addresses declarations under 37 C.F.R. § 1.130(a) as applied to design patent applications examined under the America Invents Act (AIA), i.e., applications with an effective filing date on or after March 16, 2013. For pre-AIA applications, different statutory provisions and evidentiary standards apply under former 35 U.S.C. § 102 and related case law. For transition applications filed after March 16, 2013 that claim priority to an earlier application, AIA treatment depends on whether the application ever contained a claim with an effective filing date on or after March 16, 2013. Where AIA applies, declarations under 37 C.F.R. § 1.130 may be used. Where pre-AIA applies, different statutory provisions govern.

In design patent practice, § 1.130(a) most commonly arises where a design has been publicly disclosed through commercial activity prior to filing, such as through product listings, distributor publications, or licensee activity. In these situations, the declaration must bridge the gap between inventorship and public disclosure by explaining how the design entered the public domain and why that disclosure should be attributed to the inventor.

Examiners treat § 1.130(a) declarations as standalone evidentiary submissions. They are evaluated independently of allowance posture, claim scope, or perceived commercial alignment between the applicant and the cited reference. As a result, omissions that might otherwise be overlooked in attorney remarks are frequently fatal when they appear in a declaration.

This ProGuide focuses on how examiners actually apply § 1.130(a) in design cases. It emphasizes evidentiary completeness, disclosure-path explanation, and timing precision, rather than formulaic recitation of statutory language.

Note: This ProGuide is subject to certain limitations, which are set forth in Appendix 3 of this document.

2. Recommended Form

Declarations under 37 C.F.R. § 1.130(a) should be drafted conservatively and with evidentiary precision. Because such declarations operate as statutory exceptions to prior art, omissions or ambiguities are commonly fatal.

2.1 Core Required Elements

A proper § 1.130(a) declaration should include, at a minimum:

1. Identity of Declarant

A statement that the declarant is the inventor or a joint inventor of the claimed design.

2. Identification of the Reference

Clear identification of the specific patent, application, or publication relied upon in the rejection.

3. Explanation of Disclosure Origin

A factual explanation of how the subject matter disclosed in the reference was obtained directly or indirectly from the inventor.

4. Authorization or Control

Where applicable, a statement explaining the declarant's authorization, control, or obligation relating to the disclosure (e.g., employment, assignment obligation, license, or distribution authorization).

5. Timing of Disclosure

A statement establishing that the disclosure occurred within the applicable grace period relative to the effective filing date.

6. Incorporation of Exhibits

Express identification and incorporation of supporting exhibits relied upon to substantiate the disclosure. Supporting exhibits should be clearly labeled, specifically referenced in the declaration text, and authenticated by the declarant. The declaration should explain what each exhibit is, how it was created or obtained, and why it supports the asserted disclosure pathway. Exhibits may be attached to the declaration or filed contemporaneously, but the declaration must clearly cross-reference them.

7. Online Disclosures and Archived Web Captures

For online disclosures and archived web captures, the declaration should also describe how the exhibit was retrieved and what the declarant personally observed (for example, the URL accessed, the date of access, and the steps taken to obtain an Internet Archive capture or platform timestamp). The declaration should state that the attached screenshot or archive page is a true and accurate copy of what was viewed on that date.

2.2 Drafting Approach

Declarations should be factual, specific, and self-contained. Practitioners should avoid conclusory language, legal argument, or assumptions regarding examiner inferences. Each

factual assertion should be supported either by sworn testimony within the declaration or by an incorporated exhibit.

Where possible, the declaration should explain the disclosure pathway in narrative form, sufficient to allow the examiner to understand precisely how the inventor's design entered the public domain.

2.3 Disclosure-Path Narrative Is Strongly Preferred Over Bare Assertions

Declarations that include a brief narrative explaining how the inventor's design moved from creation to public disclosure are more consistently persuasive than declarations limited to formulaic assertions. This is particularly true where the reference is a third-party publication, marketplace listing, or foreign-origin disclosure.

Effective declarations typically describe:

- the inventor's role in creating the design;
- the business or manufacturing relationship involved;
- how the design was authorized for publication or sale; and
- the inventor's awareness or control over that disclosure.

2.4 Identification of the Reference as an "Exception" Is Not Sufficient Without Supporting Facts

Several applications show that merely labeling a reference as an "exception under § 102(b)(1)(A)" or "inventor-originated" does not, by itself, satisfy § 1.130(a). The declaration must supply facts, not labels, supporting that conclusion. Practitioners should assume that examiners will disregard conclusory legal characterizations unsupported by sworn factual statements.

2.5 Explicit Identification of the Disclosure Medium Is Strongly Favored

Declarations that expressly identify the medium of disclosure (e.g., online product listing, marketplace posting, promotional material) are more consistently accepted than declarations that generically refer to "publication" or "disclosure." Where the disclosure is commercial, identifying the medium helps establish both public accessibility and inventor authorization, and reduces examiner skepticism.

2.6 Declarations Should Not Rely on Examiner Knowledge or Inference

Declarations drafted with the apparent expectation that the examiner will "connect the dots" are vulnerable. Examiners consistently require the declaration to supply all critical facts explicitly, even where those facts appear obvious from the record.

2.7 Declarations Should Address Disclosure Context, Not Merely Disclosure Identity

Effective declarations in this set do more than identify the reference and the inventor. They explain the context of disclosure, such as product launch, commercialization, or distribution, so the examiner can understand *why* the disclosure occurred and *why* it should be attributed to the inventor. Declarations limited to identity matching, without contextual explanation, are more likely to be treated as conclusory.

2.8 Avoid Reliance on Allowance Timing to Supply Missing Facts

Declarations submitted close to allowance must still independently satisfy § 1.130(a). Practitioners should not assume that proximity to allowance, or the absence of examiner pushback, excuses omissions in disclosure pathway, authorization, or timing.

2.9 Declaration Length

While there is no regulatory page limit for § 1.130(a) declarations, practitioners should aim for conciseness balanced with completeness. Declarations longer than 5 pages may invite examiner skepticism and should be used only where the factual complexity genuinely requires extensive explanation. In most cases, 2-4 pages of sworn narrative text is sufficient. Supporting exhibits are additional to this page estimate and may run longer depending on the nature of the documentation, such as screenshots, product listings, or authorization agreements. The 2-4 page guidance refers to the declaration narrative itself, not the total submission length.

2.10 Sample Declaration Language:

DECLARATION UNDER 37 C.F.R. § 1.130(a)

I, [NAME], declare that:

1. I am the inventor of the design claimed in U.S. Design Patent Application No. [APP NO.], filed [DATE].
2. The cited reference in the Office Action dated [DATE] is [SPECIFIC IDENTIFICATION OF REFERENCE].
3. The subject matter disclosed in [REFERENCE] was obtained directly from me. Specifically, [EXPLAIN HOW THE DISCLOSURE OCCURRED - e.g., 'I authorized [COMPANY] to list the product embodying my design for sale on [PLATFORM] pursuant to our manufacturing and distribution agreement dated [DATE]']. Attached as Exhibit A is [DESCRIPTION OF EXHIBIT].

[Optional - for multi-author references:]

- 3a. The reference lists [NAME OF NON-INVENTOR] as a co-author. [Select one:]
- [NAME] is also a joint inventor of the claimed design.

- [NAME] contributed [X] to the publication, but the design features relied upon in the rejection were created by and obtained from me.

4. The disclosure in [REFERENCE] occurred on [DATE], which is within one year of the effective filing date of the claimed design ([FILING DATE]). The effective filing date is [date]; therefore, the one-year grace period began on [date]. The disclosure occurred on [date], which falls within the one-year period.
5. I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Date: _____

Signature: _____

[NAME] Inventor"

2.11 Decision Tree

Should I file a § 1.130(a) declaration?

1. Is the cited reference a disclosure that originated with the inventor?
 - NO → § 1.130(a) is not available
 - YES → Continue to #2
2. Did the disclosure occur within one year of the effective filing date?
 - NO → § 1.130(a) is not available; consider priority claim
 - YES → Continue to #3
3. Can I document the disclosure pathway with evidence?
 - NO → § 1.130(a) may be insufficient; consider alternatives
 - YES → Continue to #4
4. Would amendment or argument be equally effective?
 - YES → Consider cost/benefit of alternatives
 - NO → § 1.130(a) is likely appropriate
5. Are foreign applications pending?
 - YES → Consult foreign patent counsel before filing
 - NO → Proceed with § 1.130(a) declaration"

3. Rules and Guidance for Declarations Under 1.130(a)

3.1 Declarations Under § 1.130(a) Are Evidentiary, Not Argumentative

A declaration submitted under 37 C.F.R. § 1.130(a) constitutes substantive evidence, not attorney argument. To be effective, the declaration must independently establish that the subject matter relied upon in the rejection was obtained directly or indirectly from the inventor or joint

inventor. Statements made solely in attorney remarks, even if supported by attached documents, are not treated as evidence unless the facts are expressly set forth in a sworn declaration.

Practitioners should assume that examiners will distinguish sharply between sworn factual statements and unsworn explanatory argument. Evidence not incorporated into the declaration itself may be disregarded when evaluating whether the statutory requirements of § 1.130(a) have been met.

3.1(a) Distinction from § 1.130(b).

This ProGuide addresses only declarations under 37 C.F.R. § 1.130(a), which disqualify prior art by establishing that the disclosure was made by, or obtained directly or indirectly from, the inventor. Declarations under § 1.130(b) serve a different purpose: they establish that the inventor publicly disclosed the subject matter before the third-party disclosure that is being used as prior art, thereby disqualifying the reference under 35 U.S.C. § 102(b)(1)(B) or § 102(b)(2)(B). Declarations under § 1.130(b) are less common in design patent practice and are not addressed in this ProGuide.

Cautionary note. In some cases, the record is unclear whether the third-party disclosure was obtained from the inventor (addressed by § 1.130(a)) or whether it is better characterized as a disclosure that occurred after the inventor's own public disclosure (addressed by § 1.130(b)). Where the factual posture is uncertain, practitioners should ensure the evidentiary record clearly supports the specific theory being advanced and avoid conclusory assertions that blur the distinction. If necessary to avoid an evidentiary gap, the response should address the applicable pathway with specificity and supporting exhibits.

3.1(b) Terminology Used in This ProGuide

- 'Reference': The prior art document cited by the examiner in a rejection
- 'Disclosure': The act or instance of making subject matter publicly available
- 'Publication': A specific form of disclosure, typically in written, online, or printed form
- 'Declarant': The person executing the § 1.130(a) declaration (typically the inventor)"

3.2 The Declaration Must Establish Inventor-Originated Disclosure

To remove a reference as prior art under the exceptions set forth in 35 U.S.C. § 102(b)(1)(A) (disclosures made by the inventor) or 35 U.S.C. § 102(b)(2)(A) (disclosures obtained from the inventor), the declaration must affirmatively establish that the subject matter relied upon in the rejection originated with the inventor of the application under examination. This requirement is not satisfied by conclusory statements that the reference is “owned by,” “associated with,” or “related to” the applicant.

Instead, the declaration must explain how the subject matter disclosed in the reference was obtained from the inventor, either directly or indirectly, including the mechanism by which the disclosure occurred (e.g., authorized product listing, distributor publication, licensee activity, or other controlled dissemination).

3.2(a) Direct vs. Indirect Disclosure

A disclosure is ‘obtained directly’ from the inventor when the inventor personally makes the disclosure, such as by publishing or posting the design themselves. A disclosure is ‘obtained indirectly’ from the inventor when a third party makes the disclosure based on information received from the inventor, such as where a manufacturer, distributor, or licensee publicly discloses a product embodying the inventor’s design pursuant to an authorization, agreement, or obligation involving the inventor.

To illustrate how indirect disclosure chains operate in practice: an inventor who provides design files to an overseas manufacturer, who in turn supplies the product to a domestic distributor, who then lists the product on an e-commerce platform, has made an indirect disclosure through a multi-step chain. A § 1.130(a) declaration in this scenario must trace each link, the inventor's authorization to the manufacturer, the manufacturer's relationship with the distributor, and the distributor's authority to publish the listing, with sufficient factual specificity. The longer and more attenuated the chain, the more evidentiary detail the declaration will need to supply at each step.

3.2(b) Application to § 103 Rejections.

A § 1.130(a) declaration may disqualify a reference used in an obviousness rejection under 35 U.S.C. § 103. Where a reference is removed as prior art via § 1.130(a), it cannot be relied upon in a § 103 combination. The declaration must still address each specific reference individually; blanket disqualification statements are insufficient. Practitioners should also note that where a § 103 rejection relies on multiple references and only one is successfully disqualified under § 1.130(a), the rejection may survive on the remaining references. In such cases, the response should either address all cited references with individual declarations, or separately argue patentability over the remaining prior art.

3.3 Temporal Relationship to the Effective Filing Date Must Be Explicit

A § 1.130(a) declaration must clearly establish that the inventor-originated disclosure occurred within the one-year grace period preceding the effective filing date of the claimed design, as set forth in 35 U.S.C. § 102(b)(1). Declarations that fail to identify the publication date of the reference, or that do not tie that date to the filing date of the application, are frequently found insufficient.

Where the disclosure is online, the declaration should identify the date of public availability and explain how that date was determined. Unsupported assumptions regarding publication timing are insufficient.

Best practice. To reduce timing disputes, the declaration should expressly state the effective filing date and explicitly identify the start of the one-year grace period. For example: “The effective filing date is [date]; therefore, the one-year grace period began on [date]. The disclosure occurred on [date], which falls within the one-year period.” Doing the calculation for the examiner helps avoid a finding that timing was not established.

3.3(a) Identifying the Correct Effective Filing Date in Priority Chain Applications

Where the application claims priority to or benefit of an earlier-filed application under 35 U.S.C. §§ 119 or 120, the effective filing date for purposes of the § 1.130(a) grace period analysis is the filing date of the earliest application in the priority chain to which the claim is entitled. Practitioners should not assume the effective filing date is the filing date of the application under examination. In continuation, divisional, and continuation-in-part applications, the declaration must identify the correct effective filing date and tie the disclosure date of the cited reference to that date. Where a continuation-in-part application is involved, different claims may have different effective filing dates depending on the written description support in the parent application, and each claim should be analyzed separately.

3.4 Supporting Evidence Must Be Incorporated Into the Declaration

Documents such as screenshots, product listings, authorization agreements, or publication records must be expressly identified and incorporated into the declaration as exhibits. Merely attaching such materials to the response, or describing them in attorney remarks, does not convert them into evidence.

The declaration should identify each exhibit by label and explain its relevance to the inventor-originated disclosure. Failure to do so may result in the examiner treating the materials as unsworn argument rather than evidence.

3.5 Declarations Under § 1.130(a) Are Reference-Specific

A § 1.130(a) declaration must address the specific reference relied upon in the rejection. Broad statements regarding general ownership, corporate affiliation, or design development history are insufficient unless they are tied directly to the cited reference and its disclosure.

If multiple references are applied, each reference must be addressed individually unless the declaration clearly establishes that the same inventor-originated disclosure applies to all cited references.

3.6 The Declaration Must Establish a Clear Chain of Attribution, Not Merely Common Ownership

Recent examinations confirm that examiners require a § 1.130(a) declaration to explain the chain by which the reference disclosure is attributable to the inventor, not merely that the applicant and the publisher are related entities. Declarations relying solely on common ownership, assignee identity, or corporate affiliation, without factual explanation of how the disclosure occurred, risk being treated as conclusory.

Where the disclosure arises from third-party publication (e.g., e-commerce listings, distributors, foreign manufacturers, or affiliates), the declaration must explain the relationship and authorization pathway connecting the inventor to the public disclosure.

The requirement to explain the chain of attribution (not merely show common ownership) is a rule of examiner treatment observed in practice, not merely drafting advice. It emerges repeatedly in applications where ownership was obvious but still required explanation.

3.7 Examiner Scrutiny Is Higher Where the Reference Is a Commercial Product Listing

Applications relying on § 1.130(a) to disqualify commercial product disclosures (including online listings and marketing materials) demonstrate heightened examiner scrutiny. In such cases, examiners expect the declaration to explain not only authorship of the design, but also how and why the product entered commerce, including the inventor's authorization or obligation permitting publication.

Absent such explanation, examiners may maintain the rejection even where the inventor is named on the application and the product appears to originate from the same source.

3.8 Examiner Will Not Infer Disclosure Authorization From Product Identity Alone

Examiners will not infer inventor authorization merely because the disclosed product appears identical to the claimed design or originates from the same commercial source. Even where inventorship and product identity are uncontested, examiners require an affirmative explanation of how the disclosure was authorized and made public. This rule applies with particular force to commercial disclosures, including product listings, catalogs, and marketplace postings.

3.9 § 1.130(a) Declarations Are Evaluated Independently of Allowance Posture

Examiners evaluate § 1.130(a) declarations without regard to whether the application is otherwise allowable. The sufficiency of the declaration is treated as a threshold evidentiary question, and deficiencies are not excused by favorable examination posture.

3.10 Examiners Do Not Relax § 1.130(a) Requirements Even Where the Case Is Otherwise Allowable

Examiners apply § 1.130(a) as an independent evidentiary gatekeeping requirement, even where all other statutory requirements are satisfied and the application is otherwise in condition for allowance. Favorable examination posture does not cure deficiencies in a declaration submitted under § 1.130(a).

3.11 Examiner Will Require § 1.130(a) Compliance Even Where Disclosure Appears Self-Evidently Inventor-Originated

Examiners will not dispense with § 1.130(a) requirements merely because the disclosure appears facially inventor-originated or commercially aligned with the applicant. Even where the relationship between the inventor and the disclosure is apparent from the record, examiners require a declaration that satisfies the regulation on its face.

3.12 § 1.130(a) vs. Common Ownership Statements Under § 102(b)(2)(C)

Declarations under 37 C.F.R. § 1.130(a) and common ownership statements under 35 U.S.C. § 102(b)(2)(C) serve different but complementary functions. A statement under § 102(b)(2)(C) disqualifies an earlier-filed patent application or patent as prior art by establishing that the subject matter disclosed and the claimed invention were owned by the same person, or subject to an obligation of assignment to the same person, or subject to a qualifying joint research agreement, and that this common ownership or obligation existed not later than the effective filing date of the claimed invention. However, § 102(b)(2)(C) does not apply to prior art under § 102(a)(1), such as published documents, online disclosures, or commercial product listings.

Where the cited reference is a published document or other § 102(a)(1) reference, practitioners must rely on § 1.130(a). Where the reference is an earlier-filed patent application that has also published, both mechanisms may be available depending on the nature of the rejection.

3.13 Formal Requirements for Declarations

All declarations submitted under § 1.130(a) must comply with the formal requirements of 37 C.F.R. § 1.68. In particular, the declaration must be in writing, must state that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true, must acknowledge that willful false statements are punishable under 18 U.S.C. § 1001, and must be signed by the declarant. Electronic signatures submitted through USPTO electronic filing systems satisfy these requirements, provided the signature complies with 37 C.F.R. § 1.4(d)(2). Under that provision, an S-signature must consist of the signatory's name presented between forward slash marks (e.g., /Jane A. Smith/) and must be accompanied by the printed or typed name of the signatory. Practitioners using third-party signature platforms should confirm that the resulting signature block meets this format before filing.

3.14 Joint Inventor Declarations

Where the application claims joint inventors, a § 1.130(a) declaration may be executed by any inventor or joint inventor. However, the declaration should clearly establish that the disclosure was made by or obtained from at least one of the named inventors. Where the disclosure involves only a subset of the joint inventors, the declaration should explain the contribution of each inventor to the disclosed subject matter.

In joint inventor situations, the declaration must still establish an adequate chain of attribution for the specific disclosure. If the cited reference identifies additional individuals (for example, a publication credited to an inventor and another person), the declaration should explain whether the additional individual is also a joint inventor of the claimed design or, if not, that the portion of the disclosure relied upon in the rejection was obtained directly or indirectly from at least one named inventor. The goal is to eliminate any gap suggesting that the relevant subject matter originated from a non-inventor rather than from the inventor

3.15 When to Use § 1.130(a)

Practitioners should consider a § 1.130(a) declaration where a cited reference appears to disclose subject matter originating from the inventor, the disclosure occurred within one year of the effective filing date, and the disclosure pathway can be documented with evidence. In many cases, § 1.130(a) is strategically preferable where amendment or argument would unduly narrow the claimed design.

Practitioners should also consider alternatives, including claim amendment, substantive argument, priority or benefit claims under §§ 119 or 120, or common ownership statements under § 102(b)(2)(C), where applicable.

3.16 When NOT to Use § 1.130(a)

Practitioners should consider alternatives to § 1.130(a) when:

1. The declaration would reveal confidential business information
2. The disclosure cannot be adequately documented
3. Amending claims is equally effective and less costly
4. The reference can be distinguished through argument
5. Foreign filing rights would be compromised by admitting early disclosure

In particular, practitioners should be cautious about filing § 1.130(a) declarations where foreign applications are pending, as the declaration may constitute an admission of prior public disclosure that could affect patentability in foreign jurisdictions with stricter novelty requirements.

CRITICAL FOREIGN FILING WARNING: Filing a § 1.130(a) declaration creates a sworn record of public disclosure that may bar patent rights in jurisdictions with absolute novelty requirements (e.g., Europe, Japan, China). Consult foreign counsel BEFORE filing if foreign applications are pending or planned.

3.17 Establishing Publication Dates for Online Disclosures

Where the cited reference is an online disclosure, the declaration must establish when the material became publicly accessible. Acceptable methods include platform-generated timestamps, dated screenshots, Internet Archive or Wayback Machine captures, and metadata associated with e-commerce listings. The declaration should explain how the date was determined and incorporate supporting documentation as exhibits. Unsupported assertions regarding online publication dates are insufficient

3.18 Correcting or Supplementing Insufficient Declarations

Where an examiner finds a § 1.130(a) declaration insufficient, practitioners may file a supplemental or corrected declaration addressing the identified deficiencies. The supplemental declaration should:

- Explicitly reference and incorporate the prior declaration
- Address the specific deficiencies identified by the examiner
- Provide any missing factual information
- Include any additional exhibits needed

There is no statutory limit on supplemental declarations, but repeated supplementation may draw increased scrutiny and should be avoided through careful initial preparation.

3.19 Fees

No separate fee is required for filing a § 1.130(a) declaration in response to an Office Action. However, if the declaration is filed after final rejection or after allowance, fees may apply (RCE fees, petition fees, etc.) depending on the procedural posture.

3.20 Effect on double patenting

A § 1.130(a) declaration may remove a reference as prior art for purposes of §§ 102 and 103, but it does not eliminate the possibility of a non-statutory obviousness-type double patenting rejection where the rejection is based on commonly owned or commonly inventive subject matter in a patent or application. In that circumstance, a terminal disclaimer may still be required to overcome double patenting, even if § 1.130(a) is successful in removing the reference as prior art.

3.21 A § 1.130(a) Declaration Must Address *All* Authorship Appearing on the Reference

When the cited reference lists multiple authors, contributors, or named entities, a § 1.130(a) declaration must expressly account for each such individual or entity. The declaration must explain either (i) how each named contributor obtained the disclosed design directly or

indirectly from the inventor, or (ii) why the additional named individual did not contribute to the disclosed design relied upon in the rejection.

Prosecution history support: Application 29/970,358 – examiner rejected a declaration that addressed only the inventor while the reference listed additional named contributors.

3.22 Declarant Identity Must Match the Disclosure Path

Although a declaration is typically executed by an inventor, the declarant must be a person with firsthand knowledge of the disclosure pathway. Where the disclosure occurred through a corporate entity, distributor, licensee, or online platform, the declaration must either (i) explain the declarant’s personal knowledge of those activities, or (ii) include supporting evidence establishing that knowledge.

Prosecution history support: Application 29/940,081 – examiner discounted a declaration where the inventor lacked demonstrated personal knowledge of third-party listing activity.

3.23 Declarations Must Negate Independent Third-Party Creation Where Plausible

Where the cited reference is a third-party publication or commercial listing, the declaration must affirmatively negate the possibility that the disclosure resulted from independent third-party creation. Silence on this point may render the declaration insufficient where independent creation is plausible from the face of the reference.

Prosecution history support: Application 29/947,566 – examiner required clarification that the third-party seller did not independently design the disclosed article.

4. Applications of Rules and Guidance to Objections and Rejections

4.1 Failure to Incorporate Supporting Evidence Into the Declaration (Evidence Treated as Attorney Argument)

In Application 29/937,783, the applicant attempted to disqualify a cited reference under 37 C.F.R. § 1.130(a) by submitting screenshots and other supporting materials purporting to establish inventor-originated disclosure. The examiner maintained the § 102(a)(1) rejection because the supporting documents were not expressly identified, incorporated, or explained within the declaration itself. The examiner treated the attached materials as attorney argument rather than evidence because the declaration failed to provide a sworn narrative establishing the disclosure pathway and failed to incorporate the exhibits into the declaration record. The prosecution demonstrates that merely attaching documentation to a response is insufficient unless the declaration itself expressly incorporates the exhibits and explains their relevance to the inventor-originated disclosure showing. Rule 3.1. Rule 3.4. Rule 3.6.

4.2 Declaration Accepted Where Disclosure Mechanism Was Fully Explained (Commercial Product Listing)

In Application 29/985,793, the examiner withdrew a rejection under 35 U.S.C. § 102(a)(1) after submission of a declaration under 37 C.F.R. § 1.130(a). The declaration was persuasive because it did not merely identify the inventor, but instead explained the disclosure mechanism by which the design entered the public domain through a commercial product listing. The declaration identified the specific reference, established that the disclosure was obtained directly or indirectly from the inventor, and provided an evidentiary narrative linking the inventor to the public disclosure. The declaration also addressed the timing requirement by establishing that the disclosure occurred within the applicable grace period. This example illustrates that examiners will accept § 1.130(a) declarations where the declaration functions as a complete evidentiary record, rather than relying on conclusory assertions of inventorship or ownership. Rule 3.2. Rule 3.3. Rule 3.6. Rule 3.7.

4.3 Third-Party Publication Not Excused Without Attribution Chain (Examiner Maintains § 102 Rejection)

In Application 29/949,595, the applicant submitted a declaration under 37 C.F.R. § 1.130(a) attempting to remove a reference that appeared to involve third-party publication. The examiner declined to withdraw the § 102(a)(1) rejection because the declaration failed to explain how the third party obtained and disclosed the design. Although the declarant was identified as the inventor, the examiner required sworn factual detail establishing the disclosure pathway between the inventor and the third-party publisher. This prosecution history illustrates that inventor identification alone is insufficient when the reference appears to originate from a separate entity, and the declaration must establish a clear chain of attribution rather than relying on implied affiliation or contextual inference. Rule 3.2. Rule 3.6. Rule 3.8.

4.4 Commercial Disclosure Accepted Despite Third-Party Publisher Where Authorization Was Explained

In Application 29/963,465, the cited reference appeared to be a third-party publication, but the examiner treated the reference as an exception under 35 U.S.C. § 102(b)(1)(A) after submission of a § 1.130(a) declaration. The declaration succeeded because it explained the inventor's role in authorizing the disclosure and clarified the relationship between the inventor and the entity responsible for publishing the commercial disclosure. This prosecution demonstrates that third-party publication does not preclude § 1.130(a) relief when the declaration provides a factual authorization narrative and establishes that the disclosure was obtained directly or indirectly from the inventor. Rule 3.2. Rule 3.6. Rule 3.7. Rule 3.8.

4.5 Declaration Rejected for Failure to Explain Disclosure Mechanism (Inventorship Alone Insufficient)

In Application 29/931,350, the examiner maintained a § 102(a)(1) rejection despite submission of a declaration under 37 C.F.R. § 1.130(a). The examiner acknowledged the inventor's identity but found the declaration insufficient because it did not explain how the design was disclosed to the public or what authorization permitted the disclosure. The examiner required an affirmative explanation of the mechanism by which the disclosure entered the public domain, rather than conclusory assertions that the reference originated with the inventor. This

prosecution history illustrates that the “how” of disclosure is a mandatory evidentiary component of § 1.130(a) practice and cannot be supplied through inference. Rule 3.2. Rule 3.8. Rule 3.11.

4.6 Examiner Requires Formal § 1.130(a) Showing Despite Apparent Commercial Origin

In Application 29/997,788, the examiner required strict compliance with 37 C.F.R. § 1.130(a) even though the disclosure appeared to have an obvious commercial relationship to the applicant. The examiner did not infer authorization, ownership, or disclosure origin from contextual facts in the record and instead treated the declaration as a necessary evidentiary instrument requiring complete sworn factual support. This example demonstrates that examiners apply § 1.130(a) as a formal evidentiary gatekeeping requirement and will not relax the standard merely because the commercial origin appears self-evident. Rule 3.9. Rule 3.10. Rule 3.11.

4.7 Declaration Accepted Where Timing Was Explicitly Established

In Application 29/930,688, the examiner accepted a declaration under 37 C.F.R. § 1.130(a) after determining that the disclosure date fell within the one-year grace period. The declaration was persuasive because it explicitly identified the disclosure date and tied that date directly to the effective filing date of the application, leaving no ambiguity as to the grace-period calculation. This prosecution demonstrates that timing must be treated as an express evidentiary element and should not be left to examiner inference or unstated assumptions. Rule 3.3.

4.8 Declaration Discounted Where Declarant’s Personal Knowledge Was Not Demonstrated

In Application 29/940,081, the examiner discounted a § 1.130(a) declaration because the declaration did not establish how the declarant had personal knowledge of the disclosure pathway, including the authorization process and the third-party listing activity. The examiner treated the declaration as insufficient where the disclosure occurred through a distributor or commercial listing and the declaration failed to show the declarant’s firsthand basis for the asserted facts. This prosecution history illustrates that a declaration must not only state that the disclosure was authorized, but must also establish why the declarant is competent to testify to the disclosure mechanism and authorization facts. Rule 3.22. Rule 3.8. Rule 3.6.

4.9 Declaration Rejected Where Multiple Named Contributors Were Not Addressed

In Application 29/970,358, the examiner rejected a § 1.130(a) declaration because the cited reference listed two named contributors, but the declaration addressed only the inventor and failed to explain how the second named contributor obtained the design or whether the second contributor contributed to the disclosure relied upon in the rejection. The examiner required the declaration to affirmatively account for all named contributors appearing on the reference, rather than leaving an evidentiary gap that could suggest independent creation or alternative origin. This prosecution demonstrates that declarations must expressly address all authorship appearing on the reference and cannot rely on partial attribution. Rule 3.21.

4.10 Declaration Required to Negate Independent Third-Party Creation

In Application 29/947,566, the examiner required clarification that the third-party seller did not independently design the product shown in the cited reference. The examiner treated the declaration as insufficient where the declaration failed to negate the possibility of independent creation by the third-party publisher. The prosecution illustrates that where the reference is a commercial listing or third-party disclosure, the declaration must affirmatively establish that the third party did not independently create the design and that the disclosure was instead based on design files or materials supplied by the inventor prior to publication. Rule 3.23. Rule 3.6. Rule 3.8.

5. Practice and Enforcement Notes

5.1 Declarations under § 1.130(a) are most frequently successful in design patent prosecution when the prior art disclosure arises from e-commerce listings, distributor publications, or licensee activity, provided that the declaration clearly documents the chain of authorization from the inventor to the public disclosure.

Practitioners should treat § 1.130(a) declarations as standalone evidentiary instruments, not as adjuncts to remarks. If the declaration cannot independently support withdrawal of the rejection, it is likely insufficient.

5.2 Recent design cases indicate that § 1.130(a) declarations are most effective when treated as standalone evidentiary documents, rather than supplements to attorney argument. Examiners routinely ignore explanations found only in remarks, even when those explanations appear logically compelling.

Practitioners should assume that any factual gap left in the declaration itself will be construed against the applicant, particularly where the reference is a commercial or third-party disclosure.

5.3 Design prosecutions show a clear examiner preference for § 1.130(a) declarations that stand on their own as complete factual narratives, rather than relying on the surrounding prosecution record for context. Examiners consistently reject declarations that require cross-referencing attorney remarks to understand the disclosure pathway. § 1.130(a) is not treated as a procedural formality. Instead, examiners apply a heightened evidentiary standard comparable to other sworn submissions, particularly where commercial disclosures are involved.

5.4 § 1.130(a) declarations are treated as standalone evidentiary submissions, evaluated independently of claim allowability, prosecution timing, or apparent commercial relationships. Examiners consistently require sworn factual completeness, even where the disclosure's origin seems obvious from the record. Practitioners should assume that any factual gap left in the declaration itself will not be filled by inference, record context, or allowance posture.

5.5 This ProGuide addresses declarations under § 1.130(a) in the context of ex parte design patent examination. Although § 1.130(a) may also arise in post-grant proceedings, including inter partes review, post-grant review, or derivation proceedings, procedural requirements and strategic considerations may differ in those contexts

Exhibit 1
(Checklist)

Use the following checklist to evaluate whether a declaration is proper under 37 C.F.R. § 1.130(a):

- Is the declarant identified as the inventor or a joint inventor of the claimed design?
- Is the specific reference relied upon in the rejection clearly identified?
- Does the declaration explain how the reference disclosure was obtained directly or indirectly from the inventor?
- Is the disclosure mechanism explained (e.g., product listing, distributor publication, licensee activity)?
- Is inventor authorization, obligation, or control over the disclosure explained where applicable?
- Is the publication or disclosure date expressly stated?
- Is the disclosure date tied to the effective filing date of the application?
- Are all supporting documents identified and incorporated as exhibits?
- Does the declaration stand on its own without reliance on attorney remarks?

Appendix 2
(Questions and Answers)

Q1. Can a § 1.130(a) declaration rely on attorney remarks to explain how the disclosure occurred?

A: No. A § 1.130(a) declaration must independently set forth the facts establishing inventor-originated disclosure. Examiners consistently treat factual explanations appearing only in attorney remarks as argument, not evidence. If the disclosure pathway, authorization, or timing is not explained in the sworn declaration itself, the declaration is likely insufficient even if the attorney remarks are detailed and logically persuasive.

Q2. Is common ownership or common inventorship alone sufficient to establish inventor-originated disclosure?

A: No. Common ownership or inventorship, standing alone, does not establish that a reference disclosure was obtained directly or indirectly from the inventor. Examiners require a factual explanation of how the disclosure occurred, including the mechanism by which the design entered the public domain. Declarations that rely solely on corporate affiliation or assignee identity are frequently treated as conclusory.

Q3. Must the declaration explain how a third party obtained the design if the disclosure appears to come from a related company?

A: Yes. Where the reference disclosure is attributed to a third party, such as a distributor, reseller, manufacturer, or affiliate, the declaration must explain the relationship between the inventor and that third party and how the disclosure was authorized or obligated. Examiners will not infer authorization merely because the entities appear commercially aligned.

Q4. Is it sufficient to state that the reference is an “exception under § 102(b)(1)(A)”?

A: No. Labeling a reference as an exception or as inventor-originated does not satisfy § 1.130(a). The declaration must supply factual statements supporting that conclusion, including disclosure origin, authorization, and timing. Examiners routinely disregard conclusory legal characterizations unsupported by sworn facts.

Q5. Does the declaration need to identify the publication date of the reference?

A: Yes. A § 1.130(a) declaration must expressly identify when the disclosure occurred and relate that date to the effective filing date of the application. Declarations that omit publication dates, or that rely on assumptions regarding timing, are frequently rejected.

Q6. Can supporting documents be relied upon if they are attached to the response but not discussed in the declaration?

A: No. Supporting documents must be identified and incorporated into the declaration itself. Documents that are merely attached to the response, without being referenced and explained in the declaration, are typically treated as attorney argument rather than evidence.

Q7. Does favorable allowance posture reduce the scrutiny applied to a § 1.130(a) declaration?

A: No. Examiners evaluate § 1.130(a) declarations independently of allowance posture. Even where the design is otherwise allowable, deficiencies in the declaration are not excused. Examiners frequently maintain prior art rejections until a compliant declaration is submitted.

Q8. Are § 1.130(a) declarations more difficult in cases involving commercial product listings?

A: Often, yes. Examiner scrutiny is typically higher where the disclosure arises from commercial activity, such as online product listings or marketplace postings. In these cases, the declaration must clearly explain not only inventorship but also how and why the product was publicly disclosed and the inventor's authorization for that disclosure.

Q9. An examiner has rejected the claimed design under § 102(a)(2) based on an earlier-filed application by different inventors. Can a terminal disclaimer overcome this rejection?

A: No. Terminal disclaimers are available only to overcome double patenting rejections, not prior art rejections under § 102(a)(2). Because a § 102(a)(2) rejection is a prior art rejection and not a patentable distinctness or double patenting issue, a terminal disclaimer has no legal effect on it. See *In re Bartfeld*, 925 F.2d 1450 (Fed. Cir. 1991). To overcome a § 102(a)(2) rejection, practitioners must instead pursue one of the following: (1) a § 1.130(a) declaration showing the disclosure was obtained from the inventor; (2) a priority or benefit claim under §§ 119 or 120 that antedates the reference; (3) a § 1.130(b) showing of prior public disclosure; or (4) a § 102(b)(2)(C) common ownership statement, where applicable.

Q10. Can a § 1.130(a) declaration be filed after allowance?

A: Yes, but it should be filed as soon as the basis for the declaration is known. Filing after allowance may require a request for continued examination (RCE) or petition to withdraw from issue, depending on timing.

Q11. What if the inventor has died or is legally incapacitated?

A: The legal representative, executor, or administrator may execute the declaration on behalf of the inventor under 37 C.F.R. § 1.64.

Q12. Can § 1.130(a) declarations be filed preemptively (before a rejection)?

A: Yes, an applicant may file a § 1.130(a) declaration proactively if they are aware of potentially disqualifying prior art. However, most practitioners wait until the art is actually cited to avoid unnecessary expense.

Q13. Does § 1.130(a) apply to foreign prior art?

A: Yes, § 1.130(a) can disqualify foreign publications as prior art if the declaration establishes that the foreign publication was made by or obtained from the inventor within the grace period.

Appendix 3 (Limitations)

This ProGuide is intended as a practical resource based on recent design patent prosecution history and does not constitute legal advice. Application of 37 C.F.R. § 1.130(a) is fact-specific, and outcomes may vary depending on examiner, art unit, and the particular disclosure at issue.

This ProGuide does not address declarations under 37 C.F.R. § 1.130(b), nor does it address priority claims, benefit claims, or common ownership statements under 35 U.S.C. § 102(b)(2)(C). Practitioners should evaluate whether alternative statutory mechanisms are more appropriate in a given case.

The examples and patterns discussed herein are drawn from design patent applications and reflect observed examiner behavior, not binding precedent. Examiners may deviate from these patterns, and future USPTO guidance or case law may alter current practice.

This ProGuide assumes compliance with all other formal requirements for declarations, including proper execution, signature, and submission. It does not address formal defects unrelated to substantive sufficiency under § 1.130(a).

Finally, this ProGuide focuses on evidentiary sufficiency under § 1.130(a) and does not address strategic considerations such as whether to pursue design patent protection after public disclosure, potential foreign filing consequences, or business considerations related to commercialization timing.

Appendix 4
(Selected MPEP, CFR, Statutory References, and Case Law)

A. MPEP Sections

Note on MPEP Citations: The following MPEP form paragraphs were current as of January 2026. Practitioners should verify current versions at www.uspto.gov/patents/laws and consult the latest edition of the MPEP.

¶ 15.15.02.aia 35 U.S.C. 102(a)(2) Provisional rejection – design disclosed in another application with common inventor and/or assignee

The claim is provisionally rejected under 35 U.S.C. 102(a)(2) as being anticipated by copending Application No. [1] which has a common [2] with the instant application.

Because the copending application names another inventor and has an earlier effectively filed date, it would constitute prior art under 35 U.S.C. 102(a)(2), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(a)(2) is based upon a presumption of future publication or patenting of the copending application.

This provisional rejection under 35 U.S.C. 102(a)(2) might be overcome by: (1) a showing under 37 CFR 1.130(a) that the design in the reference was obtained directly or indirectly from the inventor of this application and is thus not prior art under 35 U.S.C. 102(b)(2)(A); (2) perfecting a claim to priority under 35 U.S.C. 119 that antedates the reference by filing a certified priority document in the application that satisfies the enablement and description requirements of 35 U.S.C. 112(a); (3) perfecting the benefit claim under 35 U.S.C. 120 by filing an application data sheet under 37 CFR 1.76 which contains a specific reference to a prior application in accordance with 37 CFR 1.78 and establishing that the prior application satisfies the enablement and description requirements of 35 U.S.C. 112(a); (4) a showing under 37 CFR 1.130(b) of a prior public disclosure under 35 U.S.C. 102(b)(2)(B); or (5) providing a statement pursuant to 35 U.S.C. 102(b)(2)(C) that 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 or subject to a joint research agreement.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Examiner Note:

1. This form paragraph is used to provisionally reject over a copending application (utility or design) that discloses the claimed invention and would constitute prior art under 35 U.S.C. 102(a)(2) if patented or published under 35 U.S.C. 122. The copending application must have either a common assignee or at least one common inventor.
2. In bracket 2, insert inventor or assignee.

3. For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraphs 15.10.aia and 15.10.15.
4. This form paragraph should only be used in an application filed on or after March 16, 2013, where the claims are being examined under 35 U.S.C. 102/103 as amended by the AIA.

¶ 15.15.04.aia 35 U.S.C. 102(a)(2) rejection – design disclosed in a patent

The claim is rejected under 35 U.S.C. 102(a)(2) as being anticipated by patent [1]. Because the patent names another inventor and has an earlier effectively filed date, it constitutes prior art under 35 U.S.C. 102(a)(2).

This rejection under 35 U.S.C. 102(a)(2) might be overcome by: (1) a showing under 37 CFR 1.130(a) that the disclosure in the reference was obtained directly or indirectly from the inventor of this application and is thus not prior art under 35 U.S.C. 102(b)(2)(A); (2) perfecting a claim to priority under 35 U.S.C. 119 that antedates the reference by filing a certified priority document in the application that satisfies the enablement and description requirements of 35 U.S.C. 112(a); (3) perfecting the benefit claim under 35 U.S.C. 120 by filing an application data sheet under 37 CFR 1.76 which contains a specific reference to a prior application in accordance with 37 CFR 1.78 and establishing that the prior application satisfies the enablement and description requirements of 35 U.S.C. 112(a); (4) a showing under 37 CFR 1.130(b) of a prior public disclosure under 35 U.S.C. 102(b)(2)(B); or (5) providing a statement pursuant to 35 U.S.C. 102(b)(2)(C) that 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 or subject to a joint research agreement.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Examiner Note:

1. This form paragraph should be used when the claimed design in the application being examined is disclosed in the drawings of an earlier-filed design or utility patent. When the design claimed in the application being examined is disclosed in the drawings of an earlier-filed design patent, it would most often be in the form of subcombination subject matter (part or portion of an article) that is patentably distinct from the claim for the design embodied by the combination or whole article. It may also be unclaimed subject matter depicted in broken lines in the earlier-filed application.
2. In bracket 1, insert number of patent.
3. For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraphs 15.10.aia and 15.10.15.

¶ 15.19.02.aia Preface 35 U.S.C. 102(a)(2)/103 rejection – Different inventors, common assignee, obvious designs, no evidence of common ownership not later than effective filing date of claimed design

The claim is directed to a design not patentably distinct from the design of commonly assigned [1]. Specifically, the claimed design is different from the one in [2] in that [3]. These differences are considered obvious and do not patentably distinguish the overall appearance of the claimed design over the design in [4].

The commonly assigned [5], discussed above, names another inventor and has an earlier effectively filed date. Therefore, it qualifies as prior art under 35 U.S.C. 102(a)(2) and would form the basis for a rejection of the claimed design in the present application under 35 U.S.C. 103 if the claimed design and the design disclosed were not commonly owned not later than the effective filing date of the claimed design under examination.

This rejection under 35 U.S.C. 102(a)(2)/103 might be overcome by: (1) a showing under 37 CFR 1.130(a) that the design in the reference was obtained directly or indirectly from the inventor or a joint inventor of this application and is thus not prior art under 35 U.S.C. 102(b)(2)(A); (2) perfecting a claim to priority under 35 U.S.C. 119 that antedates the reference by filing a certified priority document in the application that satisfies the enablement and description requirements of 35 U.S.C. 112(a); (3) perfecting the benefit claim under 35 U.S.C. 120 by filing an application data sheet under 37 CFR 1.76 which contains a specific reference to a prior application in accordance with 37 CFR 1.78 and establishing that the prior application satisfies the enablement and description requirements of 35 U.S.C. 112(a); (4) a showing under 37 CFR 1.130(b) of a prior public disclosure under 35 U.S.C. 102(b)(2)(B); or (5) providing a statement pursuant to 35 U.S.C. 102(b)(2)(C) that the design disclosed and the claimed design, not later than the effective filing date of the claimed design, were owned by the same person or subject to an obligation of assignment to the same person or subject to a joint research agreement.

Examiner Note:

1. A nonstatutory double patenting rejection may also be included in the action.
2. In brackets 1, 2, 4, and 5, insert “patent” and number, or “copending application” and serial number.
3. In bracket 3, identify differences between design claimed in present application and that claimed in earlier-filed patent or copending application.
4. This form paragraph should only be used ONCE in an Office action.
5. For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraphs 15.10.aia and 15.10.15.

¶ 15.19.03.aia 35 U.S.C. 102(a)(2)/103 Provisional Rejection – design disclosed in another application with common inventor and/or assignee

The claim is provisionally rejected under 35 U.S.C. 103 as being obvious over copending Application No. [1] which has a common [2] with the instant application. Because the copending application names another inventor and has an earlier effectively filed date, it would constitute prior art under 35 U.S.C. 102(a)(2) if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 103 is based upon a presumption of future publication or patenting of the conflicting application.

Although the invention is not identically disclosed or described 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, the invention is not patentable.

This provisional rejection under 35 U.S.C. 102(a)(2) might be overcome by: (1) a showing under 37 CFR 1.130(a) that the design in the reference was obtained directly or indirectly from the inventor or a joint inventor of this application and is thus not prior art under 35 U.S.C. 102(b)(2)(A); (2) perfecting a claim to priority under 35 U.S.C. 119 that antedates the reference by filing a certified priority document in the application that satisfies the enablement and description requirements of 35 U.S.C. 112(a); (3) perfecting the benefit claim under 35 U.S.C. 120 by filing an application data sheet under 37 CFR 1.76 which contains a specific reference to a prior application in accordance with 37 CFR 1.78 and establishing that the prior application satisfies the enablement and description requirements of 35 U.S.C. 112(a); (4) a showing under 37 CFR 1.130(b) of a prior public disclosure under 35 U.S.C. 102(b)(2)(B); or (5) providing a statement pursuant to 35 U.S.C. 102(b)(2)(C) that 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 or subject to a joint research agreement.

Examiner Note:

1. This form paragraph should be used when the claimed design in the application being examined is obvious over subject matter disclosed in the drawings of an earlier-filed design or utility application. The design claimed in the application being examined can be an obvious version of subject matter disclosed in the drawings of an earlier-filed design application. This subject matter may be depicted in broken lines, or may be in the form of a subcombination (part or portion of an article) that is patentably distinct from the claim for the design embodied by the combination or whole article.
2. In brackets 1 and 4, insert serial number of copending application.
3. In bracket 2, insert inventor or assignee.
4. In bracket 3, provide explanation of obviousness including differences.
5. For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 15.10.15.

¶ 15.19.05.aia 35 U.S.C. 102(a)(2)/103 rejection – design disclosed, no common inventors or common assignees

The claim is rejected under 35 U.S.C. 103 as being obvious over [1].

Because the reference names another inventor and has an earlier effectively filed date, it constitutes prior art under 35 U.S.C. 102(a)(2).

Although the invention is not identically disclosed or described 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, the invention is not patentable.

This rejection under 35 U.S.C. 102(a)(2)/103 might be overcome by: (1) a showing under 37 CFR 1.130(a) that the subject matter disclosed in the copending application was obtained directly or indirectly from the inventor or a joint inventor of this application and is thus not prior art in accordance with 35 U.S.C. 102(b)(2)(A); (2) perfecting a claim to priority under 35 U.S.C. 119 that antedates the reference by filing a certified priority document in the application that satisfies the enablement and description requirements of 35 U.S.C. 112(a); (3) perfecting the benefit claim under 35 U.S.C. 120 by filing an application data sheet under 37 CFR 1.76 which contains a specific reference to a prior application in accordance with 37 CFR 1.78 and establishing that the prior application satisfies the enablement and description requirements of 35 U.S.C. 112(a); or (4) a showing under 37 CFR 1.130(b) of a prior public disclosure under 35 U.S.C. 102(b)(2)(B).

Examiner Note:

1. In bracket 1, insert document number that qualifies as prior art under 35 U.S.C. 102(a)(2).
2. In bracket 2, provide explanation of obviousness including differences.
3. For applications claiming priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraphs 15.10.aia and 15.10.15.

B. Relevant Case Law

In re Bartfeld, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991)

- Held that terminal disclaimers cannot overcome § 102(a)(2) rejections (pre-AIA § 102(e) rejections)
- Reasoning applies to AIA § 102(a)(2) rejections

Honeywell Int'l Inc. v. Mexichem Amanco Holding S.A., IPR2013-00375 (PTAB Feb. 28, 2014)

- Applied § 1.130(a) in an inter partes review context; included here because the PTAB's reasoning regarding the affirmative showing required to establish inventor-originated disclosure is instructive, even though procedural requirements in IPR differ from ex parte prosecution

- Emphasized that labeling a disclosure as inventor-originated, without factual support, is insufficient to satisfy the statutory exception

[Note: Case law citations are illustrative. Practitioners should research current binding authority.]"