

Appendix IV - Disqualify Prior Art

706.02(b) Overcoming a 35 U.S.C. 102 Rejection Based on a Printed Publication or Patent

706.02(b)(1) Overcoming a 35 U.S.C. 102(a)(1) or 102(a)(2) Rejection Based on a Printed Publication or Patent

706.02(b)(2) Overcoming a Pre-AIA 35 U.S.C. 102(a), (b), or (e) Rejection Based on a Printed Publication or Patent

715 Swearing Behind a Reference — Affidavit or Declaration Under 37 CFR 1.131(a)

715.01 37 CFR 1.131(a) Affidavits Versus 37 CFR 1.132 Affidavits

715.01(a) Reference Is a Joint Patent or Published Application to Applicant and Another

715.01(b) Reference and Application Have Common Assignee

715.01(c) Reference Is Publication of Applicant's Own Invention

715.01(d) Activities Applied Against the Claims

715.02 How Much of the Claimed Invention Must Be Shown, Including the General Rule as to Generic Claims

715.03 Genus-Species, Practice Relative to Cases Where Predictability Is in Question

715.04 Who May Make Affidavit or Declaration Under 37 CFR 1.131(a); Formal Requirements of Affidavits and Declarations

715.05 U.S. Patent or Application Publication Claiming Same Invention

715.07 Facts and Documentary Evidence

715.07(a) Diligence

715.07(b) Interference Testimony Sometimes Used

715.07(c) Acts Relied Upon Must Have Been Carried Out in This Country or a NAFTA or WTO Member Country

715.09 Timely Presentation

715.10 Review of Affidavit or Declaration for Evidence of Prior Public Use or Sale or Failure to Disclose Best Mode

716 Affidavits or Declarations Traversing Rejections, 37 CFR 1.132

- 716.01 Generally Applicable Criteria
 - 716.01(a) Objective Evidence of Nonobviousness
 - 716.01(b) Nexus Requirement and Evidence of Nonobviousness
 - 716.01(c) Probative Value of Objective Evidence
 - 716.01(d) Weighing Objective Evidence
- 716.02 Allegations of Unexpected Results
 - 716.02(a) Evidence Must Show Unexpected Results
 - 716.02(b) Burden on Applicant
 - 716.02(c) Weighing Evidence of Expected and Unexpected Results
 - 716.02(d) Unexpected Results Commensurate in Scope With Claimed Invention
 - 716.02(e) Comparison With Closest Prior Art
 - 716.02(f) Advantages Disclosed or Inherent
 - 716.02(g) Declaration or Affidavit Form
- 716.03 Commercial Success
 - 716.03(a) Commercial Success Commensurate in Scope With Claimed Invention
 - 716.03(b) Commercial Success Derived From Claimed Invention
- 716.04 Long-Felt Need and Failure of Others
- 716.05 Skepticism of Experts
- 716.06 Copying
- 716.07 Inoperability of References
- 716.09 Sufficiency of Disclosure
- 716.10 Attribution Affidavit or Declaration to Overcome Rejection Under Pre-AIA 35 U.S.C. 102 or 103
- 717.01 Affidavit or Declaration Under 37 CFR 1.130
 - 717.01(a) Declarations or Affidavits under 37 CFR 1.130(a) – Attribution
 - 717.01(b) Declarations or Affidavits under 37 CFR 1.130(b) – Prior Public Disclosure
 - 717.01(c) Who May Make Affidavit or Declaration; Formal Requirements of Affidavits and Declarations

- 717.01(d) U.S. Patent or Application Publication Claiming Same Invention
- 717.01(e) Passed Upon (or Decided by) by Primary Examiner
- 717.01(f) Seasonable (or Timely) Presentation
- 2155 Use of Affidavits or Declarations Under 37 CFR 1.130 To Overcome Prior Art Rejections
 - 2155.01 Showing That the Disclosure Was Made by the Inventor or a Joint Inventor
 - 2155.02 Showing That the Subject Matter Disclosed Had Been Previously Publicly Disclosed by the Inventor or a Joint Inventor
 - 2155.03 Showing That the Disclosure was Made, or That Subject Matter had Been Previously Publicly Disclosed, by Another Who Obtained the Subject Matter Disclosed Directly or Indirectly From the Inventor or a Joint Inventor
 - 2155.04 Enablement
 - 2155.05 Who May File an Affidavit or Declaration Under 37 CFR 1.130
 - 2155.06 Situations in Which an Affidavit or Declaration Is Not Available
- 718 Affidavit or Declaration to Disqualify Commonly Owned Patent as Prior Art, 37 CFR 1.131(c)