AMERICA INVENTS ACT
IMPLEMENTATION

AIA First Inventor to File (FITF)

OFFICE ACTION PREPARATION TIPS

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Office Action Summary

Office Action Summary	Application No. 59/956,507	Applicant(s) JORDAN ET AL.	
	Examiner KATHLEEN K. BRAGDON	Art Unit 1600	AIA (First Inventor to File) Status Yes

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

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Notice of Allowability

Notice of Allowability	Application No. 59/956,507	Applicant(s) JORDAN ET AL.	
	Examiner KATHLEEN K. BRAGDON	Art Unit 1600	AIA (First Inventor to File) Status Yes

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All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to _____.
   ☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on_____.

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Introductory Form Paragraphs
when application filed on or after March 16, 2013

7.03.aia Application Examined Under AIA First Inventor to File provisions-

> The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

7.03.fti Application Examined Under First to Invent provisions—

> The present application, filed on or after March 16, 2013, is being examined under the pre-AIA first to invent provisions.

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Form Paragraph Inserted before Prior Art Rejections in Transition Applications

7.06 Notice re prior art available under both pre-AIA and AIA

> In the event the determination of the status of the application as subject to AIA 35 U.S.C. 102 and 103 (or as subject to pre-AIA 35 U.S.C. 102 and 103) is incorrect, any correction of the statutory basis for the rejection will not be considered a new ground of rejection if the prior art relied upon, and the rationale supporting the rejection, would be the same under either status.

This form paragraph is used when examining transition applications which can be either AIA or pre-AIA applications.

Reminder: Transition applications are filed on or after 3/16/2013 with at least one priority/benefit claim to an application filed before 3/16/2013.

Writing Prior Art Rejections under 35 U.S.C. 102(a)(1)

Prior art rejections should always begin with citation of the appropriate statute(s).

When making a 102(a)(1) rejection using a public disclosure as of its **public availability date**, use **form paragraph *7.15.aia*,** which requires insertion of the prior number/letter of the statute:

> Claim*** rejected under 35 U.S.C. 102*** as being *** by ***.

Writing Prior Art Rejections under 35 U.S.C. 102(a)(2)

When making a 102(a)(2) rejection using a U.S. Patent Document as of its **effectively filed date** as a reference, use ONE of the following form paragraphs as appropriate:

102(a)(2) **No** Common Assignee or Inventor -- ***7.15.03.aia***

OR

102(a)(2) Common Assignee or Inventor -- ***7.15.02.aia***

Writing Prior Art Rejections under 102(a)(2) (No Common Assignee/Inventor)

Form paragraph *7.15.03.aia*:

> Claim*** rejected under 35 U.S.C. 102(a)(2) as being *** by ***.

Writing Prior Art Rejections under 102(a)(2) with Common Assignee/Inventor

Form paragraph *7.15.02.aia* requires identification of common assignee, applicant, or inventor:

> Claim*** rejected under 35 U.S.C. 102(a)(2) as being *** by ***.
>
> The applied reference has a common *** with the instant application...

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Writing Prior Art Rejections under 102(a)(2) with Common Assignee/Inventor (con't)

Continuation of form paragraph *7.15.02.aia:*

> ...**The applied reference has a common *** with the instant application.** Based upon the earlier effective filing date of the reference, 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 subject matter disclosed in the reference 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) a showing under 37 CFR 1.130(b) of a prior public disclosure under **35 U.S.C. 102(b)(2)(B);** or
>
> (3) a statement pursuant to **35 U.S.C. 102(b)(2)(C)** establishing that, not later than the effective filing date of the claimed invention, the subject matter disclosed and the claimed invention were either owned by the same person or subject to an obligation of assignment to the same person or subject to a joint research agreement.

(original appears as a single paragraph; emphasis added)

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Writing Prior Art Rejections under 35 U.S.C. 102(a)(1) and/or 102(a)(2)

If the public availability date of the U.S. Patent Document being used as a reference falls before the grace period and a 102(a)(1) rejection is made, no 102(a)(2) rejection is necessary using the same reference.

When rejecting using a U.S. Patent Document that

- has a **public availability date** that falls within the grace period and
- qualifies as prior art as of its **effectively filed date**,

rejections should be made under BOTH 102(a)(1) and 102(a)(2).

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Using 102(b)(2)(C)-Excepted Prior Art in a Prior Art Rejection under 102(a)(1)

When prior art applies under BOTH 102(a)(1) and 102(a)(2) and Applicant replies only by invoking the 102(b)(2)(C) exception removing only the 102(a)(2) rejection, the 102(a)(1) rejection should be maintained and the examiner's response should include ***form paragraph 7.17.aia***:

> Applicant has provided evidence in this file showing that the claimed invention and the subject matter disclosed in the prior art reference were owned by, or subject to an obligation of assignment to, the same entity as *** not later than the effective filing date of the claimed invention, or the subject matter disclosed in the prior art reference was developed and the claimed invention was made by, or on behalf of one or more parties to a joint research agreement in effect not later than the effective filing date of the claimed invention. However, although reference *** has been disqualified as prior art under 35 U.S.C. 102(a)(2), it is still applicable as prior art under 35 U.S.C. 102(a)(1) that cannot be disqualified under 35 U.S.C. 102(b)(2)(C)...

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Writing Prior Art Rejections under 35 U.S.C. 103

In order to be available as a reference in a 103 rejection, either alone or in combination, the reference must be available under 102(a)(1) or 102(a)(2) or both.

When rejecting under 103, examiners are not required to cite the section of AIA 35 U.S.C. 102(a) under which the prior art is available.

Writing Prior Art Rejections under 103 (No Common Inventor/Assignee)

When making a 103 rejection based on

- publicly available 102(a)(1) prior art OR
- effectively filed 102(a)(2) prior art with no common assignee or inventor,

use the **form paragraph *7.21.aia***

> Claim*** rejected under 35 U.S.C. 103 as being unpatentable over ***.

Writing Prior Art Rejections under 103 with Common Inventor/Assignee

When making a 103 rejection based on

- effectively filed 102(a)(2) prior art with having a common assignee or inventor,

use the **form paragraph *7.21.02 aia***

> Claim*** rejected under 35 U.S.C. 103 as being obvious over ***.
>
> The applied reference has a common *** with the instant application. Based upon the earlier effective filing date of the reference, it constitutes prior art under 35 U.S.C. 102(a)(2).

Writing Prior Art Rejections under 35 U.S.C. 103

The obviousness analysis has not changed BUT...

...the time focus of the inquiry for obviousness under **AIA First Inventor to File (FITF)** has been changed to:

> It would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention....

Under **pre-AIA**, the time focus is at the time the invention was made.

Note: When formulating an obviousness rationale for a non-statutory double patenting (NSDP) rejection in an AIA application, the time focus of before the effective filing date of the claimed invention also applies.

AIA-FITF TC Points of Contact

Contact	Business Unit
Cassandra Spyrou	TC 2600 & 2800
Chris Grant	TC 2100, 2400 & OPT
Tom Hughes	TC 3600, 3700 & CRU
Kathleen Bragdon	**TC 1600, 1700 & 2900**
Gerald Leffers	**OPQA/ TC 1600, 1700 & 2900**
Steve Saras	OPQA/ TC 2600 & 2800
MaryBeth Jones	OPQA/ TC 3600, 3700 & CRU
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THANK YOU!

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QUESTIONS?

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