

Examiner Checklist for Prior Art Exclusions under 35 U.S.C. § 103(c)
as amended by the Cooperative Research and Technology Enhancement
(CREATE) Act (P.L. 108-453, effective December 10, 2004)

1. If applicant is attempting to exclude § 102(e) type prior art, make sure the applied prior art rejection is under 35 U.S.C. § 103(a)

- not an obvious double patenting rejection or
- not a rejection under 35 U.S.C. 102 (e.g. claims are anticipated)

2. Check to see if the reference that is being excluded **only** qualifies as prior art under 35 U.S.C. § 102(e), (f) or (g)

- if reference qualifies as prior art under 102(a) or (b) (publication date is prior to effective filing date of application), then exclusion does not apply
 - Do not use form paragraph (FP) 7.21.02 in this situation – use FP 7.21
 - Example:
 - Reference patent A was filed on 11/01/98 (§ 102(e) prior art date) and issued on 2/01/00 (§ 102(a) prior art date)
 - Application Y has an effective US filing date of 3/01/00
 - Reference patent A is applied against the claims of Application Y under 35 U.S.C. § 103(a)

In this example, Reference patent A is prior art under 35 U.S.C. § 102(a) **and** (e). Therefore, applicant's attempt to exclude Reference patent A by just the exclusion under 35 U.S.C. § 103(c) will not be sufficient to overcome the prior art rejection. Applicant will need to take further action such as swearing behind the issue date of Reference patent A by using a rule 131 declaration or affidavit to disqualify the reference as prior art under § 102(a).

3. If the applicant is excluding the reference based upon common ownership, see if applicant submitted the required **statement** (see MPEP 706.02(1))

- for example, that the application and the reference were, **at the time the invention was made**, owned by, or subject to an obligation of assignment to, the same person
- can be signed by applicants or their attorney/agent of record
- does NOT need to be in a declaration or affidavit form
- assignment records by themselves (e.g. without the required statement by applicant) are not sufficient evidence since assignment records do not show the required "at the time the invention was made"

4. If the applicant is excluding the reference based upon a joint research agreement ("agreement"), go to number 7 on page 2.

5. If an examiner suspects that applicant may be able to properly disqualify a reference under 35 U.S.C. § 103(c), the examiner can, for example:

- obtain a patent family search from your EIC (Electronic Information Center) to see if there is an earlier disclosure of the same subject matter that is a reference under 35 U.S.C. § 102(a) or (b),
- call the applicant or attorney/agent of record and get him or her to fax in the required evidence in order to disqualify the reference, or
- apply the reference in rejection under 35 U.S.C. § 103(a)
 - may wish to apply an alternate rejection as a back-up

6. Note: 35 U.S.C. § 103(c) as revised by the CREATE Act applies to pending applications filed before November 29, 1999 as well as applications filed on or after November 29, 1999.

Examiner Checklist for Prior Art Exclusions under 35 U.S.C. § 103(c)
as amended by the Cooperative Research and Technology Enhancement
(CREATE) Act (P.L. 108-453, effective December 10, 2004)

Joint Research Agreement Prior Art Exclusions under 35 U.S.C. § 103(c)

7. If the applicant is excluding the reference based upon a joint research agreement (“agreement”), see if applicant submitted the requirements:

- A statement signed either by the applicant or the assignee (not by an attorney or agent representing either), and which is on a separate paper that is not directed to any other matters. The statement must state that:
 1. The prior art and the claimed invention were made by or on the behalf of parties to a joint research agreement as defined by 35 U.S.C. § 103(c);
 2. The agreement was in effect on or before the date the claimed invention was made; and
 3. The claimed invention was made as a result of activities undertaken within the scope of the agreement.
- Amend the specification to
 1. disclose the names of the parties to the agreement (37 CFR 1.71(f)); and
 2. set forth either (1) the date the agreement was executed and a concise statement of the field of the claimed invention OR (2) specify where in the assignment records (e.g., reel and frame numbers) this information is recorded in the Office.

8. If applicant meets the requirements set forth in 35 U.S.C. § 103(c) as amended by the CREATE Act and the interim rules, the examiner will treat the application under examination and the prior art as if they are commonly owned for purposes of 35 U.S.C. § 103(c)(1).

9. The examiner may make a subsequent new double patenting rejection based upon the disqualified prior art.

- The Office action can be made final (provided that no other new ground of rejection that was not necessitated by amendment is introduced) regardless of whether the claims themselves have been amended.
- Applicant may file a terminal disclaimer under new 37 CFR 1.321(d) to overcome the double patenting rejection.
 - Note: the disclaimer requires both parties of the joint research agreement to commonly enforce their patents in addition to a common term requirement.

10. Interim Rule implementing the CREATE Act published on January 11, 2005 in the Federal Register (70 F.R. 1818)