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Don’t Despair. Try to Declare! – Best Practices for Rule 132 Declarations

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A Rule 132 Declaration is one patent prosecution tool for introducing relevant evidence into the examination record for overcoming a rejection. Because attorney arguments cannot take the place of factual evidence, it can be beneficial for the inventor (or another expert in the same field of technology) to submit the Rule 132 Declaration as evidence, which is not provided in the originally filed patent application. Such evidence can include unexpected results achieved by the claimed invention or commercial success by the patent-pending product.

However, there are pitfalls that practitioners should avoid when filing the Rule 132 Declaration, particularly when attempting to overcome a prior art rejection of obviousness. For example, in Ex parte Eidshun, Appeal 2023-003437 (PTAB Oct. 18, 2024), the Patent Trial and Appeal Board (PTAB) found an applicant’s Rule 132 Declaration to be defective for three reasons. First, the Rule 132 Declaration failed to compare results to the closest prior art. While the Rule 132 Declaration compared the claims to an examiner’s primary reference, the PTAB instead considered another secondary reference to be the closest prior art. Second, the Rule 132 Declaration failed to establish why one of ordinary skill in the art would have considered the differences between the claims and the cited prior art to be unexpected and not merely different. Third, the PTAB found that the scope of evidence submitted in the Rule 132 Declaration was not commensurate or relative to the claims.

Though Eidshun does not provide a comprehensive list of pitfalls to avoid in preparing a 132 Declaration, it emphasizes the importance of providing factual evidence and establishing a sufficient connection between said evidence and the claimed invention.