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# **The New United States Patent Law**

**Second Edition**

Includes:  
United States Code Title 35 “Patents”  
As amended by  
The Leahy-Smith America Invents Act  
The Patent Law Treaties Implementation Act of 2012  
The Leahy-Smith America Invents Technical Corrections Act of 2013  
In Black Line Format

Published by  
**LegalPub.com, Inc.**  
Harvard, Massachusetts

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## **Preface**

On September 16, 2011, the *Leahy-Smith America Invents Act*, Public Law 112-29, 125 Stat. 284 (“AIA”), was signed into law. The AIA imposed the most sweeping changes to the U.S. patent law in nearly 60 years. (See the summary which follows this preface.) The First Edition of this publication set forth, in black line format, the changes to Title 35 of the United States Code effected by the AIA.

On December 18, 2012, the *Patent Law Treaties Implementation Act of 2012*, Public Law 112-211, 126 Stat. 1527 (“PLTIA”), was signed into law. And on January 14, 2013, the *Leahy-Smith America Invents Technical Corrections Act*, Public Law 112-274, 126 Stat. 2456 (“TCA”), was signed into law. The PLTIA and TCA together made over 130 changes to the text of the U.S. patent law, many of which are significant. (See the summaries which follow this preface.)

This Second Edition builds on the First Edition. It shows the changes to Title 35 effected by the AIA, plus the changes effected by the PLTIA and the TCA. As with the First Edition, insertions effected by the AIA are identified by underline; deletions are identified by ~~strike through~~. The changes to Title 35 effected by the PLTIA and TCA are displayed a little differently. Insertions are identified by a wavy underline; deletions are identified by a ~~wavy strike through~~. This allows the reader to visualize the successive changes to Title 35, including changes by the PLTIA and the TCA to text which had been amended by the AIA. Full citation to source legislation follows each code section.

Each of the three statutes has a provision setting forth the date on which the statute is to take effect and the scope of its applicability. Each statute also has numerous exceptions. These general “effective date” and “applicability” provisions and many of the exceptions are summarized in the Table that begins on page 16.

The publication also includes excerpts from House Judiciary Committee Report 112-98 dated June 1, 2011 which accompanied the AIA. The report sets forth the background and need for the AIA and explains many of the changes to the U.S. patent law which it imposed.

This publication does not include all statutory and regulatory provisions which are affected by the AIA, the PLTIA or the TCA. Nor does it address those provisions of the AIA, the PLTIA and the TCA which do not expressly amend the text of existing U.S. Code (e.g. sense of Congress resolutions, directions to government departments and agencies, statutory notes). Comments and corrections are welcome and may be submitted via the “contact” page of our website, [www.LegalPub.com](http://www.LegalPub.com). Corrections, if any, will be posted on the “updates” page of our website.

The Publisher  
January 16, 2014

## Official Summaries

Below is a summary of the *Leahy-Smith America Invents Act*, Public Law 112-29, 125 Stat. 284 (“AIA”), the *Patent Law Treaties Implementation Act of 2012*, Public Law 112-211, 126 Stat. 1527 (“PLTIA”), and the *Leahy-Smith America Invents Technical Corrections Act*, Public Law 112-274, 126 Stat. 2456 (“TCA”), as excerpted from the official summaries provided by the Congressional Research Service.

### *Summary of the AIA*<sup>1</sup>

- Leahy-Smith America Invents Act - (Sec. 3) Amends federal patent law to define the “effective filing date” of a claimed invention as the actual filing date of the patent or the application for patent containing a claim to the invention (thus replacing the current “first to invent” system with a “first inventor to file” system), except as specified. Requires the effective filing date for a claimed invention in an application for reissue or reissued patent to be determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought.
- Establishes a one-year grace period (a prior art exception) for inventors to file an application after certain disclosures of the claimed invention by the inventor or another who obtained the subject matter from the inventor. Revises provisions concerning novelty and nonobvious subject matter (commonly referred to as conditions for patentability).
- Repeals provisions relating to inventions made abroad and statutory invention registration.
- Permits a civil action by a patent owner against another patent owner claiming to have the same invention and who has an earlier effective filing date if the invention claimed by the earlier patent owner was derived from the inventor claimed in the patent owned by the person seeking relief. Requires such an action to be filed before the end of a specified one-year period.
- Sets forth derived patent provisions. Replaces: (1) interference proceedings with derivation proceedings, and (2) the Board of Patent Appeals and Interferences with the Patent Trial and Appeal Board (the Board).
- Requires reports from: (1) the Small Business Administration (SBA) on the effects of eliminating the use of dates of invention in the patent application process, particularly on small businesses; and (2) the U.S. Patent and Trademark Office (USPTO) on the operation of prior user rights in selected countries in the industrialized world.
- Expresses the sense of Congress that converting from a “first to invent” to a “first inventor to file” patent registration system will: (1) provide inventors with greater certainty regarding the scope of protection, and (2) promote international uniformity by harmonizing the U.S. patent system with systems commonly used in other countries with whom the United States conducts trade.
- (Sec. 4) Modifies requirements regarding the oath or declaration required of an inventor.
- Allows a person to whom an inventor has assigned (or is under an obligation to assign) an invention to make an application for patent.

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1 Excerpt from H.R. 1249 (112th Congress), CRS Summary dated September 16, 2011.

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## Summary of Statutes

- (Sec. 5) Replaces the earlier inventor to file defense to infringement for business methods with enumerated personal defenses available in actions involving validity or infringement, under specified conditions and subject to exceptions, with respect to subject matter consisting of a process, or of a machine, manufacture, or composition of matter used in a manufacturing or other commercial process, that would otherwise infringe a claimed invention being asserted if: (1) the person commercially used the subject matter in the United States, either in connection with an internal commercial use or an actual arm's length sale or other arm's length commercial transfer of a useful end result of such commercial use; and (2) the commercial use occurred at least one year before the earlier of either the effective filing date of the claimed invention or the date on which the claimed invention was disclosed to the public in a manner that qualified as an exception from prior art.
- Sets forth guidelines for assessing commercial use in a premarketing regulatory review period and by nonprofit research laboratories or entities. Prohibits certain institutions of higher education and technology transfer organizations from asserting such defenses.
- Restricts transfers of the right to assert such defenses.
- Prohibits deeming a patent invalid on novelty or non-obvious subject matter grounds solely because such prior commercial use defenses are raised or established.
- (Sec. 6) Allows a person who is not the patent owner to request to cancel as unpatentable one or more claims of patent by filing a petition with the U.S. Patent and Trademark Office (USPTO) to institute: (1) post-grant review on any ground that could be raised under specified provisions relating to invalidity of the patent or any claim, and (2) inter partes review (replaces inter partes reexamination procedures) on specified novelty and nonobvious subject matter grounds based on prior art consisting of patents and printed publications.
- Limits the filing of petitions for post-grant review to the nine-month period beginning after the grant of patent or issuance of a reissue patent. Requires any petition for inter partes review to be filed after the later of: (1) nine months after the grant or reissue, or (2) the date of termination of a post-grant review.
- Directs the USPTO to make public data available on the length of time between the institution of, and issuance of a final written decision for, each post-grant and inter partes review.
- Prohibits the USPTO Director (defined as the Under Secretary of Commerce for Intellectual Property and USPTO Director) from authorizing: (1) inter partes review unless the petition shows a reasonable likelihood that the petitioner would prevail with respect to at least one of the challenged claims; or (2) post-grant review unless information in the petition, if not rebutted, would demonstrate that it is more likely than not that at least one of the challenged claims is unpatentable, or unless such petition raises a novel or unsettled legal question important to other patents or applications.
- Disallows: (1) post-grant review and inter partes review if the petitioner (or real party in interest) has filed a related civil action before filing the petition, and (2) inter partes review if the petition is filed more than one year after the petitioner is served with a complaint alleging infringement. Prohibits the petitioner from asserting claims in certain proceedings before the USPTO and International

# Summary of Statutes Sample Pages

Trade Commission (ITC) and in specified civil actions if such claims were raised or reasonably could have been raised in the respective reviews that result in a final Board decision.

- Allows any person, at any time, to cite to the USPTO: (1) prior art bearing on the patentability of a claim, and (2) statements of the patent owner filed in a proceeding before a federal court or the USPTO in which the patent owner took a position on the scope of any claim of a particular patent. Requires, on written request of the person citing prior art or written statements, that that person's identity be kept confidential.
- Sets forth the standards applicable to inter partes reexamination during the intervening period between the enactment of this Act and the effective date of inter partes review.
- (Sec. 7) Sets forth the Board's required composition and duties. Allows appeals to the U.S. Court of Appeals for the Federal Circuit (CAFC) from specified Board decisions, including examinations, reexaminations, post-grant and inter partes reviews, and derivation proceedings.
- (Sec. 8) Allows any third party to submit any publication of potential relevance to a patent application (commonly referred to as preissuance submissions).
- (Sec. 10) Authorizes the Director, for a seven-year period and subject to conditions, to set or adjust by rule any fee established, authorized, or charged by the USPTO under specified federal patent and trademark laws. Requires the Director to notify Congress of (and publish in the Federal Register) certain proposed fee changes.
- Reduces certain fees to qualified small entities (including fees for prioritized examination of utility and plant applications) and any micro entity.
- Defines the term "micro entity" as a certifying applicant who: (1) qualifies as a small entity as defined in regulations issued by the Director; (2) has not been named as an inventor on more than four previously filed patent applications, as specified; and (3) has gross income below a designated level without having transferred ownership interest in the application to an entity with gross income exceeding such limit. Authorizes the Director to impose income, annual filing, and other micro entity qualification limits under provisions related to institutions of higher education.
- Establishes an additional fee of \$400 for original patent applications filed non-electronically.
- (Sec. 11) Sets forth fees for filing, excess claims, examination, issue, disclaimer, appeal, revival, extension, maintenance, patent search, small entity, national fees (for certain international applications), and other specified fees.
- Establishes prioritized examination fees and a 15% surcharge for specified fees to be credited to the U.S. Patent and Trademark Appropriation Account, remain available until expended, and used only for specified expenses relating to patent applications. Terminates such surcharges and prioritized examination fees on the effective date of the setting or adjustment of the underlying fee pursuant to the Director's exercise of authority under section 10 of this Act for the first time with respect to that fee.
- (Sec. 12) Establishes supplemental examinations to consider, reconsider, and correct information. Requires the Director to order reexamination if a substan-

tial new question of patentability is raised by at least one item of information in the request.

- Requires the Director to confidentially refer to the Attorney General (DOJ) any material fraud on the USPTO that may have been committed in connection with a patent when the Director becomes aware of such fraud during an ordered supplemental examination or reexamination proceeding.
- (Sec. 13) Decreases the percentage of certain invention-related royalties and income that must be paid to the federal government and correspondingly increases the percentage that must be given to small business firms when a nonprofit organization has a funding agreement with the government for the operation of a government-owned, contractor-operated facility. (An existing provision defines the term “funding agreement” as a contract, grant, or cooperative agreement entered into between a federal agency and any contractor for the performance of experimental, developmental, or research work funded in whole or in part by the federal government.)
- (Sec. 14) Deems any strategy for reducing, avoiding, or deferring tax liability insufficient to differentiate a claimed invention from the prior art when evaluating specified conditions of patentability.
- (Sec. 15) Prohibits using a failure to disclose the best mode as a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable.
- (Sec. 16) Allows virtual markings (markings that direct the public to a freely-accessible Internet address where a patented article is associated with its patent number) to provide public notice that an article is patented. Requires the Director, within three years, to report to Congress on the ability of the public to obtain information from such virtual marking and related legal issues.
- Revises provisions addressing false marking actions to: (1) prohibit anyone other than the United States from suing for the applicable penalty, and (2) allow only a person who has suffered a competitive injury to file a civil action for recovery of damages adequate to compensate for the injury. (Current law allows any person to sue for a penalty of \$500 for every such offense, in which event one-half is awarded to the person and one-half to the United States.)
- Exempts from false marking liability virtual markings with matter relating to a patent that covered that product but has expired.
- (Sec. 17) Bars using an accused infringer’s failure to obtain the advice of counsel to prove that any infringement was willful or induced.
- (Sec. 18) Requires the Director to establish, with specified standards and procedures, an eight-year transitional post-grant review proceeding for reviewing the validity of covered business-method patents (claiming a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except technological inventions).
- (Sec. 19) Amends the federal judicial code to deny state courts jurisdiction over legal actions relating to patents, plant variety protection, or copyrights. Grants the CAFC exclusive jurisdiction of appeals relating to patents or plant variety protection. Adds procedural provisions regarding joinder of accused infringers in patent cases.

# Summary of Statutes

- Provides for the removal to a U.S. district court of legal actions involving patents, plant variety protection, or copyrights, and for the remand of unrelated matters.
- (Sec. 21) Permits the USPTO to pay subsistence and travel-related expenses of persons attending certain USPTO-conducted intellectual property programs who are not federal employees. Authorizes the Director to fix a basic pay rate below a certain level for administrative patent and trademark judges appointed under specified provisions.
- (Sec. 22) Establishes in the Treasury a Patent and Trademark Fee Reserve Fund in which any USPTO fee collections for a fiscal year in excess of the amount appropriated for that fiscal year must be deposited. Directs, to the extent and in the amounts provided in appropriations Acts, amounts in the Fund to be available until expended only for obligation and expenditure by the USPTO in accordance with provisions requiring: (1) specified patent fees and any related surcharges to be used only for expenses relating to processing patent applications and other activities, services, and materials relating to patents and to cover a share of administrative costs; and (2) specified trademark fees collected under the Trademark Act of 1946 and any related surcharges to be used only for such costs relating to trademarks.
- (Sec. 23) Requires the Director, within a three-year period using specified criteria, to establish at least three U.S. satellite offices for the USPTO and submit a related report to Congress.
- (Sec. 24) Designates the satellite office to be located in Detroit, Michigan, as the “Elijah J. McCoy United States Patent and Trademark Office.”
- (Sec. 25) Authorizes the USPTO to establish regulations providing, at the request of the applicant, prioritized examination of applications for products, processes, or technologies important to the economy or national competitiveness without recovering the aggregate extra cost of providing such prioritization.
- (Sec. 26) Requires the Director, within four years, to submit a report to Congress assessing federal patent policies, the implementation of this Act, competitiveness of U.S. markets, and access to capital for investment by small businesses.
- (Sec. 27) Requires the Director to conduct a study and report to Congress on effective ways to provide independent, confirming genetic diagnostic test activity where gene patents and exclusive licensing for primary genetic diagnostic tests exist. Defines “confirming genetic diagnostic test activity” as the performance of a genetic diagnostic test, by a genetic diagnostic test provider, on an individual solely for the purpose of providing the individual with an independent confirmation of results obtained from another test provider’s prior performance of the test on the individual.
- (Sec. 28) Requires the Director to establish a Patent Ombudsman Program using available resources.
- (Sec. 29) Directs the Director to establish methods for studying the diversity of patent applicants, including applicants who are minorities, women, or veterans. Prohibits using the results to provide any preferential treatment to patent applicants.
- (Sec. 30) Expresses the sense of Congress that the patent system should protect small businesses and inventors from predatory behavior that could result in cutting off innovation.

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## Summary of Statutes

- (Sec. 31) Requires the Director to study and report to Congress on how the USPTO, in coordination with other federal agencies, can help small businesses with international patent protection and whether a revolving fund loan or grant program should be established to help pay the costs of filing, maintaining, and enforcing such international patent applications.
- (Sec. 32) Directs the Director to support intellectual property law associations in establishing pro bono programs to assist financially under-resourced independent inventors and small businesses.
- (Sec. 33) Prohibits issuing a patent on a claim directed to or encompassing a human organism in any application pending or filed on or after the enactment of this Act.
- (Sec. 34) Directs the Comptroller General (GAO) to submit a report on the consequences of litigation by non-practicing entities, or by patent assertion entities, related to patent claims under specified federal patent laws and regulations.
- (Sec. 35) Declares that this Act shall take effect one year after enactment and apply to any patent issued on or after that effective date, except as otherwise provided.
- (Sec. 37) Sets forth a provision concerning calculation of the filing period for patent extension applications related to drug products and certain other items subject to regulation under the Federal Food, Drug, and Cosmetic Act.

### *Summary of the PLTIA<sup>2</sup>*

- Patent Law Treaties Implementation Act of 2012 - Amends federal patent law to implement the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (Hague Treaty) and the Patent Law Treaty. (Both treaties were ratified by the Senate on December 7, 2007.)
- Standardizes application procedures to be consistent with other member countries.
- Title I: Hague Agreement Concerning International Registration of Industrial Designs - (Sec. 101) Allows any person who is a U.S. national, or has a domicile, habitual residence, or real and effective industrial or commercial establishment in the United States, to file an international design application for international registration with the U.S. Patent and Trademark Office (USPTO) (thereby enabling U.S. applicants to file a single application with USPTO instead of separate applications in multiple countries).
- Directs the USPTO to collect and transmit international fees and forward international design applications to the intergovernmental International Bureau recognized as the coordinating body under the Hague Treaty and its common regulations.
- Requires an international design application on an industrial design made in the United States to constitute the filing of an application in a foreign country if such application is filed: (1) in a country other than the United States, (2) at the International Bureau, or (3) with an intergovernmental organization.
- Requires the filing date of an international design application in the United States to be the effective registration date, except that any international design application designating the United States that otherwise meets the requirements of federal patent law (notwithstanding the implementation of the treaty) may be treated as a design application under existing federal laws applicable to design patents.

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2 Excerpt from S. 3486 (112th Congress), CRS Summary dated December 18, 2012.

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- Permits applicants to request a review of the filing date of an international design application in the United States. Authorizes the USPTO Director to determine that such filing date is a date other than the effective registration date.
- Sets forth requirements for determining the right of priority of national applications and prior foreign and national applications with earlier filing dates.
- Directs the Director to provide for the examination of international design applications designating the United States. Authorizes the Director to issue patents based on such applications.
- (Sec. 102) Extends provisional rights (the right to obtain royalties from persons who sell or engage in certain activities involving the invention during the period beginning on the date the application is published and ending on the date the patent is issued) to such international design applications filed under the treaty that designate the United States.
- Extends the term for design patents from 14 to 15 years from the date of grant.
- Title II: Patent Law Treaty Implementation - (Sec. 201) Revises patent application procedures with respect to filing dates, fees, and surcharges for fees, oaths, or declarations and claims submitted after the filing date. Authorizes the Director to prescribe conditions on references to previously filed applications.
- Permits the Director to establish procedures to revive an unintentionally abandoned patent application, accept an unintentionally delayed payment of the fee for issuing each patent, or accept an unintentionally delayed response by the patent owner in a reexamination proceeding, upon petition by the applicant or patent owner.
- Authorizes the Director to: (1) prescribe regulations and fees for the extension of application periods for inventors who previously filed provisional applications or applications for the same invention in a foreign country, (2) establish procedures to accept an unintentionally delayed claim for priority under the Patent Cooperation Treaty and to accept a priority claim that pertains to an application that was not filed within the specified priority period but was filed within the extended application period.
- Directs the USPTO to maintain a register of interests in patents and applications for patents. Applies patent assignment requirements to interests that constitute an assignment, grant, or conveyance.

## *Summary of the TCA<sup>3</sup>*

- Amends the Leahy-Smith America Invents Act (AIA) to make technical changes regarding the transitional program for covered business method patents and joinder of parties.
- Applies, to any civil action commenced on or after enactment of this Act, the AIA's bar on using an accused infringer's failure to obtain the advice of counsel to prove that any infringement was willful or induced. (Currently, the bar would not take effect until one year after the AIA's enactment.)
- Prohibits a nine-month waiting period for inter partes review from applying to issuances of first-to-invent patents ineligible for post-grant review. (Currently,

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<sup>3</sup> Excerpt from H.R. 6621 (112th Congress), CRS Summary dated January 14, 2013.

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## Summary of Statutes

the remaining first-to-invent patents to be issued prior to the effective date of the new first-to-file patent system have no avenue for review during the first nine months because they must wait nine months for inter partes review and are ineligible for post-grant review.)

- Revises the filing deadline for inter partes review to be after the later of either: (1) nine months after the grant of a patent (currently, nine months after such grant or the issuance of a reissue patent), or (2) the termination date of any post-grant review.
- Extends the time period for an applicant to file an inventor's oath or declaration, substitute statement, or recorded assignment until the date on which the issue fee for the patent is paid. (Current law permits a notice of allowance of a patent application only after such a filing.)
- Makes provisions concerning travel expenses for employees of the U.S. Patent and Trademark Office (USPTO) and the payment of administrative judges effective as of September 16, 2011.
- Modifies requirements and time periods for activities relating to patent term adjustments. Revises the patent extension period for certain international applications. Specifies that a civil action filed in the U.S. District Court for the Eastern District of Virginia is the exclusive remedy for challenging a USPTO decision on a request for reconsideration of a patent term adjustment determination.
- Repeals a provision prohibiting the USPTO from accepting certain international applications designating the United States from anyone not qualified under specified application requirements.
- Revises USPTO funding requirements to make all federal patent law fees available for expenses relating to patent processing and to permit patent and trademark fees to be used interchangeably to cover proportionate shares of the USPTO's administrative costs. (Currently, patent fees are used to cover administrative costs relating to patents while trademark fees are used to cover administrative costs relating to trademarks.)
- Modifies requirements for applicants filing petitions to institute derivation proceedings and delineates the criteria applied to deem an application as an earlier application with respect to an invention relative to another application.
- Sets forth authority for the Patent Trial and Appeal Board to conduct, and for courts to review appeals from, interference proceedings declared after enactment but before the effective date of certain AIA amendments replacing interference proceedings with derivation proceedings.
- Modifies the original appointment terms for members of the Patent Public Advisory Committee and the Trademark Public Advisory Committee. Directs the Secretary of Commerce to designate, from among the appointed members, a Chair and Vice Chair of each committee.

# Table—Effective Date/Applicability

Table of Effective Date/Applicability and Exceptions*	
General Effective Date/Applicability*	
<p>The Leahy-Smith America Invents Act, P.L. 112-29 ("AIA") (Enacted 9-16-11)</p>	<p>Section 35 of the AIA provides "EFFECTIVE DATE. Except as otherwise provided in this Act, the provisions of this Act shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent issued on or after that effective date."</p>
<p>The Patent Law Treaties Implementation Act of 2012, P.L. 112-211 ("PLTIA") (Enacted 12-18-12)</p>	<p>Section 103 of the PLTIA provides in pertinent part: "EFFECTIVE DATE. (a) IN GENERAL.—The amendments made by this title [Title I, §§ 101-103] shall take effect on the later of—(1) the date that is 1 year after the date of the enactment of this Act; or (2) the date of entry into force of the treaty with respect to the United States."            "(b) APPLICABILITY OF AMENDMENTS.—(1) IN GENERAL.—Subject to paragraph (2), the amendments made by this title shall apply only to international design applications, international applications, and national applications filed on and after the effective date set forth in subsection (a), and patents issuing thereon."            ...            (c) DEFINITIONS.—For purposes of this section—(1) the terms "treaty" and "international design application" have the meanings given those terms in section 381 of title 35, United States Code, as added by this title; (2) the term "international application" has the meaning given that term in section 351(c) of title 35, United States Code; and (3) the term "national application" means "national application" within the meaning of chapter 38 of title 35, United States Code, as added by this title.</p> <p>Section 203 of the PLTIA provides in pertinent part: "EFFECTIVE DATE. (a) IN GENERAL.—The amendments made by this title [Title II, §§ 201-203]—(1) shall take effect on the date that is 1 year after the date of the enactment of this Act; and (2) shall apply to—(A) any patent issued before, on, or after the effective date set forth in paragraph (1); and (B) any application for patent that is pending on or filed after the effective date set forth in paragraph (1)."</p>
<p>The Leahy-Smith America Invents Technical Corrections Act, P.L. 112-274 ("TCA") (Enacted 1-14-13)</p>	<p>Section 1(n) of the TCA provides "EFFECTIVE DATE.—Except as otherwise provided in this Act, the amendments made by this Act shall take effect on the date of enactment of this Act, and shall apply to proceedings commenced on or after such date of enactment."</p>
<p>* This Table is intended to be a starting point for finding the general effective date, applicability, and exceptions thereto, of the AIA, PLTIA and TCA. The Table does not include or reference all relevant language and exceptions. The reader is advised to review the entire text of such statutes to determine the general effective date, applicability, and exceptions thereto of any provision thereof.</p>	

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## Table—Effective Date/Applicability

<b>Exceptions to General Effective Date/Applicability*</b>				
<b>Affected Code §</b>	<b>Subject</b>	<b>Statutory §</b>	<b>Statutory Language Relating to Effective Date/Applicability</b>	
28 USC §§ 1295(a)(1), 1338(a), 1454; 35 USC § 299	Jurisdiction and procedural matters.	AIA § 19(e)	"The amendments made by this section shall apply to any civil action commenced on or after the date of the enactment of this Act."	
35 USC §§ 2(b)(2)(g), 41(h)(1)	prioritized examination fee	AIA § 11(h)(4)(A)	"This subsection shall take effect on the date that is 10 days after the date of the enactment of this Act."	
35 USC §§ 6, 141	Patent Trial and Appeal Board	AIA § 7(e)	"The amendments made by this section shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to proceedings commenced on or after that effective date, except that — [various exceptions listed]"	
35 USC §§ 6, 141	Interference Proceedings, Patent Trial and Appeal Board	TCA § 1(k)(3)	"REVIEW OF INTERFERENCE DECISIONS.—The provisions of sections 6 and 141 of title 35, United States Code, and section 1295(a)(4)(A) of title 28, United States Code, as in effect on September 15, 2012, shall apply to interference proceedings that are declared after September 15, 2012, under section 135 of title 35, United States Code, as in effect before the effective date under section 3(n) of the Leahy-Smith America Invents Act. The Patent Trial and Appeal Board may be deemed to be the Board of Patent Appeals and Interferences for purposes of such interference proceedings."	
35 USC § 32	Statute of Limitations	AIA § 3(k)(3)	"The amendment made by paragraph (1) shall apply in any case in which the time period for instituting a proceeding under section 32 of title 35, United States Code, had not lapsed before the date of the enactment of this Act."	
35 USC §§ 32, 145, 146, 154(b)(4)(A), 293	Venue	AIA § (9)b	"The amendments made by this section shall take effect on the date of the enactment of this Act and shall apply to any civil action commenced on or after that date."	
35 USC §§ 41(a), (b), (d)(1), 132(b)	Surcharge	AIA § 11(i)(2)(A)-(B)	"The surcharge provided for in Paragraph (1) -- (A) shall take effect on the date that is 10 days after the date of the enactment of this Act; and (B) shall terminate, with respect to a fee to which paragraph (1)(A) applies, on the effective date of the setting or adjustment of that fee pursuant to the exercise of the authority under section 10 for the first time with respect to that fee."	

# Table—Effective Date/Applicability

Exceptions to General Effective Date/Applicability*				
Affected Code §	Subject	Statutory §	Statutory Language Relating to Effective Date/Applicability	
35 USC § 41	Fees for patent services	AIA § 11(j)	“Except as otherwise provided in this section, this section and the amendments made by this section shall take effect on the date of the enactment of this Act.”	
35 USC § 42c	Patent Office funding	AIA § 22(b)	“The amendments made by this section shall take effect on October 1, 2011.”	
35 USC §§ 100, 102-104, 134, 135, 146, 291	First Inventor to File	AIA § 3(n)(1)(A)-(B)	“IN GENERAL.—Except as otherwise provided in this section, the amendments made by this section shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act, and shall apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time—(A) a claim to a claimed invention that has an effective filing date as defined in section 100(f) of title 35, United States Code, that is on or after the effective date described in this paragraph; or (B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.”	
35 USC §§ 100(i), 102(d)	Effective Filing Date, Right of Priority, Prior Art	PLTIA § 103(b)(2)	“EXCEPTION.— Sections 100(i) and 102(d) of title 35, United States Code, as amended by this title [Title I §§ 101-103], shall not apply to an application, or any patent issuing thereon, unless it is described in section 3(n)(1) of the Leahy-Smith America Invents Act (35 U.S.C. 100 note).”	
35 USC §§ 102(g), 135, and 291	Interfering Patents	AIA § 3(n)(2)(A)-(B)	“The provisions of sections 102(g), 135, and 291 of title 35, United States Code, as in effect on the day before the effective date set forth in paragraph (1) of this subsection, shall apply to each claim of an application for patent, and any patent issued thereon, for which the amendments made by this section also apply, if such application or patent contains or contained at any time—(A) a claim to an invention having an effective filing date as defined in section 100(f) of title 35, United States Code, that occurs before the effective date set forth in paragraph (1) of this subsection; or (B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.”	
35 USC § 111	Application for Patent, Filing Date	PLTIA § 203(b)(1)	“The amendments made by section 201(a) shall apply only to applications that are filed on or after the effective date set forth in subsection (a)(1).”	

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## Table—Effective Date/Applicability

35 USC §§ 115, 118	Inventor's Oath or Declaration	AIA § 4(e)	"The amendments made by this section shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent application that is filed on or after that effective date."
35 USC § 122	Preissuance Submissions by Third Parties	AIA § 8(b)	"The amendments made by this section shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent application filed before, on, or after that effective date."
35 USC § 123	Fee Setting Authority	AIA § 10(i)(1)	"Except as provided in subsection (h), this section and the amendments made by this section shall take effect on the date of the enactment of this Act."
35 USC § 135(a)	Derivation Proceedings	TCA § 1(k)(1)-(2)	"EFFECTIVE DATE.—The amendment made by paragraph (1) shall be effective as if included in the amendment made by section 3(i) of the Leahy-Smith America Invents Act."
35 USC § 135(e)	Correct Inventor	TCA § 1(e)(2)	"EFFECTIVE DATE.— The amendment made by paragraph (1) shall be effective as if included in the amendment made by section 3(i) of the Leahy-Smith America Invents Act."
35 USC § 157	Repeal of Statutory Invention Registration	AIA § 3(e)(3)	"The amendments made by this subsection shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act, and shall apply to any request for a statutory invention registration filed on or after that effective date."
35 USC § 202(c)(7)(E)(i)	Funding Agreements	AIA § 13(b)	"The amendments made by this section shall take effect on the date of the enactment of this Act and shall apply to any patent issued before, on, or after that date."
35 USC § 257	supplemental examination	AIA § 12(c)	"The amendments made by this section shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent issued before, on, or after that effective date."

# Table—Effective Date/Applicability

Exceptions to General Effective Date/Applicability*			Statutory Language Relating to Effective Date/Applicability
Affected Code §	Subject	Statutory §	
35 USC § 273	Defense to Infringement Based on Prior Commercial Use	AIA § 5(c)	“The amendments made by this section shall apply to any patent issued on or after the date of the enactment of this Act.”
35 USC § 282	Best mode requirement	AIA § 15(c)	“The amendments made by this section shall take effect upon the date of the enactment of this Act and shall apply to proceedings commenced on or after that date.”
35 USC § 287(a)	Virtual Marking	AIA § 16(a)(2)	“The amendment made by this subsection shall apply to any case that is pending on, or commenced on or after, the date of the enactment of this Act.”
35 USC § 292	False Marking	AIA § 16(b)(4)	“The amendments made by this subsection shall apply to all cases, without exception, that are pending on, or commenced on or after, the date of the enactment of this Act.”
35 USC § 298	Advice of counsel	TCA § 1(a)	“ADVICE OF COUNSEL.--Notwithstanding section 35 of the Leahy-Smith America Invents Act (35 U.S.C. 1 note), section 298 of title 35, United States Code, shall apply to any civil action commenced on or after the date of the enactment of this Act.”
35 USC § 301	Citation of Prior Art and Written Statements	AIA § 6(g)(3)	“The amendments made by this subsection shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent issued before, on, or after that effective date.”
35 USC § 303(a)	Reexamination	AIA § 6(h)(1)(B)	“The amendment made by this paragraph shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent issued before, on, or after that effective date.”
35 USC § 306	Reexamination Appeal	AIA § 6(h)(2)(B)	“The amendment made by this paragraph shall take effect on the date of the enactment of this Act and shall apply to any appeal of a reexamination before the Board of Patent Appeals and Interferences or the Patent Trial and Appeal Board that is pending on, or brought on or after, the date of the enactment of this Act.”

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## Table—Effective Date/Applicability

35 USC §§ 311-319	Inter partes review	AIA § 6(c)(2)(A)	“IN GENERAL.—The amendments made by subsection (a) shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent issued before, on, or after that effective date.”
35 USC § 311(c)	Inter partes review	TCA § 1(d)(1)	“INTER PARTES REVIEW.—Section 311(c) of title 35, United States Code, shall not apply to a petition to institute an inter partes review of a patent that is not a patent described in section 3(n)(1) of the Leahy-Smith America Invents Act (35 U.S.C. 100 note).”
35 USC §§ 312-313 (transition provisions)	Inter partes review (transition)	AIA § 6(c)(3)(B)(i)-(ii), (C)	“APPLICATION.—The amendments made by this paragraph— (i) shall take effect on the date of the enactment of this Act; and (ii) shall apply to requests for inter partes reexamination that are filed on or after such date of enactment, but before the effective date set forth in paragraph (2)(A) of this subsection. (C) CONTINUED APPLICABILITY OF PRIOR PROVISIONS.—The provisions of chapter 31 of title 35, United States Code, as amended by this paragraph, shall continue to apply to requests for inter partes reexamination that are filed before the effective date set forth in paragraph (2)(A) as if subsection (a) had not been enacted.”
35 USC §§ 321-329	Post Grant Review	AIA § 6(f)(2)(A)	“IN GENERAL.—The amendments made by subsection (d) shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and, except as provided in section 18 and in paragraph (3), shall apply only to patents described in section 3(n)(1).”
various, including 35 USC §§ 27, 111, 119, 261, 365	Patents in litigation	PLTIA § 203(b)(2)	“PATENTS IN LITIGATION.—The amendments made by this title [Title II, §§ 201-203] shall have no effect with respect to any patent that is the subject of litigation in an action commenced before the effective date set forth in subsection (a)(1).”
various	Technical amendments	AIA § 2(0)(l)	“The amendments made by this section shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to proceedings commenced on or after that effective date.”

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*[With amendments received through Jan. 16, 2014, P.L. 113-72.]*

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**PART I. UNITED STATES PATENT AND  
TRADEMARK OFFICE****CHAPTER 1. ESTABLISHMENT, OFFICERS AND EMPLOYEES, FUNCTIONS****§ 1. Establishment**

**(a) Establishment.** The United States Patent and Trademark Office is established as an agency of the United States, within the Department of Commerce. In carrying out its functions, the United States Patent and Trademark Office shall be subject to the policy direction of the Secretary of Commerce, but otherwise shall retain responsibility for decisions regarding the management and administration of its operations and shall exercise independent control of its budget allocations and expenditures, personnel decisions and processes, procurements, and other administrative and management functions in accordance with this title and applicable provisions of law. Those operations designed to grant and issue patents and those operations which are designed to facilitate the registration of trademarks shall be treated as separate operating units within the Office.

**(b) Offices.** The United States Patent and Trademark Office shall maintain its principal office in the metropolitan Washington, D.C., area, for the service of process and papers and for the purpose of carrying out its functions. The United States Patent and Trademark Office shall be deemed, for purposes of venue in civil actions, to be a resident of the district in which its principal office is located, except where jurisdiction is otherwise provided by law. The United States Patent and Trademark Office may establish satellite offices in such other places in the United States as it considers necessary and appropriate in the conduct of its business.

**(c) Reference.** For purposes of this title, the United States Patent and Trademark Office shall also be referred to as the “Office” and the “Patent and Trademark Office”.

**HISTORY:** (July 19, 1952, ch 950, § 1, 66 Stat. 792; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536.)

**§ 2. Powers and duties**

**(a) In general.** The United States Patent and Trademark Office, subject to the policy direction of the Secretary of Commerce—

**(1)** shall be responsible for the granting and issuing of patents and the registration of trademarks; and

**(2)** shall be responsible for disseminating to the public information with respect to patents and trademarks.

**(b) Specific powers.** The Office—

**(1)** shall adopt and use a seal of the Office, which shall be judicially noticed and with which letters patent, certificates of trademark registrations, and papers issued by the Office shall be authenticated;

**(2)** may establish regulations, not inconsistent with law, which—

**(A)** shall govern the conduct of proceedings in the Office;

**(B)** shall be made in accordance with section 553 of title 5;

**(C)** shall facilitate and expedite the processing of patent applications, particularly those which can be filed, stored, processed, searched, and retrieved electronically, subject to the provisions of section 122 [35 USC § 122] relating to the confidential status of applications;

**(D)** may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office, and may require them, before being recognized as representatives of applicants or other

persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office;

**(E)** shall recognize the public interest in continuing to safeguard broad access to the United States patent system through the reduced fee structure for small entities under section 41(h)(1) of this title [35 USC § 41(h)(1)]; and

**(F)** provide for the development of a performance-based process that includes quantitative and qualitative measures and standards for evaluating cost-effectiveness and is consistent with the principles of impartiality and competitiveness; and

**(G)** may, subject to any conditions prescribed by the Director and at the request of the patent applicant, provide for prioritization of examination of applications for products, processes, or technologies that are important to the national economy or national competitiveness without recovering the aggregate extra cost of providing such prioritization, notwithstanding section 41 or any other provision of law;

**(3)** may acquire, construct, purchase, lease, hold, manage, operate, improve, alter, and renovate any real, personal, or mixed property, or any interest therein, as it considers necessary to carry out its functions;

**(4)(A)** may make such purchases, contracts for the construction, maintenance, or management and operation of facilities, and contracts for supplies or services, without regard to the provisions of subtitle I and chapter 33 of title 40 [40 USC §§ 101 et seq. and 3301 et seq.], division C (except sections 3302, 3501(b), 3509, 3906, 4710, and 4711) of subtitle I of title 41 [41 USC §§ 3101 et seq. (except 41 USC §§ 3302, 3501(b), 3509, 3906, 4710, and 4711)], and the Stewart B. McKinney Homeless Assistance Act [McKinney-Vento Homeless Assistance Act] (42 U.S.C. 11301 et seq.); and

**(B)** may enter into and perform such purchases and contracts for printing services, including the process of composition, platemaking, presswork, silk screen processes, binding, microform, and the products of such processes, as it considers necessary to carry out the functions of the Office, without regard to sections 501 through 517 and 1101 through 1123 of title 44;

**(5)** may use, with their consent, services, equipment, personnel, and facilities of other departments, agencies, and instrumentalities of the Federal Government, on a reimbursable basis, and cooperate with such other departments, agencies, and instrumentalities in the establishment and use of services, equipment, and facilities of the Office;

**(6)** may, when the Director determines that it is practicable, efficient, and cost-effective to do so, use, with the consent of the United States and the agency, instrumentality, Patent and Trademark Office, or international organization concerned, the services, records, facilities, or personnel of any State or local government agency or instrumentality or foreign patent and trademark office or international organization to perform functions on its behalf;

**(7)** may retain and use all of its revenues and receipts, including revenues from the sale, lease, or disposal of any real, personal, or mixed property, or any interest therein, of the Office;

**(8)** shall advise the President, through the Secretary of Commerce, on national and certain international intellectual property policy issues;

**(9)** shall advise Federal departments and agencies on matters of intellectual property policy in the United States and intellectual property protection in other countries;

(10) shall provide guidance, as appropriate, with respect to proposals by agencies to assist foreign governments and international intergovernmental organizations on matters of intellectual property protection;

(11) may conduct programs, studies, or exchanges of items or services regarding domestic and international intellectual property law and the effectiveness of intellectual property protection domestically and throughout the world, and the Office is authorized to expend funds to cover the subsistence expenses and travel-related expenses, including per diem, lodging costs, and transportation costs, of persons attending such programs who are not Federal employees;

(12)(A) shall advise the Secretary of Commerce on programs and studies relating to intellectual property policy that are conducted, or authorized to be conducted, cooperatively with foreign intellectual property offices and international intergovernmental organizations; and

(B) may conduct programs and studies described in subparagraph (A); and

(13)(A) in coordination with the Department of State, may conduct programs and studies cooperatively with foreign intellectual property offices and international intergovernmental organizations; and

(B) with the concurrence of the Secretary of State, may authorize the transfer of not to exceed \$ 100,000 in any year to the Department of State for the purpose of making special payments to international intergovernmental organizations for studies and programs for advancing international cooperation concerning patents, trademarks, and other matters.

**(c) Clarification of specific powers.**

(1) The special payments under subsection (b)(13)(B) shall be in addition to any other payments or contributions to international organizations described in subsection (b)(13)(B) and shall not be subject to any limitations imposed by law on the amounts of such other payments or contributions by the United States Government.

(2) Nothing in subsection (b) shall derogate from the duties of the Secretary of State or from the duties of the United States Trade Representative as set forth in section 141 of the Trade Act of 1974 (19 U.S.C. 2171).

(3) Nothing in subsection (b) shall derogate from the duties and functions of the Register of Copyrights or otherwise alter current authorities relating to copyright matters.

(4) In exercising the Director's powers under paragraphs (3) and (4)(A) of subsection (b), the Director shall consult with the Administrator of General Services.

(5) In exercising the Director's powers and duties under this section, the Director shall consult with the Register of Copyrights on all copyright and related matters.

**(d) Construction.** Nothing in this section shall be construed to nullify, void, cancel, or interrupt any pending request-for-proposal let or contract issued by the General Services Administration for the specific purpose of relocating or leasing space to the United States Patent and Trademark Office.

**HISTORY:** (July 19, 1952, ch 950, § 1, 66 Stat. 792; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(a)(1), 116 Stat. 1904; Dec. 15, 2003, P.L. 108-178, § 4(g), 117 Stat. 2641; Jan. 4, 2011, P.L. 111-350, § 5(i)(1), 124 Stat. 3849.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, §§ 20(j)(1); 21(a); 25(1)-(3).)

### § 3. Officers and employees

**(a) Under Secretary and Director.**

**(1) In general.** The powers and duties of the United States Patent and Trade-

mark Office shall be vested in an Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (in this title referred to as the “Director”), who shall be a citizen of the United States and who shall be appointed by the President, by and with the advice and consent of the Senate. The Director shall be a person who has a professional background and experience in patent or trademark law.

**(2) Duties.**

**(A) In general.** The Director shall be responsible for providing policy direction and management supervision for the Office and for the issuance of patents and the registration of trademarks. The Director shall perform these duties in a fair, impartial, and equitable manner.

**(B) Consulting with the Public Advisory Committees.** The Director shall consult with the Patent Public Advisory Committee established in section 5 [35 USC § 5] on a regular basis on matters relating to the patent operations of the Office, shall consult with the Trademark Public Advisory Committee established in section 5 [35 USC § 5] on a regular basis on matters relating to the trademark operations of the Office, and shall consult with the respective Public Advisory Committee before submitting budgetary proposals to the Office of Management and Budget or changing or proposing to change patent or trademark user fees or patent or trademark regulations which are subject to the requirement to provide notice and opportunity for public comment under section 553 of title 5, as the case may be.

**(3) Oath.** The Director shall, before taking office, take an oath to discharge faithfully the duties of the Office.

**(4) Removal.** The Director may be removed from office by the President. The President shall provide notification of any such removal to both Houses of Congress.

**(b) Officers and employees of the Office.**

**(1) Deputy Under Secretary and Deputy Director.** The Secretary of Commerce, upon nomination by the Director, shall appoint a Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office who shall be vested with the authority to act in the capacity of the Director in the event of the absence or incapacity of the Director. The Deputy Director shall be a citizen of the United States who has a professional background and experience in patent or trademark law.

**(2) Commissioners.**

**(A) Appointment and duties.** The Secretary of Commerce shall appoint a Commissioner for Patents and a Commissioner for Trademarks, without regard to chapter 33, 51, or 53 of title 5 [5 USC §§ 3301 et seq., 5101 et seq., or 5301 et seq.]. The Commissioner for Patents shall be a citizen of the United States with demonstrated management ability and professional background and experience in patent law and serve for a term of 5 years. The Commissioner for Trademarks shall be a citizen of the United States with demonstrated management ability and professional background and experience in trademark law and serve for a term of 5 years. The Commissioner for Patents and the Commissioner for Trademarks shall serve as the chief operating officers for the operations of the Office relating to patents and trademarks, respectively, and shall be responsible for the management and direction of all aspects of the activities of the Office that affect the administration of patent and trademark operations, respectively. The Secretary may reappoint a Commissioner to subsequent terms of 5 years as long as the performance of the Commissioner as set forth in the performance agreement in subparagraph (B) is satisfactory.

**(B) Salary and performance agreement.** The Commissioners shall be paid an annual rate of basic pay not to exceed the maximum rate of basic pay for the Senior Executive Service established under section 5382 of title 5, including any applicable locality-based comparability payment that may be authorized under section 5304(h)(2)(C) of title 5. The compensation of the Commissioners shall be considered, for purposes of section 207(c)(2)(A) of title 18, to be the equivalent of that described under clause (ii) of section 207(c)(2)(A) of title 18. In addition, the Commissioners may receive a bonus in an amount of up to, but not in excess of, 50 percent of the Commissioners' annual rate of basic pay, based upon an evaluation by the Secretary of Commerce, acting through the Director, of the Commissioners' performance as defined in an annual performance agreement between the Commissioners and the Secretary. The annual performance agreements shall incorporate measurable organization and individual goals in key operational areas as delineated in an annual performance plan agreed to by the Commissioners and the Secretary. Payment of a bonus under this subparagraph may be made to the Commissioners only to the extent that such payment does not cause the Commissioners' total aggregate compensation in a calendar year to equal or exceed the amount of the salary of the Vice President under section 104 of title 3.

**(C) Removal.** The Commissioners may be removed from office by the Secretary for misconduct or nonsatisfactory performance under the performance agreement described in subparagraph (B), without regard to the provisions of title 5. The Secretary shall provide notification of any such removal to both Houses of Congress.

**(3) Other officers and employees.** The Director shall—

**(A)** appoint such officers, employees (including attorneys), and agents of the Office as the Director considers necessary to carry out the functions of the Office; and

**(B)** define the title, authority, and duties of such officers and employees and delegate to them such of the powers vested in the Office as the Director may determine.

The Office shall not be subject to any administratively or statutorily imposed limitation on positions or personnel, and no positions or personnel of the Office shall be taken into account for purposes of applying any such limitation.

**(4) Training of examiners.** The Office shall submit to the Congress a proposal to provide an incentive program to retain as employees patent and trademark examiners of the primary examiner grade or higher who are eligible for retirement, for the sole purpose of training patent and trademark examiners.

**(5) National security positions.** The Director, in consultation with the Director of the Office of Personnel Management, shall maintain a program for identifying national security positions and providing for appropriate security clearances, in order to maintain the secrecy of certain inventions, as described in section 181 [35 USC § 181], and to prevent disclosure of sensitive and strategic information in the interest of national security.

**(6) Administrative patent judges and administrative trademark judges.**—The Director may fix the rate of basic pay for the administrative patent judges appointed pursuant to section 6 and the administrative trademark judges appointed pursuant to section 17 of the Trademark Act of 1946 (15 U.S.C. 1067) at not greater than the rate of basic pay payable for level III of the Executive Schedule under section 5314 of title 5. The payment of a rate of basic pay under this para-

graph shall not be subject to the pay limitation under section 5306(e) or 5373 of title 5.

**(c) Continued applicability of title 5.** Officers and employees of the Office shall be subject to the provisions of title 5, relating to Federal employees.

**(d) Adoption of existing labor agreements.** The Office shall adopt all labor agreements which are in effect, as of the day before the effective date of the Patent and Trademark Office Efficiency Act, with respect to such Office (as then in effect).

**(e) Carryover of personnel.**

**(1) From PTO.** Effective as of the effective date of the Patent and Trademark Office Efficiency Act, all officers and employees of the Patent and Trademark Office on the day before such effective date shall become officers and employees of the Office, without a break in service.

**(2) Other personnel.** Any individual who, on the day before the effective date of the Patent and Trademark Office Efficiency Act, is an officer or employee of the Department of Commerce (other than an officer or employee under paragraph (1)) shall be transferred to the Office, as necessary to carry out the purposes of this Act, that Act, if—

**(A)** such individual serves in a position for which a major function is the performance of work reimbursed by the Patent and Trademark Office, as determined by the Secretary of Commerce;

**(B)** such individual serves in a position that performed work in support of the Patent and Trademark Office during at least half of the incumbent's work time, as determined by the Secretary of Commerce; or

**(C)** such transfer would be in the interest of the Office, as determined by the Secretary of Commerce in consultation with the Director.

Any transfer under this paragraph shall be effective as of the same effective date as referred to in paragraph (1), and shall be made without a break in service.

**(f) Transition provisions.**

**(1) Interim appointment of Director.** On or after the effective date of the Patent and Trademark Office Efficiency Act, the President shall appoint an individual to serve as the Director until the date on which a Director qualifies under subsection (a). The President shall not make more than one such appointment under this subsection.

**(2) Continuation in office of certain officers.**

**(A)** The individual serving as the Assistant Commissioner for Patents on the day before the effective date of the Patent and Trademark Office Efficiency Act may serve as the Commissioner for Patents until the date on which a Commissioner for Patents is appointed under subsection (b).

**(B)** The individual serving as the Assistant Commissioner for Trademarks on the day before the effective date of the Patent and Trademark Office Efficiency Act may serve as the Commissioner for Trademarks until the date on which a Commissioner for Trademarks is appointed under subsection (b).

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 792; Sept. 6, 1958, P.L. 85-933, § 1, 72 Stat. 1793; Sept. 23, 1959, P.L. 86-370, § 1(a), 73 Stat. 650; Aug. 14, 1964, P.L. 88-426, Title III, § 305(26), 78 Stat. 425; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Jan. 2, 1975, P.L. 93-601, § 1, 88 Stat. 1956; Aug. 27, 1982, P.L. 97-247, § 4, 96 Stat. 319; Oct. 15, 1982, P.L. 97-366, § 4, 96 Stat. 1760; Nov. 8, 1984, P.L. 98-622, Title IV, § 405, 98 Stat. 3392; Oct. 28, 1998, P.L. 105-304, Title IV, § 401(a)(1), 112 Stat. 2887; Aug. 5, 1999, P.L. 106-44, § 2(c), 113 Stat. 223; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(a)(2), 116 Stat. 1904.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, §§ 20(i)(1); 21(b).)

## § 4. Restrictions on officers and employees as to interest in patents

Officers and employees of the Patent and Trademark Office shall be incapable, during the period of their appointments and for one year thereafter, of applying for a patent and of acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in any patent, issued or to be issued by the Office. In patents applied for thereafter they shall not be entitled to any priority date earlier than one year after the termination of their appointment.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 793; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949.)

## § 5. Patent and Trademark Office Public Advisory Committees

### (a) Establishment of Public Advisory Committees.

**(1) Appointment.** The United States Patent and Trademark Office shall have a Patent Public Advisory Committee and a Trademark Public Advisory Committee, each of which shall have nine voting members who shall be appointed by the Secretary of Commerce and serve at the pleasure of the Secretary of Commerce. ~~Members of each Public Advisory Committee shall be appointed for a term of 3 years, except that of the members first appointed, three shall be appointed for a term of 1 year, and three shall be appointed for a term of 2 years. In making appointments to each Committee, the Secretary of Commerce shall consider the risk of loss of competitive advantage in international commerce or other harm to United States companies as a result of such appointments. In each year, 3 members shall be appointed to each Advisory Committee for 3-year terms that shall begin on December 1 of that year. Any vacancy on an Advisory Committee shall be filled within 90 days after it occurs. A new member who is appointed to fill a vacancy shall be appointed to serve for the remainder of the predecessor's term.~~

~~**(2) Chair.** The Secretary shall designate a chair of each Advisory Committee, whose term as chair shall be for 3 years.~~

~~**(2) Chair.**—The Secretary of Commerce, in consultation with the Director, shall designate a Chair and Vice Chair of each Advisory Committee from among the members appointed under paragraph (1). If the Chair resigns before the completion of his or her term, or is otherwise unable to exercise the functions of the Chair, the Vice Chair shall exercise the functions of the Chair.~~

~~**(3) Timing of appointments.** Initial appointments to each Advisory Committee shall be made within 3 months after the effective date of the Patent and Trademark Office Efficiency Act. Vacancies shall be filled within 3 months after they occur.~~

### (b) Basis for appointments. Members of each Advisory Committee—

**(1)** shall be citizens of the United States who shall be chosen so as to represent the interests of diverse users of the United States Patent and Trademark Office with respect to patents, in the case of the Patent Public Advisory Committee, and with respect to trademarks, in the case of the Trademark Public Advisory Committee;

**(2)** shall include members who represent small and large entity applicants located in the United States in proportion to the number of applications filed by such applicants, but in no case shall members who represent small entity patent applicants, including small business concerns, independent inventors, and nonprofit organizations, constitute less than 25 percent of the members of the Patent Public Advisory Committee, and such members shall include at least one independent inventor; and

(3) shall include individuals with substantial background and achievement in finance, management, labor relations, science, technology, and office automation.

In addition to the voting members, each Advisory Committee shall include a representative of each labor organization recognized by the United States Patent and Trademark Office. Such representatives shall be nonvoting members of the Advisory Committee to which they are appointed.

(c) **Meetings.** Each Advisory Committee shall meet at the call of the chair to consider an agenda set by the chair.

(d) **Duties.** Each Advisory Committee shall—

(1) review the policies, goals, performance, budget, and user fees of the United States Patent and Trademark Office with respect to patents, in the case of the Patent Public Advisory Committee, and with respect to Trademarks, in the case of the Trademark Public Advisory Committee, and advise the Director on these matters;

(2) within 60 days after the end of each fiscal year—

(A) prepare an annual report on the matters referred to in paragraph (1);

(B) transmit the report to the Secretary of Commerce, the President, and the Committees on the Judiciary of the Senate and the House of Representatives; and

(C) publish the report in the Official Gazette of the United States Patent and Trademark Office.

(e) **Compensation.** Each member of each Advisory Committee shall be compensated for each day (including travel time) during which such member is attending meetings or conferences of that Advisory Committee or otherwise engaged in the business of that Advisory Committee, at the rate which is the daily equivalent of the annual rate of basic pay in effect for level III of the Executive Schedule under section 5314 of title 5. While away from such member's home or regular place of business such member shall be allowed travel expenses, including per diem in lieu of subsistence, as authorized by section 5703 of title 5.

(f) **Access to information.** Members of each Advisory Committee shall be provided access to records and information in the United States Patent and Trademark Office, except for personnel or other privileged information and information concerning patent applications required to be kept in confidence by section 122 [35 USC § 122].

(g) **Applicability of certain ethics laws.** Members of each Advisory Committee shall be special Government employees within the meaning of section 202 of title 18.

(h) **Inapplicability of Federal Advisory Committee Act.** The Federal Advisory Committee Act (5 U.S.C. App.) shall not apply to each Advisory Committee.

(i) **Open meetings.** The meetings of each Advisory Committee shall be open to the public, except that each Advisory Committee may by majority vote meet in executive session when considering personnel, privileged, or other confidential information.

(j) **Inapplicability of patent prohibition.** Section 4 [35 USC § 4] shall not apply to voting members of the Advisory Committees.

HISTORY: (Added Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title V, Subtitle B, §§ 13203(b), 13206(a)(3), 116 Stat. 1902, 1904.)

(Black Line changes: Leahy-Smith America Invents Technical Corrections Act, P.L. 112-274, § 1(l)(1)(A)-(C).)

## **§ 6. Board of Patent Appeals and Interferences**

~~(a) Establishment and composition.~~ There shall be in the United States Patent and Trademark Office a Board of Patent Appeals and Interferences. The Di-

rector, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Board. The administrative patent judges shall be persons of competent legal knowledge and scientific ability who are appointed by the Secretary of Commerce, in consultation with the Director.

**(b) Duties.** The Board of Patent Appeals and Interferences shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents and shall determine priority and patentability of invention in interferences declared under section 135(a) [35 USC § 135(a)]. Each appeal and interference shall be heard by at least three members of the Board, who shall be designated by the Director. Only the Board of Patent Appeals and Interferences may grant rehearings.

**(c) Authority of the Secretary.** The Secretary of Commerce may, in his or her discretion, deem the appointment of an administrative patent judge who, before the date of the enactment of this subsection [enacted Aug. 12, 2008], held office pursuant to an appointment by the Director to take effect on the date on which the Director initially appointed the administrative patent judge.

**(d) Defense to challenge of appointment.** It shall be a defense to a challenge to the appointment of an administrative patent judge on the basis of the judge's having been originally appointed by the Director that the administrative patent judge so appointed was acting as a de facto officer.

## **§ 6. Patent Trial and Appeal Board**

**(a) In general.**—There shall be in the Office a Patent Trial and Appeal Board. The Director, the Deputy Director, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Patent Trial and Appeal Board. The administrative patent judges shall be persons of competent legal knowledge and scientific ability who are appointed by the Secretary, in consultation with the Director. Any reference in any Federal law, Executive order, rule, regulation, or delegation of authority, or any document of or pertaining to the Board of Patent Appeals and Interferences is deemed to refer to the Patent Trial and Appeal Board.

**(b) Duties.**—The Patent Trial and Appeal Board shall—

**(1)** on written appeal of an applicant, review adverse decisions of examiners upon applications for patents pursuant to section 134(a);

**(2)** review appeals of reexaminations pursuant to section 134(b);

**(3)** conduct derivation proceedings pursuant to section 135; and

**(4)** conduct inter partes reviews and post-grant reviews pursuant to chapters 31 and 32.

**(c) 3-Member panels.**—Each appeal, derivation proceeding, post-grant review, and inter partes review shall be heard by at least 3 members of the Patent Trial and Appeal Board, who shall be designated by the Director. Only the Patent Trial and Appeal Board may grant rehearings.

**(d) Treatment of prior appointments.**—The Secretary of Commerce may, in the Secretary's discretion, deem the appointment of an administrative patent judge who, before the date of the enactment of this subsection, held office pursuant to an appointment by the Director to take effect on the date on which the Director initially appointed the administrative patent judge. It shall be a defense to a challenge to the appointment of an administrative patent judge on the basis of the judge's having been originally appointed by the Director that the administrative patent judge so appointed was acting as a de facto officer.

HISTORY: (Added Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title V, Subtitle B, § 13203(a)(2), 116 Stat. 1902; Aug. 12, 2008, P.L. 110-313, § 1(a)(1), 122 Stat. 3014.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, § 7(a)(1).)

## § 7. Library

The Director shall maintain a library of scientific and other works and periodicals, both foreign and domestic, in the Patent and Trademark Office to aid the officers in the discharge of their duties.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 793; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

## § 8. Classification of patents

The Director may revise and maintain the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patent are filed.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 794; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

## § 9. Certified copies of records

The Director may furnish certified copies of specifications and drawings of patents issued by the Patent and Trademark Office, and of other records available either to the public or to the person applying therefor.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 794; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

## § 10. Publications

(a) The Director may publish in printed, typewritten, or electronic form, the following:

1. Patents and published applications for patents, including specifications and drawings, together with copies of the same. The Patent and Trademark Office may print the headings of the drawings for patents for the purpose of photolithography.
2. Certificates of trade-mark registrations, including statements and drawings, together with copies of the same.
3. The Official Gazette of the United States Patent and Trademark Office.
4. Annual indexes of patents and patentees, and of trade-marks and registrants.
5. Annual volumes of decisions in patent and trade-mark cases.
6. Pamphlet copies of the patent laws and rules of practice, laws and rules relating to trade-marks, and circulars or other publications relating to the business of the Office.

(b) The Director may exchange any of the publications specified in items 3, 4, 5, and 6 of subsection (a) of this section for publications desirable for the use of the Patent and Trademark Office.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 794; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, §§ 13205(2)(A), 13206(b)(1)(B), (3)(A), 116 Stat. 1903, 1906.)

## § 11. Exchange of copies of patents and applications with foreign countries

The Director may exchange copies of specifications and drawings of United States patents and published applications for patents for those of foreign countries. The Director shall not enter into an agreement to provide such copies of specifications and drawings of United States patents and applications to a foreign country, other than a NAFTA country or a WTO member country, without the express authoriza-

tion of the Secretary of Commerce. For purposes of this section, the terms “NAFTA country” and “WTO member country” have the meanings given those terms in section 104(b) [35 USC § 104(b)].

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 794; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, §§ 13205(2)(B), 13206(b)(1)(B), 116 Stat. 1903, 1906.)

## **§ 12. Copies of patents and applications for public libraries**

The Director may supply copies of specifications and drawings of patents and published applications for patents in printed or electronic form to public libraries in the United States which shall maintain such copies for the use of the public, at the rate for each year’s issue established for this purpose in section 41(d) of this title [35 USC § 41(d)].

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 794; Aug. 27, 1982, P.L. 97-247, § 15, 96 Stat. 321; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, §§ 13205(2)(C), 13206(b)(1)(B), (3)(B), 116 Stat. 1903, 1906.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, § 20(j)(1))

## **§ 13. Annual report to Congress**

The Director shall report to the Congress, not later than 180 days after the end of each fiscal year, the moneys received and expended by the Office, the purposes for which the moneys were spent, the quality and quantity of the work of the Office, the nature of training provided to examiners, the evaluation of the Commissioner of Patents and the Commissioner of Trademarks by the Secretary of Commerce, the compensation of the Commissioners, and other information relating to the Office.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 794; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536.)

## **[§ 14. Redesignated]**

### **CHAPTER 2. PROCEEDINGS IN THE PATENT AND TRADEMARK OFFICE**

## **§ 21. Filing date and day for taking action**

(a) The Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Director.

(b) When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 794; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Aug. 27, 1982, P.L. 97-247, § 12, 96 Stat. 321; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

## **§ 22. Printing of papers filed**

The Director may require papers filed in the Patent and Trademark Office to be printed, typewritten, or on an electronic medium.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 795; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

## § 23. Testimony in Patent and Trademark Office cases

The Director may establish rules for taking affidavits and depositions required in cases in the Patent and Trademark Office. Any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where he resides, may take such affidavits and depositions.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 795; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

## § 24. Subpoenas, witnesses

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent and Trademark Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office.

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 795; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949.)

## § 25. Declaration in lieu of oath

(a) The Director may by rule prescribe that any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration in such form as the Director may prescribe, such declaration to be in lieu of the oath otherwise required.

(b) Whenever such written declaration is used, the document must warn the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001).

HISTORY: (Added March 26, 1964, P.L. 88-292, § 1, 78 Stat. 171; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

## § 26. Effect of defective execution

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be executed in a specified manner may be provisionally accepted by the Director despite a defective execution, provided a properly executed document is submitted within such time as may be prescribed.

HISTORY: (Added March 26, 1964, P.L. 88-292, § 1, 78 Stat. 171; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

## **§ 27. Revival of applications; reinstatement of reexamination proceedings**

The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to revive an unintentionally abandoned application for patent, accept an unintentionally delayed payment of the fee for issuing each patent, or accept an unintentionally delayed response by the patent owner in a reexamination proceeding, upon petition by the applicant for patent or patent owner.

HISTORY: (Black Line changes: Patent Law Treaties Implementation Act of 2012, P.L. 112-211, § 201(b)(1).)

### **CHAPTER 3. PRACTICE BEFORE PATENT AND TRADEMARK OFFICE**

#### **[§ 31. Repealed]**

#### **§ 32. Suspension or exclusion from practice**

The Director may, after notice and opportunity for a hearing suspend or exclude, either generally or in any particular case, from further practice before the Patent and Trademark Office, any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 2(b)(2)(D) of this title [35 USC § 2(b)(2)(D)], or who shall, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The Director shall have the discretion to designate any attorney who is an officer or employee of the United States Patent and Trademark Office to conduct the hearing required by this section. A proceeding under this section shall be commenced not later than the earlier of either the date that is 10 years after the date on which the misconduct forming the basis for the proceeding occurred, or 1 year after the date on which the misconduct forming the basis for the proceeding is made known to an officer or employee of the Office as prescribed in the regulations established under section 2(b)(2)(D). The United States District Court for the District of Columbia United States District Court for the Eastern District of Virginia, under such conditions and upon such proceedings as it by its rules determines, may review the action of the Director upon the petition of the person so refused recognition or so suspended or excluded.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 795; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, §§ 3(k)(1); 9(a); 20(j)(1).)

#### **§ 33. Unauthorized representation as practitioner**

Whoever, not being recognized to practice before the Patent and Trademark Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent, shall be fined not more than \$ 1,000 for each offense.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 796; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949.)

### **CHAPTER 4. PATENT FEES; FUNDING; SEARCH SYSTEMS**

#### **§ 41. Patent fees; patent and trademark search systems**

(a) The Director shall charge the following fees:

~~(1)(A) On filing each application for an original patent, except in design or plant cases, \$ 690.~~

~~(B) In addition, on filing or on presentation at any other time, \$ 78 for each claim in independent form which is in excess of 3, \$ 18 for each claim (whether independent or dependent) which is in excess of 20, and \$ 260 for each application containing a multiple dependent claim.~~

~~(C) On filing each provisional application for an original patent, \$ 150.~~

~~(2) For issuing each original or reissue patent, except in design or plant cases, \$ 1,210.~~

~~(3) In design and plant cases—~~

~~(A) on filing each design application, \$ 310;~~

~~(B) on filing each plant application, \$ 480;~~

~~(C) on issuing each design patent, \$ 430; and~~

~~(D) on issuing each plant patent, \$ 580.~~

~~(4)(A) On filing each application for the reissue of a patent, \$ 690.~~

~~(B) In addition, on filing or on presentation at any other time, \$ 78 for each claim in independent form which is in excess of the number of independent claims of the original patent, and \$ 18 for each claim (whether independent or dependent) which is in excess of 20 and also in excess of the number of claims of the original patent.~~

~~(5) On filing each disclaimer, \$ 110.~~

~~(6)(A) On filing an appeal from the examiner to the Board of Patent Appeals and Interferences, \$ 300.~~

~~(B) In addition, on filing a brief in support of the appeal, \$ 300, and on requesting an oral hearing in the appeal before the Board of Patent Appeals and Interferences, \$ 260.~~

~~(7) On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, \$ 1,210, unless the petition is filed under section 133 or 151 of this title [35 USC § 133 or 151], in which case the fee shall be \$ 110.~~

~~(8) For petitions for 1-month extensions of time to take actions required by the Director in an application—~~

~~(A) on filing a first petition, \$ 110;~~

~~(B) on filing a second petition, \$ 270; and~~

~~(C) on filing a third petition or subsequent petition, \$ 490.~~

~~(9) Basic national fee for an international application where the Patent and Trademark Office was the International Preliminary Examining Authority and the International Searching Authority, \$ 670.~~

~~(10) Basic national fee for an international application where the Patent and Trademark Office was the International Searching Authority but not the International Preliminary Examining Authority, \$ 690.~~

~~(11) Basic national fee for an international application where the Patent and Trademark Office was neither the International Searching Authority nor the International Preliminary Examining Authority, \$ 970.~~

~~(12) Basic national fee for an international application where the international preliminary examination fee has been paid to the Patent and Trademark Office, and the international preliminary examination report states that the provisions of Article 33(2), (3), and (4) of the Patent Cooperation Treaty have been satisfied for all claims in the application entering the national stage, \$ 96.~~

**(13)** For filing or later presentation of each independent claim in the national stage of an international application in excess of 3, § 78.

**(14)** For filing or later presentation of each claim (whether independent or dependent) in a national stage of an international application in excess of 20, § 18.

**(15)** For each national stage of an international application containing a multiple dependent claim, § 260.

For the purpose of computing fees, a multiple dependent claim referred to in section 112 of this title [35 USC § 112] or any claim depending therefrom shall be considered as separate dependent claims in accordance with the number of claims to which reference is made. Errors in payment of the additional fees may be rectified in accordance with regulations of the Director.

**(b)** The Director shall charge the following fees for maintaining in force all patents based on applications filed on or after December 12, 1980:

**(1)** 3 years and 6 months after grant, § 830.

**(2)** 7 years and 6 months after grant, § 1,900.

**(3)** 11 years and 6 months after grant, § 2,910.

Unless payment of the applicable maintenance fee is received in the Patent and Trademark Office on or before the date the fee is due or within a grace period of 6 months thereafter, the patent will expire as of the end of such grace period. The Director may require the payment of a surcharge as a condition of accepting within such 6-month grace period the payment of an applicable maintenance fee. No fee may be established for maintaining a design or plant patent in force.

**(a) General fees.**—The Director shall charge the following fees:

**(1) Filing and basic national fees.**—

**(A)** On filing each application for an original patent, except for design, plant, or provisional applications, §330.

**(B)** On filing each application for an original design patent, §220.

**(C)** On filing each application for an original plant patent, §220.

**(D)** On filing each provisional application for an original patent, §220.

**(E)** On filing each application for the reissue of a patent, §330.

**(F)** The basic national fee for each international application filed under the treaty defined in section 351(a) entering the national stage under section 371, §330.

**(G)** In addition, excluding any sequence listing or computer program listing filed in an electronic medium as prescribed by the Director, for any application the specification and drawings of which exceed 100 sheets of paper (or equivalent as prescribed by the Director if filed in an electronic medium), \$270 for each additional 50 sheets of paper (or equivalent as prescribed by the Director if filed in an electronic medium) or fraction thereof.

**(2) Excess claims fees.**—

**(A) In general.**—In addition to the fee specified in paragraph (1)—

**(i)** on filing or on presentation at any other time, \$220 for each claim in independent form in excess of 3;

**(ii)** on filing or on presentation at any other time, \$52 for each claim (whether dependent or independent) in excess of 20; and

**(iii)** for each application containing a multiple dependent claim, §390.

**(B) Multiple dependent claims.**—For the purpose of computing fees under subparagraph (A), a multiple dependent claim referred to in section 112 or any claim depending therefrom shall be considered as separate dependent claims in accordance with the number of claims to which reference is made.

**(C) Refunds; errors in payment.**—The Director may by regulation provide for a refund of any part of the fee specified in subparagraph (A) for any claim that is canceled before an examination on the merits, as prescribed by the Director, has been made of the application under section 131. Errors in payment of the additional fees under this paragraph may be rectified in accordance with regulations prescribed by the Director.

**(3) Examination fees.**—

**(A) In general.**—

**(i)** For examination of each application for an original patent, except for design, plant, provisional, or international applications, \$220.

**(ii)** For examination of each application for an original design patent, \$140.

**(iii)** For examination of each application for an original plant patent, \$170.

**(iv)** For examination of the national stage of each international application, \$220.

**(v)** For examination of each application for the reissue of a patent, \$650.

**(B) Applicability of other fee provisions.**—The provisions of paragraphs (3) and (4) of section 111(a) relating to the payment of the fee for filing the application shall apply to the payment of the fee specified in subparagraph (A) with respect to an application filed under section 111(a). The provisions of section 371(d) relating to the payment of the national fee shall apply to the payment of the fee specified in subparagraph (A) with respect to an international application.

**(4) Issue fees.**—

**(A)** For issuing each original patent, except for design or plant patents, \$1,510.

**(B)** For issuing each original design patent, \$860.

**(C)** For issuing each original plant patent, \$1,190.

**(D)** For issuing each reissue patent, \$1,510.

**(5) Disclaimer fee.**—On filing each disclaimer, \$140.

**(6) Appeal fees.**—

**(A)** On filing an appeal from the examiner to the Patent Trial and Appeal Board, \$540.

**(B)** In addition, on filing a brief in support of the appeal, \$540, and on requesting an oral hearing in the appeal before the Patent Trial and Appeal Board, \$1,080.

~~**(7) Revival fees.**—On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, \$1,620, unless the petition is filed under section 133 or 151, in which case the fee shall be \$540.~~

**(7) Revival Fees.**—On filing each petition for the revival of an abandoned application for a patent, for the delayed payment of the fee for issuing each patent, for the delayed response by the patent owner in any reexamination proceeding, for the delayed payment of the fee for maintaining a patent in force, for the delayed submission of a priority or benefit claim, or for the extension of the 12-month period for filing a subsequent application, \$1,700.00. The Director may refund any part of the fee specified in this paragraph, in exceptional circumstances as determined by the Director[.]

**(8) Extension fees.**—For petitions for 1-month extensions of time to take actions required by the Director in an application—

**(A)** on filing a first petition, \$130;

(B) on filing a second petition, \$360; and

(C) on filing a third or subsequent petition, \$620.

**(b) Maintenance fees.—**

**(1) In general.**—The Director shall charge the following fees for maintaining in force all patents based on applications filed on or after December 12, 1980:

(A) Three years and 6 months after grant, \$980.

(B) Seven years and 6 months after grant, \$2,480.

(C) Eleven years and 6 months after grant, \$4,110.

**(2) Grace period; surcharge.**—Unless payment of the applicable maintenance fee under paragraph (1) is received in the Office on or before the date the fee is due or within a grace period of 6 months thereafter, the patent shall expire as of the end of such grace period. The Director may require the payment of a surcharge as a condition of accepting within such 6-month grace period the payment of an applicable maintenance fee.

**(3) No maintenance fee for design or plant patent.**—No fee may be established for maintaining a design or plant patent in force.

**(c)(1) The Director**

**(c) Delays in payment of maintenance fees.—**

~~**(1) Acceptance.**—The Director may accept the payment of any maintenance fee required by subsection (b) of this section which is made within twenty-four months after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable. The Director may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-month grace period. If the Director accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.~~

**(1) Acceptance.**—The Director may accept the payment of any maintenance fee required by subsection (b) after the 6-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional. The Director may require the payment of the fee specified in subsection (a)(7) as a condition of accepting payment of any maintenance fee after the 6-month grace period. If the Director accepts payment of a maintenance fee after the 6-month grace period, the patent shall be considered as not having expired at the end of the grace period.

~~**(2) A patent**~~ **(2) Effect on rights of others.**—A patent, the term of which has been maintained as a result of the acceptance of a payment of a maintenance fee under this subsection, shall not abridge or affect the right of any person or that person's successors in business who made, purchased, offered to sell, or used anything protected by the patent within the United States, or imported anything protected by the patent into the United States after the 6-month grace period but prior to the acceptance of a maintenance fee under this subsection, to continue the use of, to offer for sale, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported. The court before which such matter is in question may provide for the continued manufacture, use, offer for sale, or sale of the thing made, purchased, offered for sale, or used within the United States, or imported into the United States, as specified, or for the manufacture, use, offer for sale, or sale in the United States of which substantial preparation was made after the 6-month grace period but before the acceptance of a maintenance fee under this subsection, and the court may also provide for the continued practice of any process that is practiced, or for the practice of which substantial preparation was made, after the 6-month grace period but before the

acceptance of a maintenance fee under this subsection, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced after the 6-month grace period but before the acceptance of a maintenance fee under this subsection.

**(d)** The Director shall establish fees for all other processing, services, or materials relating to patents not specified in this section to recover the estimated average cost to the Office of such processing, services, or materials, except that the Director shall charge the following fees for the following services:

- (1)** For recording a document affecting title, \$ 40 per property.
- (2)** For each photocopy, \$.25 per page.
- (3)** For each black and white copy of a patent, \$ 3.

The yearly fee for providing a library specified in section 13 of this title [35 USC § 13] with uncertified printed copies of the specifications and drawings for all patents in that year shall be \$ 50.

**(d) Patent Search and Other Fees.—**

**(1) Patent search fees.—**

**(A) In general.—**The Director shall charge the fees specified under subparagraph (B) for the search of each application for a patent, except for provisional applications. The Director shall adjust the fees charged under this paragraph to ensure that the fees recover an amount not to exceed the estimated average cost to the Office of searching applications for patent by Office personnel.

**(B) Specific fees.—**The fees referred to in subparagraph (A) are—

- (i)** \$540 for each application for an original patent, except for design, plant, provisional, or international applications;
- (ii)** \$100 for each application for an original design patent;
- (iii)** \$330 for each application for an original plant patent;
- (iv)** \$540 for the national stage of each international application; and
- (v)** \$540 for each application for the reissue of a patent.

**(C) Applicability of other provisions.—**The provisions of paragraphs (3) and (4) of section 111(a) relating to the payment of the fee for filing the application shall apply to the payment of the fee specified in this paragraph with respect to an application filed under section 111(a). The provisions of section 371(d) relating to the payment of the national fee shall apply to the payment of the fee specified in this paragraph with respect to an international application.

**(D) Refunds.—**The Director may by regulation provide for a refund of any part of the fee specified in this paragraph for any applicant who files a written declaration of express abandonment as prescribed by the Director before an examination has been made of the application under section 131.

**(2) Other fees.—**

**(A) In general.—**The Director shall establish fees for all other processing, services, or materials relating to patents not specified in this section to recover the estimated average cost to the Office of such processing, services, or materials, except that the Director shall charge the following fees for the following services:

- (i)** For recording a document affecting title, \$40 per property.
- (ii)** For each photocopy, \$.25 per page.
- (iii)** For each black and white copy of a patent, \$3.

**(B) Copies for libraries.—**The yearly fee for providing a library specified in section 12 with uncertified printed copies of the specifications and drawings for all patents in that year shall be \$50.

**(e) The Director Waiver of fees; copies regarding notice.—**The Director

may waive the payment of any fee for any service or material related to patents in connection with an occasional or incidental request made by a department or agency of the Government, or any officer thereof. The Director may provide any applicant issued a notice under section 132 of this title [35 USC § 132] with a copy of the specifications and drawings for all patents referred to in that notice without charge.

**(f) The fees Adjustment of fees.**—The fees established in subsections (a) and (b) of this section may be adjusted by the Director on October 1, 1992, and every year thereafter, to reflect any fluctuations occurring during the previous 12 months in the Consumer Price Index, as determined by the Secretary of Labor. Changes of less than 1 per centum may be ignored.

~~**(g) No fee established by the Director under this section shall take effect until at least 30 days after notice of the fee has been published in the Federal Register and in the Official Gazette of the Patent and Trademark Office.**~~

~~**(h)(1) Fees charged under subsection (a) or (b) shall be reduced by 50 percent with respect to their application to any small business concern as defined under section 3 of the Small Business Act, and to any independent inventor or nonprofit organization as defined in regulations issued by the Director.**~~

~~**(2) With respect to its application to any entity described in paragraph (1), any surcharge or fee charged under subsection (c) or (d) shall not be higher than the surcharge or fee required of any other entity under the same or substantially similar circumstances.**~~

**(h) Fees for small entities.**—

**(1) Reductions in fees.**—Subject to paragraph (3), fees charged under subsections (a), (b), and (d)(1) shall be reduced by 50 percent with respect to their application to any small business concern as defined under section 3 of the Small Business Act, and to any independent inventor or nonprofit organization as defined in regulations issued by the Director.

**(2) Surcharges and other fees.**—With respect to its application to any entity described in paragraph (1), any surcharge or fee charged under subsection (c) or (d) shall not be higher than the surcharge or fee required of any other entity under the same or substantially similar circumstances.

**(3) Reduction for electronic filing.**—The fee charged under subsection (a) (1)(A) shall be reduced by 75 percent with respect to its application to any entity to which paragraph (1) applies, if the application is filed by electronic means as prescribed by the Director.

~~**(i)(1) The Director (i) Electronic patent and trademark data.**~~

**(1) Maintenance of collections.**—The Director shall maintain, for use by the public, paper, microform, or electronic collections of United States patents, foreign patent documents, and United States trademark registrations arranged to permit search for and retrieval of information. The Director may not impose fees directly for the use of such collections, or for the use of the public patent or trademark search rooms or libraries.

~~**(2) The Director (2) Availability of automated search systems.**~~—The Director shall provide for the full deployment of the automated search systems of the Patent and Trademark Office so that such systems are available for use by the public, and shall assure full access by the public to, and dissemination of, patent and trademark information, using a variety of automated methods, including electronic bulletin boards and remote access by users to mass storage and retrieval systems.

~~**(3) The Director (3) Access fees.**~~—The Director may establish reasonable fees for access by the public to the automated search systems of the Patent and Trade-

mark Office. If such fees are established, a limited amount of free access shall be made available to users of the systems for purposes of education and training. The Director may waive the payment by an individual of fees authorized by this subsection upon a showing of need or hardship, and if such a waiver is in the public interest.

**(4) The Director (4) Annual report to congress.**—The Director shall submit to the Congress an annual report on the automated search systems of the Patent and Trademark Office and the access by the public to such systems. The Director shall also publish such report in the Federal Register. The Director shall provide an opportunity for the submission of comments by interested persons on each such report.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 796; July 24, 1965, P.L. 89-83, §§ 1, 2, 79 Stat. 259; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Nov. 14, 1975, P.L. 94-131, § 3, 89 Stat. 690; Dec. 12, 1980, P.L. 96-517, § 2, 94 Stat. 3017; Aug. 27, 1982, P.L. 97-247, § 3(a)-(e), 96 Stat. 317; Sept. 8, 1982, P.L. 97-256, Title I, § 101(1)-(4), 96 Stat. 816; Nov. 8, 1984, P.L. 98-622, Title II, § 204(a), 98 Stat. 3388; Nov. 6, 1986, P.L. 99-607, § 1(b)(2), 100 Stat. 3470; Dec. 10, 1991, P.L. 102-204, § 5(a)-(c)(1), (d)(1), (2)(A), 105 Stat. 1637–1639; Oct. 23, 1992, P.L. 102-444, § 1, 106 Stat. 2245; Dec. 8, 1994, P.L. 103-465, Title V, Subtitle C, §§ 532(b)(2), 533(b)(1), 108 Stat. 4986, 4988; Nov. 10, 1998, P.L. 105-358, § 3, 112 Stat. 3272; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, §§ 11(a), (b)(1)-(2), (c), (d), (e)(1)-(3), (4)(A)-(D); 20(j)(1); Patent Law Treaties Implementation Act of 2012, P.L. 112-211, § 202(b)(1)(A)-(B).)

## § 42. Patent and Trademark Office funding

**(a)** All fees for services performed by or materials furnished by the Patent and Trademark Office will be payable to the Director.

**(b)** All fees paid to the Director and all appropriations for defraying the costs of the activities of the Patent and Trademark Office will be credited to the Patent and Trademark Office Appropriation Account in the Treasury of the United States.

**(c) (1)** ~~To the extent and in the amounts provided in advance in appropriations Acts, fees authorized in this title or any other Act to be charged or established by the Director shall be collected by and shall be available shall, subject to paragraph (3), be available to the Director to carry out the activities of the Patent and Trademark Office. All fees available to the Director under section 31 of the Trademark Act of 1946 [15 USC § 1113] shall be used only for the processing of trademark registrations and for other activities, services, and materials relating to trademarks and to cover a proportionate share of the administrative costs of the Patent and Trademark Office.~~

**(2)** There is established in the Treasury a Patent and Trademark Fee Reserve Fund. If fee collections by the Patent and Trademark Office for a fiscal year exceed the amount appropriated to the Office for that fiscal year, fees collected in excess of the appropriated amount shall be deposited in the Patent and Trademark Fee Reserve Fund. To the extent and in the amounts provided in appropriations Acts, amounts in the Fund shall be made available until expended only for obligation and expenditure by the Office in accordance with paragraph (3).

**(3) (A)** Any fees that are collected under sections 41, 42, and 376, this title, and any surcharges on such fees, may only be used for expenses of the Office relating to the processing of patent applications and for other activities, services, and materials relating to patents and to cover a share of the administrative costs of the Office relating to patents a proportionate share of the administrative costs of the Office.

**(B)** Any fees that are collected under section 31 of the Trademark Act of 1946, and any surcharges on such fees, may only be used for expenses of the Office relating to the processing of trademark registrations and for other activities, services,

and materials relating to trademarks and to cover a share of the administrative costs of the Office relating to trademarks a proportionate share of the administrative costs of the Office.

(d) The Director may refund any fee paid by mistake or any amount paid in excess of that required.

(e) The Secretary of Commerce shall, on the day each year on which the President submits the annual budget to the Congress, provide to the Committees on the Judiciary of the Senate and the House of Representatives—

(1) a list of patent and trademark fee collections by the Patent and Trademark Office during the preceding fiscal year;

(2) a list of activities of the Patent and Trademark Office during the preceding fiscal year which were supported by patent fee expenditures, trademark fee expenditures, and appropriations;

(3) budget plans for significant programs, projects, and activities of the Office, including out-year funding estimates;

(4) any proposed disposition of surplus fees by the Office; and

(5) such other information as the committees consider necessary.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 796; Nov. 14, 1975, P.L. 94-131, § 4, 89 Stat. 690; Dec. 12, 1980, P.L. 96-517, § 3, 94 Stat. 3018; Aug. 27, 1982, P.L. 97-247, § 3(g), 96 Stat. 319; Sept. 13, 1982, P.L. 97-258, § 3(i), 96 Stat. 1065; Dec. 10, 1991, P.L. 102-204, §§ 4, 5(e), 105 Stat. 1637, 1640; Nov. 10, 1998, P.L. 105-358, § 4, 112 Stat. 3274; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, § 22(a)(1)-(4); Leahy-Smith America Invents Technical Corrections Act, P.L. 112-274, § 1(j)(1)(A)-(B), (2).)

## PART II. PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

### CHAPTER 10. PATENTABILITY OF INVENTIONS

#### § 100. Definitions

When used in this title [35 USC §§ 1 et seq.] unless the context otherwise indicates—

(a) The term “invention” means invention or discovery.

(b) The term “process” means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(c) The terms “United States” and “this country” mean the United States of America, its territories and possessions.

(d) The word “patentee” includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

(e) The term “third-party requester” means a person requesting ex parte reexamination under section 302 [35 USC § 302] ~~or inter partes reexamination under section 311~~ [35 USC § 311] who is not the patent owner.

(f) The term “inventor” means the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.

(g) The terms “joint inventor” and “coinventor” mean any 1 of the individuals who invented or discovered the subject matter of a joint invention.

(h) The term “joint research agreement” means a written contract, grant, or cooperative agreement entered into by 2 or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

**(i)(1)** The term “effective filing date” for a claimed invention in a patent or application for patent means—

**(A)** if subparagraph (B) does not apply, the actual filing date of the patent or the application for the patent containing a claim to the invention; or

**(B)** the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority under section 119, 365(a), or 365(b) or to the benefit of an earlier filing date under section 120, 121, or 365(e) right of priority under section 119, 365(a), 365(b), 386(a), or 386(b) or to the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c).

**(2)** The effective filing date for a claimed invention in an application for reissue or reissued patent shall be determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought.

**(j)** The term “claimed invention” means the subject matter defined by a claim in a patent or an application for a patent.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 797; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, § 3(a)(1)-(2); Patent Law Treaties Implementation Act of 2012, P.L. 112-211, § 102(1).)

## § 101. Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title [35 USC §§ 1 et seq.].

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 797.)

## § 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

**(a)** the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

**(b)** the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

**(c)** he has abandoned the invention, or

**(d)** the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

**(e)** the invention was described in (1) an application for patent, published under section 122(b) [35 USC § 122(b)], by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) [35 USC § 351(a)] shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or

**(f)** he did not himself invent the subject matter sought to be patented, or

(g) (1) during the course of an interference conducted under section 135 [35 USC § 135] or section 291 [35 USC § 291], another inventor involved therein establishes, to the extent permitted in section 104 [35 USC § 104], that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

## **§ 102. Conditions for patentability; novelty**

(a) Novelty; Prior Art.—A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) Exceptions.—

(1) Disclosures made 1 year or less before the effective filing date of the claimed invention.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(2) Disclosures appearing in applications and patents.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) 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.

(c) Common Ownership Under Joint Research Agreements.—Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if—

(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;

(2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(d) Patents and Published Applications Effective as Prior Art.—For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application—

(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or

(2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), or 365(b), or to claim the benefit of an earlier filing date under section 120, 121, or 365(c) to claim a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b), or to claim the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 797; July 28, 1972, P.L. 92-358, § 2, 86 Stat. 502; Nov. 14, 1975, P.L. 94-131, § 5, 89 Stat. 691; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a) (9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13205(1), 116 Stat. 1902.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, § 3(b)(1); Patent Law Treaties Implementation Act of 2012, P.L. 112-211, § 102(2).)

## **~~§ 103. Conditions for patentability; non-obvious subject matter~~**

~~(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title [35 USC § 102], if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.~~

~~(b)(1) Notwithstanding subsection (a), and upon timely election by the applicant for patent to proceed under this subsection, a biotechnological process using or resulting in a composition of matter that is novel under section 102 [35 USC § 102] and nonobvious under subsection (a) of this section shall be considered nonobvious if—~~

~~(A) claims to the process and the composition of matter are contained in either the same application for patent or in separate applications having the same effective filing date; and~~

~~(B) the composition of matter, and the process at the time it was invented, were owned by the same person or subject to an obligation of assignment to the same person.~~

~~(2) A patent issued on a process under paragraph (1)—~~

~~(A) shall also contain the claims to the composition of matter used in or made by that process, or~~

~~(B) shall, if such composition of matter is claimed in another patent, be set to expire on the same date as such other patent, notwithstanding section 154 [35 USC § 154].~~

~~(3) For purposes of paragraph (1), the term “biotechnological process” means—~~

~~(A) a process of genetically altering or otherwise inducing a single- or multi-celled organism to—~~

~~(i) express an exogenous nucleotide sequence;~~

# 35 USC § 103 ~~Sample Pages~~

~~(ii) inhibit, eliminate, augment, or alter expression of an endogenous nucleotide sequence, or~~

~~(iii) express a specific physiological characteristic not naturally associated with said organism;~~

~~(B) cell fusion procedures yielding a cell line that expresses a specific protein, such as a monoclonal antibody; and~~

~~(C) a method of using a product produced by a process defined by subparagraph (A) or (B), or a combination of subparagraphs (A) and (B).~~

~~(e)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title [35 USC § 102], shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.~~

~~(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if—~~

~~(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;~~

~~(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and~~

~~(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.~~

~~(3) For purposes of paragraph (2), the term “joint research agreement” means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.~~

## § 103. Conditions for patentability; non-obvious subject matter

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 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. Patentability shall not be negated by the manner in which the invention was made.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 798; Nov. 8, 1984, P.L. 98-622, Title I, § 103, 98 Stat. 3384; Nov. 1, 1995, P.L. 104-41, § 1, 109 Stat. 351; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Dec. 10, 2004, P.L. 108-453, § 2, 118 Stat. 3596.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, § 3(c).)

## § 104. Invention made abroad

~~(a) In general.~~

~~(1) Proceedings.~~ In proceedings in the Patent and Trademark Office, in the courts, and before any other competent authority, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country other than a NAFTA country or a WTO member country, except as provided in sections 119 and 365 of this title [35 USC §§ 119 and 365].

~~(2) Rights.~~ If an invention was made by a person, civil or military—

(A) while domiciled in the United States, and serving in any other country in connection with operations by or on behalf of the United States;

(B) while domiciled in a NAFTA country and serving in another country in connection with operations by or on behalf of that NAFTA country, or

(C) while domiciled in a WTO member country and serving in another country in connection with operations by or on behalf of that WTO member country; that person shall be entitled to the same rights of priority in the United States with respect to such invention as if such invention had been made in the United States, that NAFTA country, or that WTO member country, as the case may be.

**(3) Use of information.** To the extent that any information in a NAFTA country or a WTO member country concerning knowledge, use, or other activity relevant to proving or disproving a date of invention has not been made available for use in a proceeding in the Patent and Trademark Office, a court, or any other competent authority to the same extent as such information could be made available in the United States, the Director, court, or such other authority shall draw appropriate inferences, or take other action permitted by statute, rule, or regulation, in favor of the party that requested the information in the proceeding.

**(b) Definitions.** As used in this section—

(1) the term “NAFTA country” has the meaning given that term in section 2(4) of the North American Free Trade Agreement Implementation Act [19 USC § 3301(4)]; and

(2) the term “WTO member country” has the meaning given that term in section 2(10) of the Uruguay Round Agreements Act [19 USC § 3501(10)].

HISTORY: (July 19 1952, ch 950, § 1, 66 Stat. 798; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Nov. 14, 1975, P.L. 94-131, § 6, 89 Stat. 691; Nov. 8, 1984, P.L. 98-622, Title IV, § 403(a), 98 Stat. 3392; Dec. 8, 1993, P.L. 103-182, Title III, Subtitle C, § 331, 107 Stat. 2113; Dec. 8, 1994, P.L. 103-465, Title V, Subtitle C, § 531(a), 108 Stat. 4982; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, § 3(d).)

## § 105. Inventions in outer space

(a) Any invention made, used or sold in outer space on a space object or component thereof under the jurisdiction or control of the United States shall be considered to be made, used or sold within the United States for the purposes of this title, except with respect to any space object or component thereof that is specifically identified and otherwise provided for by an international agreement to which the United States is a party, or with respect to any space object or component thereof that is carried on the registry of a foreign state in accordance with the Convention on Registration of Objects Launched into Outer Space.

(b) Any invention made, used or sold in outer space on a space object or component thereof that is carried on the registry of a foreign state in accordance with the Convention on Registration of Objects Launched into Outer Space, shall be considered to be made, used or sold within the United States for the purposes of this title if specifically so agreed in an international agreement between the United States and the state of registry.

HISTORY: (Added Nov. 15, 1990, P.L. 101-580, § 1(a), 104 Stat. 2863.)

## CHAPTER 11. APPLICATION FOR PATENT

### § 111. Application

(a) In general.

(1) **Written application.** An application for patent shall be made, or autho-

ized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.

(2) **Contents.** Such application shall include—

(A) a specification as prescribed by section 112 of this title [35 USC § 112];

(B) a drawing as prescribed by section 113 of this title [35 USC § 113]; and

(C) an oath by the applicant or declaration as prescribed by section 115 of this title [35 USC § 115].

~~(3) **Fee and oath or declaration.** The application must be accompanied by the fee required by law. The fee and oath or declaration may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.~~

~~(4) **Failure to submit.** Upon failure to submit the fee and oath or declaration within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath or declaration was unavoidable or unintentional. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.~~

~~(3) **Fee, Oath or Declaration, and Claims.**—The application shall be accompanied by the fee required by law. The fee, oath or declaration, and 1 or more claims may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the fee, oath or declaration, and 1 or more claims within such prescribed period, the application shall be regarded as abandoned.~~

~~(4) **Filing Date.**—The filing date of an application shall be the date on which a specification, with or without claims, is received in the United States Patent and Trademark Office.~~

**(b) Provisional application.**

(1) **Authorization.** A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Director. Such application shall include—

(A) a specification as prescribed by the first paragraph of section 112 of this title [35 USC § 112] section 112(a); and

(B) a drawing as prescribed by section 113 of this title [35 USC § 113].

(2) **Claim.** A claim, as required by the second through fifth paragraphs of section 112 [35 USC § 112], subsections (b) through (e) of section 112, shall not be required in a provisional application.

~~(3) **Fee.**~~

~~(A) The application must be accompanied by the fee required by law.~~

~~(B) The fee may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.~~

~~(C) Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee was unavoidable or unintentional.~~

~~(4) **Filing date.** The filing date of a provisional application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.~~

~~(3) **Fee.**—The application shall be accompanied by the fee required by law. The fee may be submitted after the filing date of the application, within such period and~~

under such conditions, including the payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned.

**(4) Filing Date.**—The filing date of a provisional application shall be the date on which a specification, with or without claims, is received in the United States Patent and Trademark Office.

**(5) Abandonment.** Notwithstanding the absence of a claim, upon timely request and as prescribed by the Director, a provisional application may be treated as an application filed under subsection (a). Subject to section 119(e)(3) of this title [35 USC § 119(e)(3)], if no such request is made, the provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival after such 12-month period.

**(6) Other basis for provisional application.** Subject to all the conditions in this subsection and section 119(e) of this title [35 USC § 119(e)], and as prescribed by the Director, an application for patent filed under subsection (a) may be treated as a provisional application for patent.

**(7) No right of priority or benefit of earliest filing date.** A provisional application shall not be entitled to the right of priority of any other application under ~~section 119 or 365(a)~~ section 119, 365(a), or 386(a) of this title [35 USC § 119 or 365(a)] or to the benefit of an earlier filing date in the United States under ~~section 120, 121, or 365(e)~~ section 120, 121, 365(c), or 386(c) of this title [35 USC § 120, 121, or 365(c)].

**(8) Applicable provisions.** The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to ~~sections 115, 131, 135, and 157~~ sections 131 and 135 of this title.

**(c) Prior Filed Application.**—Notwithstanding the provisions of subsection (a), the Director may prescribe the conditions, including the payment of a surcharge, under which a reference made upon the filing of an application under subsection (a) to a previously filed application, specifying the previously filed application by application number and the intellectual property authority or country in which the application was filed, shall constitute the specification and any drawings of the subsequent application for purposes of a filing date. A copy of the specification and any drawings of the previously filed application shall be submitted within such period and under such conditions as may be prescribed by the Director. A failure to submit the copy of the specification and any drawings of the previously filed application within the prescribed period shall result in the application being regarded as abandoned. Such application shall be treated as having never been filed, unless—

(1) the application is revived under section 27; and

(2) a copy of the specification and any drawings of the previously filed application are submitted to the Director.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 798; Aug. 27, 1982, P.L. 97-247, § 5, 96 Stat. 319; Dec. 8, 1994, P.L. 103-465, Title V, Subtitle C, § 532(b)(3), 108 Stat. 4986; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, §§ 3(e)(2); 4(a)(3)(A)-(C), (d)(1)-(2); 20(j)(1); Patent Law Treaties Implementation Act of 2012, P.L. 112-211, § 102(3)(A)-(B), § 201(a)(1)-(3).)

## § 112. Specification

The specification **(a) In General.**—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in

such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention or joint inventor of carrying out the invention.

The specification **(b) Conclusion.**—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention—inventor or a joint inventor regards as the invention.

A claim **(c) Form.**—A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, **(d) Reference in Dependent Forms.**—Subject to subsection (e), a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim **(e) Reference in Multiple Dependent Form.**—A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element **(f) Element in Claim for a Combination.**—An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 798; July 24, 1965, P.L. 89-83, § 9, 79 Stat. 261; Nov. 14, 1975, P.L. 94-131, § 7, 89 Stat. 691.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, §§ 4(c)(1)(A)-(B), 2(A)-(B), (3)-(6).)

## § 113. Drawings

The applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented. When the nature of such subject matter admits of illustration by a drawing and the applicant has not furnished such a drawing, the Director may require its submission within a time period of not less than two months from the sending of a notice thereof. Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 799; Nov. 14, 1975, P.L. 94-131, § 8, 89 Stat. 691; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

## § 114. Models, specimens

The Director may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Director may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 799; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b) (1)(B), 116 Stat. 1906.)

## **§ 115. Oath of applicant**

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States, and such oath is valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him. For purposes of this section, a consular officer shall include any United States citizen serving overseas, authorized to perform notarial functions pursuant to section 1750 of the Revised Statutes, as amended (22 U.S.C. 4221).

## **§ 115. Inventor's oath or declaration**

**(a) Naming the Inventor; Inventor's Oath or Declaration.**—An application for patent that is filed under section 111(a) or commences the national stage under section 371 shall include, or be amended to include, the name of the inventor for any invention claimed in the application. Except as otherwise provided in this section, each individual who is the inventor or a joint inventor of a claimed invention in an application for patent shall execute an oath or declaration in connection with the application.

**(b) Required Statements.**—An oath or declaration under subsection (a) shall contain statements that—

**(1)** the application was made or was authorized to be made by the affiant or declarant; and

**(2)** such individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.

**(c) Additional Requirements.**—The Director may specify additional information relating to the inventor and the invention that is required to be included in an oath or declaration under subsection (a).

**(d) Substitute Statement.**—

**(1) In general.**—In lieu of executing an oath or declaration under subsection (a), the applicant for patent may provide a substitute statement under the circumstances described in paragraph (2) and such additional circumstances that the Director may specify by regulation.

**(2) Permitted circumstances.**—A substitute statement under paragraph (1) is permitted with respect to any individual who—

**(A)** is unable to file the oath or declaration under subsection (a) because the individual—

**(i)** is deceased;

**(ii)** is under legal incapacity; or

**(iii)** cannot be found or reached after diligent effort; or

(B) is under an obligation to assign the invention but has refused to make the oath or declaration required under subsection (a).

(3) Contents.—A substitute statement under this subsection shall—

(A) identify the individual with respect to whom the statement applies;

(B) set forth the circumstances representing the permitted basis for the filing of the substitute statement in lieu of the oath or declaration under subsection (a); and

(C) contain any additional information, including any showing, required by the Director.

(e) Making Required Statements in Assignment of Record.—An individual who is under an obligation of assignment of an application for patent may include the required statements under subsections (b) and (c) in the assignment executed by the individual, in lieu of filing such statements separately.

(f) Time for Filing.—A notice of allowance under section 151 may be provided to an applicant for patent only if the applicant for patent has filed each required oath or declaration under subsection (a) or has filed a substitute statement under subsection (d) or recorded an assignment meeting the requirements of subsection (e).

(f) Time for Filing.—The applicant for patent shall provide each required oath or declaration under subsection (a), substitute statement under subsection (d), or recorded assignment meeting the requirements of subsection (e) no later than the date on which the issue fee for the patent is paid.

(g) Earlier-Filed Application Containing Required Statements or Substitute Statement.—

(1) Exception.—The requirements under this section shall not apply to an individual with respect to an application for patent in which the individual is named as the inventor or a joint inventor and who claims that claims the benefit under section 120, 121, or 365(c) section 120, 121, 365(c), or 386(c) of the filing of an earlier-filed application, if—

(A) an oath or declaration meeting the requirements of subsection (a) was executed by the individual and was filed in connection with the earlier-filed application;

(B) a substitute statement meeting the requirements of subsection (d) was filed in connection with the earlier filed application with respect to the individual; or

(C) an assignment meeting the requirements of subsection (e) was executed with respect to the earlier-filed application by the individual and was recorded in connection with the earlier-filed application.

(2) Copies of oaths, declarations, statements, or assignments.—Notwithstanding paragraph (1), the Director may require that a copy of the executed oath or declaration, the substitute statement, or the assignment filed in connection with the earlier-filed application be included in the later-filed application.

(h) Supplemental and Corrected Statements; Filing Additional Statements.—

(1) In general.—Any person making a statement required under this section may withdraw, replace, or otherwise correct the statement at any time. If a change is made in the naming of the inventor requiring the filing of 1 or more additional statements under this section, the Director shall establish regulations under which such additional statements may be filed.

(2) Supplemental statements not required.—If an individual has executed an oath or declaration meeting the requirements of subsection (a) or an assignment meeting the requirements of subsection (e) with respect to an appli-

cation for patent, the Director may not thereafter require that individual to make any additional oath, declaration, or other statement equivalent to those required by this section in connection with the application for patent or any patent issuing thereon.

**(3) Savings clause.**—A patent shall not be invalid or unenforceable based upon the failure to comply with a requirement under this section if the failure is remedied as provided under paragraph (1).

**(1) Acknowledgment of Penalties.**—Any declaration or statement filed pursuant to this section shall contain an acknowledgment that any willful false statement made in such declaration or statement is punishable under section 1001 of title 18 by fine or imprisonment of not more than 5 years, or both.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 799; Aug. 27, 1982, P.L. 97-247, § 14(a), 96 Stat. 321; Oct. 21, 1998, P.L. 105-277, Div G, Title XXII, Ch 2, § 2222(d), 112 Stat. 2681-818.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, § 4(a)(1); Patent Law Treaties Implementation Act of 2012, P.L. 112-211, § 102(4); Leahy-Smith America Invents Technical Corrections Act, P.L. 112-274, § 1(f)(1)-(2).)

## § 116. Inventors

**When (a) Joint Inventions.**—When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

~~If a joint inventor~~ **(b) Omitted Inventor.**—~~If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Director, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.~~

**Whenever (c) Correction of Errors in Application.**—~~Whenever through error a person is named in an application for patent as the inventor, or through error an inventor is not named in an application, and such error arose without any deceptive intention on his part, the Director may permit the application to be amended accordingly, under such terms as he prescribes.~~

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 799; Aug. 27, 1982, P.L. 97-247, § 6(a), 96 Stat. 320; Nov. 8, 1984, P.L. 98-622, Title I, § 104(a), 98 Stat. 3384; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, §§ 20(a)(1), (2), (3) (A)-(B).)

## § 117. Death or incapacity of inventor

Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

## § 118. Filing by other than inventor

~~Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent~~

on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Director may grant a patent to such inventor upon such notice to him as the Director deems sufficient, and on compliance with such regulations as he prescribes.

A person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent. A person who otherwise shows sufficient proprietary interest in the matter may make an application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties. If the Director grants a patent on an application filed under this section by a person other than the inventor, the patent shall be granted to the real party in interest and upon such notice to the inventor as the Director considers to be sufficient.

HISTORY: (Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, § 4(b)(1).)

### **§ 119. Benefit of earlier filing date; right of priority**

(a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within ~~twelve~~ 12 months from the earliest date on which such foreign application was filed; ~~but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing. The Director may prescribe regulations, including the requirement for payment of the fee specified in section 41(a)(7), pursuant to which the 12-month period set forth in this subsection may be extended by an additional 2 months if the delay in filing the application in this country within the 12-month period was unintentional.~~

(b)(1) No application for patent shall be entitled to this right of priority unless a claim is filed in the Patent and Trademark Office, identifying the foreign application by specifying the application number on that foreign application, the intellectual property authority or country in or for which the application was filed, and the date of filing the application, at such time during the pendency of the application as required by the Director.

(2) The Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim. The Director may establish procedures, including the payment of a surcharge including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed claim under this section.

(3) The Director may require a certified copy of the original foreign application, specification, and drawings upon which it is based, a translation if not in the English language, and such other information as the Director considers necessary. Any such certification shall be made by the foreign intellectual property authority in which the foreign application was filed and show the date of the application and of the filing of the specification and other papers.

(c) In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application

in the same foreign country instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

**(d)** Applications for inventors' certificates filed in a foreign country in which applicants have a right to apply, at their discretion, either for a patent or for an inventor's certificate shall be treated in this country in the same manner and have the same effect for purpose of the right of priority under this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents, provided such applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of such filing.

**(e)(1)** An application for patent filed under section 111(a) or section 363 of this title [35 USC § 111(a) or 363] for an invention disclosed in the manner provided by the first paragraph of section 112 of this title [35 USC § 112] section 112(a) (other than the requirement to disclose the best mode) in a provisional application filed under section 111(b) of this title [35 USC § 111(b)], by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title [35 USC § 111(b)], if the application for patent filed under section 111(a) or section 363 of this title [35 USC § 111(a) or 363] is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. The Director may prescribe regulations, including the requirement for payment of the fee specified in section 41(a)(7), pursuant to which the 12-month period set forth in this subsection may be extended by an additional 2 months if the delay in filing the application under section 111(a) or section 363 within the 12-month period was unintentional. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge including the payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application.

**(2)** A provisional application filed under section 111(b) of this title [35 USC § 111(b)] may not be relied upon in any proceeding in the Patent and Trademark Office unless the fee set forth in subparagraph (A) or (C) of section 41(a)(1) of this title [35 USC § 41(a)(1)] has been paid.

**(3)** If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day. For an application for patent filed under section 363 in a Receiving Office other than the Patent and Trademark Office, the 12-month and additional 2-month period set forth in this subsection shall be extended as provided under the treaty and Regulations as defined in section 351.

**(f)** Applications for plant breeder's rights filed in a WTO member country (or in a foreign UPOV Contracting Party) shall have the same effect for the purpose of the right of priority under subsections (a) through (c) of this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents.

(g) As used in this section—

(1) the term “WTO member country” has the same meaning as the term is defined in section 104(b)(2) of this title [35 USC § 104(b)(2)]; and

(2) the term “UPOV Contracting Party” means a member of the International Convention for the Protection of New Varieties of Plants.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 800; Oct. 3, 1961, P.L. 87-333, § 1, 75 Stat. 748; July 28, 1972, P.L. 92-358, § 1, 86 Stat. 501; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Dec. 8, 1994, P.L. 103-465, Title V, Subtitle C, § 532(b)(1), 108 Stat. 4985; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(2), 116 Stat. 1906.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, §§ 3(g)(6); 15(b); 20(j)(1); Patent Law Treaties Implementation Act of 2012, P.L. 112-211, § 201(c)(1)(A)(i)-(ii), (B)(1)(I)-(II)(aa)-(bb), (ii), § 202(b)(2).)

## § 120. Benefit of earlier filing date in the United States

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title [~~35 USC § 112~~] section 112(a) (other than the requirement to disclose the best mode) in an application previously filed in the United States, or as provided by ~~section 363~~ section 363 or 385 of this title [35 USC § 363], which is filed by an inventor or inventors named ~~which names an inventor or joint inventor~~ in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, ~~including the payment of a surcharge~~ including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed submission of an amendment under this section.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 800; Nov. 14, 1975, P.L. 94-131, § 9, 89 Stat. 691; Nov. 8, 1984, P.L. 98-622, Title I, § 104(b), 98 Stat. 3385; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, §§ 3(f); 15(b); 20(j)(1); Patent Law Treaties Implementation Act of 2012, P.L. 112-211, § 102(5), § 202(b)(3).)

## § 121. Divisional applications

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title [35 USC § 120] it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. ~~If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Director may dispense with signing and execution by the inventor.~~ The validity of a patent shall not

be questioned for failure of the Director to require the application to be restricted to one invention.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 800; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, §§ 4(a)(2); 20(j)(1))

## § 122. Confidential status of applications; publication of patent applications

**(a) Confidentiality.** Except as provided in subsection (b), applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of an Act of Congress or in such special circumstances as may be determined by the Director.

### **(b) Publication.**

#### **(1) In general.**

**(A)** Subject to paragraph (2), each application for a patent shall be published, in accordance with procedures determined by the Director, promptly after the expiration of a period of 18 months from the earliest filing date for which a benefit is sought under this title. At the request of the applicant, an application may be published earlier than the end of such 18-month period.

**(B)** No information concerning published patent applications shall be made available to the public except as the Director determines.

**(C)** Notwithstanding any other provision of law, a determination by the Director to release or not to release information concerning a published patent application shall be final and nonreviewable.

#### **(2) Exceptions.**

**(A)** An application shall not be published if that application is—

**(i)** no longer pending;

**(ii)** subject to a secrecy order under section 181 of this title [35 USC § 181];

**(iii)** a provisional application filed under section 111(b) of this title [35 USC § 111(b)]; or

**(iv)** an application for a design patent filed under chapter 16 of this title [35 USC §§ 171 et seq.].

**(B)(i)** If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

**(ii)** An applicant may rescind a request made under clause (i) at any time.

**(iii)** An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, ~~unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.~~

**(iv)** If an applicant rescinds a request made under clause (i) or notifies the Director that an application was filed in a foreign country or under a multilateral

international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).

(v) If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign filed applications corresponding to an application filed in the Patent and Trademark Office or the description of the invention in such foreign filed applications is less extensive than the application or description of the invention in the application filed in the Patent and Trademark Office, the applicant may submit a redacted copy of the application filed in the Patent and Trademark Office eliminating any part or description of the invention in such application that is not also contained in any of the corresponding applications filed in a foreign country. The Director may only publish the redacted copy of the application unless the redacted copy of the application is not received within 16 months after the earliest effective filing date for which a benefit is sought under this title. The provisions of section 154(d) [35 USC § 154(d)] shall not apply to a claim if the description of the invention published in the redacted application filed under this clause with respect to the claim does not enable a person skilled in the art to make and use the subject matter of the claim.

(c) **Protest and pre-issuance opposition.** The Director shall establish appropriate procedures to ensure that no protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant.

(d) **National security.** No application for patent shall be published under subsection (b)(1) if the publication or disclosure of such invention would be detrimental to the national security. The Director shall establish appropriate procedures to ensure that such applications are promptly identified and the secrecy of such inventions is maintained in accordance with chapter 17 of this title [35 USC §§ 181 et seq.].

**(e) Preissuance Submissions by Third Parties.—**

(1) In general.—Any third party may submit for consideration and inclusion in the record of a patent application, any patent, published patent application, or other printed publication of potential relevance to the examination of the application, if such submission is made in writing before the earlier of—

(A) the date a notice of allowance under section 151 is given or mailed in the application for patent; or

(B) the later of—

(i) 6 months after the date on which the application for patent is first published under section 122 by the Office, or

(ii) the date of the first rejection under section 132 of any claim by the examiner during the examination of the application for patent.

(2) Other requirements.—Any submission under paragraph (1) shall—

(A) set forth a concise description of the asserted relevance of each submitted document;

(B) be accompanied by such fee as the Director may prescribe; and

(C) include a statement by the person making such submission affirming that the submission was made in compliance with this section.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 801; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, §§ 8(a); 20(j)(1); Patent Law Treaties Implementation Act of 2012, P.L. 112-211, § 202(b)(4).)

## **§ 123. Micro entity defined**

**(a) In general.**—For purposes of this title, the term “micro entity” means an applicant who makes a certification that the applicant—

**(1)** qualifies as a small entity, as defined in regulations issued by the Director;

**(2)** has not been named as an inventor on more than 4 previously filed patent applications, other than applications filed in another country, provisional applications under section 111(b), or international applications filed under the treaty defined in section 351(a) for which the basic national fee under section 41(a) was not paid;

**(3)** did not, in the calendar year preceding the calendar year in which the applicable fee is being paid, have a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding 3 times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census; and

**(4)** has not assigned, granted, or conveyed, and is not under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding 3 times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

**(b) Applications Resulting From Prior Employment.**—An applicant is not considered to be named on a previously filed application for purposes of subsection (a)(2) if the applicant has assigned, or is under an obligation by contract or law to assign, all ownership rights in the application as the result of the applicant’s previous employment.

**(c) Foreign Currency Exchange Rate.**—If an applicant’s or entity’s gross income in the preceding calendar year is not in United States dollars, the average currency exchange rate, as reported by the Internal Revenue Service, during that calendar year shall be used to determine whether the applicant’s or entity’s gross income exceeds the threshold specified in paragraphs (3) or (4) of subsection (a).

**(d) Institutions of higher education.**—For purposes of this section, a micro entity shall include an applicant who certifies that—

**(1)** the applicant’s employer, from which the applicant obtains the majority of the applicant’s income, is an institution of higher education as defined in section 101(a) of the Higher Education Act of 1965 (20 U.S.C. 1001(a)); or

**(2)** the applicant has assigned, granted, conveyed, or is under an obligation by contract or law, to assign, grant, or convey, a license or other ownership interest in the particular applications to such an institution of higher education.

**(e) Director’s authority.**—In addition to the limits imposed by this section, the Director may, in the Director’s discretion, impose income limits, annual filing limits, or other limits on who may qualify as a micro entity pursuant to this section if the Director determines that such additional limits are reasonably necessary to avoid an undue impact on other patent applicants or owners or are otherwise reasonably necessary and appropriate. At least 3 months before any limits proposed to be imposed pursuant to this subsection take effect, the Director shall inform the Committee on the Judiciary of the House of Representatives and the Committee on the Judiciary of the Senate of any such proposed limits.

HISTORY: (Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, § 10(g)(1); Leahy-Smith America Invents Technical Corrections Act, P.L. 112-274, § 1(m).)

**CHAPTER 12. EXAMINATION OF APPLICATION**

**§ 131. Examination of application**

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 801; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

**§ 132. Notice of rejection; reexamination**

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

(b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title [35 USC § 41(h)(1)].

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 801; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, § 20(j)(1).)

**§ 133. Time for prosecuting application**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, ~~unless it be shown to the satisfaction of the Director that such delay was unavoidable.~~

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 801; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

(Black Line changes: Patent Law Treaties Implementation Act of 2012, P.L. 112-211, § 202(b)(5).)

**§ 134. Appeal to the Board of Patent Appeals and Interferences**

**§ 134. Appeal to the Patent Trial and Appeal Board**

(a) **Patent applicant.** An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the ~~Board of Patent Appeals and Interferences~~ Patent Trial and Appeal Board, having once paid the fee for such appeal.

(b) **Patent owner.** A patent owner in ~~any reexamination proceeding a reexamination~~ may appeal from the final rejection of any claim by the primary examiner to the ~~Board of Patent Appeals and Interferences~~ Patent Trial and Appeal Board, having once paid the fee for such appeal.

**(c) Third-party.** A third-party requester in an inter partes proceeding may appeal to the Board of Patent Appeals and Interferences Patent Trial and Appeal Board from the final decision of the primary examiner favorable to the patentability of any original or proposed amended or new claim of a patent, having once paid the fee for such appeal.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 801; Nov. 8, 1984, P.L. 98-622, Title II, § 204(b)(1), 98 Stat. 3388; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle A, § 13106(b), Subtitle B, § 13202(b)(1), 116 Stat. 1901.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, §§ 3(j)(1), (3); 7(b)(1), (2).)

## **§ 135. Interferences**

**(a)** Whenever an application is made for a patent which, in the opinion of the Director, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the Director shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability. Any final decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent and Trademark Office of the claims involved, and the Director may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved in the patent, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation by the Patent and Trademark Office.

**(b)(1)** A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

**(2)** A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an application published under section 122(b) of this title [35 USC § 122(b)] may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published.

**(c)** Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent and Trademark Office before the termination of the interference as between the said parties to the agreement or understanding. If any party filing the same so requests, the copy shall be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person on a showing of good cause. Failure to file the copy of such agreement or understanding shall render permanently unenforceable such agreement or understanding and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved. The Director may, however, on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six-month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

The Director shall give notice to the parties or their attorneys of record, a reasonable time prior to said termination, of the filing requirement of this section. If the Director

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gives such notice at a later time, irrespective of the right to file such agreement or understanding within the six-month period on a showing of good cause, the parties may file such agreement or understanding within sixty days of the receipt of such notice.

Any discretionary action of the Director under this subsection shall be reviewable under section 10 of the Administrative Procedure Act.

(d) Parties to a patent interference, within such time as may be specified by the Director by regulation, may determine such contest or any aspect thereof by arbitration. Such arbitration shall be governed by the provisions of title 9 [9 USC §§ 1 et seq.] to the extent such title is not inconsistent with this section. The parties shall give notice of any arbitration award to the Director, and such award shall, as between the parties to the arbitration, be dispositive of the issues to which it relates. The arbitration award shall be unenforceable until such notice is given. Nothing in this subsection shall preclude the Director from determining patentability of the invention involved in the interference.

## **§ 135. Derivation proceedings**

~~(a) **Institution of Proceeding.**—An applicant for patent may file a petition to institute a derivation proceeding in the Office. The petition shall set forth with particularity the basis for finding that an inventor named in an earlier application derived the claimed invention from an inventor named in the petitioner’s application and, without authorization, the earlier application claiming such invention was filed. Any such petition may be filed only within the 1-year period beginning on the date of the first publication of a claim to an invention that is the same or substantially the same as the earlier application’s claim to the invention, shall be made under oath, and shall be supported by substantial evidence. Whenever the Director determines that a petition filed under this subsection demonstrates that the standards for instituting a derivation proceeding are met, the Director may institute a derivation proceeding. The determination by the Director whether to institute a derivation proceeding shall be final and nonappealable.~~

### **(a) Institution of Proceeding.—**

(1) **In General.**—An applicant for patent may file a petition with respect to an invention to institute a derivation proceeding in the Office. The petition shall set forth with particularity the basis for finding that an individual named in an earlier application as the inventor or a joint inventor derived such invention from an individual named in the petitioner’s application as the inventor or a joint inventor and, without authorization, the earlier application claiming such invention was filed. Whenever the Director determines that a petition filed under this subsection demonstrates that the standards for instituting a derivation proceeding are met, the Director may institute a derivation proceeding.

(2) **Time for Filing.**—A petition under this section with respect to an invention that is the same or substantially the same invention as a claim contained in a patent issued on an earlier application, or contained in an earlier application when published or deemed published under section 122(b), may not be filed unless such petition is filed during the 1-year period following the date on which the patent containing such claim was granted or the earlier application containing such claim was published, whichever is earlier.

(3) **Earlier Application.**—For purposes of this section, an application shall not be deemed to be an earlier application with respect to an invention, relative to another application, unless a claim to the invention was or could have been made in such application having an effective filing date that is earlier than the effective filing date of any claim to the invention that was or could have been made in such other application.

**(4) No Appeal.**—A determination by the Director whether to institute a derivation proceeding under paragraph (1) shall be final and not appealable.

**(b) Determination by Patent Trial and Appeal Board.**—In a derivation proceeding instituted under subsection (a), the Patent Trial and Appeal Board shall determine whether an inventor named in the earlier application derived the claimed invention from an inventor named in the petitioner’s application and, without authorization, the earlier application claiming such invention was filed. In appropriate circumstances, the Patent Trial and Appeal Board may correct the naming of the inventor in any application or patent at issue. The Director shall prescribe regulations setting forth standards for the conduct of derivation proceedings, including requiring parties to provide sufficient evidence to prove and rebut a claim of derivation.

**(c) Deferral of Decision.**—The Patent Trial and Appeal Board may defer action on a petition for a derivation proceeding until the expiration of the 3-month period beginning on the date on which the Director issues a patent that includes the claimed invention that is the subject of the petition. The Patent Trial and Appeal Board also may defer action on a petition for a derivation proceeding, or stay the proceeding after it has been instituted, until the termination of a proceeding under chapter 30, 31, or 32 involving the patent of the earlier applicant.

**(d) Effect of Final Decision.**—The final decision of the Patent Trial and Appeal Board, if adverse to claims in an application for patent, shall constitute the final refusal by the Office on those claims. The final decision of the Patent Trial and Appeal Board, if adverse to claims in a patent, shall, if no appeal or other review of the decision has been or can be taken or had, constitute cancellation of those claims, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation.

**(e) Settlement.**—Parties to a proceeding instituted under subsection (a) may terminate the proceeding by filing a written statement reflecting the agreement of the parties as to the ~~correct inventors~~ correct inventor of the claimed invention in dispute. Unless the Patent Trial and Appeal Board finds the agreement to be inconsistent with the evidence of record, if any, it shall take action consistent with the agreement. Any written settlement or understanding of the parties shall be filed with the Director. At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents or applications, and shall be made available only to Government agencies on written request, or to any person on a showing of good cause.

**(f) Arbitration.**—Parties to a proceeding instituted under subsection (a) may, within such time as may be specified by the Director by regulation, determine such contest or any aspect thereof by arbitration. Such arbitration shall be governed by the provisions of title 9, to the extent such title is not inconsistent with this section. The parties shall give notice of any arbitration award to the Director, and such award shall, as between the parties to the arbitration, be dispositive of the issues to which it relates. The arbitration award shall be unenforceable until such notice is given. Nothing in this subsection shall preclude the Director from determining the patentability of the claimed inventions involved in the proceeding.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 801; Oct. 15, 1962, P.L. 87-831, 76 Stat. 958; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Nov. 8, 1984, P.L. 98-622, Title I, § 105, Title II, § 202, 98 Stat. 3385, 3386; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, § 3(i); Leahy-Smith America Invents Technical Corrections Act, P.L. 112-274, § 1(e)(1), (k)(1).)

**CHAPTER 13. REVIEW OF PATENT AND TRADEMARK OFFICE****§ 141. Appeal to Court of Appeals for the Federal Circuit**

An applicant dissatisfied with the decision in an appeal to the Board of Patent Appeals and Interferences under section 134 of this title [35 USC § 134] may appeal the decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal the applicant waives his or her right to proceed under section 145 of this title [35 USC § 145]. A patent owner, or a third-party requester in an inter partes reexamination proceeding, who is in any reexamination proceeding dissatisfied with the final decision in an appeal to the Board of Patent Appeals and Interferences under section 134 [35 USC § 134] may appeal the decision only to the United States Court of Appeals for the Federal Circuit. A party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences on the interference may appeal the decision to the United States Court of Appeals for the Federal Circuit, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal in accordance with section 142 of this title [35 USC § 142], files notice with the Director that the party elects to have all further proceedings conducted as provided in section 146 of this title [35 USC § 146]. If the appellant does not, within thirty days after the filing of such notice by the adverse party, file a civil action under section 146 [35 USC § 146], the decision appealed from shall govern the further proceedings in the case.

**§ 141. Appeal to Court of Appeals for the Federal Circuit**

**(a) Examinations.**—An applicant who is dissatisfied with the final decision in an appeal to the Patent Trial and Appeal Board under section 134(a) may appeal the Board's decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal, the applicant waives his or her right to proceed under section 145.

**(b) Reexaminations.**—A patent owner who is dissatisfied with the final decision in an appeal of a reexamination to the Patent Trial and Appeal Board under section 134(b) may appeal the Board's decision only to the United States Court of Appeals for the Federal Circuit.

**(c) Post-Grant and Inter Partes Reviews.**—A party to an inter partes review or a post-grant review who is dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) or 328(a) (as the case may be) may appeal the Board's decision only to the United States Court of Appeals for the Federal Circuit.

**(d) Derivation Proceedings.**—A party to a derivation proceeding who is dissatisfied with the final decision of the Patent Trial and Appeal Board in the proceeding may appeal the decision to the United States Court of Appeals for the Federal Circuit, but such appeal shall be dismissed if any adverse party to such derivation proceeding, within 20 days after the appellant has filed notice of appeal in accordance with section 142, files notice with the Director that the party elects to have all further proceedings conducted as provided in section 146. If the appellant does not, within 30 days after the filing of such notice by the adverse party, file a civil action under section 146, the Board's decision shall govern the further proceedings in the case.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 802; April 2, 1982, P.L. 97-164, Title I, Part B, § 163(a)(7), (b)(2), 96 Stat. 49, 50; Nov. 8, 1984, P.L. 98-622, Title II, § 203(a), 98 Stat. 3387; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle A, § 13106(c), Subtitle B, § 13206(b)(1)(B), 116 Stat. 1901, 1906.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, § 7(c)(1).)

## **§ 142. Notice of appeal**

When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 802; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; April 2, 1982, P.L. 97-164, Title I, Part B, § 163(a)(7), 96 Stat. 49; Nov. 8, 1984, P.L. 98-620, Title IV, Subtitle C, § 414(a), 98 Stat. 3363; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

## **§ 143. Proceedings on appeal**

With respect to an appeal described in section 142 of this title [35 USC § 142], the Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the Director forward the original or certified copies of such documents during pendency of the appeal. ~~In an ex parte case or any reexamination case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal.~~ In an ex parte case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all of the issues raised in the appeal. The Director shall have the right to intervene in an appeal from a decision entered by the Patent Trial and Appeal Board in a derivation proceeding under section 135 or in an inter partes or post-grant review under chapter 31 or 32. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 802; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; April 2, 1982, P.L. 97-164, Title I, Part B, § 163(a)(7), 96 Stat. 49; Nov. 8, 1984, P.L. 98-620, Title IV, Subtitle C, § 414(a), 98 Stat. 3363; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title V, Subtitle B, §§ 13202(b)(2), 13206(b)(1)(B), 116 Stat. 1901, 1906.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, §§ 7(c)(3)(A), (B); 20(j)(1).)

## **§ 144. Decision on appeal**

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 802; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; April 2, 1982, P.L. 97-164, Title I, Part B, § 163(a)(7) in part, 96 Stat. 49; Nov. 8, 1984, P.L. 98-620, Title IV, Subtitle C, § 414(a), 98 Stat. 3363; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

## **§ 145. Civil action to obtain patent**

An applicant dissatisfied with the decision of the ~~Board of Patent Appeals and Interferences Patent Trial and Appeal Board~~ United States District Court for the District of Columbia in an appeal under section 134(a) of this title [35 USC § 134(a)] may, unless appeal has been taken to the United States Court of Appeals for the Federal Circuit, have remedy by civil action against the Director in the United States District Court for the District of Columbia ~~United States District~~

Court for the Eastern District of Virginia if commenced within such time after such decision, not less than sixty days, as the Director appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the ~~Board of Patent Appeals and Interferences Patent Trial and Appeal Board~~, as the facts in the case may appear and such adjudication shall authorize the Director to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 803; April 2, 1982, P.L. 97-164, Title I, Part B, § 163(a)(7) in part, 96 Stat. 49; Nov. 8, 1984, P.L. 98-622, Title II § 203(b), 98 Stat. 3387; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, §§ 3(j)(1); 9(a); 20(j)(1).)

## **~~§ 146. Civil action in case of interference~~**

### **§ 146. Civil action in case of derivation proceeding**

Any party to an ~~interference~~ derivation proceeding dissatisfied with the decision of the ~~Board of Patent Appeals and Interferences Patent Trial and Appeal Board~~ on the ~~interference~~ derivation proceeding, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Director appoints or as provided in section 141 of this title [35 USC § 141], unless he has appealed to the United States Court of Appeals for the Federal Circuit, and such appeal is pending or has been decided. In such suits the record in the Patent and Trademark Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the ~~United States District Court for the District of Columbia~~ United States District Court for the Eastern District of Virginia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Director shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Director to issue such patent on the filing in the Patent and Trademark Office of a certified copy of the judgment and on compliance with the requirements of law.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 803; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; April 2, 1982, P.L. 97-164, Title I, Part B, § 163(a)(7) in part, 96 Stat. 49; Nov. 8, 1984, P.L. 98-622, Title II, § 203(c), 98 Stat. 3387; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, §§ 3(j)(1), (2)(A)(i) and (ii), (4); 9(a); 20(j)(1))

## CHAPTER 14. ISSUE OF PATENT

### **§ 151. Issue of patent**

~~If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.~~

~~Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.~~

~~Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof and, if not paid, the patent shall lapse at the termination of this three-month period. In calculating the amount of a remaining balance, charges for a page or less may be disregarded.~~

~~If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be accepted by the Director as though no abandonment or lapse had ever occurred.~~

### **§ 151. Issue of patent**

**(a) In General.**—If it appears that an applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee and any required publication fee, which shall be paid within 3 months thereafter.

**(b) Effect of Payment.**—Upon payment of this sum the patent may issue, but if payment is not timely made, the application shall be regarded as abandoned.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 803; July 24, 1965, P.L. 89-83, § 4, 79 Stat. 260; Jan. 2, 1975, P.L. 93-601, § 3, 88 Stat. 1956; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a) (9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

(Black Line changes: Patent Law Treaties Implementation Act of 2012, P.L. 112-211, § 202(b) (6).)

### **§ 152. Issue of patent to assignee**

Patents may be granted to the assignee of the inventor of record in the Patent and Trademark Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title [35 USC §§ 1 et seq.].

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 804; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949.)

### **§ 153. How issued**

Patents shall be issued in the name of the United States of America, under the seal of the Patent and Trademark Office, and shall be signed by the Director or have his signature placed thereon and shall be recorded in the Patent and Trademark Office.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 804; Jan. 2, 1975, P.L. 93-596, § 1, 88 Stat. 1949; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, §§ 13203(c), 13206(b)(1)(B), 116 Stat. 1902, 1906.)

### **§ 154. Contents and term of patent; provisional rights**

#### **(a) In general.**

**(1) Contents.** Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, of the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States, and, if the invention is a process, of the right to exclude others from using, offering for sale or selling throughout the

United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof.

**(2) Term.** Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(e) section 120, 121, 365(c), or 386(c) of this title, from the date on which the earliest such application was filed.

**(3) Priority.** Priority under section 119, 365(a), or 365(b) section 119, 365(a), 365(b), 386(a), or 386(b) of this title shall not be taken into account in determining the term of a patent.

**(4) Specification and drawing.** A copy of the specification and drawing shall be annexed to the patent and be a part of such patent.

**(b) Adjustment of patent term**

**(1) Patent term guarantees.**

**(A) Guarantee of prompt patent and trademark office responses.** Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

**(i)** provide at least one of the notifications under section 132 of this title or a notice of allowance under section 151 of this title not later than 14 months after—

**(I)** the date on which an application was filed under section 111(a) of this title; or

**(II)** the date on which an international application fulfilled the requirements of section 371 of this title of commencement of the national stage under section 371 in an international application;

**(ii)** respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken;

**(iii)** act on an application within 4 months after the date of a decision by the Board of Patent Appeals and Interferences Patent Trial and Appeal Board under section 134 or 135 or a decision by a Federal court under section 141, 145, or 146 in a case in which allowable claims remain in the application; or

**(iv)** issue a patent within 4 months after the date on which the issue fee was paid under section 151 and all outstanding requirements were satisfied, the term of the patent shall be extended 1 day for each day after the end of the period specified in clause (i), (ii), (iii), or (iv), as the case may be, until the action described in such clause is taken.

**(B) Guarantee of no more than 3-year application pendency.** Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States the application under section 111(a) in the United States or, in the case of an international application, the date of commencement of the national stage under section 371 in the international application, not including—

**(i)** any time consumed by continued examination of the application requested by the applicant under section 132(b);

**(ii)** any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences Patent Trial and Appeal Board or by a Federal court; or

(iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C),

the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

**~~(C) Guarantee or adjustments for delays due to interferences, secrecy orders, and appeals.~~ (C) Guarantee of adjustments for delays due to derivation proceedings, secrecy orders, and appeals.**—Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to—

(i) a proceeding under section 135(a);

(ii) the imposition of an order under section 181; or

(iii) appellate review by the ~~Board of Patent Appeals and Interferences~~ Patent Trial and Appeal Board or by a Federal court in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability,

the term of the patent shall be extended 1 day for each day of the pendency of the proceeding, order, or review, as the case may be.

**(2) Limitations.**

**(A) In general.** To the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

**(B) Disclaimed term.** No patent the term of which has been disclaimed beyond a specified date may be adjusted under this section beyond the expiration date specified in the disclaimer.

**(C) Reduction of period of adjustment.**

(i) The period of adjustment of the term of a patent under paragraph (1) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application.

(ii) With respect to adjustments to patent term made under the authority of paragraph (1)(B), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of 3 months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, measuring such 3-month period from the date the notice was given or mailed to the applicant.

(iii) The Director shall prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

**(3) Procedures for patent term adjustment determination.**

**(A)** The Director shall prescribe regulations establishing procedures for the application for and determination of patent term adjustments under this subsection.

**(B)** Under the procedures established under subparagraph (A), the Director shall—

(i) make a determination of the period of any patent term adjustment under this subsection, and shall transmit a notice of that determination ~~with the written notice of allowance of the application under section 151 no later than the date of issuance of the patent; and~~

(ii) provide the applicant one opportunity to request reconsideration of any patent term adjustment determination made by the Director.

(C) The Director shall reinstate all or part of the cumulative period of time of an adjustment under paragraph (2)(C) if the applicant, prior to the issuance of the patent, makes a showing that, in spite of all due care, the applicant was unable to respond within the 3-month period, but in no case shall more than three additional months for each such response beyond the original 3-month period be reinstated.

(D) The Director shall proceed to grant the patent after completion of the Director's determination of a patent term adjustment under the procedures established under this subsection, notwithstanding any appeal taken by the applicant of such determination.

**(4) Appeal of patent term adjustment determination.**

(A) An applicant dissatisfied with a ~~determination made by the Director under paragraph (3) shall have remedy~~ the Director's decision on the applicant's request for reconsideration under paragraph (3)(B)(ii) shall have exclusive remedy by a civil action against the Director filed in the United States District Court for the District of Columbia United States District Court for the Eastern District of Virginia within 180 days after the ~~grant of the patent~~ the date of the Director's decision on the applicant's request for reconsideration. Chapter 7 of title 5 [5 USC §§ 701 et seq.], shall apply to such action. Any final judgment resulting in a change to the period of adjustment of the patent term shall be served on the Director, and the Director shall thereafter alter the term of the patent to reflect such change.

(B) The determination of a patent term adjustment under this subsection shall not be subject to appeal or challenge by a third party prior to the grant of the patent.

**(c) Continuation.**

(1) **Determination.** The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers.

(2) **Remedies.** The remedies of sections 283, 284, and 285 of this title shall not apply to acts which—

(A) were commenced or for which substantial investment was made before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act; and

(B) became infringing by reason of paragraph (1).

(3) **Remuneration.** The acts referred to in paragraph (2) may be continued only upon the payment of an equitable remuneration to the patentee that is determined in an action brought under chapter 28 and chapter 29 (other than those provisions excluded by paragraph (2)) of this title.

**(d) Provisional rights.**

(1) **In general.** In addition to other rights provided by this section, a patent shall include the right to obtain a reasonable royalty from any person who, during the period beginning on the date of publication of the application for such patent under section 122(b), or in the case of an international application filed under the treaty defined in section 351(a) designating the United States under Article 21(2) (a) of such treaty or an international design application filed under the treaty defined in section 381(a)(1) designating the United States under Article 5 of such treaty, the date of publication of the application, and ending on the date the patent is issued—

**(A)(i)** makes, uses, offers for sale, or sells in the United States the invention as claimed in the published patent application or imports such an invention into the United States; or

**(ii)** if the invention as claimed in the published patent application is a process, uses, offers for sale, or sells in the United States or imports into the United States products made by that process as claimed in the published patent application; and

**(B)** had actual notice of the published patent application and, in a case in which the right arising under this paragraph is based upon an international application designating the United States that is published in a language other than English, had a translation of the international application into the English language.

**(2) Right based on substantially identical inventions.** The right under paragraph (1) to obtain a reasonable royalty shall not be available under this subsection unless the invention as claimed in the patent is substantially identical to the invention as claimed in the published patent application.

**(3) Time limitation on obtaining a reasonable royalty.** The right under paragraph (1) to obtain a reasonable royalty shall be available only in an action brought not later than 6 years after the patent is issued. The right under paragraph (1) to obtain a reasonable royalty shall not be affected by the duration of the period described in paragraph (1).

**(4) Requirements for international applications.**

**(A) Effective date.** The right under paragraph (1) to obtain a reasonable royalty based upon the publication under the treaty defined in section 351(a) of an international application designating the United States shall commence on the date of publication under the treaty of the international application, or, if the publication under the treaty of the international application is in a language other than English, on the date on which the Patent and Trademark Office receives a translation of the publication in the English language.

**(B) Copies.** The Director may require the applicant to provide a copy of the international application and a translation thereof.

HISTORY: (July 19, 1952, ch 950, § 1, 66 Stat. 804; July 24, 1965, P.L. 89-83, § 5, 79 Stat. 261; Dec. 12, 1980, P.L. 96-517, § 4, 94 Stat. 3018; Aug. 23, 1988, P.L. 100-418, Title IX, Subtitle A, § 9002, 102 Stat. 1563; Dec. 8, 1994, P.L. 103-465, Title V, Subtitle C, § 532(a)(1), 108 Stat. 4983; Oct. 11, 1996, P.L. 104-295, § 20(e)(1), 110 Stat. 3529; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, §§ 13204, 13206(a)(8), 116 Stat. 1902, 1904.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, §§ 3(j)(1), 2(B); 9(a); 20(j)(1); Patent Law Treaties Implementation Act of 2012, P.L. 112-211, § 102(6)(A)(i)-(ii), (B); Leahy-Smith America Invents Technical Corrections Act, P.L. 112-274, § 1(h)(1)(A)-(B), (2), (3)(A)-(B).)

## **§ 155. Patent term extension**

Notwithstanding the provisions of section 154, the term of a patent which encompasses within its scope a composition of matter or a process for using such composition shall be extended if such composition or process has been subjected to a regulatory review by the Federal Food and Drug Administration pursuant to the Federal Food, Drug, and Cosmetic Act [21 USC §§ 301 et seq.] leading to the publication of regulation permitting the interstate distribution and sale of such composition or process and for which there has thereafter been a stay of regulation of approval imposed pursuant to section 409 of the Federal Food, Drug, and Cosmetic Act [21 USC § 348] which stay was in effect on January 1, 1981, by a length of time to be measured from the date such stay of regulation of approval was imposed

until such proceedings are finally resolved and commercial marketing permitted. The patentee, his heirs, successors or assigns shall notify the Director within ninety days of the date of enactment of this section [enacted Jan. 3, 1983] or the date the stay of regulation of approval has been removed, whichever is later, of the number of the patent to be extended and the date the stay was imposed and the date commercial marketing was permitted. On receipt of such notice, the Director shall promptly issue to the owner of record of the patent a certificate of extension, under seal, stating the fact and length of the extension and identifying the composition of matter or process for using such composition to which such extension is applicable. Such certificate shall be recorded in the official file of each patent extended and such certificate shall be considered as part of the original patent, and an appropriate notice shall be published in the Official Gazette of the Patent and Trademark Office.

HISTORY: (Added Jan. 4, 1983, P.L. 97-414, § 11(a), 96 Stat. 2065; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, § 20(k).)

## **§ 155A. Patent term restoration**

(a) Notwithstanding section 154 of this title, the term of each of the following patents shall be extended in accordance with this section:

(1) Any patent which encompasses within its scope a composition of matter which is a new drug product, if during the regulatory review of the product by the Federal Food and Drug Administration—

(A) the Federal Food and Drug Administration notified the patentee, by letter dated February 20, 1976, that such product's new drug application was not approvable under section 505(b)(1) of the Federal Food, Drug and Cosmetic Act [21 USC § 355(b)(1)];

(B) in 1977 the patentee submitted to the Federal Food and Drug Administration the results of a health effects test to evaluate the carcinogenic potential of such product;

(C) the Federal Food and Drug Administration approved, by letter dated December 18, 1979, the new drug application for such product; and

(D) the Federal Food and Drug Administration approved, by letter dated May 26, 1981, a supplementary application covering the facility for the production of such product.

(2) Any patent which encompasses within its scope a process for using the composition of matter described in paragraph (1).

(b) The term of any patent described in subsection (a) shall be extended for a period equal to the period beginning February 20, 1976, and ending May 26, 1981, and such patent shall have the effect as if originally issued with such extended term.

(c) The patentee of any patent described in subsection (a) of this section shall, within ninety days after the date of enactment of this section [enacted Oct. 13, 1983], notify the Director of the number of any patent so extended. On receipt of such notice, the Director shall conform such extension by placing a notice thereof in the official file of such patent and publishing an appropriate notice of such extension in the Official Gazette of the Patent and Trademark Office.

HISTORY: (Added Oct. 13, 1983, P.L. 98-127, § 4(a), 97 Stat. 832; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536; Nov. 2, 2002, P.L. 107-273, Div C, Title III, Subtitle B, § 13206(b)(1)(B), 116 Stat. 1906.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, § 20(k).)

## § 156. Extension of patent term

(a) The term of a patent which claims a product, a method of using a product, or a method of manufacturing a product shall be extended in accordance with this section from the original expiration date of the patent, which shall include any patent term adjustment granted under section 154(b), if—

(1) the term of the patent has not expired before an application is submitted under subsection (d)(1) for its extension;

(2) the term of the patent has never been extended under subsection (e)(1) of this section;

(3) an application for extension is submitted by the owner of record of the patent or its agent and in accordance with the requirements of paragraphs (1) through (4) of subsection (d);

(4) the product has been subject to a regulatory review period before its commercial marketing or use;

(5)(A) except as provided in subparagraph (B) or (C), the permission for the commercial marketing or use of the product after such regulatory review period is the first permitted commercial marketing or use of the product under the provision of law under which such regulatory review period occurred;

(B) in the case of a patent which claims a method of manufacturing the product which primarily uses recombinant DNA technology in the manufacture of the product, the permission for the commercial marketing or use of the product after such regulatory review period is the first permitted commercial marketing or use of a product manufactured under the process claimed in the patent; or

(C) for purposes of subparagraph (A), in the case of a patent which—

(i) claims a new animal drug or a veterinary biological product which (I) is not covered by the claims in any other patent which has been extended, and (II) has received permission for the commercial marketing or use in non-food-producing animals and in food-producing animals, and

(ii) was not extended on the basis of the regulatory review period for use in non-food-producing animals,

the permission for the commercial marketing or use of the drug or product after the regulatory review period for use in food-producing animals is the first permitted commercial marketing or use of the drug or product for administration to a food-producing animal.

The product referred to in paragraphs (4) and (5) is hereinafter in this section referred to as the “approved product”.

(b) Except as provided in subsection (d)(5)(F), the rights derived from any patent the term of which is extended under this section shall during the period during which the term of the patent is extended—

(1) in the case of a patent which claims a product, be limited to any use approved for the product—

(A) before the expiration of the term of the patent—

(i) under the provision of law under which the applicable regulatory review occurred, or

(ii) under the provision of law under which any regulatory review described in paragraph (1), (4), or (5) of subsection (g) occurred, and

(B) on or after the expiration of the regulatory review period upon which the extension of the patent was based;

(2) in the case of a patent which claims a method of using a product, be limited to any use claimed by the patent and approved for the product—

**SELECTED PROVISIONS OF TITLE 28**

*[With amendments received through Jan. 16, 2014, P.L. 113-72.]*

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**CHAPTER 83—COURTS OF APPEALS**

**1295. Jurisdiction of the United States Court of Appeals for the Federal Circuit**

(a) The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction –

~~(1) of an appeal from a final decision of a district court of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, the District Court of the Virgin Islands, or the District Court for the Northern Mariana Islands, if the jurisdiction of that court was based, in whole or in part, on section 1338 of this title, except that a case involving a claim arising under any Act of Congress relating to copyrights, exclusive rights in mask works, or trademarks and no other claims under section 1338(a) shall be governed by sections 1291, 1292, and 1294 of this title;~~

(1) of an appeal from a final decision of a district court of the United States, the District Court of Guam, the District Court of the Virgin Islands, or the District Court of the Northern Mariana Islands, in any civil action arising under, or in any civil action in which a party has asserted a compulsory counterclaim arising under, any Act of Congress relating to patents or plant variety protection;

(2) of an appeal from a final decision of a district court of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, the District Court of the Virgin Islands, or the District Court for the Northern Mariana Islands, if the jurisdiction of that court was based, in whole or in part, on section 1346 of this title, except that jurisdiction of an appeal in a case brought in a district court under section 1346(a)(1), 1346(b), 1346(e), or 1346(f) of this title or under section 1346(a)(2) when the claim is founded upon an Act of Congress or a regulation of an executive department providing for internal revenue shall be governed by sections 1291, 1292, and 1294 of this title;

(3) of an appeal from a final decision of the United States Court of Federal Claims;

(4) of an appeal from a decision of –

~~(A) the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office with respect to patent applications and interferences, at the instance of an applicant for a patent or any party to a patent interference, and any such appeal shall waive the right of such applicant or party to proceed under section 145 or 146 of title 35;~~

(A) the Patent Trial and Appeal Board of the United States Patent and Trademark Office with respect to a patent application, derivation proceeding, reexamination, post-grant review, or inter partes review under title 35, at the instance of a party who exercised that party's right to participate in the applicable proceeding before or appeal to the Board, except that an applicant or a party to a derivation proceeding may also have remedy by civil action pursuant to section 145 or 146 of title 35; an appeal under this subparagraph of a decision of the Board with respect to an application or derivation proceeding shall waive the right of such applicant or party to proceed under section 145 or 146 of title 35;

(B) the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office or the Trademark Trial and Appeal Board with respect to applications for registration of marks and other proceedings as provided in section 21 of the Trademark Act of 1946 (15 U.S.C. 1071); or

(C) a district court to which a case was directed pursuant to section 145, 146, or 154(b) of title 35;

(5) of an appeal from a final decision of the United States Court of International Trade;

(6) to review the final determinations of the United States International Trade Commission relating to unfair practices in import trade, made under section 337 of the Tariff Act of 1930 (19 U.S.C. 1337);

(7) to review, by appeal on questions of law only, findings of the Secretary of Commerce under U.S. note 6 to subchapter X of chapter 98 of the Harmonized Tariff Schedule of the United States (relating to importation of instruments or apparatus);

(8) of an appeal under section 71 of the Plant Variety Protection Act (7 U.S.C. 2461);

(9) of an appeal from a final order or final decision of the Merit Systems Protection Board, pursuant to sections 7703(b)(1) and 7703(d) of title 5;

(10) of an appeal from a final decision of an agency board of contract appeals pursuant to section 7107(a)(1) of title 41;

(11) of an appeal under section 211 of the Economic Stabilization Act of 1970;

(12) of an appeal under section 5 of the Emergency Petroleum Allocation Act of 1973;

(13) of an appeal under section 506(c) of the Natural Gas Policy Act of 1978; and

(14) of an appeal under section 523 of the Energy Policy and Conservation Act.

(b) The head of any executive department or agency may, with the approval of the Attorney General, refer to the Court of Appeals for the Federal Circuit for judicial review any final decision rendered by a board of contract appeals pursuant to the terms of any contract with the United States awarded by that department or agency which the head of such department or agency has concluded is not entitled to finality pursuant to the review standards specified in section 7107(b) of title 41. The head of each executive department or agency shall make any referral under this section within one hundred and twenty days after the receipt of a copy of the final appeal decision.

(c) The Court of Appeals for the Federal Circuit shall review the matter referred in accordance with the standards specified in section 7107(b) of title 41. The court shall proceed with judicial review on the administrative record made before the board of contract appeals on matters so referred as in other cases pending in such court, shall determine the issue of finality of the appeal decision, and shall, if appropriate, render judgment thereon, or remand the matter to any administrative or executive body or official with such direction as it may deem proper and just.

-SOURCE- (Added Pub. L. 97-164, title I, Sec. 127(a), Apr. 2, 1982, 96 Stat. 37; amended Pub. L. 98-622, title II, Sec. 205(a), Nov. 8, 1984, 98 Stat. 3388; Pub. L. 100-418, title I, Sec. 1214(a)(3), Aug. 23, 1988, 102 Stat. 1156; Pub. L. 100-702, title X, Sec. 1020(a)(3), Nov. 19, 1988, 102 Stat. 4671; Pub. L. 102-572, title I, Sec. 102(c), title IX, Sec. 902(b)(1), Oct. 29, 1992, 106 Stat. 4507, 4516; Pub. L. 106-113, div. B, Sec. 1000(a)(9) [title IV, Secs. 4402(b)(2), 4732(b)(14)], Nov. 29, 1999, 113 Stat. 1536, 1501A-560, 1501A-584; Pub. L. 111-350, Sec. 5(g)(5), Jan. 4, 2011, 124 Stat. 3848.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, §§ 7(c)(2); 19(b).)

**CHAPTER 85—DISTRICT COURTS; JURISDICTION**

**§ 1338. Patents, plant variety protection, copyrights, mask works, designs, trademarks, and unfair competition**

(a) The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trademarks. ~~Such jurisdiction shall be exclusive of the courts of the states in patent, plant variety protection and copyright cases. No State court shall have jurisdiction over any claim for relief arising under any Act of Congress relating to patents, plant variety protection, or copyrights. For purposes of this subsection, the term ‘State’ includes any State of the United States, the District of Columbia, the Commonwealth of Puerto Rico, the United States Virgin Islands, American Samoa, Guam, and the Northern Mariana Islands.~~

(b) The district courts shall have original jurisdiction of any civil action asserting a claim of unfair competition when joined with a substantial and related claim under the copyright, patent, plant variety protection or trademark laws.

(c) Subsections (a) and (b) apply to exclusive rights in mask works under chapter 9 of title 17, and to exclusive rights in designs under chapter 13 of title 17, to the same extent as such subsections apply to copyrights.

(June 25, 1948, ch. 646, 62 Stat. 931; Pub. L. 91-577, title III, Sec. 143(b), Dec. 24, 1970, 84 Stat. 1559; Pub. L. 100-702, title X, Sec. 1020(a)(4), Nov. 19, 1988, 102 Stat. 4671; Pub. L. 105-304, title V, Sec. 503(b)(1), (2)(A), Oct. 28, 1998, 112 Stat. 2917; Pub. L. 106-113, div. B, Sec. 1000(a)(9) [title III, Sec. 3009(1)], Nov. 29, 1999, 113 Stat. 1536, 1501A-551.)

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, § 19(a).)

**CHAPTER 87—DISTRICT COURTS; VENUE**

**§ 1400. Patents and copyrights, mask works and designs**

(a) Civil actions, suits, or proceedings arising under any Act of Congress relating to copyrights or exclusive rights in mask works or designs may be instituted in the district in which the defendant or his agent resides or may be found.

(b) Any civil action for patent infringement may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.

(June 25, 1948, ch. 646, 62 Stat. 936; Pub. L. 100-702, title X, Sec. 1020(a)(5), Nov. 19, 1988, 102 Stat. 4671; Pub. L. 105-304, title V, Sec. 503(c)(1), (2), Oct. 28, 1998, 112 Stat. 2917; Pub. L. 106-44, Sec. 2(a), Aug. 5, 1999, 113 Stat. 223.)

**CHAPTER 89—DISTRICT COURTS; REMOVAL OF  
CASES FROM STATE COURTS**

**§ 1454. Patent, plant variety protection, and copyright cases**

**(a) In general.**—A civil action in which any party asserts a claim for relief arising under any Act of Congress relating to patents, plant variety protection, or copyrights may be removed to the district court of the United States for the district and division embracing the place where the action is pending.

**(b) Special rules.**—The removal of an action under this section shall be made in accordance with section 1446, except that if the removal is based solely on this section—

**(1)** the action may be removed by any party; and

**(2)** the time limitations contained in section 1446(b) may be extended at any time for cause shown.

**(c) Clarification of jurisdiction in certain cases.**—The court to which a civil action is removed under this section is not precluded from hearing and determining any claim in the civil action because the State court from which the civil action is removed did not have jurisdiction over that claim.

**(d) Remand.**—If a civil action is removed solely under this section, the district court—

**(1)** shall remand all claims that are neither a basis for removal under subsection (a) nor within the original or supplemental jurisdiction of the district court under any Act of Congress; and

**(2)** may, under the circumstances specified in section 1367(c), remand any claims within the supplemental jurisdiction of the district court under section 1367.

(Black Line changes: Leahy-Smith America Invents Act, P.L. 112-29, § 19(c)(1).)

## Excerpt from the House Judiciary Committee Report on the America Invents Act

(Rept. 112-98, June 1, 2011)

### Purpose and Summary

[Publisher's Note: Subsequent to this Report, H.R. 1249 was amended by the House of Representatives. These amendments are summarized in the end note following this Report.]

The Constitution explicitly grants Congress the power to “promote the progress of science and useful arts, by securing for limited times to . . . inventors the exclusive right to their respective . . . discoveries.”<sup>2</sup> Congress has responded by authorizing patents to issue to inventors of new and useful inventions or improvements on inventions.<sup>3</sup> The patent law thus accomplishes two objectives, consistent with the authorization granted by the Constitution: first, it encourages inventors by granting them limited, but exclusive rights to their inventions; second, in exchange for the grant of those exclusive rights, the patent law requires disclosure of the invention and terminates the monopoly after a period of years.<sup>4</sup> This disclosure and limited time benefits both society and future inventors by making the details of the invention available to the public immediately, and the right to make use of that invention after the expiration of 20 years from the date the patent application was filed.

Congress has not enacted comprehensive patent law reform in nearly 60 years.<sup>5</sup> The object of the patent law today must remain true to the constitutional command, but its form needs to change, both to correct flaws in the system that have become unbearable, and to accommodate changes in the economy and the litigation practices in the patent realm. The need to update our patent laws has been meticulously documented in 15 hearings before the Committee or its Subcommittee on Courts, the Internet, and Intellectual Property, as well as eight hearings before the United States Senate Committee on the Judiciary. In addition, these legislative findings are augmented by the Federal Trade Commission and the National Academy of Sciences,<sup>6</sup> both of which published authoritative reports on patent reform, and a plethora of academic commentary.<sup>7</sup>

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2 U.S. Const. Art. 1, § 8.

3 See 35 U.S.C. § 101.

4 See Perspectives on Patents: Post-Grant Review Procedures and Other Litigation Reforms: Hearing before the Subcomm. on Intellectual Prop. of the Senate Comm. on the Judiciary, 109th Cong. (2006) (statement of Nathan P. Myhrvold, Chief Executive Officer, Intellectual Ventures); Perspectives on Patents: Hearing before the Subcomm. on Intellectual Prop. of the Senate Comm. on the Judiciary, 109th Cong. (2005) (statement of Dean Kamen, President, DEKA Research and Development Corp.).

5 The last major revision of the patent laws was the Patent Act of 1952, P.L. 82–593.

6 The National Academy of Sciences (NAS), and the Federal Trade Commission (FTC) conducted multi-year studies on the patent system and its need for reform. See National Research Council of the National Academies, *A Patent System for the 21st Century* (2004) (hereinafter “NAS Report”); and Federal Trade Comm’n, *To Promote Innovation: The Proper Balance of Competition and Patent Law and Policy* (2003) (hereinafter “FTC Report”).

7 See, e.g., Mark A. Lemley and Carl Shapiro, *Patent Holdup and Royalty Stacking*, 85 *Tex. L. Rev.* 1991 (2007); Donald S. Chisum, *Reforming Patent Law Reform*, 4 *J. Marshall Rev. Intell. Prop. L.* 336 (2005); Gerald J. Mossinghoff, *The First-to-Invent Rule in the U.S. Patent System has Provided no Advantage to Small Entities*, 87 *JPTOS* 514 (2005); Joseph Farrell & Robert P. Merges, *Incentives to Challenge and Defend Patents: Why Litigation Won’t Reliably*

While Congress has considered patent reform legislation over the last four Congresses, the need to modernize our patent laws has found expression in the courts, as well. The Supreme Court has reversed the Federal Circuit in six of the patent-related cases that it has heard since the beginning of the 109th Congress.<sup>8</sup> The Court's decisions have moved in the direction of improving patent quality and making the determination of patent validity more efficient. The decisions reflect a growing sense that questionable patents are too easily obtained and are too difficult to challenge.<sup>9</sup> Recent decisions by the Federal Circuit reflect a similar trend in response to these concerns.<sup>10</sup> But the courts are constrained in their decisions by the text of the statutes at issue. It is time for Congress to act.

The voices heard during the debate over changes to the patent law have been diverse and their proposals have been far from uniform. They have focused the Committee's attention on the value of harmonizing our system for granting patents with the best parts of other major patent systems throughout the industrialized world for the benefit of U.S. patent holders; improving patent quality and providing a more efficient system for challenging patents that should not have issued; and reducing unwarranted litigation costs and inconsistent damage awards.

The purpose of the "America Invents Act," as reported by the Committee on the Judiciary, is to ensure that the patent system in the 21st century reflects the constitutional imperative. Congress must promote innovation by granting inventors temporally limited monopolies on their inventions in a manner that ultimately benefits the public through the disclosure of the invention to the public. The legislation is designed to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.

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Fix Patent Office Errors and Why Administrative Patent Review Might Help, 19 Berkeley Tech. L.J. 943,958 (2004); see also Adam B. Jaffe & Josh Lerner, *Innovation and Its Discontents: How Our Broken Patent System is Endangering Innovation and Progress, and What to Do About It* (2004); Kevin G. Rivette & David Kline, *Rembrandts in the Attic, Unlocking the Hidden Value of Patents* (2000).

8 See *Bilski v. Kappos*, 130 S.Ct. 3218 (2010) (reversing the Federal Circuit and holding that the machine-or-transformation test is not the sole test for determining the patent eligibility of a process); *Quanta Computer, Inc. v. LG Elecs. Inc.*, 553 U.S. 617 (2008) (reversing the Federal Circuit and holding that patent exhaustion applies to method patents when the essential or inventive feature of the invention is embodied in the product); *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437 (2007) (reversing the Federal Circuit and limiting the extraterritorial reach of section 271(f), which imposes liability on a party which supplies from the U.S. components of a patented invention for combination outside the U.S.); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) (reversing the Federal Circuit and strengthening the standard for determining when an invention is obvious under section 103); *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118 (2007) (reversing the Federal Circuit and holding that the threat of a private enforcement action is sufficient to confirm standing under the Constitution); *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006) (reversing the Federal Circuit and holding that the generally applicable four-factor test for injunctive relief applies to disputes in patent cases).

9 See generally *Patent Reform in the 111th Congress: Legislation and Recent Court Decisions*, Senate Judiciary Committee, 111th Cong. (2009) (statement of Professor Mark A. Lemley, Stanford Law School).

10 See, e.g., *In re Seagate Tech., LLC*, 497 F.3d 1360 (Fed. Cir. 2007) (holding that willful infringement requires at least a demonstration of objectively reckless behavior and removing any affirmative obligation to obtain an opinion of counsel letter to combat an allegation of willful infringement).

If the United States is to maintain its competitive edge in the global economy, it needs a system that will support and reward all innovators with high quality patents. The Committee has taken testimony from and its members have held meetings with interested parties that have different and often conflicting perspectives on the patent system. The Committee has taken all of those views into consideration, and drafted and then amended the “America Invents Act” to balance the competing interests. The legislation ordered reported by the Committee on a vote of 32–3 is a consensus approach that will modernize the United States patent system in significant respects.

## Background and Need for the Legislation

### *First Inventor to File*

The “America Invents Act” creates a new “first-inventor-to-file” system. Every industrialized nation other than the United States uses a patent priority system commonly referred to as “first-to-file.” In a first-to-file system, when more than one application claiming the same invention is filed, the priority of a right to a patent is based on the earlier-filed application. The United States, by contrast, currently uses a “first-to-invent” system, in which priority is established through a proceeding to determine which applicant actually invented the claimed invention first. Differences between the two systems arise in large part from the date that is most relevant to each respective system. In a first-to-file system, the filing date of the application is most relevant;<sup>11</sup> the filing date of an application is an objective date, simple to determine, for it is listed on the face of the patent. In contrast, in a first-to-invent system, the date the invention claimed in the application was actually invented is the determinative date. Unlike the objective date of filing, the date someone invents something is often uncertain, and, when disputed, typically requires corroborating evidence as part of an adjudication.

There are significant, practical differences between the two systems. Among them is the ease of determining the right to a claimed invention in the instance in which two different people file patent applications for the same invention. In a first-to-file system, the application with the earlier filing date prevails and will be awarded the patent, if one issues. In the first-to-invent system, a lengthy, complex and costly administrative proceeding (called an “interference proceeding”) must be conducted at the United States Patent and Trademark Office (“USPTO”) to determine who actually invented first.<sup>12</sup> Interference proceedings can take years to complete (even if there is no appeal to the United States Court of Appeals for the Federal Circuit), cost hundreds of thousands of dollars, and require extensive discovery.<sup>13</sup> In addition, because it is always possible that an applicant could be involved in an interference proceeding, companies must maintain extensive recording and document retention systems in case they are later required to prove the date they invented the claimed invention.

Another important difference between the two systems is that in some first-to-file systems, prior art can include the inventor’s own disclosure of his invention

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11 When the term “filing date” is used herein, it is also meant to include, when appropriate, the effective filing date, i.e., the earliest date the claim in an application-claims priority.

12 See 35 U.S.C. § 135.

13 See, e.g., Robert W. Pritchard, *The Future is Now—The Case for Patent Harmonization*, 20 N.C. J. Int’l L. & Com. Reg. 291, 313 (1995).

prior to the filing date of his application. Such systems do not provide the inventor any grace period during which time he is allowed to publish his invention without fear of its later being used against him as prior art. The Committee heard from universities and small inventors, in particular, about the importance of maintaining that grace period in our system.<sup>14</sup> They argued that the grace period affords the necessary time to prepare and file applications, and in some instances, to obtain the necessary funding that enables the inventor to prepare adequately the application. In addition, the grace period benefits the public by encouraging early disclosure of new inventions, regardless of whether an application may later be filed for a patent on it.

Numerous organizations, institutions, and companies have advocated that the U.S. adopt a first-to-file system similar to those used in the rest of the world.<sup>15</sup> The National Academy of Sciences made a similar recommendation after an extensive study of the patent system.<sup>16</sup> When the United States patent system was first adopted, inventors did not typically file in other countries. It is now common for inventors and companies to file for protection in several countries at the same time.<sup>17</sup> Thus, United States applicants, who also want to file abroad, are forced to follow and comply with two different filing systems. Maintaining a filing system so different from the rest of the world disadvantages United States

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14 See, e.g., Perspectives on Patents: Harmonization and Other Matters: Hearing Before the Subcomm. on Intellectual Prop. of the Senate Comm. on the Judiciary, 109th Cong. (2005) (statement of Charles E. Phelps, Provost, University of Rochester, on behalf of the Association of American Universities); Patent Law Reform: Injunctions and Damages: Hearing Before the Subcomm. on Intellectual Prop. of the Senate Comm. on the Judiciary, 109th Cong. (2005) (statement of Carl Gulbrandsen, Managing Director, Wisconsin Alumni Research Foundation (WARF)); Perspective on Patents: Hearing Before the Subcomm. on Intellectual Prop. of the Senate Comm. on the Judiciary, 109th Cong. (2005) (statement of William Parker, Diffraction, Ltd.).

15 See, e.g., Perspectives on Patents: Harmonization and Other Matters: Hearing Before the Subcomm. on Intellectual Prop. of the Senate Comm. on the Judiciary, 109th Cong. (2005) (statement of Gerald J. Mossinghoff, Former Assistant Secretary of Commerce and Commissioner of Patents and Trademarks); Perspectives on Patents: Harmonization and Other Matters: Hearing Before the Subcomm. on Intellectual Prop. of the Senate Comm. on the Judiciary, 109th Cong. (2005) (statement of Q. Todd Dickinson, Former Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office); Patent Law Reform: Injunctions and Damages: Hearing Before the Subcomm. on Intellectual Prop. of the Senate Comm. on the Judiciary, 109th Cong. (2005) (statement of Jeffrey P. Kushan, Partner, Sidley Austin Brown & Wood, LLP); Patent Law Reform: Injunctions and Damages: Hearing Before the Subcomm. on Intellectual Prop. of the Senate Comm. on the Judiciary, 109th Cong. (2005) (statement of Mark A. Lemley, Professor, Stanford Law School); Perspectives on Patents: Hearing Before the Subcomm. on Intellectual Prop. of the Senate Comm. on the Judiciary, 109th Cong. (2005) (statement of Robert A. Armitage, Senior Vice President and General Patent Counsel, Eli Lilly and Company); Perspectives on Patents: Hearing Before the Subcomm. on Intellectual Prop. of the Senate Comm. on the Judiciary, 109th Cong. (2005) (statement of Michael K. Kirk, Executive Director, American Intellectual Property Law Association).

16 See NAS Report at 124; see also Perspectives on Patents: Hearing Before the Subcomm. on Intellectual Prop. of the Senate Comm. on the Judiciary, 109th Cong. (2005) (statement of Richard C. Levin, Yale University).

17 See Perspectives on Patents: Harmonization and Other Matters: Hearing Before the Subcomm. on Intellectual Prop. of the Senate Comm. on the Judiciary, 109th Cong. (2005) (statement of Gerald J. Mossinghoff, Former Assistant Secretary of Commerce and Commissioner of Patents and Trademarks) .

applicants who, in most instances, also file in other countries.<sup>18</sup> A change is long overdue.<sup>19</sup>

Drawing on the best aspects of the two existing systems, the America Invents Act creates a new “first-inventor-to-file” system. This new system provides patent applicants in the United States the efficiency benefits of the first-to-file systems used in the rest of the world by moving the U.S. system much closer to a first-to-file system and making the filing date that which is most relevant in determining whether an application is patentable. The new system continues, however, to provide inventors the benefit of the 1-year grace period. As part of the transition to a simpler, more efficient first-inventor-to-file system, this provision eliminates costly, complex interference proceedings, because priority will be based on the first application. A new administrative proceeding—called a “derivation” proceeding—is created to ensure that the first person to file the application is actually a true inventor. This new proceeding will ensure that a person will not be able to obtain a patent for the invention that he did not actually invent. If a dispute arises as to which of two applicants is a true inventor (as opposed to who invented it first), it will be resolved through an administrative proceeding by the Patent Board. The Act also simplifies how prior art is determined, provides more certainty, and reduces the cost associated with filing and litigating patents.

The Act maintains a 1-year grace period for U.S. applicants. Applicants’ own publication or disclosure that occurs within 1 year prior to filing will not act as prior art against their applications. Similarly, disclosure by others during that time based on information obtained (directly or indirectly) from the inventor will not constitute prior art. This 1-year grace period should continue to give U.S. applicants the time they need to prepare and file their applications.

This provision also, and necessarily, modifies the prior-art sections of the patent law. Prior art will be measured from the filing date of the application and will typically include all art that publicly exists prior to the filing date, other than disclosures by the inventor within 1 year of filing. Prior art also will no longer have any geographic limitations. Thus, in section 102 the “in this country” limitation as applied to “public use” and “on sale” is removed, and the phrase “available to the public” is added to clarify the broad scope of relevant prior art, as well as to emphasize the fact that it must be publicly accessible. Prior art based on earlier-filed United States

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18 See Perspectives on Patents: Hearing Before the Subcomm. on Intellectual Prop. of the Senate Comm. on the Judiciary, 109th Cong. (2005) (statement of Richard C. Levin, President, Yale University, and Mark B. Meyers, Visiting Executive Professor, Management Department at the Wharton Business School, University of Pennsylvania), estimating that it costs as much as \$750,000 to \$1 million to obtain worldwide patent protection on an important invention, and the lack of harmonization regarding filing systems adds unnecessary cost and delay.

19 The NAS recommended changing the U.S. to a first-to-file system, while maintaining a grace period. See NAS Report at 124–27. See also Patent Reform in the 111th Congress: Legislation and Recent Court Decisions: Hearing Before the Senate Comm. on the Judiciary, 111th Cong. (2009) (statement of Steven Appleton, Chairman and Chief Executive Officer, Micron Technologies, Inc.); Patent Reform in the 111th Congress: Legislation and Recent Court Decisions: Hearing Before the Senate Comm. on the Judiciary, 111th Cong. (2009) (statement of Philip S. Johnson, Chief Patent Counsel, Johnson & Johnson); Patent Reform in the 111th Congress: Legislation and Recent Court Decisions: Hearing Before the Senate Comm. on the Judiciary, 111th Cong. (2009) (statement of Herbert C. Wamsley, Executive Director, Intellectual Property Owners Association); Patent Reform in the 111th Congress: Legislation and Recent Court Decisions: Hearing Before the Senate Comm. on the Judiciary, 111th Cong. (2009) (statement of Mark A. Lemley, Professor, Stanford Law School).

applications is maintained,<sup>20</sup> as is current law's grace period, which will apply to all actions by the patent owner during the year prior to filing that would otherwise create § 102(a) prior art.<sup>21</sup> Sections (and subsections) of the existing statute are re-numbered, modified, or deleted consistent with converting to a first-inventor-to-file system.<sup>22</sup> Finally, the intent behind the CREATE Act to promote joint research activities is preserved by including a prior art exception for subject matter invented by parties to a joint research agreement. The Act also provides that its enactment of new section 102(c) of title 35 is done with the same intent to promote joint research activities that was expressed in the Cooperative Research and Technology Enhancement Act of 2004 (Public Law 108–453), and that section 102(c) shall be administered in a manner consistent with such intent.

### *Inventor's oath or declaration*

The U.S. patent system, when first adopted in 1790, contemplated that individual inventors would file their own patent applications, or would have a patent practitioner do so on their behalf. It has become increasingly common for patent applications to be assigned to corporate entities, most commonly the employer of the inventor.<sup>23</sup> In fact, many employment contracts require employees to assign their inventions to their employer.<sup>24</sup>

Current law still reflects the antiquated notion that it is the inventor who files the application, not the company-assignee. For example, every inventor must sign an oath as part of the patent application stating that the inventor believes he or she is the true inventor of the invention claimed in the application.<sup>25</sup> By the time an application is eventually filed, however, the applicant filing as an assignee may have difficulty locating and obtaining every inventor's signature for the statutorily required oath. Although the USPTO has adopted certain regulations to allow filing of an application when the inventor's signature is unobtainable,<sup>26</sup> many have advocated that the statute be modernized to facilitate the filing of applications by assignees.<sup>27</sup>

The Act updates the patent system by facilitating the process by which an assignee may file and prosecute patent applications. It provides similar flexibility for a person to whom the inventor is obligated to assign, but has not assigned, rights to the invention (the "obligated assignee").

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20 Compare current § 102(e) with new § 102(a)(2).

21 See generally 157 Cong. Rec. S.1496–97 (daily ed. March 9, 2011), S. 1370–71 (daily ed. March 8, 2011).

22 The Committee does not intend a substantive change by replacing the word "negated" in section 103 of title 35 with "negated."

23 See John R. Allison & Mark A. Lemley, *The Growing Complexity of the United States Patent System*, 82 B.U. L. Rev. 77, 97 (2002) (study showing that approximately 85% of the patents issued between 1996–98 were assigned by inventors to corporations; an increase from 79% during the period between 1976–78).

24 See Jerry C. Liu, *Overview of Patent Ownership Considerations in Joint Technology Development*, 2005 Syracuse Sci. & Tech. L. Rep. 1 (2005).

25 35 U.S.C. § 115.

26 See 37 C.F.R. § 1.47, which permits an applicant to petition the Director of the USPTO to have the application accepted without every inventor's signature in limited circumstances, e.g., when the inventor cannot be found or refuses to participate in the application.

27 See *Perspectives on Patents: Harmonization and Other Matters: Hearing Before the Subcomm. on Intellectual Prop. of the Senate Comm. on the Judiciary, 109th Cong.* (2005) (statement of David Beier, Senior Vice President of Global Government Affairs, Amgen).

Section 115 of title 35 is amended to allow a substitute statement to be submitted in lieu of an inventor's oath when either the inventor (i) is unable to submit an oath, or (ii) is both unwilling to do so and under an obligation to assign the invention. If an error is discovered, the statement may later be corrected. A savings clause is included to prevent an invalidity or unenforceability challenge to the patent based on failure to comply with these requirements, provided that any error has been remedied. Willful false statements remain punishable, however, under Federal criminal laws.<sup>28</sup>

Section 118 of title 35 is also amended to make it easier for an assignee to file a patent application. The amendment now allows obligated assignees—entities to which the inventor is obligated to assign the application—to file applications, as well. It also allows a person who has a sufficient proprietary interest in the invention to file an application to preserve that person's rights and those of the inventor.

### *Defense to infringement based on earlier inventor*

Under current law, “prior user rights” may offer a defense to patent infringement when the patent in question is a “business method patent”<sup>29</sup> and its inventor uses the invention, but never files a patent application for it.<sup>30</sup> If the same invention is later patented by another party, the prior user may not be liable for infringement to the new patent holder, although all others may be.

Many counties [sic, probably should be “countries”] include a more expansive prior-user rights regime within their first-to-file system. In the United States, this is particularly important to high-tech businesses that prefer not to patent every process or method that is part of their commercial operations. The Act responds to this point by revising US law as follows: First, the prior-use defense may be asserted against any patent (not just method patents), provided the person asserting the defense reduced the subject matter of the patent to practice and commercially used the subject matter at least 1 year before the effective filing date of the patent. Second, the defense cannot be asserted if the subject matter was derived from the patent holder or persons in privity with the patent holder. And third, the defense cannot be asserted unless the prior user both reduced the subject matter of the patent to practice and commercially used it at least 1 year before the effective filing date of the patent or the date that the patentee publicly disclosed the invention and invoked the § 102(b) grace period, whichever is earlier.

This narrow expansion of prior-user rights balances the interests of patent holders, including universities, against the legitimate concerns of businesses that want to avoid infringement suits relating to processes that they developed and used prior to another party acquiring related patents.

### *Post-grant review proceedings*

The Act amends ex parte and inter partes reexamination and establishes a new post-grant review procedure. Under current law, there are two ways to challenge the validity and enforceability of a patent that has issued. The patent may be challenged in district court litigation or in a reexamination at the USPTO.

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<sup>28</sup> See 18 U.S.C. § 1001.

<sup>29</sup> 35 U.S.C. § 273(a)(3) states: “The term ‘method’ means a method of doing or conducting business.”

<sup>30</sup> See 35 U.S.C. § 273.

Nearly 30 years ago, Congress created the administrative “reexamination” process, through which the USPTO could review the validity of already-issued patents on the request of either the patent holder or a third party,<sup>31</sup> in the expectation that it would serve as an effective and efficient alternative to often costly and protracted district court litigation.<sup>32</sup> Reexamination requires the USPTO to review the patent in light of a substantial new question of patentability not presented during the original examination.<sup>33</sup> The initial reexamination statute had several limitations that later proved to make it a less viable alternative to litigation for evaluating patent validity than Congress intended. First, a reexamination request could only be based on prior art, and could not be based on prior public use or prior sales. Moreover, the requestor could not raise any challenge based on § 101 (utility, eligibility) or § 112 (indefiniteness, enablement, written description, best mode). A third party alleging a patent is invalid, therefore, had fewer challenges it could raise in the proceeding and, therefore, may instead opt to risk infringement and litigate the validity of the patent in court. Second, in the original reexamination system, the third-party challenger had no role once the proceeding was initiated, while the patent holder had significant input throughout the entire process. Third, a challenger that lost at the USPTO under reexamination had no right to appeal an examiner’s, or the Patent Board’s, decision either administratively or in court. Restrictions such as these made reexamination a much less favored avenue to challenge questionable patents than litigation. Reexamination proceedings are also often costly, taking several years to complete,<sup>34</sup> and are first conducted by examiners and, if the patent is rejected, then by Patent Board judges. Thus, many patents must go through two rounds of administrative review (one by the examiner, and a second by the Patent Board) adding to the length of the proceeding.<sup>35</sup>

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31 See 35 U.S.C. §§ 301–307. A patent holder will typically request reexamination to bolster the patent in view of new prior art. A third party may request reexamination to challenge, and ultimately invalidate, the patent.

32 “Reexamination will permit efficient resolution of questions about the validity of issued patents without recourse to expensive and lengthy infringement litigation.... The reexamination of issued patents could be conducted with a fraction of the time and cost of formal legal proceedings and would help restore confidence in the effectiveness of our patent system.... It is anticipated that these measures provide a useful and necessary alternative for challengers and for patent owners to test the validity of united states patents in an efficient and relatively inexpensive manner.” See H.R. Rep. No. 96–1307(I) at 3 (1980), reprinted in 1980 U.S.C.A.N.6460, 6462–63.

33 See 35 U.S.C. § 303.

34 See Perspectives on Patents: Hearing Before the Subcomm. on Intellectual Prop. of the Senate Comm. on the Judiciary, 109th Cong. (2005) (statement of Jon W. Dudas, Undersecretary of Commerce for Intellectual Property, Director of the U.S. Patent and Trademark Office), explaining that “a large number of reexamination proceedings have been pending before the USPTO for more than 4 years,” and questioning whether this amount of time is consistent with the statutory requirement that “[a]ll reexamination proceedings . . . will be conducted with special dispatch within the Office.” See also 35 U.S.C. § 305.

35 For several years, the standard practice at the USPTO was to assign the reexamination to the patent examiner who had originally examined that patent. In addition, the same third-party requester could file multiple, serial reexaminations based on the same “substantial new question of patentability,” so long as the initial reexamination was not complete. More recently, the USPTO ended some of these procedures, and now reexaminations are handled by a Central Reexamination Unit (CRU), and subsequent serial reexamination, based on the same “substantial new question of patentability,” is no longer permitted. See, e.g., Manual of Patent Examining Procedure (MPEP) §§ 2236 and 2240 (August 2006).