

Amendments to Titles of United States Code by Leahy-Smith America Invents Act

The Leahy-Smith America Invents Act (Act) that was signed by President Obama on September 16, 2011 amends provisions of titles 28, 35, 42, and 51 of U.S.C. I have compiled the following reference tables focusing only on the amendments to these laws to show the changes for easy reference.¹²³

In summary, 74 sections (not counting individual subsections) of the US Patent law have been affected by the Act in total. Four sections have been repealed, 18 sections/subsections have been substantially rewritten in terms of the amount of amended texts, and 17 new sections/subsections have been added to title 35 U.S.C.

With respect to title 28 of the United States Code, 3 sections have been amended.

With respect to title 42 of the United States Code, 1 section has been amended.

With respect to title 51 of the United States Code, 1 section has been amended.

One of the significant changes to title 35 is the new definition of prior art as defined by the amended section 102. The effective date of the amended section 35 U.S.C. § 102 is 3/16/2013, and the amended section applies to (1) a claim to a claimed invention that has an effective filing date as defined in amended section 100(i) of title 35 that is on or after the effective date; or (2) a specific reference under amended section 120, 121, or 365(c) of title 35 to any patent or application that contains or contained at any time such a claim. See also section 3(n)(1) of the Act. Therefore, pre-amended 35 U.S.C. § 102 may still apply to some patent applications filed after March 16, 2013. This also means that a substantial amount of patent applications will remain in the patent examination pipeline to be examined under the old section 102 after 3/16/2013 for years to come due to the backlog of over 700,000 patent applications in the USPTO and a possible new wave of patent applications filed before 3/16/2013. Predictably, a

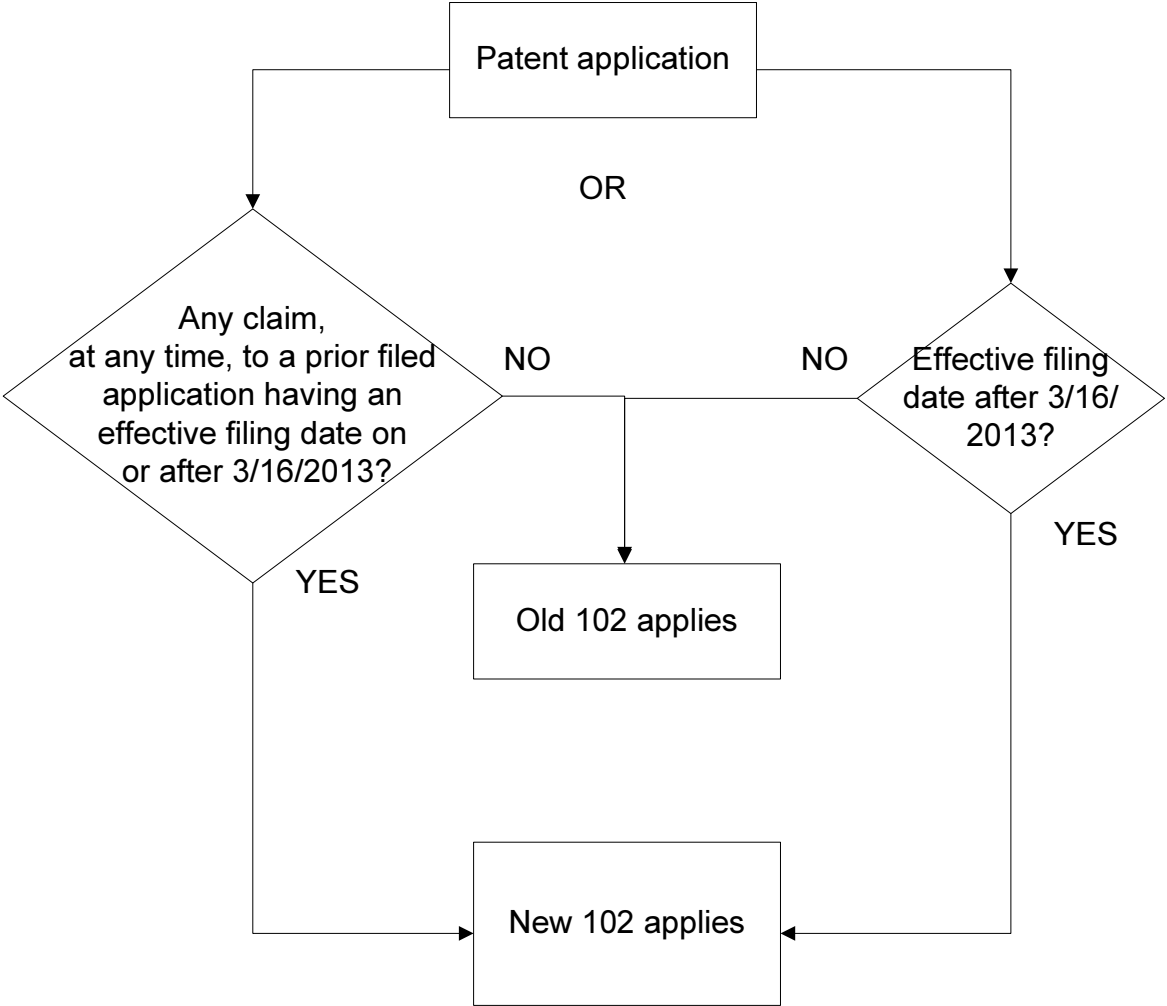
¹ I didn't incorporate the changes to section 20(g)(3)(A) of the Act because the amendment to the "Court of Federal Claims" was made in 1992 under Third paragraph, Pub. L. 102-572.

² I didn't incorporate all of the changes in the section 20(j) ("Unnecessary References") of the Act.

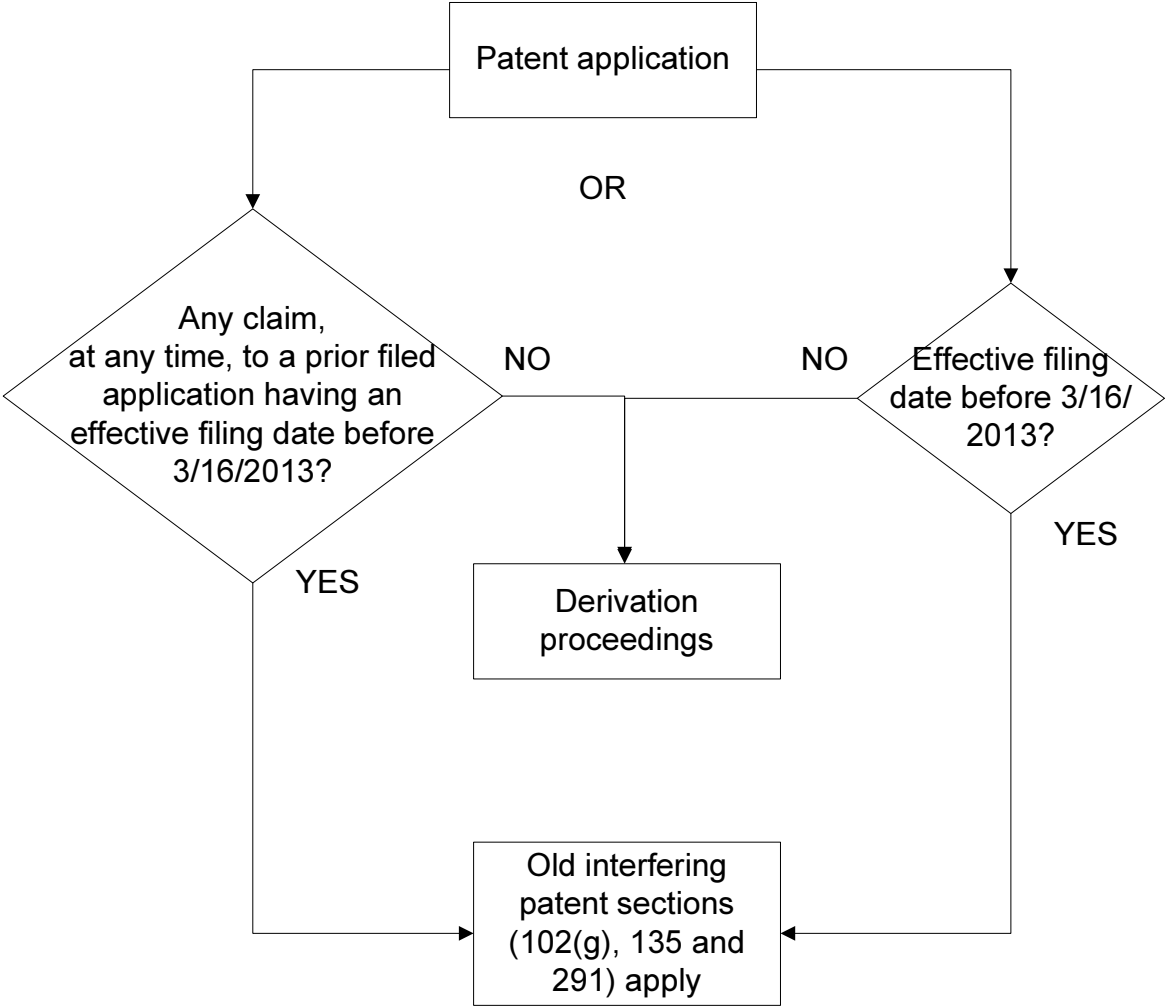
³ Although not as amendments to Title 35 U.S.C., a prioritized examination fee of \$4,800.00 is established under section 11(h)(1)(A) of the Act and a 15% surcharge on fees in sections 35 U.S.C. §§ 41(a), 41(b), 41(d)(1), and 132(b) is established under section 11(i)(1) of the Act. The effective date of these provisions is 10 days after September 16, 2011, pursuant to section 11(h)(4) and 11(i)(2)(A), respectively, of the Act.

surge of new applications is expected before the new 15% increase in fees on September 26, 2011, but it is yet to be seen whether applicants will rush to file before March 16, 2013 as multinational corporations may already operate under the first-to-file system internally.

Co-existence of New and Old 102 and 103 after 3/16/2013



New Definition for Interfering Patents (AIA, § 3(n)(2))



A. Sections of Title 35 of United States Code that were amended (* denotes new section; ** denotes rewritten section; *** denotes repealed section):

| | Amended section of Title 35 | Amending section of the Act | Effective date and section of the Act |
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| 1. | 35 U.S.C. § 2(b)(2) 35 U.S.C. § 2(b)(11) | 25 21(a) | 09/16/2012; 35 09/16/2012; 35 |
| 2. | 35 U.S.C. § 3(b)(6)* 35 U.S.C. § 3(e)(2) | 21(b) 20(i)(1) | 09/16/2012; 35 09/16/2012; 20(l) |
| 3. | 35 U.S.C. § 6 | 7(a)(1)-(2) | 09/16/2012; 7(e) |
| 4. | 35 U.S.C. § 32 | 3(k)(1); 9(a) | 09/16/2011; 3(k)(3); 9(b) |
| 5. | 35 U.S.C. § 41(a)-(b)** 35 U.S.C. § 41(h)(1)** | 11(a)-(e) 10(h)(1) | 09/16/2011; 11(j) 09/16/2011; 10(h)(2) |
| 6. | 35 U.S.C. § 100 | 3(a) | 03/16/2013; 3(n)(1) |
| 7. | 35 U.S.C. § 102** | 3(b) | 03/16/2013; 3(n)(1) |
| 8. | 35 U.S.C. § 103** | 3(c) | 03/16/2013; 3(n)(1) |
| 9. | 35 U.S.C. § 104*** | 3(d) | 03/16/2013; 3(n)(1) |
| 10. | 35 U.S.C. § 111(a) 35 U.S.C. § 111(b)(1)(A) and (2) 35 U.S.C. § 111(b)(8) | 4(a)(3) 4(d) 3(e)(2) | 09/16/2012; 4(e) 09/16/2012; 4(e) 03/16/2013; 3(e)(3) |
| 11. | 35 U.S.C. § 112 | 4(c) | 09/16/2012; 4(e) |
| 12. | 35 U.S.C. § 115** | 4(a)(1) and (a)(4) | 09/16/2012; 4(e) |
| 13. | 35 U.S.C. § 116 | 20(a) | 09/16/2012; 20(l) |
| 14. | 35 U.S.C. § 118** | 4(b)(1) | 09/16/2012; 4(e) |
| 15. | 35 U.S.C. § 119(a) 35 U.S.C. § 119(e)(1) | 3(g)(6) 15(b) | 03/16/2013; 3(n)(1) 09/16/2011; 15(c) |
| 16. | 35 U.S.C. § 120 | 15(b) | 09/16/2011; 15(c) |
| 17. | 35 U.S.C. § 121 | 4(a)(2) | 09/16/2012; 4(e) |
| 18. | 35 U.S.C. § 122(e)* | 8(a) | 09/16/2012; 8(b) |
| 19. | 35 U.S.C. § 123* | 10(g)(1) | 09/16/2011; 10(i)(1) |
| 20. | 35 U.S.C. § 134 | 3(j)(1), 3(j)(3)-(4) | 03/16/2013; 3(n)(1) |
| 21. | 35 U.S.C. § 135** | 3(i) | 03/16/2013; 3(n)(1) |
| 22. | 35 U.S.C. § 141** | 7(c)(1) | 09/16/2012; 7(e) |
| 23. | 35 U.S.C. § 143 | 7(c)(3) | 09/16/2012; 7(e) |
| 24. | 35 U.S.C. § 145 | 3(j)(1); 9(a) | 03/16/2013; 3(n)(1); 9(b) |

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| 25. | 35 U.S.C. § 146 | 3(j)(1); 9(a) | 03/16/2013; 3(n)(1); 09/16/2011; 9(b) |
| 26. | 35 U.S.C. § 154 | 9(a) | 03/16/2013; 3(n)(1); 09/16/2011; 9(b) |
| 27. | 35 U.S.C. § 155*** | 20(k) | 09/16/2012; 20(l) |
| 28. | 35 U.S.C. § 155A*** | 20(k) | 09/16/2012; 20(l) |
| 29. | 35 U.S.C. § 156 | 37(a) | 09/16/2011; 37(b) |
| 30. | 35 U.S.C. § 157*** | 3(e)(1) | 03/16/2013; 3(e)(3) |
| 31. | 35 U.S.C. § 172 | 3(g)(1) | 03/16/2013; 3(n)(1) |
| 32. | 35 U.S.C. § 184 | 20(b)(1)-(3) | 09/16/2012; 20(l) |
| 33. | 35 U.S.C. § 185 | 20(c) | 09/16/2012; 20(l) |
| 34. | 35 U.S.C. § 202(b)(3) 35 U.S.C. § 202(c)(2) 35 U.S.C. § 202(c)(3) 35 U.S.C. § 202(c)(7)(D) 35 U.S.C. § 202(c)(7)(E)(i) | 20(i)(2)(A) 3(g)(7)(A) 3(g)(7)(B) 20(i)(2)(B) 13(a) | 09/16/2012; 20(l) 03/16/2013; 3(n)(1) 03/16/2013; 3(n)(1) 09/16/2012; 20(l) 09/16/2011; 13(b) |
| 35. | 35 U.S.C. § 209 | 20(i)(3) | 09/16/2012; 20(l) |
| 36. | 35 U.S.C. § 251 | 4(b)(2) and 20(d) | 09/16/2012; 4(e) and 20(l) |
| 37. | 35 U.S.C. § 253 | 20(e) | 09/16/2012; 20(l) |
| 38. | 35 U.S.C. § 256 | 20(f) | 09/16/2012; 20(l) |
| 39. | 35 U.S.C. § 257* | 12(a)-(b) | 09/16/2012; 12(c) |
| 40. | 35 U.S.C. § 273** | 5(a)-(b) | 09/16/2011; 5(c) |
| 41. | 35 U.S.C. § 282(3) 35 U.S.C. § 282 (other than (3) above) | 15(a) 20(g) | 09/16/2011; 15(c) 09/16/2012; 20(l) |
| 42. | 35 U.S.C. § 287(a) 35 U.S.C. § 287(c)(2)(G) 35 U.S.C. § 287(c)(4) | 16(a)(1) 20(i)(3) 20(i)(4) | 09/16/2011; 16(a)(2) 09/16/2012; 20(l) 09/16/2012; 20(l) |
| 43. | 35 U.S.C. § 288 | 20(h) | 09/16/2012; 20(l) |
| 44. | 35 U.S.C. § 291* | 3(h)(1)-(2) | 03/16/2013; 3(n)(1) |
| 45. | 35 U.S.C. § 292 | 16(b) | 09/16/2011; 16(b)(4) |
| 46. | 35 U.S.C. § 293 | 9(a) | 09/16/2011; 9(b) |
| 47. | 35 U.S.C. § 298* | 17(a) | 09/16/2012; 35 |
| 48. | 35 U.S.C. § 299* | 19(d)(1) | 09/16/2011; 19(e) |
| 49. | 35 U.S.C. § 301** | 6(g)(1)-(2) | 09/16/2012; 6(g)(3) |
| 50. | 35 U.S.C. § 303 | 6(h)(1)(A) | 09/16/2012; 6(h)(1)(B) |
| 51. | 35 U.S.C. § 305 | 3(j) | 03/16/2013; 3(n)(1) |
| 52. | 35 U.S.C. § 306 | 6(h)(2)(A) | 09/16/2012; 6(h)(2)(B) |

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| 53. | 35 U.S.C. § 311** | 6(a)-(b) | 09/16/2012; 6(c) |
| 54. | 35 U.S.C. § 312** | 6(a)-(b) | 09/16/2012; 6(c) |
| 55. | 35 U.S.C. § 313** | 6(a)-(b) | 09/16/2012; 6(c) |
| 56. | 35 U.S.C. § 314** | 6(a)-(b) | 09/16/2012; 6(c) |
| 57. | 35 U.S.C. § 315** | 6(a)-(b) | 09/16/2012; 6(c) |
| 58. | 35 U.S.C. § 316** | 6(a)-(b) | 09/16/2012; 6(c) |
| 59. | 35 U.S.C. § 317** | 6(a)-(b) | 09/16/2012; 6(c) |
| 60. | 35 U.S.C. § 318** | 6(a)-(b) | 09/16/2012; 6(c) |
| 61. | 35 U.S.C. § 319* | 6(a)-(b) | 09/16/2012; 6(c) |
| 62. | 35 U.S.C. § 321* | 6(d)-(e) | 09/16/2012; 6(f) |
| 63. | 35 U.S.C. § 322* | 6(d)-(e) | 09/16/2012; 6(f) |
| 64. | 35 U.S.C. § 323* | 6(d)-(e) | 09/16/2012; 6(f) |
| 65. | 35 U.S.C. § 324* | 6(d)-(e) | 09/16/2012; 6(f) |
| 66. | 35 U.S.C. § 325* | 6(d)-(e) | 09/16/2012; 6(f) |
| 67. | 35 U.S.C. § 326* | 6(d)-(e) | 09/16/2012; 6(f) |
| 68. | 35 U.S.C. § 327* | 6(d)-(e) | 09/16/2012; 6(f) |
| 69. | 35 U.S.C. § 328* | 6(d)-(e) | 09/16/2012; 6(f) |
| 70. | 35 U.S.C. § 329* | 6(d)-(e) | 09/16/2012; 6(f) |
| 71. | 35 U.S.C. § 363 | 3(g)(3) | 03/16/2013; 3(n)(1) |
| 72. | 35 U.S.C. § 371 | 20(i)(5) | 09/16/2012; 20(l) |
| 73. | 35 U.S.C. § 374 | 3(g)(4) | 03/16/2013; 3(n)(1) |
| 74. | 35 U.S.C. § 375 | 3(g)(5) | 03/16/2013; 3(n)(1) |

B. Sections of Title 28 of United States Code that were amended (* denotes new section; ** denotes rewritten section):

| | Amended section of Title 28 | Amending section of the Act | Effective date section of the Act |
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| 1. | 28 U.S.C. § 1295(a)(1)** 28 U.S.C. § 1295(a)(4)(A) | 19(b) 7(c)(2) | 09/16/2011; 19(e) 09/16/2012; 7(e) |
| 2. | 28 U.S.C. § 1338 | 19(a) | 09/16/2011; 19(e) |
| 3. | 28 U.S.C. § 1454* | 19(c)(1) | 09/16/2011; 19(e) |

C. Sections of Title 51 of United States Code that were amended (* denotes new section; ** denotes rewritten section; *** denotes repealed section):

| | Amended section of Title 51 | Amending section of the Act | Effective date section of the Act |
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| 4. | 51 U.S.C. § 20135 | 7(d)(2) | 09/16/2012; 7(e) |

D. Sections of Title 42 of United States Code that were amended:

| | Amended section of Title 42 | Amending section of the Act | Effective date section of the Act |
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| 5. | 42 U.S.C. § 2182 | 7(d)(1) | 09/16/2012; 7(e) |

E. Sections of Title 35 of United States Code showing changes thereto and their corresponding effective date

1. Title 35 U.S.C.

| Existing section number | Existing section text | Amended section number | Amended section text | Effective date |
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| <p>35 U.S.C. § 2</p> <p>>>Back to index<<</p> | <p>(b)(2) ... (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; and</p> <p>(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;</p> | <p>35 U.S.C. § 2</p> | <p>(b)(2) ... (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; and</p> <p>(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; <u>and</u></p> <p><u>(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</u></p> | <p>1-year after September 16, 2011; not retroactive to patents issued before the date of effective date.</p> |

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| <p>>>Back to index<<</p> | <p>(b)(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;</p> | | <p><u>competitiveness without recovering the aggregate extra cost of providing such prioritization, notwithstanding section 41 or any other provision of law;</u> (b)(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, <u>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;</u></p> | <p>1-year after September 16, 2011; not retroactive to patents issued before the date of effective date.</p> |
| <p>35 U.S.C. § 3 >>Back to index<<</p> | <p>... (b)(6) None. ... (e)(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</p> | <p>35 U.S.C. § 3</p> | <p>... (b)(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</p> | <p>1-year after September 16, 2011; not retroactive to patents issued before the date of effective date.</p> |

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| | 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, ... | | 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 paragraph shall not be subject to the pay limitation under section 5306(e) or 5373 of title 5. ... (e)(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 that Act, ... | 1-year after September 16, 2011; not retroactive to patents issued before the date of effective date. |
| 35 U.S.C. § 6 (Board of Patent Appeals and Interferences) >>Back to index<< | (a) Establishment and Composition.— There shall be in the United States Patent and Trademark Office a Board of Patent Appeals and Interferences. The Director, the Deputy Director, the Commissioner | 35 U.S.C. § 6 (Board of Patent Appeals and Interferences Patent Trial and Appeal Board) | <u>(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</u> | 1-year after September 16, 2011; not retroactive to patents issued before the date of effective date. |

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| | <p>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.</p> <p>(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). 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.</p> <p>(c) Authority of the Secretary.— The Secretary of Commerce may, in his or her discretion, deem the appointment of an</p> | | <p><u>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.</u></p> <p><u>(b) Duties- The Patent Trial and Appeal Board shall--</u></p> <p><u>(1) on written appeal of an applicant, review adverse decisions of examiners upon applications for patents pursuant to section 134(a);</u></p> <p><u>(2) review appeals of reexaminations pursuant to section 134(b);</u></p> <p><u>(3) conduct derivation proceedings pursuant to section 135; and</u></p> | |
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| | <p>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.</p> <p>(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.</p> | | <p><u>(4) conduct inter partes reviews and post-grant reviews pursuant to chapters 31 and 32.</u></p> <p><u>(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.</u></p> <p><u>(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</u></p> | |
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| | | | <p><u>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.</u></p> | |
| <p>35 U.S.C. § 32 (Suspension or exclusion from practice)</p> <p>>>>Back to index<<</p> | <p>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, 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</p> | <p>35 U.S.C. § 32 (Suspension or exclusion from practice)</p> | <p>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, 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</p> | <p>(1) Effective to any case in which the time period for instituting a proceeding under section 32 of title 35, United States Code, had not lapsed before September 16, 2011.</p> |

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| | is an officer or employee of the United States Patent and Trademark Office to conduct the hearing required by this section. The United States District Court for the District of Columbia, 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. | | is an officer or employee of the United States Patent and Trademark Office to conduct the hearing required by this section. <u>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).</u> The United States District Court for the District of Columbia <u>Eastern District of Virginia</u> , 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. | On September 16, 2011 and applies to any civil action commenced on or after that date. |
| 35 U.S.C. § 41 (Patent Fees) >>Back to index<< | (a) The Director shall charge the following fees: (1) (A) On filing each application for an original patent, except in design or plant cases, | 35 U.S.C. § 41 | (a) <u>General Fees-</u> The Director shall charge the following fees: <u>(1) FILING AND BASIC NATIONAL FEES-</u> | (1) On September 16, 2011. |

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| | <p>\$690.</p> <p>(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.</p> <p>(C) On filing each provisional application for an original patent, \$150.</p> <p>(2) For issuing each original or reissue patent, except in design or plant cases, \$1,210.</p> <p>(3) In design and plant cases—</p> <p>(A) on filing each design application, \$310;</p> <p>(B) on filing each plant application, \$480;</p> <p>(C) on issuing each design patent, \$430; and</p> <p>(D) on issuing each plant patent, \$580.</p> <p>(4)</p> <p>(A) On filing each application for the reissue of a patent, \$690.</p> <p>(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</p> | | <p><u>(A) On filing each application for an original patent, except for design, plant, or provisional applications, \$330.</u></p> <p><u>(B) On filing each application for an original design patent, \$220.</u></p> <p><u>(C) On filing each application for an original plant patent, \$220.</u></p> <p><u>(D) On filing each provisional application for an original patent, \$220.</u></p> <p><u>(E) On filing each application for the reissue of a patent, \$330.</u></p> <p><u>(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.</u></p> <p><u>(G) In addition, excluding any sequence listing or computer program listing filed in an electronic medium as prescribed by the Director,</u></p> | |
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| | <p>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.</p> <p>(5) On filing each disclaimer, \$110.</p> <p>(6)</p> <p>(A) On filing an appeal from the examiner to the Board of Patent Appeals and Interferences, \$300.</p> <p>(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.</p> <p>(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, in which case the fee</p> | | <p><u>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.</u></p> <p><u>(2) EXCESS CLAIMS FEES-</u></p> <p><u>(A) IN GENERAL- In addition to the fee specified in paragraph (1)--</u></p> <p><u>(i) on filing or on presentation at any other time, \$220 for each claim in independent form in excess of 3;</u></p> <p><u>(ii) on filing or on presentation at any other time, \$52 for each claim (whether dependent or independent) in excess of 20; and</u></p> <p><u>(iii) for each application containing a multiple dependent claim, \$390.</u></p> | |
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| <p>>>Back to index<<</p> | <p>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</p> | | <p><u>(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.</u></p> <p><u>(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.</u></p> <p><u>(3) EXAMINATION FEES-</u></p> <p><u>(A) IN GENERAL-</u></p> <p><u>(i) For examination of each application for an original</u></p> | |
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| | <p>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.</p> <p>(13) For filing or later presentation of each independent claim in the national stage of an international application in excess of 3, \$78.</p> <p>(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.</p> <p>(15) For each national stage of an international application containing a multiple dependent claim, \$260.</p> <p>For the purpose of computing fees, a multiple dependent claim referred to in section 112 of this title or</p> | | <p><u>patent, except for design, plant, provisional, or international applications, \$220.</u></p> <p><u>(ii) For examination of each application for an original design patent, \$140.</u></p> <p><u>(iii) For examination of each application for an original plant patent, \$170.</u></p> <p><u>(iv) For examination of the national stage of each international application, \$220.</u></p> <p><u>(v) For examination of each application for the reissue of a patent, \$650.</u></p> <p><u>(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</u></p> | |
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| <p>>>Back to index<<</p> | <p>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.</p> <p>(b) The Director shall charge the following fees for maintaining in force all patents based on applications filed on or after December 12, 1980:</p> <p>(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.</p> <p>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</p> | | <p><u>shall apply to the payment of the fee specified in subparagraph (A) with respect to an international application.</u></p> <p><u>(4) ISSUE FEES-</u></p> <p><u>(A) For issuing each original patent, except for design or plant patents, \$1,510.</u></p> <p><u>(B) For issuing each original design patent, \$860.</u></p> <p><u>(C) For issuing each original plant patent, \$1,190.</u></p> <p><u>(D) For issuing each reissue patent, \$1,510.</u></p> <p><u>(5) DISCLAIMER FEE- On filing each disclaimer, \$140.</u></p> <p><u>(6) APPEAL FEES-</u></p> <p><u>(A) On filing an appeal from the examiner to the Patent Trial and Appeal Board, \$540.</u></p> <p><u>(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,</u></p> | |
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| | <p>the payment of an applicable maintenance fee. No fee may be established for maintaining a design or plant patent in force.</p> <p>(c)</p> <p>(1) 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.</p> <p>(2) A patent, the term of which has been maintained as a result of the acceptance</p> | | <p><u>\$1,080.</u></p> <p><u>(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.</u></p> <p><u>(8) EXTENSION FEES- For petitions for 1-month extensions of time to take actions required by the Director in an application--</u></p> <p><u>(A) on filing a first petition, \$130;</u></p> <p><u>(B) on filing a second petition, \$360; and</u></p> <p><u>(C) on filing a third or subsequent petition, \$620.</u></p> <p><u>(b) Maintenance Fees-</u></p> <p><u>(1) IN GENERAL- The</u></p> | |
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| <p>>>Back to index<<</p> | <p>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</p> | | <p><u>Director shall charge the following fees for maintaining in force all patents based on applications filed on or after December 12, 1980:</u></p> <p><u>(A) Three years and 6 months after grant, \$980.</u></p> <p><u>(B) Seven years and 6 months after grant, \$2,480.</u></p> <p><u>(C) Eleven years and 6 months after grant, \$4,110.</u></p> <p><u>(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.</u></p> <p><u>(3) NO MAINTENANCE FEE FOR DESIGN OR PLANT</u></p> | |
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| | <p>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.</p> <p>(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:</p> <p>(1) For recording a document affecting title, \$40 per</p> | | <p><u>PATENT- No fee may be established for maintaining a design or plant patent in force.</u></p> <p>(c)(1) The Director <u>(c) Delays in payment of Maintenance Fees – (1) Acceptance- The Director</u> 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.</p> <p>(2) A patent <u>(2) Effect on</u></p> | |
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| <p>>>Back to index<<</p> | <p>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 [1] of this title with uncertified printed copies of the specifications and drawings for all patents in that year shall be \$50. (e) 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 with a copy of the specifications and drawings for all patents referred to in that notice without charge. (f) 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</p> | | <p><u>Rights of Others-</u> 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</p> | |
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| | <p>the Consumer Price Index, as determined by the Secretary of Labor. Changes of less than 1 per centum may be ignored.</p> <p>(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.</p> <p>(h)</p> <p>(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.</p> <p>(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.</p> | | <p>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.</p> <p><u>(d) Patent Search and Other Fees-</u></p> <p><u>(1) PATENT SEARCH FEES-</u></p> <p><u>(A) IN GENERAL- The Director shall charge the fees specified under subparagraph (B) for the search of each application</u></p> | |
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| <p>>>Back to index<<</p> | <p>(i) (1) 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 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 may establish reasonable fees for access by the public to the</p> | | <p><u>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.</u></p> <p><u>(B) SPECIFIC FEES- The fees referred to in subparagraph (A) are--</u></p> <p><u>(i) \$540 for each application for an original patent, except for design, plant, provisional, or international applications;</u></p> <p><u>(ii) \$100 for each application for an original design patent;</u></p> <p><u>(iii) \$330 for each application for an original plant patent;</u></p> <p><u>(iv) \$540 for the national stage of each international application; and</u></p> <p><u>(v) \$540 for each application for the reissue of a patent.</u></p> <p><u>(C) APPLICABILITY OF OTHER PROVISIONS- The provisions of paragraphs (3) and (4) of</u></p> | |
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| | <p>automated search systems of the Patent and Trademark 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.</p> <p>(4) 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.</p> | | <p><u>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.</u></p> <p><u>(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.</u></p> <p><u>(2) OTHER FEES-</u></p> <p><u>(A) IN GENERAL- The Director shall establish fees for all other processing services, or materials relating to patents not specified in</u></p> | |
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| <p>>>Back to index<<</p> | | | <p><u>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:</u></p> <p><u>(i) For recording a document affecting title, \$40 per property.</u></p> <p><u>(ii) For each photocopy, \$.25 per page.</u></p> <p><u>(iii) For each black and white copy of a patent, \$3.</u></p> <p><u>(B) COPIES FOR LIBRARIES-</u> <u>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.</u></p> <p>...</p> <p><u>(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</u></p> | |
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| <p>>>Back to index<<</p> | | | <p>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 with a copy of the specifications and drawings for all patents referred to in that notice without charge.</p> <p>(f) The fees <u>Adjustment of Fees-</u> 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.</p> <p>(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.</p> <p><u>(h) Fees for Small Entities-</u></p> | <p>(2) Upon the expiration of 60-day beginning on September 16, 2011.</p> |
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| | | | <p><u>(1) REDUCTIONS IN FEES-</u> <u>Subject to paragraph (3),</u> <u>fees charged under</u> <u>subsections (a), (b), and</u> <u>(d)(1) shall be reduced by 50</u> <u>percent with respect to their</u> <u>application to any small</u> <u>business concern as defined</u> <u>under section 3 of the Small</u> <u>Business Act, and to any</u> <u>independent inventor or</u> <u>nonprofit organization as</u> <u>defined in regulations issued</u> <u>by the Director.</u></p> <p><u>(2) SURCHARGES AND</u> <u>OTHER FEES-</u> <u>With respect to</u> <u>its application to any entity</u> <u>described in paragraph (1),</u> <u>any surcharge or fee charged</u> <u>under subsection (c) or (d)</u> <u>shall not be higher than the</u> <u>surcharge or fee required of</u> <u>any other entity under the</u> <u>same or substantially similar</u> <u>circumstances.</u></p> <p><u>(3) REDUCTION FOR</u> <u>ELECTRONIC FILING-</u> <u>The fee</u> <u>charged under subsection</u> <u>(a)(1)(A) shall be reduced by</u> <u>75 percent with respect to its</u> <u>application to any entity to</u> <u>which paragraph (1) applies,</u> <u>if the application is filed by</u></p> | |
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| | | | <p><u>electronic means as prescribed by the Director.</u></p> <p>(f)</p> <p>(1) The Director <u>(i) Electronic Patent and Trademark Data-</u> <u>(1) Maintenance of Collections-</u> 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.</p> <p>(2) The Director <u>(2)</u> <u>AVAILABILITY OF AUTOMATED SEARCH SYSTEMS-</u> 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</p> | |
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| | | | <p>trademark information, using a variety of automated methods, including electronic bulletin boards and remote access by users to mass storage and retrieval systems.</p> <p>(3) The Director <u>(3) ACCESS FEES-</u> The Director may establish reasonable fees for access by the public to the automated search systems of the Patent and Trademark 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.</p> <p>(4) The Director <u>(4) ANNUAL REPORT TO CONGRESS-</u> 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</p> | |
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| | | | the Federal Register. The Director shall provide an opportunity for the submission of comments by interested persons on each such report. | |
| <p>35 U.S.C. § 100</p> <p>>>Back to index<<</p> | <p>(a) The term "invention" means invention or discovery.</p> <p>(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.</p> <p>(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.</p> <p>(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.</p> <p>(e) The term "third-party requester" means a person requesting ex parte reexamination under section 302 or inter partes reexamination under section 311 who is not the patent owner.</p> | <p>35 U.S.C. § 100</p> | <p>(a) The term "invention" means invention or discovery.</p> <p>(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.</p> <p>(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.</p> <p>(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.</p> <p>(e) The term "third-party requester" means a person requesting ex parte reexamination under section 302 or inter partes reexamination under section 311 who is not the patent owner;</p> <p>(f) The term inventor means</p> | <p>Upon expiration of 18 months beginning on September 16, 2011 and applies to (A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) 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.</p> |

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,

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| | | | <p><u>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(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.</u></p> <p><u>(j) The term claimed invention means the subject matter defined by a claim in a patent or an application for a patent.</u></p> | |
| <p>35 U.S.C. § 102 (Conditions for patentability; novelty and loss of right to patent)</p> <p>>>Back to index<<</p> | <p>A person shall be entitled to a patent unless—</p> <p>(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</p> <p>(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</p> | <p>35 U.S.C. § 102 (Conditions for patentability; novelty and loss of right to patent)</p> <p>(rewritten)</p> | <p>(a) Novelty; Prior Art--A person shall be entitled to a patent unless--</p> <p>(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</p> <p>(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed</p> | <p>Upon expiration of 18 months beginning on September 16, 2011 and applies to (A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) of title 35, United States Code, that is on or after the effective date described in this paragraph; or</p> <p>(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.</p> |

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| | <p>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), 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) shall have the effects for</p> | | <p>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.</p> <p>(b) Exceptions-</p> <p>(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--</p> <p>(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</p> <p>(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</p> | |
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| <p>>>Back to index<<</p> | <p>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</p> <p>(f) he did not himself invent the subject matter sought to be patented, or</p> <p>(g) (1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or</p> <p>(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</p> | | <p>matter disclosed directly or indirectly from the inventor or a joint inventor.</p> <p>(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS- A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if--</p> <p>(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;</p> <p>(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</p> <p>(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</p> | |
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| | <p>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.</p> | | <p>or subject to an obligation of assignment to the same person.</p> <p>(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--</p> <p>(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;</p> <p>(2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and</p> <p>(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the</p> | |
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| <p>>>Back to index<<</p> | | | <p>parties to the joint research agreement.</p> <p>(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--</p> <p>(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or</p> <p>(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), 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.’.</p> | |
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| | | | (2) CONTINUITY OF INTENT UNDER THE CREATE ACT- The enactment of section 102(c) of title 35, United States Code, under paragraph (1) of this subsection is done with the same intent to promote joint research activities that was expressed, including in the legislative history, through the enactment of the Cooperative Research and Technology Enhancement Act of 2004 (Public Law 108-453; the CREATE Act'), the amendments of which are stricken by subsection (c) of this section. The United States Patent and Trademark Office shall administer section 102(c) of title 35, United States Code, in a manner consistent with the legislative history of the CREATE Act that was relevant to its administration by the United States Patent and Trademark Office. | |
| 35 U.S.C. § 103 (Conditions for patentability; non-obvious subject matter) >>Back to index<< | (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, if the differences | 35 U.S.C. § 103 (conditions for patentability; non-obvious subject matter) (rewritten) | 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 | Upon expiration of 18 months beginning on September 16, 2011 and applies to (A) a claim to a claimed invention that has an effective filing date as |

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| | <p>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.</p> <p>(b)</p> <p>(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 and nonobvious under subsection (a) of this section shall be considered nonobvious if—</p> <p>(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</p> <p>(B) the composition of</p> | | <p>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.</p> | <p>defined in section 100(i) of title 35, United States Code, that is on or after the effective date described in this paragraph; or</p> <p>(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.</p> |
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| | <p>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.</p> <p>(2) A patent issued on a process under paragraph (1)—</p> <p>(A) shall also contain the claims to the composition of matter used in or made by that process, or</p> <p>(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.</p> <p>(3) For purposes of paragraph (1), the term “biotechnological process” means—</p> <p>(A) a process of genetically altering or otherwise inducing a single- or multi-celled organism to—</p> <p>(i) express an exogenous nucleotide sequence,</p> <p>(ii) inhibit, eliminate, augment, or alter expression of an endogenous nucleotide sequence, or</p> <p>(iii) express a specific physiological characteristic not naturally associated with</p> | | | |
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| | <p>said organism;</p> <p>(B) cell fusion procedures yielding a cell line that expresses a specific protein, such as a monoclonal antibody; and</p> <p>(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).</p> <p>(c)</p> <p>(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, 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.</p> <p>(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</p> | | | |
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| | <p>obligation of assignment to the same person if—</p> <p>(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;</p> <p>(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and</p> <p>(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.</p> <p>(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.</p> | | | |
| <p>35 U.S.C. § 104 (invention made abroad)</p> <p>>>Back to index<<</p> | <p>(a) In General.—</p> <p>(1) Proceedings.— In proceedings in the Patent and Trademark Office, in the courts, and before any other</p> | <p>Repealed.</p> | <p>None.</p> | <p>Upon expiration of 18 months beginning on September 16, 2011 and applies to (A) a claim to a claimed invention that has an</p> |

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| | <p>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.</p> <p>(2) Rights.— If an invention was made by a person, civil or military—</p> <p>(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,</p> <p>(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</p> <p>(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,</p> <p>that person shall be entitled to the same rights of priority in the United States with</p> | | | <p>effective filing date as defined in section 100(i) of title 35, United States Code, that is on or after the effective date described in this paragraph; or</p> <p>(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.</p> |
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| | <p>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.</p> <p>(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.</p> <p>(b) Definitions.— As used in this section—</p> <p>(1) the term “NAFTA country” has the meaning given that term in section 2(4) of the</p> | | | |
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| | <p>North American Free Trade Agreement Implementation Act; and</p> <p>(2) the term "WTO member country" has the meaning given that term in section 2(10) of the Uruguay Round Agreements Act.</p> | | | |
| <p>35 U.S.C. § 111</p> <p>>>Back to index<<</p> | <p>(a)</p> <p>(1) Written application.— An 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.</p> <p>(2) Contents.— Such application shall include—</p> <p>(A) a specification as prescribed by section 112 of this title;</p> <p>(B) a drawing as prescribed by section 113 of this title; and</p> <p>(C) an oath by the applicant as prescribed by section 115 of this title.</p> <p>(3) Fee and oath.— The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such</p> | <p>35 U.S.C. § 111</p> | <p>(a)</p> <p>(1) Written application.— An 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.</p> <p>(2) Contents.— Such application shall include—</p> <p>(A) a specification as prescribed by section 112 of this title;</p> <p>(B) a drawing as prescribed by section 113 of this title; and</p> <p>(C) an oath by the applicant <u>or declaration</u> as prescribed by section 115 of this title.</p> <p>(3) Fee and oath <u>or declaration</u>.— The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such</p> | <p>(a): Upon expiration of the 1-year period beginning on September 16, 2011 and applies to any patent application that is filed on or after that effective date.</p> |

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| | <p>conditions, including the payment of a surcharge, as may be prescribed by the Director.</p> <p>(4) Failure to submit.— Upon failure to submit the fee and oath 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 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.</p> <p>(b)</p> <p>(1)(A) a specification as prescribed by the first paragraph of section 112 of this title; and...</p> <p>(2) CLAIM.-A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.</p> <p>...</p> <p>(8) The provisions of this title relating to applications for</p> | | <p>period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.</p> <p>(4) Failure to submit.— Upon failure to submit the fee and oath <u>or declaration</u> 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 <u>or declaration</u> 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.</p> <p>(b)</p> <p>(1)(A) a specification as prescribed by the first paragraph of section 112(a) of this title <u>section 112(a)</u>; and...</p> <p>(2) CLAIM.-A claim, as required by the second through fifth paragraphs of section 112 <u>subsections (b) through (e) of section 112</u>, shall not be required in a</p> | <p>(1)(A) and (2): Upon expiration of the 1-year period beginning on September 16, 2011 and applies to any patent application that is filed on or after that effective date.</p> |
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| | <p>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 of this title.</p> | | <p>provisional application. ... (8) 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 <u>sections 131 and 135</u> of this title.</p> | <p>(8): Upon the expiration of the 18 months period beginning on September 16, 2011 and applies to any request for a statutory invention registration filed on or after that effective date.</p> |
| <p>35 U.S.C. § 112 >>Back to index<<</p> | <p>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. 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. A claim may be written in</p> | <p>35 U.S.C. § 112</p> | <p>(a) <u>In General-</u> 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. <u>carrying out the invention.</u> (b) <u>Conclusion-</u> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the</p> | <p>Effect upon the expiration of the 1-year period beginning on September 16, 2011 and shall apply to any patent application that is filed on or after that effective date.</p> |

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| | <p>independent or, if the nature of the case admits, in dependent or multiple dependent form. Subject to the following paragraph, 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.</p> <p>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.</p> <p>An element in a claim for a</p> | | <p>applicant inventor or a joint inventor regards as his <u>the</u> invention.</p> <p>(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, <u>(d) Reference in Dependent Forms-</u> <u>Subject to subsection (e),</u> 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.</p> <p><u>(e) Reference in Multiple Dependent Form-</u> 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</p> | |
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| | 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. | | dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered. <u>(f) Element in Claim for a Combination-</u> 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. | |
| 35 U.S.C. § 115 (Oath of applicant) >>Back to index<< | 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 | 35 U.S.C. § 115 (Oath of applicant Inventor's oath or declaration) (rewritten) | (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 | Upon the expiration of 1-year beginning on September 16, 2011 and applies to any patent application that is filed on or after that effective date. |

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| | <p>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 is 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. 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).</p> | | <p>for patent shall execute an oath or declaration in connection with the application.</p> <p>(b) Required Statements- An oath or declaration under subsection (a) shall contain statements that--</p> <p>(1) the application was made or was authorized to be made by the affiant or declarant; and</p> <p>(2) such individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.</p> <p>(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).</p> <p>(d) Substitute Statement-</p> <p>(1) IN GENERAL- In lieu of executing an oath or declaration under subsection</p> | |
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| <p>>> Back to index <<</p> | | | <p>(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.</p> <p>(2) PERMITTED CIRCUMSTANCES- A substitute statement under paragraph (1) is permitted with respect to any individual who--</p> <p>(A) is unable to file the oath or declaration under subsection (a) because the individual--</p> <p>(i) is deceased;</p> <p>(ii) is under legal incapacity; or</p> <p>(iii) cannot be found or reached after diligent effort; or</p> <p>(B) is under an obligation to assign the invention but has refused to make the oath or declaration required under subsection (a).</p> | |
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| | | | <p>(3) CONTENTS- A substitute statement under this subsection shall--</p> <p>(A) identify the individual with respect to whom the statement applies;</p> <p>(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</p> <p>(C) contain any additional information, including any showing, required by the Director.</p> <p>(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.</p> <p>(f) Time for Filing- A notice of allowance under section 151 may be provided to an</p> | |
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| <p>>>Back to index<<</p> | | | <p>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).</p> <p>(g) Earlier-Filed Application Containing Required Statements or Substitute Statement-</p> <p>(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 the benefit under section 120, 121, or 365(c) of the filing of an earlier-filed application, if--</p> <p>(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;</p> | |
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| | | | <p>(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</p> <p>(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.</p> <p>(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.</p> <p>(h) Supplemental and Corrected Statements; Filing Additional Statements-</p> <p>(1) IN GENERAL- Any person making a statement required under this section may</p> | |
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| | | | <p>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.</p> <p>(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 application 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.</p> <p>(3) SAVINGS CLAUSE- A patent shall not be invalid or unenforceable based upon the failure to comply with a</p> | |
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| | | | <p>requirement under this section if the failure is remedied as provided under paragraph (1).</p> <p>(i) 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.</p> | |
| <p>35 U.S.C. § 116</p> <p>>>Back to index<<</p> | <p>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...</p> <p>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</p> | <p>35 U.S.C. § 116</p> | <p><u>(a) Joint Inventions-</u> 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...</p> <p><u>(b) Omitted Inventor-</u> 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</p> | <p>Upon the expiration of 1-year beginning on September 16, 2011 and applies to proceedings commenced on or after that effective date.</p> |

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| | <p>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.</p> <p>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.</p> | | <p>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.</p> <p><u>(c) Correction of Errors in Application-</u> 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.</p> | |
| <p>35 U.S.C. § 118</p> <p>>>Back to index<<</p> | <p>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</p> | <p>35 U.S.C. § 118</p> <p>(rewritten)</p> | <p>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</p> | <p>Upon the expiration of the 1-year beginning on September 16, 2011 and applies to any patent application that is filed on or after that effective date.</p> |

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| | <p>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.</p> | | <p>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.</p> | |
| <p>35 U.S.C. § 119 >>Back to index<<</p> | <p>(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</p> | | <p>(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</p> | <p>Upon the expiration of 18 months beginning on September 16, 2011 and applies to and applies (A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) 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.</p> |

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| | <p>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 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.</p> <p>...</p> <p>(e)(1) An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such</p> | | <p>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 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.</p> <p>...</p> <p>(e)(1) An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112(a) <u>(other than the requirement to disclose the best mode)</u> of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional</p> | |
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| | <p>invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title 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. 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, to accept an unintentionally delayed</p> | | <p>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, if the application for patent filed under section 111(a) or section 363 of this title 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. 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</p> | <p>Effective on the date of the enactment; prospective effectiveness.</p> |
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| | submission of an amendment under this subsection during the pendency of the application | | surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application | |
| 35 U.S.C. § 120 >> Back to index << | <p>An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named 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</p> | 35 U.S.C. § 120 | <p>An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112(a) <u>(other than the requirement to disclose the best mode)</u> of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named <u>which names an inventor or joint inventor</u> 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</p> | Upon September 16, 2011. |

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| | <p>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, to accept an unintentionally delayed submission of an amendment under this section.</p> | | <p>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, to accept an unintentionally delayed submission of an amendment under this section.</p> | |
| <p>35 U.S.C. § 121 >>Back to index<<</p> | <p>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 it shall be entitled to the benefit of the filing date of</p> | <p>35 U.S.C. § 121</p> | <p>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 it shall be entitled to the benefit of the filing date of</p> | <p>Upon the expiration of 1-year beginning on September 16, 2011 and applies to any patent application that is filed on or after that effective date.</p> |

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| | <p>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.</p> | | <p>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.</p> | |
| <p>35 U.S.C. § 122(e) >>Back to index<<</p> | None | <p>35 U.S.C. § 122(e)</p> | <p><u>Preissuance Submissions by Third Parties-</u> (1) <u>IN GENERAL-</u> Any third</p> | <p>Upon the expiration of 1-year beginning on September 16, 2011 and applies to any patent</p> |

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| | | | <p><u>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--</u></p> <p><u>(A) the date a notice of allowance under section 151 is given or mailed in the application for patent; or</u></p> <p><u>(B) the later of--</u></p> <p><u>(i) 6 months after the date on which the application for patent is first published under section 122 by the Office, or</u></p> <p><u>(ii) the date of the first rejection under section 132 of any claim by the examiner during the examination of the application for patent.</u></p> <p><u>(2) OTHER REQUIREMENTS- Any submission under paragraph (1) shall--</u></p> <p><u>(A) set forth a concise</u></p> | <p>application filed before, on or after that effective date.</p> |
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| | | | <p><u>description of the asserted relevance of each submitted document;</u></p> <p><u>(B) be accompanied by such fee as the Director may prescribe; and</u></p> <p><u>(C) include a statement by the person making such submission affirming that the submission was made in compliance with this section.</u></p> | |
| <p>35 U.S.C. § 123</p> <p>>>Back to index<<</p> | None | 35 U.S.C. § 123 (Micro entity defined) | <p>(a) In General- For purposes of this title, the term micro entity means an applicant who makes a certification that the applicant--</p> <p>(1) qualifies as a small entity, as defined in regulations issued by the Director;</p> <p>(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;</p> | On September 16, 2011. |

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| | | | <p>(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</p> <p>(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.</p> | |
| | | | (b) Applications Resulting | |

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| | | | <p>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.</p> <p>(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).</p> <p>(d) Institutions of Higher Education- For purposes of this section, a micro entity shall include an applicant who certifies that--</p> | |
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| <p>>>Back to index<<</p> | | | <p>(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</p> <p>(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.</p> <p>(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</p> | |
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| | | | 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. | |
| <p>35 U.S.C. § 134 (Appeal to the Board of Patent Appeals and Interferences)</p> <p>>>Back to index<<</p> | <p>(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, having once paid the fee for such appeal.</p> <p>(b) PATENT OWNER.- A patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.</p> <p>(c) THIRD-PARTY.- A third-party requester in an inter partes proceeding may appeal to the Board of Patent Appeals and</p> | <p>35 U.S.C. § 134 (Appeal to the Board of Patent Appeals and Interferences Patent Trial and Appeal Board)</p> | <p>(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 <u>Patent Trial and Appeal Board</u>, having once paid the fee for such appeal.</p> <p>(b) PATENT OWNER.- A patent owner in any reexamination proceeding <u>an reexamination</u> may appeal from the final rejection of any claim by the primary examiner to the Board of Patent Appeals and Interferences <u>Patent Trial and Appeal Board</u>, having once paid the fee for such appeal.</p> <p>(c) THIRD-PARTY.- A third-party requester in an inter</p> | <p>Upon expiration of 18 months beginning on September 16, 2011 and applies to (A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) 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.</p> |

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| | Interferences 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. | | partes proceeding may appeal to the Board of Patent Appeals and Interferences 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. | |
| 35 U.S.C. § 135 (Interferences) >>Back to index<< | (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 | 35 U.S.C. § 135 (Interferences Derivation Proceedings) (rewritten) | (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 | Upon expiration of 18 months beginning on September 16, 2011 and applies to (A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) 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. |

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| | <p>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.</p> <p>(b)</p> <p>(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.</p> <p>(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 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.</p> | | <p>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.</p> <p>(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</p> | |
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| | <p>(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,</p> | | <p>forth standards for the conduct of derivation proceedings, including requiring parties to provide sufficient evidence to prove and rebut a claim of derivation.</p> <p>(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.</p> <p>(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</p> | |
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| | <p>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.</p> <p>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 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.</p> <p>Any discretionary action of the Director under this subsection shall be reviewable under section 10 of the Administrative Procedure Act.</p> <p>(d) Parties to a patent interference, within such</p> | | <p>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.</p> <p>(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 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</p> | |
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| <p>>>Back to index<<</p> | <p>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 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.</p> | | <p>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.</p> <p>(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</p> | |
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| | | | of the claimed inventions involved in the proceeding. | |
| <p>35 U.S.C. § 141</p> <p>>>Back to index<<</p> | <p>An applicant dissatisfied with the decision in an appeal to the Board of Patent Appeals and Interferences under section 134 of this title 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. 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 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</p> | <p>35 U.S.C. § 141</p> <p>(rewritten)</p> | <p>(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.</p> <p>(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.</p> <p>(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</p> | <p>Upon the expiration of 1-year beginning on September 16, 2011.</p> |

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| | <p>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, files notice with the Director that the party elects to have all further proceedings conducted as provided in section 146 of this title. 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, the decision appealed from shall govern the further proceedings in the case.</p> | | <p>be) may appeal the Board's decision only to the United States Court of Appeals for the Federal Circuit.</p> <p>(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.</p> | |
| <p>35 U.S.C. § 143 >>Back to index<<</p> | <p>With respect to an appeal described in section 142 of this title, the Director shall</p> | <p>35 U.S.C. § 143</p> | <p>With respect to an appeal described in section 142 of this title, the Director shall</p> | <p>Upon the expiration of 1-year beginning on September 16, 2011.</p> |

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| | <p>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. 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. 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</p> | | <p>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. <u>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.</u> The court shall, before hearing an appeal, give notice of the</p> | |
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| | | | time and place of the hearing to the Director and the parties in the appeal. 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. | |
| <p>35 U.S.C. § 145</p> <p>>>Back to index<<</p> | <p>An applicant dissatisfied with the decision of the Board of Patent Appeals and Interferences in an appeal under section 134(a) of this title 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 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, as the facts in the case may appear, and such adjudication shall authorize the Director to</p> | <p>35 U.S.C. § 145</p> | <p>An applicant dissatisfied with the decision of the Board of Patent Appeals and Interferences <u>Patent Trial and Appeal Board</u> in an appeal under section 134(a) of this title 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 <u>Eastern District of Virginia</u> 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 <u>Patent Trial and Appeal Board</u>, as the facts in</p> | <p>Upon the expiration of 18 months on the beginning of September 16, 2011 and applies to (A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) 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; except for the amendment regarding United District Court for the Eastern District of Virginia, which is effective on September 16, 2011.</p> |

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| | issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant. | | 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. | |
| 35 U.S.C. § 146 (Civil action in case of interference) >>Back to index<< | Any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences on the interference, 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, 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 | 35 U.S.C. § 146 (Civil action in case of interference derivation proceedings) | Any party to an interference <u>derivation proceeding</u> dissatisfied with the decision of the Board of Patent Appeals and Interferences <u>Patent Trial and Appeal Board</u> on the interference <u>derivation proceeding</u> , 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, 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 | Upon the expiration of 18 months beginning on September 16, 2011 and applies to (A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) 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; except for the amendment regarding United District Court for the Eastern District of Virginia, which is effective on September 16, 2011. |

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| | <p>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 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</p> | | <p>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 <u>Eastern District of Virginia</u> 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</p> | |
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| | 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. | | 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. | |
| 35 U.S.C. § 154 (contents and term of patent; provisional rights) >>Back to index<< | ... (b)(1)(A)(iii) act on an application within 4 months after the date of a decision by the Board of Patent Appeals and Interferences 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... (b)(1)(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 | 35 U.S.C. § 154 (contents and term of patent; provisional rights) | ... (b)(1)(A)(iii) act on an application within 4 months after the date of a decision by the Board of Patent Appeals and Interferences <u>Patent Trial and Appeal Board</u> 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... (b)(1)(B)(ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order | Upon the expiration of 18 months beginning on September 16, 2011; except for the amendment regarding United District Court for the Eastern District of Virginia, which is effective on September 16, 2011. |

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| | <p>time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or...</p> <p>(b)(1)(C)(iii) appellate review by the Board of Patent Appeals and Interferences 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...</p> <p>(b)(4)(A) An applicant dissatisfied with a determination made by the Director under paragraph (3) shall have remedy by a civil action against the Director filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent. Chapter 7 of title 5 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</p> | | <p>under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences <u>Patent Trial and Appeal Board</u> or by a Federal court; or...</p> <p>(b)(1)(C)(iii) appellate review by the Board of Patent Appeals and Interferences <u>Patent Trial and Appeal Board</u> 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...</p> <p>(b)(4)(A) An applicant dissatisfied with a determination made by the Director under paragraph (3) shall have remedy by a civil action against the Director filed in the United States District Court for the District of Columbia <u>Eastern District of Virginia</u> within 180 days after the grant of the patent. Chapter 7 of title 5 shall apply to such action. Any</p> | |
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| | Director, and the Director shall thereafter alter the term of the patent to reflect such change. | | 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. | |
| 35 U.S.C. § 155 >>Back to index<< | 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 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, which stay was in effect on January 1, 1981, by a length of time to be measured from | Repealed. | None. | Upon the expiration of 1-year beginning on September 16, 2011 and applies to proceedings commenced on or after that effective date. |

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| | <p>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 90 days of the date of enactment of this section 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</p> | | | |
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| | original patent, and an appropriate notice shall be published in the Official Gazette of the Patent and Trademark Office. | | | |
| <p>35 U.S.C. § 155A</p> <p>>>Back to index<<</p> | <p>(a) Notwithstanding section 154 of this title, the term of each of the following patents shall be extended in accordance with this section:</p> <p>(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 -</p> <p>(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;</p> <p>(B) in 1977 the patentee submitted to the Federal Food and Drug Administration the results of a health effects test to</p> | Repealed. | None. | Upon the expiration of 1-year beginning on September 16, 2011 and applies to proceedings commenced on or after that effective date. |

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| | <p>evaluate the carcinogenic potential of such product;</p> <p>(C) the Federal Food and Drug Administration approved, by letter dated December 18, 1979, the new drug application for such application; and</p> <p>(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.</p> <p>(2) Any patent which encompasses within its scope a process for using the composition described in paragraph (1).</p> <p>(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.</p> <p>(c) The patentee of any</p> | | | |
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| | <p>patent described in subsection (a) of this section shall, within ninety days after the date of enactment of this section, notify the Director of the number of any patent so extended. On receipt of such notice, the Director shall confirm 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.</p> | | | |
| <p>35 U.S.C. § 156 >>Back to index<<</p> | <p>(d)(1) To obtain an extension of the term of a patent under this section, the owner of record of the patent or its agent shall submit an application to the Director. Except as provided in paragraph (5), such an application may only be submitted within the sixty-day period beginning on the date the product received permission under the provision of law under which the applicable regulatory review period occurred for commercial marketing or use. The application shall contain— (A) the identity of the</p> | <p>35 U.S.C. § 156</p> | <p>(d)(1) To obtain an extension of the term of a patent under this section, the owner of record of the patent or its agent shall submit an application to the Director. Except as provided in paragraph (5), such an application may only be submitted within the sixty-day period beginning on the date the product received permission under the provision of law under which the applicable regulatory review period occurred for commercial marketing or use. The application shall contain— (A) the identity of the</p> | <p>On September 16, 2011 and applies to any application for extension of a patent term under 35 U.S.C. § 156 that is pending on, that is filed after, or as to which a decision regarding the application is subject to judicial review on, the date of September 16, 2011.</p> |

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| | <p>approved product and the Federal statute under which regulatory review occurred;</p> <p>(B) the identity of the patent for which an extension is being sought and the identity of each claim of such patent which claims the approved product or a method of using or manufacturing the approved product;</p> <p>(C) information to enable the Director to determine under subsections (a) and (b) the eligibility of a patent for extension and the rights that will be derived from the extension and information to enable the Director and the Secretary of Health and Human Services or the Secretary of Agriculture to determine the period of the extension under subsection (g);</p> <p>(D) a brief description of the activities undertaken by the applicant during the applicable regulatory review period with respect to the approved product and the significant dates applicable</p> | | <p>approved product and the Federal statute under which regulatory review occurred;</p> <p>(B) the identity of the patent for which an extension is being sought and the identity of each claim of such patent which claims the approved product or a method of using or manufacturing the approved product;</p> <p>(C) information to enable the Director to determine under subsections (a) and (b) the eligibility of a patent for extension and the rights that will be derived from the extension and information to enable the Director and the Secretary of Health and Human Services or the Secretary of Agriculture to determine the period of the extension under subsection (g);</p> <p>(D) a brief description of the activities undertaken by the applicant during the applicable regulatory review period with respect to the approved product and the significant dates applicable</p> | |
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| | <p>to such activities; and</p> <p>(E) such patent or other information as the Director may require.</p> | | <p>to such activities; and</p> <p>(E) such patent or other information as the Director may require.</p> <p><u>For purposes of determining the date on which a product receives permission under the second sentence of this paragraph, if such permission is transmitted after 4:30 P.M., Eastern Time, on a business day, or is transmitted on a day that is not a business day, the product shall be deemed to receive such permission on the next business day. For purposes of the preceding sentence, the term business day means any Monday, Tuesday, Wednesday, Thursday, or Friday, excluding any legal holiday under section 6103 of title 5.</u></p> | |
| <p>35 U.S.C. § 157</p> <p>>>Back to index<<</p> | <p>(a) Notwithstanding any other provision of this title, the Director is authorized to publish a statutory invention registration containing the specification and drawings of a regularly filed application for a patent without examination if the applicant—</p> | <p>Repealed.</p> | <p>Repealed</p> | <p>Upon the expiration of 18 months beginning on September 16, 2011 and applies to any request for a statutory invention registration filed on or after that effective date.</p> |

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| | <p>(1) meets the requirements of section 112 of this title;</p> <p>(2) has complied with the requirements for printing, as set forth in regulations of the Director;</p> <p>(3) waives the right to receive a patent on the invention within such period as may be prescribed by the Director; and</p> <p>(4) pays application, publication, and other processing fees established by the Director.</p> <p>If an interference is declared with respect to such an application, a statutory invention registration may not be published unless the issue of priority of invention is finally determined in favor of the applicant.</p> <p>(b) The waiver under subsection (a)(3) of this section by an applicant shall take effect upon publication of the statutory invention registration.</p> <p>(c) A statutory invention registration published pursuant to this section shall have all of the attributes specified for patents in this title except those specified in section 183 and sections 271</p> | | | |
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| | <p>through 289 of this title. A statutory invention registration shall not have any of the attributes specified for patents in any other provision of law other than this title. A statutory invention registration published pursuant to this section shall give appropriate notice to the public, pursuant to regulations which the Director shall issue, of the preceding provisions of this subsection. The invention with respect to which a statutory invention certificate is published is not a patented invention for purposes of section 292 of this title.</p> <p>(d) The Director shall report to the Congress annually on the use of statutory invention registrations. Such report shall include an assessment of the degree to which agencies of the Federal Government are making use of the statutory invention registration system, the degree to which it aids the management of federally developed technology, and an assessment of the cost</p> | | | |
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| | savings to the Federal Government of the use of such procedures. | | | |
| 35 U.S.C. § 172 >>Back to index<< | The right of priority provided for by subsections (a) through (d) of section 119 of this title and the time specified in section 102 (d) shall be six months in the case of designs. The right of priority provided for by section 119 (e) of this title shall not apply to designs. | 35 U.S.C. § 172 | The right of priority provided for by subsections (a) through (d) of section 119 of this title and the time specified in section 102 (d) shall be six months in the case of designs. The right of priority provided for by section 119 (e) of this title shall not apply to designs. | Upon expiration of 18 months beginning on September 16, 2011 and applies to (A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) 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 U.S.C. § 184 >>Back to index<< | Except when authorized by a license obtained from the Commissioner of Patents a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an | 35 U.S.C. § 184 | <u>(a) Filing in Foreign Country-</u> Except when authorized by a license obtained from the Commissioner of Patents a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to | Upon the expiration of 1-year beginning on September 16, 2011 and applies to proceedings commenced on or after that effective date. |

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| | <p>order issued by the Commissioner of Patents pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been filed abroad through error and without deceptive intent and the application does not disclose an invention within the scope of section 181 of this title.</p> <p>The term "application" when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.</p> <p>The scope of a license shall permit subsequent modifications, amendments, and supplements containing additional subject matter if the application upon which the request for the license is based is not, or was not, required to be made available for inspection under section 181 of this title and if such modifications, amendments, and</p> | | <p>an invention subject to an order issued by the Commissioner of Patents pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been filed abroad through error and without deceptive intent and the application does not disclose an invention within the scope of section 181 of this title.</p> <p><u>(b) Application-</u> The term "application" when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.</p> <p><u>(c) Subsequent Modifications, Amendments, and Supplements-</u> The scope of a license shall permit subsequent modifications, amendments, and supplements containing additional subject matter if the application upon which</p> | |
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| | <p>supplements do not change the general nature of the invention in a manner which would require such application to be made available for inspection under such section 181. In any case in which a license is not, or was not, required in order to file an application in any foreign country, such subsequent modifications, amendments, and supplements may be made, without a license, to the application filed in the foreign country if the United States application was not required to be made available for inspection under section 181 and if such modifications, amendments, and supplements do not, or did not, change the general nature of the invention in a manner which would require the United States application to have been made available for inspection under such section 181.</p> | | <p>the request for the license is based is not, or was not, required to be made available for inspection under section 181 of this title and if such modifications, amendments, and supplements do not change the general nature of the invention in a manner which would require such application to be made available for inspection under such section 181. In any case in which a license is not, or was not, required in order to file an application in any foreign country, such subsequent modifications, amendments, and supplements may be made, without a license, to the application filed in the foreign country if the United States application was not required to be made available for inspection under section 181 and if such modifications, amendments, and supplements do not, or did not, change the general nature of the invention in a manner which would require the United States application to have been made available for inspection under such</p> | |
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| <p>35 U.S.C. § 185</p> <p>>>Back to index<<</p> | <p>Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184 of this title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid, unless the failure to procure such license was through error and without deceptive intent, and the patent does not disclose subject matter within the scope of section 181 of this title.</p> | <p>35 U.S.C. § 185</p> | <p>section 181.</p> <p>Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184 of this title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid, unless the failure to procure such license was through error and without deceptive intent, and the patent does not disclose subject matter within the scope of section 181 of this title.</p> | <p>Upon the expiration of 1-year beginning on September 16, 2011 and applies to proceedings commenced on or after that effective date.</p> |
| <p>35 U.S.C. § 202</p> <p>>>Back to index<<</p> | <p>(b)(3) If the contractor believes that a determination is contrary to the policies and objectives of this</p> | <p>35 U.S.C. § 202</p> | <p>(b)(3) If the contractor believes that a determination is contrary to the policies and objectives of this</p> | <p>Upon the expiration of 1-year beginning on September 16, 2011 and applies to proceedings</p> |

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| | <p>chapter or constitutes an abuse of discretion by the agency, the determination shall be subject to the section 203 (b)...</p> <p>(c)(2) That the contractor make a written election within two years after disclosure to the Federal agency (or such additional time as may be approved by the Federal agency) whether the contractor will retain title to a subject invention: Provided, That in any case where publication, on sale, or public use, has initiated the one year statutory period in which valid patent protection can still be obtained in the United States, the period for election may be shortened by the Federal agency to a date that is not more than sixty days prior to the end of the statutory period: And provided further, That the Federal Government may receive title to any subject invention in which the contractor does not elect to retain rights or fails to elect rights within such times.</p> | | <p>chapter or constitutes an abuse of discretion by the agency, the determination shall be subject to the section 203 (b)...</p> <p>(c)(2) That the contractor make a written election within two years after disclosure to the Federal agency (or such additional time as may be approved by the Federal agency) whether the contractor will retain title to a subject invention: Provided, that in any case where publication, on sale, or public use, has initiated the one year statutory period in which valid patent protection can still be obtained in the United States <u>the 1-year period referred to in section 102(b) would end before the end of that 2-year period,</u> the period for election may be shortened by the Federal agency to a date that is not more than sixty days prior to the end of the statutory period before the end of that 1-year: And provided further, That the Federal Government may receive title to any subject invention in which</p> | <p>commenced on or after that effective date.</p> <p>Upon expiration of 18 months beginning on September 16, 2011 and applies to (A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) 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.</p> |
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| | <p>(c)(3) That a contractor electing rights in a subject invention agrees to file a patent application prior to any statutory bar date that may occur under this title due to publication, on sale, or public use, and shall thereafter file corresponding patent applications in other countries in which it wishes to retain title within reasonable times, and that the Federal Government may receive title to any subject inventions in the United States or other countries in which the contractor has not filed patent applications on the subject invention within such times...</p> <p>(c)(7)(D) a requirement that, except where it proves infeasible after a reasonable inquiry, in the licensing of subject inventions shall be given to small business firms; and...</p> <p>(c)(7)(E)(i) that after payment of patenting costs, licensing costs, payments to inventors, and other expenses incidental to the</p> | | <p>the contractor does not elect to retain rights or fails to elect rights within such times.</p> <p>(c)(3) That a contractor electing rights in a subject invention agrees to file a patent application prior to any statutory bar date that may occur under this title due to publication, on sale, or public use <u>the expiration of the 1-year period referred to in section 102(b)</u>, and shall thereafter file corresponding patent applications in other countries in which it wishes to retain title within reasonable times, and that the Federal Government may receive title to any subject inventions in the United States or other countries in which the contractor has not filed patent applications on the subject invention within such times.</p> <p>(c)(7)(D) a requirement that, except where it proves infeasible after a reasonable inquiry, in the licensing of subject inventions shall be given to</p> | <p>Upon expiration of 18 months beginning on September 16, 2011 and applies to (A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) 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.</p> <p>Upon the expiration of 1-year beginning on September 16, 2011 and applies to proceedings commenced on or after that effective date.</p> |
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| | <p>administration of subject inventions, 100 percent of the balance of any royalties or income earned and retained by the contractor during any fiscal year up to an amount equal to 5 percent of the annual budget of the facility, shall be used by the contractor for scientific research, development, and education consistent with the research and development mission and objectives of the facility, including activities that increase the licensing potential of other inventions of the facility; provided that if said balance exceeds 5 percent of the annual budget of the facility, that 75 percent of such excess shall be paid to the Treasury of the United States and the remaining 25 percent shall be used for the same purposes as described above in this clause (D); and...</p> | | <p>small business firms <u>except where it is determined to be infeasible following a reasonable inquiry, a preference in the licensing of subject inventions shall be given to small business firms;</u> and...</p> <p>(c)(7)(E)(i) that after payment of patenting costs, licensing costs, payments to inventors, and other expenses incidental to the administration of subject inventions, 100 percent of the balance of any royalties or income earned and retained by the contractor during any fiscal year up to an amount equal to 5 percent of the annual budget of the facility, shall be used by the contractor for scientific research, development, and education consistent with the research and development mission and objectives of the facility, including activities that increase the licensing potential of other inventions of the facility; provided that if said balance exceeds 5 percent of the annual budget of the facility, that 75 <u>15</u></p> | <p>On September 16, 2011 and applies to any patent issued before, on, or after that date.</p> |
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| | | | percent of such excess shall be paid to the Treasury of the United States and the remaining 25 <u>85</u> percent shall be used for the same purposes as described above in this clause (D); and... | |
| 35 U.S.C. § 209 >>Back to index<< | (d)(1) retaining a nontransferable, irrevocable, paid-up license for any Federal agency to practice the invention or have the invention practiced throughout the world by or on behalf of the Government of the United States;... | 35 U.S.C. § 209 | (d)(1) retaining a nontransferable , <u>nontransferable</u> irrevocable, paid-up license for any Federal agency to practice the invention or have the invention practiced throughout the world by or on behalf of the Government of the United States;... | Upon the expiration of 1-year beginning on September 16, 2011 and applies to proceedings commenced on or after that effective date. |
| 35 U.S.C. § 251 >>Back to index<< | Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the | 35 U.S.C. § 251 | (a) In General- Whenever any patent is, through error without any deceptive intention , deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the | Upon the expiration of the 1-year beginning on September 16, 2011 and applies to any patent application that is filed on or after that effective date. |

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| | <p>unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.</p> <p>The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.</p> <p>The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.</p> <p>No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.</p> | | <p>unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.</p> <p><u>(b) Multiple Reissued Patents-</u> The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.</p> <p><u>(c) Applicability of This Title-</u> The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent <u>or the application for the original patent was filed by the assignee of the entire interest.</u></p> <p><u>(d) Reissue Patent Enlarging</u></p> | |
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| | | | <p><u>Scope of Claims</u>- No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.</p> | |
| <p>35 U.S.C. § 253</p> <p>>>Back to index<<</p> | <p>Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him. In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.</p> | <p>35 U.S.C. § 253</p> | <p><u>(a) In General</u>- Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.</p> <p><u>(b) Additional Disclaimer or Dedication</u>- In the manner set forth in subsection (a) in like manner any patentee or applicant may disclaim or dedicate to the public the</p> | <p>Upon the expiration of the 1-year beginning on September 16, 2011 and applies to proceedings commenced on or after that effective date.</p> |

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| | | | entire term, or any terminal part of the term, of the patent granted or to be granted. | |
| <p>35 U.S.C. § 256</p> <p>>>Back to index<<</p> | <p>Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issued a certificate correcting such error. The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.</p> | <p>35 U.S.C. § 256</p> | <p><u>(a) Correction-</u> Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issued a certificate correcting such error.</p> <p><u>(b) Patent Valid if Error Corrected-</u> The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.</p> | <p>Upon the expiration of the 1-year beginning on September 16, 2011 and applies to proceedings commenced on or after that effective date.</p> |

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| <p>35 U.S.C. § 257</p> <p>>>Back to index<<</p> | <p>None</p> | <p>35 U.S.C. § 257</p> | <p>(a) Request for Supplemental Examination- A patent owner may request supplemental examination of a patent in the Office to consider, reconsider, or correct information believed to be relevant to the patent, in accordance with such requirements as the Director may establish. Within 3 months after the date a request for supplemental examination meeting the requirements of this section is received, the Director shall conduct the supplemental examination and shall conclude such examination by issuing a certificate indicating whether the information presented in the request raises a substantial new question of patentability.</p> <p>(b) Reexamination Ordered- If the certificate issued under subsection (a) indicates that a substantial new question of patentability is raised by 1 or more items of information in the request, the Director shall order reexamination of the patent. The reexamination shall be</p> | <p>Upon the expiration of 1-year beginning on September 16, 2011 and applies to any patent issued before, on, or after that effective date.</p> |
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| <p>>>Back to index<<</p> | | | <p>conducted according to procedures established by chapter 30, except that the patent owner shall not have the right to file a statement pursuant to section 304. During the reexamination, the Director shall address each substantial new question of patentability identified during the supplemental examination, notwithstanding the limitations in chapter 30 relating to patents and printed publication or any other provision of such chapter.</p> <p>(c) Effect-</p> <p>(1) IN GENERAL- A patent shall not be held unenforceable on the basis of conduct relating to information that had not been considered, was inadequately considered, or was incorrect in a prior examination of the patent if the information was considered, reconsidered, or corrected during a supplemental examination of the patent. The making of a request under subsection (a),</p> | |
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| | | | <p>or the absence thereof, shall not be relevant to enforceability of the patent under section 282.</p> <p>(2) EXCEPTIONS-</p> <p>(A) PRIOR ALLEGATIONS- Paragraph (1) shall not apply to an allegation pled with particularity in a civil action, or set forth with particularity in a notice received by the patent owner under section 505(j)(2)(B)(iv)(II) of the Federal Food, Drug, and Cosmetic Act (21 U.S.C. 355(j)(2)(B)(iv)(II)), before the date of a supplemental examination request under subsection (a) to consider, reconsider, or correct information forming the basis for the allegation.</p> <p>(B) PATENT ENFORCEMENT ACTIONS- In an action brought under section 337(a) of the Tariff Act of 1930 (19 U.S.C. 1337(a)), or section 281 of this title, paragraph (1) shall not apply to any defense raised in the action that is based upon information that was considered, reconsidered, or</p> | |
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| <p>>>> Back to index <<</p> | | | <p>corrected pursuant to a supplemental examination request under subsection (a), unless the supplemental examination, and any reexamination ordered pursuant to the request, are concluded before the date on which the action is brought.</p> <p>(d) Fees and Regulations-</p> <p>(1) FEES- The Director shall, by regulation, establish fees for the submission of a request for supplemental examination of a patent, and to consider each item of information submitted in the request. If reexamination is ordered under subsection (b), fees established and applicable to ex parte reexamination proceedings under chapter 30 shall be paid, in addition to fees applicable to supplemental examination.</p> <p>(2) REGULATIONS- The Director shall issue regulations governing the form, content, and other requirements of requests for</p> | |
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| | | | <p>supplemental examination, and establishing procedures for reviewing information submitted in such requests.</p> <p>(e) Fraud- If the Director becomes aware, during the course of a supplemental examination or reexamination proceeding ordered under this section, that a material fraud on the Office may have been committed in connection with the patent that is the subject of the supplemental examination, then in addition to any other actions the Director is authorized to take, including the cancellation of any claims found to be invalid under section 307 as a result of a reexamination ordered under this section, the Director shall also refer the matter to the Attorney General for such further action as the Attorney General may deem appropriate. Any such referral shall be treated as confidential, shall not be included in the file of the patent, and shall not be disclosed to the public unless the United States</p> | |
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| | | | <p>charges a person with a criminal offense in connection with such referral.</p> <p>(f) Rule of Construction- Nothing in this section shall be construed--</p> <p>(1) to preclude the imposition of sanctions based upon criminal or antitrust laws (including section 1001(a) of title 18, the first section of the Clayton Act, and section 5 of the Federal Trade Commission Act to the extent that section relates to unfair methods of competition);</p> <p>(2) to limit the authority of the Director to investigate issues of possible misconduct and impose sanctions for misconduct in connection with matters or proceedings before the Office; or</p> <p>(3) to limit the authority of the Director to issue regulations under chapter 3 relating to sanctions for misconduct by</p> | |
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| | | | representatives practicing before the Office. | |
| <p>35 U.S.C. § 273</p> <p>>>Back to index<<</p> | <p>(a) Definitions.— For purposes of this section—</p> <p>(1) the terms “commercially used” and “commercial use” mean use of a method in the United States, so long as such use is 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, whether or not the subject matter at issue is accessible to or otherwise known to the public, except that the subject matter for which commercial marketing or use is subject to a premarketing regulatory review period during which the safety or efficacy of the subject matter is established, including any period specified in section 156 (g), shall be deemed “commercially used” and in “commercial use” during such regulatory review period;</p> <p>(2) in the case of activities performed by a nonprofit research laboratory, or nonprofit entity such as a university, research center, or</p> | <p>35 U.S.C. § 273</p> <p>(rewritten)</p> | <p>(a) In General- A person shall be entitled to a defense under section 282(b) with respect to subject matter consisting of a process, or consisting 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 against the person if--</p> <p>(1) such person, acting in good faith, 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</p> <p>(2) such commercial use occurred at least 1 year before the earlier of either--</p> <p>(A) the effective filing date of the claimed invention; or</p> <p>(B) the date on which the</p> | <p>On September 16, 2011.</p> |

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| <p>>> Back to index <<</p> | <p>hospital, a use for which the public is the intended beneficiary shall be considered to be a use described in paragraph (1), except that the use—</p> <p>(A) may be asserted as a defense under this section only for continued use by and in the laboratory or nonprofit entity; and</p> <p>(B) may not be asserted as a defense with respect to any subsequent commercialization or use outside such laboratory or nonprofit entity;</p> <p>(3) the term "method" means a method of doing or conducting business; and</p> <p>(4) the "effective filing date" of a patent is the earlier of the actual filing date of the application for the patent or the filing date of any earlier United States, foreign, or international application to which the subject matter at issue is entitled under section 119, 120, or 365 of this title.</p> <p>(b) Defense to Infringement.—</p> <p>(1) In general.— It shall be a defense to an action for infringement under section</p> | | <p>claimed invention was disclosed to the public in a manner that qualified for the exception from prior art under section 102(b).</p> <p>(b) Burden of Proof- A person asserting a defense under this section shall have the burden of establishing the defense by clear and convincing evidence.</p> <p>(c) Additional Commercial Uses-</p> <p>(1) PREMARKETING REGULATORY REVIEW- Subject matter for which commercial marketing or use is subject to a premarketing regulatory review period during which the safety or efficacy of the subject matter is established, including any period specified in section 156(g), shall be deemed to be commercially used for purposes of subsection (a)(1) during such regulatory review period.</p> <p>(2) NONPROFIT LABORATORY USE- A use of subject matter by a nonprofit research laboratory or other</p> | |
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| | <p>271 of this title with respect to any subject matter that would otherwise infringe one or more claims for a method in the patent being asserted against a person, if such person had, acting in good faith, actually reduced the subject matter to practice at least 1 year before the effective filing date of such patent, and commercially used the subject matter before the effective filing date of such patent.</p> <p>(2) Exhaustion of right.— The sale or other disposition of a useful end product produced by a patented method, by a person entitled to assert a defense under this section with respect to that useful end result shall exhaust the patent owner’s rights under the patent to the extent such rights would have been exhausted had such sale or other disposition been made by the patent owner.</p> <p>(3) Limitations and qualifications of defense.— The defense to infringement under this section is subject to the following:</p> <p>(A) Patent.— A person may not assert the defense under</p> | | <p>nonprofit entity, such as a university or hospital, for which the public is the intended beneficiary, shall be deemed to be a commercial use for purposes of subsection (a)(1), except that a defense under this section may be asserted pursuant to this paragraph only for continued and noncommercial use by and in the laboratory or other nonprofit entity.</p> <p>(d) Exhaustion of Rights- Notwithstanding subsection (e)(1), the sale or other disposition of a useful end result by a person entitled to assert a defense under this section in connection with a patent with respect to that useful end result shall exhaust the patent owner’s rights under the patent to the extent that such rights would have been exhausted had such sale or other disposition been made by the patent owner.</p> <p>(e) Limitations and Exceptions-</p> <p>(1) PERSONAL DEFENSE-</p> | |
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| <p>>> Back to index <<</p> | <p>this section unless the invention for which the defense is asserted is for a method.</p> <p>(B) Derivation.— A person may not assert the defense under this section if the subject matter on which the defense is based was derived from the patentee or persons in privity with the patentee.</p> <p>(C) Not a general license.— The defense asserted by a person under this section is not a general license under all claims of the patent at issue, but extends only to the specific subject matter claimed in the patent with respect to which the person can assert a defense under this chapter, except that the defense shall also extend to variations in the quantity or volume of use of the claimed subject matter, and to improvements in the claimed subject matter that do not infringe additional specifically claimed subject matter of the patent.</p> <p>(4) Burden of proof.— A person asserting the defense under this section shall have the burden of establishing the defense by clear and</p> | | <p>(A) IN GENERAL- A defense under this section may be asserted only by the person who performed or directed the performance of the commercial use described in subsection (a), or by an entity that controls, is controlled by, or is under common control with such person.</p> <p>(B) TRANSFER OF RIGHT- Except for any transfer to the patent owner, the right to assert a defense under this section shall not be licensed or assigned or transferred to another person except as an ancillary and subordinate part of a good-faith assignment or transfer for other reasons of the entire enterprise or line of business to which the defense relates.</p> <p>(C) RESTRICTION ON SITES- A defense under this section, when acquired by a person as part of an assignment or transfer described in subparagraph (B), may only be asserted for uses at sites where the subject matter that would otherwise infringe</p> | |
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| | <p>convincing evidence.</p> <p>(5) Abandonment of use.— A person who has abandoned commercial use of subject matter may not rely on activities performed before the date of such abandonment in establishing a defense under this section with respect to actions taken after the date of such abandonment.</p> <p>(6) Personal defense.— The defense under this section may be asserted only by the person who performed the acts necessary to establish the defense and, except for any transfer to the patent owner, the right to assert the defense shall not be licensed or assigned or transferred to another person except as an ancillary and subordinate part of a good faith assignment or transfer for other reasons of the entire enterprise or line of business to which the defense relates.</p> <p>(7) Limitation on sites.— A defense under this section, when acquired as part of a good faith assignment or transfer of an entire enterprise or line of business to which the defense relates,</p> | | <p>a claimed invention is in use before the later of the effective filing date of the claimed invention or the date of the assignment or transfer of such enterprise or line of business.</p> <p>(2) DERIVATION- A person may not assert a defense under this section if the subject matter on which the defense is based was derived from the patentee or persons in privity with the patentee.</p> <p>(3) NOT A GENERAL LICENSE- The defense asserted by a person under this section is not a general license under all claims of the patent at issue, but extends only to the specific subject matter for which it has been established that a commercial use that qualifies under this section occurred, except that the defense shall also extend to variations in the quantity or volume of use of the claimed subject matter, and to improvements in the claimed subject matter that do not infringe additional specifically claimed subject matter of the</p> | |
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| | <p>may only be asserted for uses at sites where the subject matter that would otherwise infringe one or more of the claims is in use before the later of the effective filing date of the patent or the date of the assignment or transfer of such enterprise or line of business.</p> <p>(8) Unsuccessful assertion of defense.— If the defense under this section is pleaded by a person who is found to infringe the patent and who subsequently fails to demonstrate a reasonable basis for asserting the defense, the court shall find the case exceptional for the purpose of awarding attorney fees under section 285 of this title.</p> <p>(9) Invalidity.— A patent shall not be deemed to be invalid under section 102 or 103 of this title solely because a defense is raised or established under this section.</p> | | <p>patent.</p> <p>(4) ABANDONMENT OF USE- A person who has abandoned commercial use (that qualifies under this section) of subject matter may not rely on activities performed before the date of such abandonment in establishing a defense under this section with respect to actions taken on or after the date of such abandonment.</p> <p>(5) UNIVERSITY EXCEPTION-</p> <p>(A) IN GENERAL- A person commercially using subject matter to which subsection (a) applies may not assert a defense under this section if the claimed invention with respect to which the defense is asserted was, at the time the invention was made, owned or subject to an obligation of assignment to either 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 a technology transfer organization whose primary purpose is to facilitate the</p> | |
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| | | | <p>commercialization of technologies developed by one or more such institutions of higher education.</p> <p>(B) EXCEPTION- Subparagraph (A) shall not apply if any of the activities required to reduce to practice the subject matter of the claimed invention could not have been undertaken using funds provided by the Federal Government.</p> <p>(f) Unreasonable Assertion of Defense- If the defense under this section is pleaded by a person who is found to infringe the patent and who subsequently fails to demonstrate a reasonable basis for asserting the defense, the court shall find the case exceptional for the purpose of awarding attorney fees under section 285.</p> <p>(g) Invalidity- A patent shall not be deemed to be invalid under section 102 or 103 solely because a defense is raised or established under this section.</p> | |
| 35 U.S.C. § 282 | A patent shall be presumed | 35 U.S.C. § 282 | <u>(a) In General-</u> A patent shall | Upon the expiration of the 1- |

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| <p>>>Back to index<<</p> | <p>valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim.</p> <p>Notwithstanding the preceding sentence, if a claim to a composition of matter is held invalid and that claim was the basis of a determination of nonobviousness under section 103 (b)(1), the process shall no longer be considered nonobvious solely on the basis of section 103 (b)(1). The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.</p> <p>The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:</p> <p>(1) Noninfringement, absence of liability for infringement or</p> | | <p>be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim.</p> <p>Notwithstanding the preceding sentence, if a claim to a composition of matter is held invalid and that claim was the basis of a determination of nonobviousness under section 103 (b)(1), the process shall no longer be considered nonobvious solely on the basis of section 103 (b)(1). The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.</p> <p><u>(b) Defenses-</u> The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:</p> <p>(1) Noninfringement, absence of liability for infringement or</p> | <p>year beginning on September 16, 2011 and applies to proceedings commenced on or after that effective date.</p> |
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| | <p>unenforceability, (2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability, (3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title, ... In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Federal Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or</p> | | <p>unenforceability, (2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability, (3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title, - <u>(A) any requirement of section 112, except that the failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable; or</u> <u>(B) any requirement of section 251.</u> ... <u>(c) Notice of Actions; Actions During Extension of Patent Term-</u> In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and</p> | <p>On September 16, 2011 and applies to proceedings commenced on or after that date.</p> |
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| | <p>offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires.</p> | | <p>name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Federal Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires.</p> | |
| <p>35 U.S.C. § 287</p> <p>>>Back to index<<</p> | <p>(a) Patentees, and persons making, offering for sale, or selling within the United States any patented article for or under them, or importing any patented article into the United States, may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation "pat.", together with the number of the</p> | <p>35 U.S.C. § 287</p> | <p>(a) Patentees, and persons making, offering for sale, or selling within the United States any patented article for or under them, or importing any patented article into the United States, may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation "pat.", together with the number of the</p> | <p>On September 16, 2011.</p> |

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| | <p>patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.</p> <p>...</p> <p>(c)(2)(G) the term "State" shall mean any state [1] or territory of the United States, the District of Columbia, and the Commonwealth of Puerto Rico...</p> <p>(c)(4) This subsection shall not apply to any patent issued based on an application the earliest effective filing date of which is prior to</p> | | <p>patent, <u>or by fixing thereon the word patent or the abbreviation pat. Together with an address of a posting on the Internet, accessible to the public without charge for accessing the address, that associates the patented article with the number of the patent,</u> or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.</p> <p>...</p> <p>(c)(2)(G) the term "State" shall mean any state <u>State</u> or territory of the United States, the District of Columbia, and the</p> | <p>Upon the expiration of the 1-year beginning on September 16, 2011 and applies to proceedings commenced on or after that</p> |
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| | September 30, 1996. | | Commonwealth of Puerto Rico... (c)(4) This subsection shall not apply to any patent issued based on an application the earliest effective filing date of which is prior to <u>which has an effective filing date before</u> September 30, 1996. | effective date. Upon the expiration of the 1-year beginning on September 16, 2011 and applies to proceedings commenced on or after that effective date. |
| 35 U.S.C. § 288 >>Back to index<< | Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent and Trademark Office before the commencement of the suit. | 35 U.S.C. § 288 | Whenever, without deceptive intention , a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent and Trademark Office before the commencement of the suit. | Upon the expiration of the 1-year beginning on September 16, 2011 and applies to proceedings commenced on or after that effective date. |
| 35 U.S.C. § 291 (Interfering Patents) >>Back to index<< | The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of the validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section. | 35 U.S.C. § 291 (Interfering Derived Patents) (rewritten) | (a) In General- The owner of a patent may have relief by civil action against the owner of another patent that claims the same invention and has an earlier effective filing date, if the invention claimed in such other patent was derived from the inventor of the invention claimed in the patent owned by the person seeking relief under this | Upon expiration of 18 months beginning on September 16, 2011 and applies to (A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) of title 35, United States Code, that is on or after the effective date described in this paragraph; or (B) a specific reference under |

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| | | | <p>section.</p> <p>(b) Filing Limitation- An action under this section may be filed only before the end of the 1-year period beginning on the date of the issuance of the first patent containing a claim to the allegedly derived invention and naming an individual alleged to have derived such invention as the inventor or joint inventor.</p> | <p>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.</p> |
| <p>35 U.S.C. § 292</p> <p>>>Back to index<<</p> | <p>(a) Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used, offered for sale, or sold by such person within the United States, or imported by the person into the United States, the name or any imitation of the name of the patentee, the patent number, or the words "patent," "patentee," or the like, with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made, offered for sale, sold, or imported into the United</p> | <p>35 U.S.C. § 292</p> | <p>(a) Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used, offered for sale, or sold by such person within the United States, or imported by the person into the United States, the name or any imitation of the name of the patentee, the patent number, or the words "patent," "patentee," or the like, with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made, offered for sale, sold, or imported into the United</p> | <p>All cases, without exception, that are pending on, or commenced on or after, the date of September 16, 2011.</p> |

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| | <p>States by or with the consent of the patentee; or Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article the word "patent" or any word or number importing the same is patented, for the purpose of deceiving the public; or Whoever marks upon, or affixes to, or uses in advertising in connection with any article the words "patent applied for," "patent pending," or any word importing that an application for patent has been made, when no application for patent has been made, or if made, is not pending, for the purpose of deceiving the public - Shall be fined not more than \$500 for every such offense.</p> <p>(b) Any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States.</p> | | <p>States by or with the consent of the patentee; or Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article the word "patent" or any word or number importing the same is patented, for the purpose of deceiving the public; or Whoever marks upon, or affixes to, or uses in advertising in connection with any article the words "patent applied for," "patent pending," or any word importing that an application for patent has been made, when no application for patent has been made, or if made, is not pending, for the purpose of deceiving the public - Shall be fined not more than \$500 for every such offense. <u>Only the United States may sue for the penalty authorized by this subsection.</u></p> <p>(b) Any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States.</p> <p><u>(b) A person who has</u></p> | |
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| | | | <p><u>suffered a competitive injury as a result of a violation of this section may file a civil action in a district court of the United States for recovery of damages adequate to compensate for the injury.</u></p> <p><u>(c) The marking of a product, in a manner described in subsection (a), with matter relating to a patent that covered that product but has expired is not a violation of this section.</u></p> | |
| <p>35 U.S.C. § 293</p> <p>>>Back to index<<</p> | <p>Every patentee not residing in the United States may file in the Patent and Trademark Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. If the person designated cannot be found at the address given in the last designation, or if no person has been designated, the United States District Court for the District of Columbia shall have jurisdiction and summons shall be served by</p> | <p>35 U.S.C. § 293</p> | <p>Every patentee not residing in the United States may file in the Patent and Trademark Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. If the person designated cannot be found at the address given in the last designation, or if no person has been designated, the United States District Court for the District of Columbia <u>Eastern District of Virginia</u> shall have jurisdiction and</p> | <p>Upon September 16, 2011.</p> |

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| | publication or otherwise as the court directs. The court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally within the jurisdiction of the court. | | summons shall be served by publication or otherwise as the court directs. The court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally within the jurisdiction of the court. | |
| 35 U.S.C. § 298 | None | 35 U.S.C. § 298 >>Back to index<< | The failure of an infringer to obtain the advice of counsel with respect to any allegedly infringed patent, or the failure of the infringer to present such advice to the court or jury, may not be used to prove that the accused infringer willfully infringed the patent or that the infringer intended to induce infringement of the patent. | Upon the expiration of 1-year beginning on September 16, 2011 and applies to any patent issued on or after that effective date. |
| 35 U.S.C. § 299 | None | 35 U.S.C. § 299 >>Back to index<< | (a) Joinder of Accused Infringers- With respect to any civil action arising under any Act of Congress relating to patents, other than an action or trial in which an act of infringement under section 271(e)(2) has been pled, parties that are accused infringers may be joined in one action as defendants or counterclaim defendants, or have their actions | Any civil action commenced on or after September 16, 2011. |

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| | | | <p>consolidated for trial, or counterclaim defendants only if--</p> <p>(1) any right to relief is asserted against the parties jointly, severally, or in the alternative with respect to or arising out of the same transaction, occurrence, or series of transactions or occurrences relating to the making, using, importing into the United States, offering for sale, or selling of the same accused product or process; and</p> <p>(2) questions of fact common to all defendants or counterclaim defendants will arise in the action.</p> <p>(b) Allegations Insufficient for Joinder- For purposes of this subsection, accused infringers may not be joined in one action as defendants or counterclaim defendants, or have their actions consolidated for trial, based solely on allegations that they each have infringed the patent or patents in suit.</p> <p>(c) Waiver- A party that is an</p> | |
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| | | | accused infringer may waive the limitations set forth in this section with respect to that party. | |
| <p>35 U.S.C. § 301</p> <p>>>Back to index<<</p> | <p>Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential.</p> | <p>35 U.S.C. § 301</p> <p>(rewritten)</p> | <p>(a) In General- Any person at any time may cite to the Office in writing--</p> <p>(1) prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent; or</p> <p>(2) statements of the patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of a particular patent.</p> <p>(b) Official File- If the person citing prior art or written statements pursuant to subsection (a) explains in writing the pertinence and manner of applying the prior art or written statements to at least 1 claim of the patent, the citation of the prior art or written statements and the explanation thereof shall become a part of the official</p> | <p>Upon expiration of 1-year beginning on September 16, 2011 and applies to any patent issued before, on or after that effective date.</p> |

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| | | | <p>file of the patent.</p> <p>(c) Additional Information- A party that submits a written statement pursuant to subsection (a)(2) shall include any other documents, pleadings, or evidence from the proceeding in which the statement was filed that addresses the written statement.</p> <p>(d) Limitations- A written statement submitted pursuant to subsection (a)(2), and additional information submitted pursuant to subsection (c), shall not be considered by the Office for any purpose other than to determine the proper meaning of a patent claim in a proceeding that is ordered or instituted pursuant to section 304, 314, or 324. If any such written statement or additional information is subject to an applicable protective order, such statement or information shall be redacted to exclude information that is subject to that order.</p> | |
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| | | | (e) Confidentiality- Upon the written request of the person citing prior art or written statements pursuant to subsection (a), that person's identity shall be excluded from the patent file and kept confidential. | |
| 35 U.S.C. § 303 >>Back to index<< | (a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On his own initiative, and any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the | 35 U.S.C. § 303 | (a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On his own initiative, and any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title <u>section 301 or 302</u> . The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously | Upon expiration of 1-year beginning on September 16, 2011 and applies to any patent issued before, on or after that effective date. |

| | Office or considered by the Office. | | cited by or to the Office or considered by the Office. | |
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| <p>35 U.S.C. § 305</p> <p>>>Back to index<<</p> | <p>After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent</p> | <p>35 U.S.C. § 305</p> | <p>After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent</p> | <p>Upon expiration of 18 months beginning on September 16, 2011 and applies to (A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) 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.</p> |

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| | Appeals and Interferences, will be conducted with special dispatch within the Office. | | Appeals and Interferences <u>Patent Trial and Appeal Board</u> , will be conducted with special dispatch within the Office. | |
| 35 U.S.C. § 306 >>Back to index<< | The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent. | 35 U.S.C. § 306 | The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 <u>144</u> of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent. | On September 16, 2011 and applies to any appeal of a reexamination before the BPAI or the Patent Trial and Appeal Board that is pending on, or brought on or after, September 16, 2011. |
| 35 U.S.C. § 311-318 | CHAPTER 31 OPTIONAL INTER PARTES REEXAMINATION PROCEDURES 311 Request for inter partes reexamination. 312 Determination of issue by Director. 313 Inter partes reexamination order by Director. 314 Conduct of inter partes reexamination proceedings. | 35 U.S.C. § 311-319 | <u>CHAPTER 31--INTER PARTES REVIEW</u> <u>Sec.</u> <u>311. Inter partes review.</u> <u>312. Petitions.</u> <u>313. Preliminary response to petition.</u> <u>314. Institution of inter partes review.</u> <u>315. Relation to other proceedings or actions.</u> | The Director shall, not later than the date that is 1 year after September 16, 2011, issue regulations to carry out chapter 31 of title 35, United States Code, as amended by subsection (a) of this section. Effective date: Expiration of the 1-year period beginning on September 16, 2011. |

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| | <p>315 Appeal.</p> <p>316 Certificate of patentability, unpatentability, and claim cancellation.</p> <p>317 Inter partes reexamination prohibited.</p> <p>318 Stay of litigation.</p> | | <p><u>316. Conduct of inter partes review.</u></p> <p><u>317. Settlement.</u></p> <p><u>318. Decision of the Board.</u></p> <p><u>319. Appeal.</u></p> | |
| <p>35 U.S.C. § 311</p> <p>>>Back to index<<</p> | <p>(a) IN GENERAL.- Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.</p> <p>(b) REQUIREMENTS.- The request shall-</p> <p>(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and</p> <p>(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.</p> | <p>35 U.S.C. § 311</p> <p>(rewritten)</p> | <p>(a) In General- Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent. The Director shall establish, by regulation, fees to be paid by the person requesting the review, in such amounts as the Director determines to be reasonable, considering the aggregate costs of the review.</p> <p>(b) Scope- A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.</p> | <p>The Director shall, not later than the date that is 1 year after the date of the enactment, issue regulations to carry out chapter 31 of 35 U.S.C.</p> <p>Effective date: Expiration of the 1-year period beginning on September 16, 2011.</p> |

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| | (c) COPY.- The Director promptly shall send a copy of the request to the owner of record of the patent. | | (c) Filing Deadline- A petition for inter partes review shall be filed after the later of either-- (1) the date that is 9 months after the grant of a patent or issuance of a reissue of a patent; or (2) if a post-grant review is instituted under chapter 32, the date of the termination of such post-grant review. | |
| 35 U.S.C. § 312 >>Back to index<< | (a) REEXAMINATION.- Not later than 3 months after the filing of a request for inter partes reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by | 35 U.S.C. § 312 (rewritten) Transition (effective on the date of enactment): (a) REEXAMINATION.- Not later than 3 months after the filing of a request for inter partes reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request <u>the information presented in the request shows that there is a</u> | (a) Requirements of Petition- A petition filed under section 311 may be considered only if-- (1) the petition is accompanied by payment of the fee established by the Director under section 311; (2) the petition identifies all real parties in interest; (3) the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the | The Director shall, not later than the date that is 1 year after the date of the enactment, issue regulations to carry out chapter 31 of 35 U.S.C. Effective date: Expiration of the 1-year period beginning on September 16, 2011. |

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| | <p>the Office.</p> <p>(b) RECORD.- A record of the Director's determination under subsection (a) shall be placed in the official file of the patent, and a copy shall be promptly given or mailed to the owner of record of the patent and to the third-party requester.</p> <p>(c) FINAL DECISION.- A determination by the Director under subsection (a) shall be final and non-appealable. Upon a determination that no substantial new question of patentability has been raised, the Director may refund a portion of the inter partes reexamination fee required under section 311.</p> | <p><u>reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request</u>, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability <u>A showing that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request</u> is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.</p> <p>(b) RECORD.- A record of the Director's determination under subsection (a) shall be placed in the official file of the patent, and a copy shall be promptly given or mailed to the owner of record of the patent and to the third-party requester.</p> <p>(c) FINAL DECISION.- A determination by the Director under subsection (a) shall be final and non-appealable. Upon a</p> | <p>evidence that supports the grounds for the challenge to each claim, including--</p> <p>(A) copies of patents and printed publications that the petitioner relies upon in support of the petition; and</p> <p>(B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on expert opinions;</p> <p>(4) the petition provides such other information as the Director may require by regulation; and</p> <p>(5) the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner.</p> <p>(b) Public Availability- As soon as practicable after the receipt of a petition under section 311, the Director shall make the petition available to the public.</p> | |
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| | | determination that no <u>substantial new question of patentability has been raised</u> , the showing required by <u>subsection (a) has not been made</u> , the Director may refund a portion of the inter partes reexamination fee required under section 311. | | |
| <p>35 U.S.C. § 313</p> <p>>>Back to index<<</p> | <p>If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for inter partes reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the inter partes reexamination conducted in accordance with section 314.</p> | <p>35 U.S.C. § 313 (rewritten)</p> <p>Transition (effective on the date of the enactment)</p> <p>If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised <u>it has been shown that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request</u>, the determination shall include an order for inter partes reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the inter partes reexamination conducted in</p> | <p>If an inter partes review petition is filed under section 311, the patent owner shall have the right to file a preliminary response to the petition, within a time period set by the Director, that sets forth reasons why no inter partes review should be instituted based upon the failure of the petition to meet any requirement of this chapter.</p> | <p>The Director shall, not later than the date that is 1 year after the date of the enactment, issue regulations to carry out chapter 31 of 35 U.S.C.</p> <p>Effective date: Expiration of the 1-year period beginning on September 16, 2011.</p> |

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| | | accordance with section 314. | | |
| <p>35 U.S.C. § 314</p> <p>>>Back to index<<</p> | <p>(a) IN GENERAL.- Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any inter partes reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.</p> <p>(b) RESPONSE.-</p> <p>(1) With the exception of the inter partes reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party. In addition, the Office shall send to the third-party requester a copy of any communication sent by the Office to the patent owner concerning the patent subject to the inter partes</p> | <p>35 U.S.C. § 314</p> <p>(rewritten)</p> | <p>(a) Threshold- The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.</p> <p>(b) Timing- The Director shall determine whether to institute an inter partes review under this chapter pursuant to a petition filed under section 311 within 3 months after--</p> <p>(1) receiving a preliminary response to the petition under section 313; or</p> <p>(2) if no such preliminary response is filed, the last date on which such response may be filed.</p> <p>(c) Notice- The Director shall notify the petitioner</p> | <p>The Director shall, not later than the date that is 1 year after the date of the enactment, issue regulations to carry out chapter 31 of 35 U.S.C.</p> <p>Effective date: Expiration of the 1-year period beginning on September 16, 2011.</p> |

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| | <p>reexamination proceeding.</p> <p>(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.</p> <p>(c) SPECIAL DISPATCH.- Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.</p> | | <p>and patent owner, in writing, of the Director's determination under subsection (a), and shall make such notice available to the public as soon as is practicable. Such notice shall include the date on which the review shall commence.</p> <p>(d) No Appeal- The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.</p> | |
| <p>35 U.S.C. § 315</p> <p>>> Back to index <<</p> | <p>(a) PATENT OWNER.- The patent owner involved in an inter partes reexamination proceeding under this chapter-</p> <p>(1) may appeal under the</p> | <p>35 U.S.C. § 315</p> <p>(rewritten)</p> | <p>(a) Infringer's Civil Action-</p> <p>(1) INTER PARTES REVIEW BARRED BY CIVIL ACTION- An inter partes review may not be instituted if, before the date on which</p> | <p>The Director shall, not later than the date that is 1 year after the date of the enactment, issue regulations to carry out chapter 31 of 35 U.S.C.</p> |

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| | <p>provisions of section 134 and may appeal under the provisions of sections 141 through 144, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent; and</p> <p>(2) may be a party to any appeal taken by a third-party requester under subsection (b).</p> <p>(b) THIRD-PARTY REQUESTER.- A third-party requester-</p> <p>(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; and</p> <p>(2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144.</p> | | <p>the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.</p> <p>(2) STAY OF CIVIL ACTION- If the petitioner or real party in interest files a civil action challenging the validity of a claim of the patent on or after the date on which the petitioner files a petition for inter partes review of the patent, that civil action shall be automatically stayed until either--</p> <p>(A) the patent owner moves the court to lift the stay;</p> <p>(B) the patent owner files a civil action or counterclaim alleging that the petitioner or real party in interest has infringed the patent; or</p> <p>(C) the petitioner or real party in interest moves the court to dismiss the civil action.</p> | <p>Effective date: Expiration of the 1-year period beginning on September 16, 2011.</p> |
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| <p>>>Back to index<<</p> | <p>(c) CIVIL ACTION.- A third-party requester whose request for an inter partes reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the inter partes reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.</p> | | <p>(3) TREATMENT OF COUNTERCLAIM- A counterclaim challenging the validity of a claim of a patent does not constitute a civil action challenging the validity of a claim of a patent for purposes of this subsection.</p> <p>(b) Patent Owner's Action- An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).</p> <p>(c) Joinder- If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a</p> | |
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| | | | <p>preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.</p> <p>(d) Multiple Proceedings- Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of an inter partes review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.</p> <p>(e) Estoppel-</p> <p>(1) PROCEEDINGS BEFORE THE OFFICE- The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in</p> | |
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| | | | <p>interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.</p> <p>(2) CIVIL ACTIONS AND OTHER PROCEEDINGS- The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not assert either in a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.</p> | |
| <p>35 U.S.C. § 316</p> <p>>>Back to index<<</p> | <p>(a) IN GENERAL.- In an inter partes reexamination proceeding under this</p> | <p>35 U.S.C. § 316</p> <p>(rewritten)</p> | <p>(a) Regulations- The Director shall prescribe regulations--</p> | <p>The Director shall, not later than the date that is 1 year after the date of the</p> |

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| | <p>chapter, when the time for appeal has expired or any appeal proceeding has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent any proposed amended or new claim determined to be patentable.</p> <p>(b) AMENDED OR NEW CLAIM.- Any proposed amended or new claim determined to be patentable and incorporated into a patent following an inter partes reexamination proceeding shall have the same effect as that specified in section 252 of this title for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation therefor, prior to issuance of</p> | | <p>(1) providing that the file of any proceeding under this chapter shall be made available to the public, except that any petition or document filed with the intent that it be sealed shall, if accompanied by a motion to seal, be treated as sealed pending the outcome of the ruling on the motion;</p> <p>(2) setting forth the standards for the showing of sufficient grounds to institute a review under section 314(a);</p> <p>(3) establishing procedures for the submission of supplemental information after the petition is filed;</p> <p>(4) establishing and governing inter partes review under this chapter and the relationship of such review to other proceedings under this title;</p> <p>(5) setting forth standards and procedures for discovery of relevant evidence, including that such</p> | <p>enactment, issue regulations to carry out chapter 31 of 35 U.S.C.</p> <p>Effective date: Expiration of the 1-year period beginning on September 16, 2011.</p> |
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| <p>>>Back to index<<</p> | <p>a certificate under the provisions of subsection (a) of this section.</p> | | <p>discovery shall be limited to-</p> <ul style="list-style-type: none"> (A) the deposition of witnesses submitting affidavits or declarations; and (B) what is otherwise necessary in the interest of justice; (6) prescribing sanctions for abuse of discovery, abuse of process, or any other improper use of the proceeding, such as to harass or to cause unnecessary delay or an unnecessary increase in the cost of the proceeding; (7) providing for protective orders governing the exchange and submission of confidential information; (8) providing for the filing by the patent owner of a response to the petition under section 313 after an inter partes review has been instituted, and requiring that the patent owner file with such response, through affidavits or declarations, any additional factual evidence | |
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| | | | <p>and expert opinions on which the patent owner relies in support of the response;</p> <p>(9) setting forth standards and procedures for allowing the patent owner to move to amend the patent under subsection (d) to cancel a challenged claim or propose a reasonable number of substitute claims, and ensuring that any information submitted by the patent owner in support of any amendment entered under subsection (d) is made available to the public as part of the prosecution history of the patent;</p> <p>(10) providing either party with the right to an oral hearing as part of the proceeding;</p> <p>(11) requiring that the final determination in an inter partes review be issued not later than 1 year after the date on which the Director notices the institution of a review under this chapter, except that the Director may, for good cause shown,</p> | |
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| <p>>>Back to index<<</p> | | | <p>extend the 1-year period by not more than 6 months, and may adjust the time periods in this paragraph in the case of joinder under section 315(c);</p> <p>(12) setting a time period for requesting joinder under section 315(c); and</p> <p>(13) providing the petitioner with at least 1 opportunity to file written comments within a time period established by the Director.</p> <p>(b) Considerations- In prescribing regulations under this section, the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.</p> <p>(c) Patent Trial and Appeal Board- The Patent Trial and Appeal Board shall, in accordance with section 6,</p> | |
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| | | | <p>conduct each inter partes review instituted under this chapter.</p> <p>(d) Amendment of the Patent-</p> <p>(1) IN GENERAL- During an inter partes review instituted under this chapter, the patent owner may file 1 motion to amend the patent in 1 or more of the following ways:</p> <p>(A) Cancel any challenged patent claim.</p> <p>(B) For each challenged claim, propose a reasonable number of substitute claims.</p> <p>(2) ADDITIONAL MOTIONS- Additional motions to amend may be permitted upon the joint request of the petitioner and the patent owner to materially advance the settlement of a proceeding under section 317, or as permitted by regulations prescribed by the Director.</p> <p>(3) SCOPE OF CLAIMS-</p> | |
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| | | | <p>An amendment under this subsection may not enlarge the scope of the claims of the patent or introduce new matter.</p> <p>(e) Evidentiary Standards- In an inter partes review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.</p> | |
| <p>35 U.S.C. § 317</p> <p>>> Back to index <<</p> | <p>(a) ORDER FOR REEXAMINATION.- Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.</p> <p>(b) FINAL DECISION.- Once a final decision has been entered against a party in a</p> | <p>35 U.S.C. § 317</p> <p>(rewritten)</p> | <p>(a) In General- An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed. If the inter partes review is terminated with respect to a petitioner under this section, no estoppel under section 315(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner, on the basis of that petitioner's institution of that inter partes review. If no petitioner</p> | <p>The Director shall, not later than the date that is 1 year after the date of the enactment, issue regulations to carry out chapter 31 of 35 U.S.C.</p> <p>Effective date: Expiration of the 1-year period beginning on September 16, 2011.</p> |

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| | <p>civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the</p> | | <p>remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).</p> <p>(b) Agreements in Writing- Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the inter partes review as between the parties. 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, and shall be made available only to Federal Government agencies on written request, or to any</p> | |
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| | Patent and Trademark Office at the time of the inter partes reexamination proceedings. | | person on a showing of good cause. | |
| <p>35 U.S.C. § 318</p> <p>>>Back to index<<</p> | Once an order for inter partes reexamination of a patent has been issued under section 313, the patent owner may obtain a stay of any pending litigation which involves an issue of patentability of any claims of the patent which are the subject of the inter partes reexamination order, unless the court before which such litigation is pending determines that a stay would not serve the interests of justice. | <p>35 U.S.C. § 318</p> <p>(rewritten)</p> | <p>(a) Final Written Decision- If an inter partes review is instituted and not dismissed under this chapter, the Patent Trial and Appeal Board shall issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 316(d).</p> <p>(b) Certificate- If the Patent Trial and Appeal Board issues a final written decision under subsection (a) and the time for appeal has expired or any appeal has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent by operation of the certificate any new or amended claim determined to be patentable.</p> | <p>The Director shall, not later than the date that is 1 year after the date of the enactment, issue regulations to carry out chapter 31 of 35 U.S.C.</p> <p>Effective date: Expiration of the 1-year period beginning on September 16, 2011.</p> |

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| | | | <p>(c) Intervening Rights- Any proposed amended or new claim determined to be patentable and incorporated into a patent following an inter partes review under this chapter shall have the same effect as that specified in section 252 for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation therefor, before the issuance of a certificate under subsection (b).</p> <p>(d) Data on Length of Review- The Office shall make available to the public data describing the length of time between the institution of, and the issuance of a final written decision under subsection (a) for, each inter partes review.</p> | |
| <p>35 U.S.C. § 319</p> <p>>>Back to index<<</p> | none | 35 U.S.C. § 319 | A party dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) may appeal the decision | The Director shall, not later than the date that is 1 year after the date of the enactment, issue regulations to carry out chapter 31 of 35 |

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| | | | pursuant to sections 141 through 144. Any party to the inter partes review shall have the right to be a party to the appeal. | U.S.C. Effective date: Expiration of the 1-year period beginning on September 16, 2011. |
| | | <p>Chapter 32 – Post-grant Review</p> <p>A transitional proceeding may be established pursuant to section 18 of the Act and the transitional period shall expire upon the expiration of 8 years beginning on 1 year anniversary of September 16, 2011, see also section 18(a)(3) of the Act.</p> | <p>Sec. 321. Post-grant review. 322. Petitions.</p> <p>323. Preliminary response to petition. 324. Institution of post-grant review. 325. Relation to other proceedings or actions. 326. Conduct of post-grant review. 327. Settlement. 328. Decision of the Board. 329. Appeal.</p> | <p>The Director shall, not later than the date that is 1 year after the \$nactment, issue regulations to carry out chapter 32 of title 35, United States Code, as amended by subsection (a) of this section.</p> <p>Effective upon the expiration of 1-year beginning on September 16, 2011 and, except section 321(c) and subsections (b), (e)(2), and (f) of section 325.</p> |
| | | <p>35 U.S.C. § 321</p> <p>>>Back to index<<</p> | <p>(a) In General- Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute a post-grant review of the patent. The Director shall establish, by regulation, fees to be paid by the person requesting the review, in such amounts as the Director determines to be reasonable, considering the aggregate costs of the post-grant review.</p> | <p>Upon the expiration of 1-year beginning on September 16, 2011, except section 321(c), which is not part of the transitional period.</p> |

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| | | | <p>(b) Scope- A petitioner in a post-grant review may request to cancel as unpatentable 1 or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of section 282(b) (relating to invalidity of the patent or any claim).</p> <p>(c) Filing Deadline- A petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a reissue patent (as the case may be).</p> | |
| | | <p>35 U.S.C. § 322</p> <p>>>Back to index<<</p> | <p>(a) Requirements of Petition- A petition filed under section 321 may be considered only if--</p> <p>(1) the petition is accompanied by payment of the fee established by the Director under section 321;</p> <p>(2) the petition identifies all real parties in interest;</p> <p>(3) the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the</p> | <p>Upon the expiration of 1-year beginning on September 16, 2011.</p> |

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| | | | <p>challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim, including--</p> <p>(A) copies of patents and printed publications that the petitioner relies upon in support of the petition; and</p> <p>(B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on other factual evidence or on expert opinions;</p> <p>(4) the petition provides such other information as the Director may require by regulation; and</p> <p>(5) the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner.</p> <p>(b) Public Availability- As soon as practicable after the receipt of a petition under section 321, the Director</p> | |
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| | | | shall make the petition available to the public. | |
| | | 35 U.S.C. § 323 >>Back to index<< | <p>If a post-grant review petition is filed under section 321, the patent owner shall have the right to file a preliminary response to the petition, within a time period set by the Director, that sets forth reasons why no post-grant review should be instituted based upon the failure of the petition to meet any requirement of this chapter.</p> | <p>Upon the expiration of 1-year beginning on September 16, 2011.</p> |
| | | 35 U.S.C. § 324 >>Back to index<< | <p>(a) Threshold- The Director may not authorize a post-grant review to be instituted unless the Director determines that the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.</p> <p>(b) Additional Grounds- The determination required under subsection (a) may also be satisfied by a showing that the petition raises a novel or unsettled legal question that is</p> | <p>Upon the expiration of 1-year beginning on September 16, 2011.</p> |

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| | | | <p>important to other patents or patent applications.</p> <p>(c) Timing- The Director shall determine whether to institute a post-grant review under this chapter pursuant to a petition filed under section 321 within 3 months after--</p> <p>(1) receiving a preliminary response to the petition under section 323; or</p> <p>(2) if no such preliminary response is filed, the last date on which such response may be filed.</p> <p>(d) Notice- The Director shall notify the petitioner and patent owner, in writing, of the Director's determination under subsection (a) or (b), and shall make such notice available to the public as soon as is practicable. Such notice shall include the date on which the review shall commence.</p> <p>(e) No Appeal- The determination by the Director whether to institute a post-grant review under</p> | |
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| | | | <p>this section shall be final and nonappealable.</p> | |
| | | <p>35 U.S.C. § 325</p> <p>>>Back to index<<</p> | <p>(a) Infringer's Civil Action-</p> <p>(1) POST-GRANT REVIEW BARRED BY CIVIL ACTION- A post-grant review may not be instituted under this chapter if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.</p> <p>(2) STAY OF CIVIL ACTION- If the petitioner or real party in interest files a civil action challenging the validity of a claim of the patent on or after the date on which the petitioner files a petition for post-grant review of the patent, that civil action shall be automatically stayed until either--</p> <p>(A) the patent owner moves the court to lift the stay;</p> <p>(B) the patent owner files a civil action or counterclaim alleging that the petitioner or real party in interest has infringed the patent; or</p> | <p>Upon the expiration of 1-year beginning on September 16, 2011, except subsections (b), (e)(2), and (f) of section 325.</p> |

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| | | <p style="text-align: center;">>>Back to index<<</p> | <p>(C) the petitioner or real party in interest moves the court to dismiss the civil action.</p> <p>(3) TREATMENT OF COUNTERCLAIM- A counterclaim challenging the validity of a claim of a patent does not constitute a civil action challenging the validity of a claim of a patent for purposes of this subsection.</p> <p>(b) Preliminary Injunctions- If a civil action alleging infringement of a patent is filed within 3 months after the date on which the patent is granted, the court may not stay its consideration of the patent owner’s motion for a preliminary injunction against infringement of the patent on the basis that a petition for post-grant review has been filed under this chapter or that such a post-grant review has been instituted under this chapter.</p> <p>(c) Joinder- If more than 1 petition for a post-grant review under this chapter is</p> | |
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| | | | <p>properly filed against the same patent and the Director determines that more than 1 of these petitions warrants the institution of a post-grant review under section 324, the Director may consolidate such reviews into a single post-grant review.</p> <p>(d) Multiple Proceedings- Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of any post-grant review under this chapter, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the post-grant review or other proceeding or matter may proceed, including providing for the stay, transfer, consolidation, or termination of any such matter or proceeding. In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior</p> | |
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| | | <p style="text-align: center;">>>Back to index<<</p> | <p>art or arguments previously were presented to the Office.</p> <p>(e) Estoppel-</p> <p>(1) PROCEEDINGS BEFORE THE OFFICE- The petitioner in a post-grant review of a claim in a patent under this chapter that results in a final written decision under section 328(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that post-grant review.</p> <p>(2) CIVIL ACTIONS AND OTHER PROCEEDINGS- The petitioner in a post-grant review of a claim in a patent under this chapter that results in a final written decision under section 328(a), or the real party in interest or privy of the petitioner, may not assert either in a civil action arising in whole or in part under section 1338 of title 28 or in</p> | |
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| | | | <p>a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that post-grant review.</p> <p>(f) Reissue Patents- A post-grant review may not be instituted under this chapter if the petition requests cancellation of a claim in a reissue patent that is identical to or narrower than a claim in the original patent from which the reissue patent was issued, and the time limitations in section 321(c) would bar filing a petition for a post-grant review for such original patent.</p> | |
| | | <p>35 U.S.C. § 326</p> <p>>>Back to index<<</p> | <p>(a) Regulations- The Director shall prescribe regulations--</p> <p>(1) providing that the file of any proceeding under this chapter shall be made available to the public, except that any petition or document filed with the intent that it be sealed shall,</p> | <p>Upon the expiration of 1-year beginning on September 16, 2011.</p> |

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| | | | <p>if accompanied by a motion to seal, be treated as sealed pending the outcome of the ruling on the motion;</p> <p>(2) setting forth the standards for the showing of sufficient grounds to institute a review under subsections (a) and (b) of section 324;</p> <p>(3) establishing procedures for the submission of supplemental information after the petition is filed;</p> <p>(4) establishing and governing a post-grant review under this chapter and the relationship of such review to other proceedings under this title;</p> <p>(5) setting forth standards and procedures for discovery of relevant evidence, including that such discovery shall be limited to evidence directly related to factual assertions advanced by either party in the proceeding;</p> <p>(6) prescribing sanctions for abuse of discovery, abuse of</p> | |
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| | | <p style="text-align: center;">>>Back to index<<</p> | <p>process, or any other improper use of the proceeding, such as to harass or to cause unnecessary delay or an unnecessary increase in the cost of the proceeding;</p> <p>(7) providing for protective orders governing the exchange and submission of confidential information;</p> <p>(8) providing for the filing by the patent owner of a response to the petition under section 323 after a post-grant review has been instituted, and requiring that the patent owner file with such response, through affidavits or declarations, any additional factual evidence and expert opinions on which the patent owner relies in support of the response;</p> <p>(9) setting forth standards and procedures for allowing the patent owner to move to amend the patent under subsection (d) to cancel a challenged claim or propose a reasonable number of substitute claims, and</p> | |
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| | | | <p>ensuring that any information submitted by the patent owner in support of any amendment entered under subsection (d) is made available to the public as part of the prosecution history of the patent;</p> <p>(10) providing either party with the right to an oral hearing as part of the proceeding;</p> <p>(11) requiring that the final determination in any post-grant review be issued not later than 1 year after the date on which the Director notices the institution of a proceeding under this chapter, except that the Director may, for good cause shown, extend the 1-year period by not more than 6 months, and may adjust the time periods in this paragraph in the case of joinder under section 325(c); and</p> <p>(12) providing the petitioner with at least 1 opportunity to file written comments within a time period established by the Director.</p> | |
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| | | <p>>>Back to index<<</p> | <p>(b) Considerations- In prescribing regulations under this section, the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.</p> <p>(c) Patent Trial and Appeal Board- The Patent Trial and Appeal Board shall, in accordance with section 6, conduct each post-grant review instituted under this chapter.</p> <p>(d) Amendment of the Patent-</p> <p>(1) IN GENERAL- During a post-grant review instituted under this chapter, the patent owner may file 1 motion to amend the patent in 1 or more of the following ways:</p> <p>(A) Cancel any challenged patent claim.</p> | |
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| | | | <p>(B) For each challenged claim, propose a reasonable number of substitute claims.</p> <p>(2) ADDITIONAL MOTIONS- Additional motions to amend may be permitted upon the joint request of the petitioner and the patent owner to materially advance the settlement of a proceeding under section 327, or upon the request of the patent owner for good cause shown.</p> <p>(3) SCOPE OF CLAIMS- An amendment under this subsection may not enlarge the scope of the claims of the patent or introduce new matter.</p> <p>(e) Evidentiary Standards- In a post-grant review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.</p> | |
| | | <p>35 U.S.C. § 327</p> <p>>>Back to index<<</p> | <p>(a) In General- A post-grant review instituted under this chapter shall be terminated</p> | <p>Upon the expiration of 1-year beginning on September 16, 2011.</p> |

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| | | | <p>with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed. If the post-grant review is terminated with respect to a petitioner under this section, no estoppel under section 325(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner, on the basis of that petitioner's institution of that post-grant review. If no petitioner remains in the post-grant review, the Office may terminate the post-grant review or proceed to a final written decision under section 328(a).</p> <p>(b) Agreements in Writing- Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of a post-grant review under this section</p> | |
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| | | | shall be in writing, and a true copy of such agreement or understanding shall be filed in the Office before the termination of the post-grant review as between the parties. 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, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause. | |
| | | <p>35 U.S.C. § 328</p> <p>>>Back to index<<</p> | <p>(a) Final Written Decision- If a post-grant review is instituted and not dismissed under this chapter, the Patent Trial and Appeal Board shall issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 326(d).</p> <p>(b) Certificate- If the Patent Trial and Appeal Board issues a final written decision under subsection (a) and the time</p> | <p>Upon the expiration of 1-year beginning on September 16, 2011.</p> |

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| | | | <p>for appeal has expired or any appeal has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent by operation of the certificate any new or amended claim determined to be patentable.</p> <p>(c) Intervening Rights- Any proposed amended or new claim determined to be patentable and incorporated into a patent following a post-grant review under this chapter shall have the same effect as that specified in section 252 of this title for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation therefor, before the issuance of a certificate under subsection (b).</p> | |
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| | | | (d) Data on Length of Review- The Office shall make available to the public data describing the length of time between the institution of, and the issuance of a final written decision under subsection (a) for, each post-grant review. | |
| | | 35 U.S.C. § 329 >>Back to index<< | A party dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 328(a) may appeal the decision pursuant to sections 141 through 144. Any party to the post-grant review shall have the right to be a party to the appeal. | Upon the expiration of 1-year beginning on September 16, 2011. |
| 35 U.S.C. § 363 >>Back to index<< | An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102 (e) of this title. | 35 U.S.C. § 363 | An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102 (e) of this title. | Upon expiration of 18 months beginning on September 16, 2011 and applies to (A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) 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 |

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| | | | | any time such a claim. |
| 35 U.S.C. § 371 >>Back to index<< | (b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22(1) or (2), or under article 39(1)(a) of the treaty | 35 U.S.C. § 371 | (b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22(1) or (2), or under article 39(1)(a) of the treaty. | Upon the expiration of 1-year beginning on September 16, 2011. |
| 35 U.S.C. § 374 >>Back to index<< | The publication under the treaty defined in section 351 (a) of this title, of an international application designating the United States shall be deemed a publication under section 122 (b), except as provided in sections 102 (e) and 154 (d) of this title. | 35 U.S.C. § 374 | The publication under the treaty defined in section 351 (a) of this title, of an international application designating the United States shall be deemed a publication under section 122 (b), except as provided in sections 102 (e) and 154 (d) <u>section 154(d)</u> of this title. | Upon expiration of 18 months beginning on September 16, 2011 and applies to (A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) 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 U.S.C. § 375 >>Back to index<< | (a) A patent may be issued by the Director based on an international application designating the United States, in accordance with the provisions of this title. Subject to section 102 (e) of this title, such patent shall have the force and effect of a | 35 U.S.C. § 375 | (a) A patent may be issued by the Director based on an international application designating the United States, in accordance with the provisions of this title. Subject to section 102 (e) of this title, such <u>Such</u> patent shall have the force and | Upon expiration of 18 months beginning on September 16, 2011 and applies to (A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) of title 35, United States Code, that is on or after the |

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| | (a)(4)(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; | | <u>interferences derivation proceeding, reexamination, post-grant review or inter partes review under title 35, at the instance of an applicant for a patent or any party to a patent interference, and any such appeal 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;</u> | |
| 28 U.S.C. § 1338 >>Back to index<< | (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 | 28 U.S.C. § 1338 | (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 | Any civil action commenced on or after September 16, 2011. |

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| | courts of the states in patent, plant variety protection and copyright cases. | | courts of the states in patent, plant variety protection and copyright cases. <u>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.</u> | |
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3. Title 51 U.S.C.

| Existing section number | Existing section text | Amended section number | Amended section text | Effective date |
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| 51 U.S.C. § 20135 >>Back to index<< | ... (e) ISSUANCE OF PATENT TO APPLICANT.— Upon any application as to which any such statement has been transmitted to the Administrator, the Director may, if the invention is patentable, issue a patent to the applicant unless the Administrator, within 90 days after receipt of the | 51 U.S.C. § 20135 | ... (e) ISSUANCE OF PATENT TO APPLICANT.— Upon any application as to which any such statement has been transmitted to the Administrator, the Director may, if the invention is patentable, issue a patent to the applicant unless the Administrator, within 90 days after receipt of the | Upon the expiration of 1-year beginning on September 16, 2011. |

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| | <p>application and statement, requests that the patent be issued to the Administrator on behalf of the United States. If, within such time, the Administrator files such a request with the Director, the Director shall transmit notice thereof to the applicant, and shall issue such patent to the Administrator unless the applicant within 30 days after receipt of the notice requests a hearing before the Board of Patent Appeals and Interferences on the question whether the Administrator is entitled under this section to receive the patent. The Board may hear and determine, in accordance with rules and procedures established for interference cases, the question so presented, and its determination shall be subject to appeal by the applicant or by the Administrator to the United States Court of Appeals for the Federal Circuit in accordance with procedures governing appeals from decisions of the Board of Patent Appeals and Interferences in other proceedings.</p> | | <p>application and statement, requests that the patent be issued to the Administrator on behalf of the United States. If, within such time, the Administrator files such a request with the Director, the Director shall transmit notice thereof to the applicant, and shall issue such patent to the Administrator unless the applicant within 30 days after receipt of the notice requests a hearing before the Board of Patent Appeals and Interferences <u>Patent Trial and Appeal Board</u> on the question whether the Administrator is entitled under this section to receive the patent. The Board may hear and determine, in accordance with rules and procedures established for interference <u>and derivation</u> cases, the question so presented, and its determination shall be subject to appeal by the applicant or by the Administrator to the United States Court of Appeals for the Federal Circuit in accordance with procedures governing appeals from decisions of the Board of</p> | |
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| | <p>(f) Subsequent Transfer of Patent in Case of False Representations.— Whenever a patent has been issued to an applicant in conformity with subsection (e), and the Administrator thereafter has reason to believe that the statement filed by the applicant in connection with the patent contained a false representation of a material fact, the Administrator, within 5 years after the date of issuance of the patent, may file with the Director a request for the transfer to the Administrator of title to the patent on the records of the Director. Notice of any such request shall be transmitted by the Director to the owner of record of the patent, and title to the patent shall be so transferred to the Administrator unless, within 30 days after receipt of notice, the owner of record requests a hearing before the Board of Patent Appeals and Interferences on the question whether any such false representation was contained in the statement filed in connection with the</p> | | <p>Patent Appeals and Interferences in other proceedings. (f) Subsequent Transfer of Patent in Case of False Representations.— Whenever a patent has been issued to an applicant in conformity with subsection (e), and the Administrator thereafter has reason to believe that the statement filed by the applicant in connection with the patent contained a false representation of a material fact, the Administrator, within 5 years after the date of issuance of the patent, may file with the Director a request for the transfer to the Administrator of title to the patent on the records of the Director. Notice of any such request shall be transmitted by the Director to the owner of record of the patent, and title to the patent shall be so transferred to the Administrator unless, within 30 days after receipt of notice, the owner of record requests a hearing before the Board of Patent Appeals and Interferences <u>Patent Trial and Appeal</u></p> | |
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| | <p>patent. The question shall be heard and determined, and the determination shall be subject to review, in the manner prescribed by subsection (e) for questions arising thereunder. A request made by the Administrator under this subsection for the transfer of title to a patent, and prosecution for the violation of any criminal statute, shall not be barred by the failure of the Administrator to make a request under subsection (e) for the issuance of the patent to the Administrator, or by any notice previously given by the Administrator stating that the Administrator had no objection to the issuance of the patent to the applicant.</p> | | <p><u>Board</u> on the question whether any such false representation was contained in the statement filed in connection with the patent. The question shall be heard and determined, and the determination shall be subject to review, in the manner prescribed by subsection (e) for questions arising thereunder. A request made by the Administrator under this subsection for the transfer of title to a patent, and prosecution for the violation of any criminal statute, shall not be barred by the failure of the Administrator to make a request under subsection (e) for the issuance of the patent to the Administrator, or by any notice previously given by the Administrator stating that the Administrator had no objection to the issuance of the patent to the applicant.</p> | |
| 28 U.S.C. § 1454 | None | <p>28 U.S.C. § 1454</p> <p>>>Back to Index<<</p> | <p>(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</p> | <p>Any civil action commenced on or after September 16, 2011.</p> |

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| | | | <p>district court of the United States for the district and division embracing the place where the action is pending.</p> <p>(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--</p> <p>(1) the action may be removed by any party; and</p> <p>(2) the time limitations contained in section 1446(b) may be extended at any time for cause shown.</p> <p>(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.</p> <p>(d) Remand- If a civil action is removed solely under this section, the district court--</p> | |
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| | | | <p>(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</p> <p>(2) may, under the circumstances specified in section 1367(c), remand any claims within the supplemental jurisdiction of the district court under section 1367.</p> | |
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4. Title 42 U.S.C.

| Existing section number | Existing section text | Amended section number | Amended section text | Effective date |
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| <p>42 U.S.C. § 2182</p> <p>>>Back to index<<</p> | <p>Any invention or discovery, useful in the production or utilization of special nuclear material or atomic energy, made or conceived in the course of or under any contract, subcontract, or arrangement entered into with or for the benefit of the Commission, regardless of whether the contract, subcontract, or arrangement involved the expenditure of funds by the Commission, shall be vested in, and be the property of, the Commission,</p> | <p>42 U.S.C. § 2182</p> | <p>Any invention or discovery, useful in the production or utilization of special nuclear material or atomic energy, made or conceived in the course of or under any contract, subcontract, or arrangement entered into with or for the benefit of the Commission, regardless of whether the contract, subcontract, or arrangement involved the expenditure of funds by the Commission, shall be vested in, and be the property of, the Commission,</p> | <p>Upon the expiration of 1-year beginning on September 16, 2011.</p> |

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| | <p>except that the Commission may waive its claim to any such invention or discovery under such circumstances as the Commission may deem appropriate, consistent with the policy of this section. No patent for any invention or discovery, useful in the production or utilization of special nuclear material or atomic energy, shall be issued unless the applicant files with the application, or within thirty days after request therefor by the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (unless the Commission advises the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office that its rights have been determined and that accordingly no statement is necessary) a statement under oath setting forth the full facts surrounding the making or conception of the invention or discovery described in the application and whether the</p> | | <p>except that the Commission may waive its claim to any such invention or discovery under such circumstances as the Commission may deem appropriate, consistent with the policy of this section. No patent for any invention or discovery, useful in the production or utilization of special nuclear material or atomic energy, shall be issued unless the applicant files with the application, or within thirty days after request therefor by the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (unless the Commission advises the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office that its rights have been determined and that accordingly no statement is necessary) a statement under oath setting forth the full facts surrounding the making or conception of the invention or discovery described in the application and whether the</p> | |
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| | <p>invention or discovery was made or conceived in the course of or under any contract, subcontract, or arrangement entered into with or for the benefit of the Commission, regardless of whether the contract, subcontract, or arrangement involved the expenditure of funds by the Commission. The Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office shall as soon as the application is otherwise in condition for allowance forward copies of the application and the statement to the Commission.</p> <p>The Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office may proceed with the application and issue the patent to the applicant (if the invention or discovery is otherwise patentable) unless the Commission, within 90 days after receipt of copies of the application and statement, directs the Under Secretary</p> | | <p>invention or discovery was made or conceived in the course of or under any contract, subcontract, or arrangement entered into with or for the benefit of the Commission, regardless of whether the contract, subcontract, or arrangement involved the expenditure of funds by the Commission. The Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office shall as soon as the application is otherwise in condition for allowance forward copies of the application and the statement to the Commission.</p> <p>The Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office may proceed with the application and issue the patent to the applicant (if the invention or discovery is otherwise patentable) unless the Commission, within 90 days after receipt of copies of the application and statement, directs the Under Secretary</p> | |
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| | <p>of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office to issue the patent to the Commission (if the invention or discovery is otherwise patentable) to be held by the Commission as the agent of and on behalf of the United States.</p> <p>If the Commission files such a direction with the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, and if the applicant's statement claims, and the applicant still believes, that the invention or discovery was not made or conceived in the course of or under any contract, subcontract or arrangement entered into with or for the benefit of the Commission entitling the Commission to the title to the application or the patent the applicant may, within 30 days after notification of the filing of such a direction, request a hearing before the Board of Patent Appeals and Interferences. The Board shall have the power to hear and determine whether the</p> | | <p>of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office to issue the patent to the Commission (if the invention or discovery is otherwise patentable) to be held by the Commission as the agent of and on behalf of the United States.</p> <p>If the Commission files such a direction with the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, and if the applicant's statement claims, and the applicant still believes, that the invention or discovery was not made or conceived in the course of or under any contract, subcontract or arrangement entered into with or for the benefit of the Commission entitling the Commission to the title to the application or the patent the applicant may, within 30 days after notification of the filing of such a direction, request a hearing before the Board of Patent Appeals and Interferences <u>Patent Trial and Appeal Board</u>. The Board shall have the power to hear</p> | |
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| | <p>Commission was entitled to the direction filed with the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office. The Board shall follow the rules and procedures established for interference cases and an appeal may be taken by either the applicant or the Commission from the final order of the Board to the United States Court of Appeals for the Federal Circuit in accordance with the procedures governing the appeals from the Board of Patent Appeals and Interferences.</p> <p>If the statement filed by the applicant should thereafter be found to contain false material statements any notification by the Commission that it has no objections to the issuance of a patent to the applicant shall not be deemed in any respect to constitute a waiver of the provisions of this section or of any applicable civil or criminal statute, and the Commission may have the title to the patent</p> | | <p>and determine whether the Commission was entitled to the direction filed with the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office. The Board shall follow the rules and procedures established for interference cases and an appeal may be taken by either the applicant or the Commission from the final order of the Board to the United States Court of Appeals for the Federal Circuit in accordance with the procedures governing the appeals from the Board of Patent Appeals and Interferences <u>Patent Trial and Appeal Board</u>.</p> <p>If the statement filed by the applicant should thereafter be found to contain false material statements any notification by the Commission that it has no objections to the issuance of a patent to the applicant shall not be deemed in any respect to constitute a waiver of the provisions of this section or of any applicable civil or criminal statute, and</p> | |
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| | <p>transferred to the Commission on the records of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office in accordance with the provisions of this section. A determination of rights by the Commission pursuant to a contractual provision or other arrangement prior to the request of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office for the statement, shall be final in the absence of false material statements or nondisclosure of material facts by the applicant.</p> | | <p>the Commission may have the title to the patent transferred to the Commission on the records of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office in accordance with the provisions of this section. A determination of rights by the Commission pursuant to a contractual provision or other arrangement prior to the request of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office for the statement, shall be final in the absence of false material statements or nondisclosure of material facts by the applicant.</p> | |
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