

EFFECTIVE DATE OF 1994 AMENDMENT

Amendment by Pub. L. 103-465 effective on date that is one year after date on which the WTO Agreement enters into force with respect to the United States [Jan. 1, 1995], with provisions relating to earliest filed patent application, see section 534(a), (b)(3) of Pub. L. 103-465, set out as a note under section 154 of this title.

CHAPTER 31—INTER PARTES REVIEW

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AMENDMENTS

2011—Pub. L. 112-29, §6(a), Sept. 16, 2011, 125 Stat. 299, substituted “INTER PARTES REVIEW” for “OPTIONAL INTER PARTES REEXAMINATION PROCEDURES” in chapter heading and amended analysis generally, adding items 311 to 319, and striking out former items 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”, 315 “Appeal”, 316 “Certificate of patentability, unpatentability, and claim cancellation”, 317 “Inter partes reexamination prohibited”, and 318 “Stay of litigation”.

2002—Pub. L. 107-273, div. C, title III, §13202(c)(1), Nov. 2, 2002, 116 Stat. 1902, made technical correction to directory language of Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-567, which enacted this chapter.

§ 311. Inter partes review

(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.

(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.

(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

(2) if a post-grant review is instituted under chapter 32, the date of the termination of such post-grant review.

(Added Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-567; amended Pub. L. 107-273, div. C, title III, §13202(a)(1), (c)(1), Nov. 2, 2002, 116 Stat. 1901, 1902; Pub. L. 112-29, §6(a), Sept. 16, 2011, 125 Stat. 299; Pub. L. 112-274, §1(d)(2), Jan. 14, 2013, 126 Stat. 2456.)

AMENDMENTS

2013—Subsec. (c)(1). Pub. L. 112-274 struck out “or issuance of a reissue of a patent” after “grant of a patent”.

2011—Pub. L. 112-29 amended section generally. Prior to amendment, section related to request for inter partes reexamination.

2002—Pub. L. 107-273, §13202(c)(1), made technical correction to directory language of Pub. L. 106-113, which enacted this section.

Subsec. (a). Pub. L. 107-273, §13202(a)(1)(A), substituted “third-party requester” for “person”.

Subsec. (c). Pub. L. 107-273, §13202(a)(1)(B), substituted “The” for “Unless the requesting person is the owner of the patent, the”.

EFFECTIVE DATE OF 2013 AMENDMENT

Amendment by Pub. L. 112-274 effective Jan. 14, 2013, and applicable to proceedings commenced on or after such date, see section 1(n) of Pub. L. 112-274, set out as a note under section 5 of this title.

EFFECTIVE DATE OF 2011 AMENDMENT

Pub. L. 112-29, §6(c)(2), Sept. 16, 2011, 125 Stat. 304, provided that:

“(A) IN GENERAL.—The amendments made by subsection (a) [enacting section 319 of this title and amending this section and sections 312 to 318 of this title] shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act [Sept. 16, 2011] and shall apply to any patent issued before, on, or after that effective date.

“(B) GRADUATED IMPLEMENTATION.—The Director [Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] may impose a limit on the number of inter partes reviews that may be instituted under chapter 31 of title 35, United States Code, during each of the first 4 1-year periods in which the amendments made by subsection (a) are in effect, if such number in each year equals or exceeds the number of inter partes reexaminations that are ordered under chapter 31 of title 35, United States Code, in the last fiscal year ending before the effective date of the amendments made by subsection (a).”

EFFECTIVE DATE

Chapter effective Nov. 29, 1999, and applicable to any patent issuing from an original application filed in the United States on or after that date, see section 1000(a)(9) [title IV, §4608(a)] of Pub. L. 106-113, set out as an Effective Date of 1999 Amendment note under section 41 of this title.

REGULATIONS

Pub. L. 112-29, §6(c)(1), Sept. 16, 2011, 125 Stat. 304, provided that: “The Director [Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] shall, not later than the date that is 1 year after the date of the enactment of this Act [Sept. 16, 2011], issue regulations to carry out chapter 31 of title 35, United States Code, as amended by subsection (a) of this section.”

APPLICABILITY OF FILING DEADLINE

Pub. L. 112-274, §1(d)(1), Jan. 14, 2013, 126 Stat. 2456, provided that: “Section 311(c) of title 35, United States Code, shall not apply to a petition to institute an inter partes review of a patent that is not a patent described in section 3(n)(1) of the Leahy-Smith America Invents Act [Pub. L. 112-29] (35 U.S.C. 100 note).”

REPORT TO CONGRESS

Pub. L. 106-113, div. B, §1000(a)(9) [title IV, subtitle F, §4606], Nov. 29, 1999, 113 Stat. 1536, 1501A-571, required the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office to submit to Congress a report on possible inequities of certain inter partes reexamination proceedings no later than 5 years after Nov. 29, 1999.

§ 312. Petitions

(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 evidence that supports the grounds for the challenge to each claim, including—

(A) copies of patents and printed publications that the petitioner relies upon in support of the petition; and

(B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on expert opinions;

(4) the petition provides such other information as the Director may require by regulation; and

(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.

(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.

(Added Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A–568; amended Pub. L. 107–273, div. C, title III, §§13105(a), 13202(a)(2), (c)(1), Nov. 2, 2002, 116 Stat. 1900–1902; Pub. L. 112–29, §6(a), (c)(3)(A)(i), Sept. 16, 2011, 125 Stat. 300, 305.)

AMENDMENTS

2011—Pub. L. 112–29, §6(a), amended section generally. Prior to amendment, section related to determination of issue by Director.

Subsec. (a). Pub. L. 112–29, §6(c)(3)(A)(i)(I), substituted “the information presented in the request shows that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request,” for “a substantial new question of patentability affecting any claim of the patent concerned is raised by the request,” and “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” for “The existence of a substantial new question of patentability”.

Subsec. (c). Pub. L. 112–29, §6(c)(3)(A)(i)(II), substituted “the showing required by subsection (a) has not been made,” for “no substantial new question of patentability has been raised.”

2002—Pub. L. 107–273, §13202(c)(1), made technical correction to directory language of Pub. L. 106–113, which enacted this section.

Subsec. (a). Pub. L. 107–273, §13202(a)(2)(A), struck out second sentence which read as follows: “On the Director’s initiative, and at any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications.”

Pub. L. 107–273, §13105(a), inserted at end “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 the Office.”

Subsec. (b). Pub. L. 107–273, §13202(a)(2)(B), struck out “, if any” after “third-party requester”.

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 6(a) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112–29, set out as a note under section 311 of this title.

Pub. L. 112–29, §6(c)(3)(B), (C), Sept. 16, 2011, 125 Stat. 305, provided that:

“(B) APPLICATION.—The amendments made by this paragraph [amending this section and section 313 of this title]—

“(i) shall take effect on the date of the enactment of this Act [Sept. 16, 2011]; and

“(ii) shall apply to requests for inter partes reexamination that are filed on or after such date of enactment, but before the effective date set forth in paragraph (2)(A) of this subsection [set out as a note under section 311 of this title].

“(C) CONTINUED APPLICABILITY OF PRIOR PROVISIONS.—The provisions of chapter 31 of title 35, United States Code, as amended by this paragraph [amending this section and section 313 of this title], shall continue to apply to requests for inter partes reexamination that are filed before the effective date set forth in paragraph (2)(A) as if subsection (a) [enacting section 319 of this title and amending this section and sections 312 to 318 of this title] had not been enacted.”

EFFECTIVE DATE OF 2002 AMENDMENT

Amendment by section 13105(a) of Pub. L. 107–273 applicable with respect to any determination of the Director of the United States Patent and Trademark Office that is made on or after Nov. 2, 2002, see section 13105(b) of Pub. L. 107–273, set out as a note under section 303 of this title.

§ 313. Preliminary response to petition

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.

(Added Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A–568; amended Pub. L. 107–273, div. C, title III, §13202(c)(1), Nov. 2, 2002, 116 Stat. 1902; Pub. L. 112–29, §6(a), (c)(3)(A)(ii), Sept. 16, 2011, 125 Stat. 300, 305.)

AMENDMENTS

2011—Pub. L. 112–29, §6(c)(3)(A)(ii), which directed substitution of “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” for “a substantial new question of patentability affecting a claim of the patent is raised”, was executed by making the substitution for “a substantial new question of patentability affecting a claim of a patent is raised”, to reflect the probable intent of Congress.

Pub. L. 112–29, §6(a), amended section generally. Prior to amendment, text read as follows: “If, in a determination made under section 312(a), the Director finds that 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, 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.”

2002—Pub. L. 107-273 made technical correction to directory language of Pub. L. 106-113, which enacted this section.

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 6(a) of Pub. L. 112-29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112-29, set out as a note under section 311 of this title.

Amendment by section 6(c)(3)(A)(i) of Pub. L. 112-29 effective Sept. 16, 2011, and applicable to requests for inter partes reexamination filed on or after Sept. 16, 2011, but before the effective date set forth in section 6(c)(2)(A) of Pub. L. 112-29, with continued applicability of prior provisions, see section 6(c)(3)(B), (C) of Pub. L. 112-29, set out as a note under section 312 of this title.

§ 314. Institution of inter partes review

(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.

(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—

(1) receiving a preliminary response to the petition under section 313; or

(2) if no such preliminary response is filed, the last date on which such response may be filed.

(c) **NOTICE.**—The Director shall notify the petitioner 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.

(d) **NO APPEAL.**—The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.

(Added Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-568; amended Pub. L. 107-273, div. C, title III, § 13202(a)(3), (c)(1), Nov. 2, 2002, 116 Stat. 1901, 1902; Pub. L. 112-29, § 6(a), Sept. 16, 2011, 125 Stat. 300.)

AMENDMENTS

2011—Pub. L. 112-29 amended section generally. Prior to amendment, section related to conduct of inter partes reexamination proceedings.

2002—Pub. L. 107-273, § 13202(c)(1), made technical correction to directory language of Pub. L. 106-113, which enacted this section.

Subsec. (b). Pub. L. 107-273, § 13202(a)(3), redesignated par. (2) as (1), substituted “the Office shall send to the third-party requester a copy” for “the third-party requester shall receive a copy”, redesignated par. (3) as (2), and struck out former par. (1) which read as follows: “This subsection shall apply to any inter partes reexamination proceeding in which the order for inter partes reexamination is based upon a request by a third-party requester.”

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by Pub. L. 112-29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011,

and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112-29, set out as a note under section 311 of this title.

§ 315. Relation to other proceedings or actions

(a) **INFRINGEMENT'S CIVIL ACTION.**—

(1) **INTER PARTES REVIEW BARRED BY CIVIL ACTION.**—An inter partes review may not be instituted 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.

(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—

(A) the patent owner moves the court to lift the stay;

(B) the patent owner files a civil action or counterclaim alleging that the petitioner or real party in interest has infringed the patent; or

(C) the petitioner or real party in interest moves the court to dismiss the civil action.

(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.

(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).

(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 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.

(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.

(e) **ESTOPPEL.**—

(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 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.

(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.

(Added Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A–569; amended Pub. L. 107–273, div. C, title III, §§13106(a), 13202(a)(4), (c)(1), Nov. 2, 2002, 116 Stat. 1900–1902; Pub. L. 112–29, §6(a), Sept. 16, 2011, 125 Stat. 300.)

REFERENCES IN TEXT

Section 337 of the Tariff Act of 1930, referred to in subsec. (e)(2), is classified to section 1337 of Title 19, Customs Duties.

AMENDMENTS

2011—Pub. L. 112–29 amended section generally. Prior to amendment, section related to appeals.

2002—Pub. L. 107–273, §13202(c)(1), made technical correction to directory language of Pub. L. 106–113, which enacted this section.

Subsec. (b). Pub. L. 107–273, §13106(a), reenacted heading without change and amended text generally. Prior to amendment, text read as follows: “A third-party requester may—

“(1) appeal under the provisions of section 134 with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; or

“(2) be a party to any appeal taken by the patent owner under the provisions of section 134, subject to subsection (c).”

Subsec. (c). Pub. L. 107–273, §13202(a)(4), struck out “United States Code,” after “title 28,”.

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112–29, set out as a note under section 311 of this title.

EFFECTIVE DATE OF 2002 AMENDMENT

Amendment by section 13106(a) of Pub. L. 107–273 applicable with respect to any reexamination proceeding commenced on or after Nov. 2, 2002, see section 13106(d) of Pub. L. 107–273, set out as a note under section 134 of this title.

ESTOPPEL EFFECT OF REEXAMINATION

Pub. L. 106–113, div. B, §1000(a)(9) [title IV, subtitle F, §4607], Nov. 29, 1999, 113 Stat. 1536, 1501A–571, provided for estoppel from challenging certain facts determined during inter partes reexamination under former section 311 of this title and contained a severability provision.

§ 316. Conduct of inter partes review

(a) REGULATIONS.—The Director shall prescribe regulations—

(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;

(2) setting forth the standards for the showing of sufficient grounds to institute a review under section 314(a);

(3) establishing procedures for the submission of supplemental information after the petition is filed;

(4) establishing and governing inter partes review under this chapter and the relationship of such review to other proceedings under this title;

(5) setting forth standards and procedures for discovery of relevant evidence, including that such discovery shall be limited to—

(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 and expert opinions on which the patent owner relies in support of the response;

(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;

(10) providing either party with the right to an oral hearing as part of the proceeding;

(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, 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);

(12) setting a time period for requesting joinder under section 315(c); and

(13) providing the petitioner with at least 1 opportunity to file written comments within a time period established by the Director.

(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.

(c) **PATENT TRIAL AND APPEAL BOARD.**—The Patent Trial and Appeal Board shall, in accordance with section 6, conduct each inter partes review instituted under this chapter.

(d) **AMENDMENT OF THE PATENT.**—

(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:

(A) Cancel any challenged patent claim.

(B) For each challenged claim, propose a reasonable number of substitute claims.

(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.

(3) **SCOPE OF CLAIMS.**—An amendment under this subsection may not enlarge the scope of the claims of the patent or introduce new matter.

(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.

(Added Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A–569; amended Pub. L. 107–273, div. C, title III, §13202(c)(1), Nov. 2, 2002, 116 Stat. 1902; Pub. L. 112–29, §6(a), Sept. 16, 2011, 125 Stat. 302.)

AMENDMENTS

2011—Pub. L. 112–29 amended section generally. Prior to amendment, section related to certificate of patentability, unpatentability, and claim cancellation.

2002—Pub. L. 107–273 made technical correction to directory language of Pub. L. 106–113, which enacted this section.

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112–29, set out as a note under section 311 of this title.

§ 317. Settlement

(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 remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).

(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 con-

templation 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 person on a showing of good cause.

(Added Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A–570; amended Pub. L. 107–273, div. C, title III, §13202(a)(5), (c)(1), Nov. 2, 2002, 116 Stat. 1901, 1902; Pub. L. 112–29, §6(a), Sept. 16, 2011, 125 Stat. 303.)

AMENDMENTS

2011—Pub. L. 112–29 amended section generally. Prior to amendment, section related to restriction on subsequent request for inter partes reexamination.

2002—Pub. L. 107–273, §13202(c)(1), made technical correction to directory language of Pub. L. 106–113, which enacted this section.

Subsec. (a). Pub. L. 107–273, §13202(a)(5)(A), substituted “third-party requester nor its privies” for “patent owner nor the third-party requester, if any, nor privies of either”.

Subsec. (b). Pub. L. 107–273, §13202(a)(5)(B), struck out “United States Code,” after “title 28,”.

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112–29, set out as a note under section 311 of this title.

§ 318. Decision of the Board

(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).

(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.

(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).

(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.

(Added Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A–570; amended Pub. L. 107–273, div. C, title III, §13202(c)(1), Nov. 2, 2002, 116 Stat. 1902; Pub. L. 112–29, §6(a), Sept. 16, 2011, 125 Stat. 303.)

AMENDMENTS

2011—Pub. L. 112–29 amended section generally. Prior to amendment, text read as follows: “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.”

2002—Pub. L. 107–273 made technical correction to directory language of Pub. L. 106–113, which enacted this section.

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112–29, set out as a note under section 311 of this title.

§ 319. Appeal

A party dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) may appeal the decision pursuant to sections 141 through 144. Any party to the inter partes review shall have the right to be a party to the appeal.

(Added Pub. L. 112–29, §6(a), Sept. 16, 2011, 125 Stat. 304.)

EFFECTIVE DATE

Section effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment note under section 311 of this title.

CHAPTER 32—POST-GRANT REVIEW

Sec.	
321.	Post-grant review.
322.	Petitions.
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.
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§ 321. Post-grant review

(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.

(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).

(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 re-issue patent (as the case may be).

(Added Pub. L. 112–29, §6(d), Sept. 16, 2011, 125 Stat. 306.)

EFFECTIVE DATE

Pub. L. 112–29, §6(f)(2), (3), Sept. 16, 2011, 125 Stat. 311, provided that:

“(2) APPLICABILITY.—

“(A) IN GENERAL.—The amendments made by subsection (d) [enacting this chapter] shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act [Sept. 16, 2011] and, except as provided in section 18 [set out as a note below] and in paragraph (3), shall apply only to patents described in section 3(n)(1) [set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title].

“(B) LIMITATION.—The Director [Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] may impose a limit on the number of post-grant reviews that may be instituted under chapter 32 of title 35, United States Code, during each of the first 4 1-year periods in which the amendments made by subsection (d) are in effect.

“(3) PENDING INTERFERENCES.—

“(A) PROCEDURES IN GENERAL.—The Director shall determine, and include in the regulations issued under paragraph (1) [set out as a note below], the procedures under which an interference commenced before the effective date set forth in paragraph (2)(A) is to proceed, including whether such interference—

“(i) is to be dismissed without prejudice to the filing of a petition for a post-grant review under chapter 32 of title 35, United States Code; or

“(ii) is to proceed as if this Act [see Short Title of 2011 Amendment note set out under section 1 of this title] had not been enacted.

“(B) PROCEEDINGS BY PATENT TRIAL AND APPEAL BOARD.—For purposes of an interference that is commenced before the effective date set forth in paragraph (2)(A), the Director may deem the Patent Trial and Appeal Board to be the Board of Patent Appeals and Interferences, and may allow the Patent Trial and Appeal Board to conduct any further proceedings in that interference.

“(C) APPEALS.—The authorization to appeal or have remedy from derivation proceedings in sections 141(d) and 146 of title 35, United States Code, as amended by this Act, and the jurisdiction to entertain appeals from derivation proceedings in section 1295(a)(4)(A) of title 28, United States Code, as amended by this Act, shall be deemed to extend to any final decision in an interference that is commenced before the effective date set forth in paragraph (2)(A) of this subsection and that is not dismissed pursuant to this paragraph.”

REGULATIONS

Pub. L. 112–29, §6(f)(1), Sept. 16, 2011, 125 Stat. 311, provided that: “The Director [Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] shall, not later than the date that is 1 year after the date of the