CHAPTER 1—ESTABLISHMENT, OFFICERS AND EMPLOYEES, FUNCTIONS

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AMENDMENTS


§1. Establishment

(a) ESTABLISHMENT—The United States Patent and Trademark Office is established as an agency of the United States, within the Department of Commerce. In carrying out its functions, the United States Patent and Trademark Office shall be subject to the policy direction of the Secretary of Commerce, but otherwise shall retain responsibility for decisions regarding the management and administration of its operations and shall exercise independent control of its budget allocations and expenditures, personnel decisions and processes, procurements, and other administrative and management functions in accordance with this title and applicable provisions of law. Those operations designed to grant and issue patents and those operations which are designed to facilitate the registration of trademarks shall be treated as separate operating units within the Office.
(b) OFFICES.—The United States Patent and Trademark Office shall maintain its principal office in the metropolitan Washington, D.C., area, for the service of process and papers and for the purpose of carrying out its functions. The United States Patent and Trademark Office shall be deemed, for purposes of venue in civil actions, to be a resident of the district in which its principal office is located, except where jurisdiction is otherwise provided by law. The United States Patent and Trademark Office may establish satellite offices in such other places in the United States as it considers necessary and appropriate in the conduct of its business.

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


HISTORICAL AND REVISION NOTES


The word “all” is omitted from the corresponding section of the existing statute and “except as otherwise provided by law” added, since some old records are kept in the National Archives, see 4 U.S.C., 1946 ed., ch. 8A.

The phrase “and to trade-mark registrations” is added. There is no enactment corresponding to this section in the trade-mark law. The original chapter of the Revised Statutes containing this section deals with the Patent Office as such in its administration of trademarks as well as patents. This is explicitly brought out in some of the corresponding sections of the present chapter. Changes in language are made.

AMENDMENTS

1999—Pub. L. 106–113 reenacted section catchline without change and amended text generally. Prior to amendment, text read as follows: “The Patent and Trademark Office shall continue as an office in the Department of Commerce, where records, books, drawings, specifications, and other papers and things pertaining to patents and to trademark registrations shall be kept and preserved, except as otherwise provided by law.”


CHANGE OF NAME


EFFECTIVE DATE OF 2011 AMENDMENT


EFFECTIVE DATE OF 1975 AMENDMENT


SHORT TITLE OF 2012 AMENDMENT


SHORT TITLE OF 2011 AMENDMENT


SHORT TITLE OF 2004 AMENDMENT


SHORT TITLE OF 2002 AMENDMENT


SHORT TITLE OF 1999 AMENDMENT


tion 41 of this title and section 1113 of Title 15, Commerce and Trade] may be cited as the ‘Patent and Trademark Fee Fairness Act of 1999’.


Short Title of 1998 Amendments


Pub. L. 106–113, div. B, §1000(a)(9) [title IV, subtitle F, §4601], Nov. 29, 1999, 113 Stat. 1536, 1501A–567, provided that: ‘‘This subtitle [enacting chapter 31 of this title, amending sections 41, 100, 134, 141, 143, and 145 of this title, and enacting provisions set out as notes under sections 41, 111, and 122 of this title] may be cited as the ‘Optional Inter Partes Reexamination Procedure Act of 1999.’’


Short Title of 1988 Amendment


Pub. L. 100–418, title IX, §901(a), Aug. 23, 1988, 102 Stat. 1567, provided that: ‘‘This section [amending sections 184 to 186 of this title and enacting provisions set out as notes under section 184 of this title] may be cited as the ‘Patent Law Amendments Act of 1984.’’

Short Title of 1984 Amendment


Transfer of Functions and Assets of Patent and Trademark Office


‘‘SEC. 4741. REFERENCES.

‘‘(a) IN GENERAL.—Any reference in any other Federal law, Executive order, rule, regulation, or delegation of authority, or any document of or pertaining to a department or office from which a function is transferred by this subtitle [see Tables for classification]—

‘‘(1) to the head of such department or office is deemed to refer to the head of the department or office to which such function is transferred; and

‘‘(2) to such department or office is deemed to refer to the department or office to which such function is transferred.

‘‘(b) SPECIFIC REFERENCES.—Any reference in any other Federal law, Executive order, rule, regulation, or delegation of authority, or any document of or pertaining to the Patent and Trademark Office—

‘‘(1) to the Commissioner of Patents and Trademarks is deemed to refer to the Commissioner for Patents and Trademarks; or

‘‘(2) to the Assistant Commissioner for Trademarks is deemed to refer to the Commissioner for Trademarks.

‘‘SEC. 4742. EXERCISE OF AUTHORITIES.

‘‘Except as otherwise provided by law, a Federal official to whom a function is transferred by this subtitle may, for purposes of performing the function, exercise all authorities under any other provision of law that were available with respect to the performance of that function to the official responsible for the performance of the function immediately before the effective date of the transfer of the function under this subtitle.

‘‘SEC. 4743. SAVINGS PROVISIONS.

‘‘(a) LEGAL DOCUMENTS.—All orders, determinations, rules, regulations, permits, grants, loans, contracts, agreements, certificates, licenses, and privileges—

‘‘(1) that have been issued, made, granted, or allowed to become effective by the President, the Secretary of Commerce, any officer or employee of any office transferred by this subtitle, or any other Government official, or by a court of competent jurisdiction, or by operation of law.

‘‘(2) that are in effect on the effective date of such transfer (or become effective after such date pursuant to their terms as in effect on such effective date), shall continue in effect according to their terms until modified, terminated, superseded, set aside, or revoked in accordance with law by the President, any other authorized official, a court of competent jurisdiction, or operation of law.

‘‘(b) PROCEEDINGS.—This subtitle shall not affect any proceedings or any application for any benefits, services, licenses, permits, certificates, or financial assistance pending on the effective date of this subtitle [see Effective Date of 1999 Amendment note above] before an office transferred by this subtitle, but such proceedings and applications shall be continued. Orders shall be issued in such proceedings, appeals shall be taken therefrom, and payments shall be made pursuant to such orders, as if this subtitle had not been enacted, and orders issued in any such proceeding shall continue in effect until modified, terminated, superseded, or revoked by a duly authorized official, by a court of competent jurisdiction, or by operation of law. Nothing in this subsection shall be considered to prohibit the discontinuance or modification of any such proceeding under the same terms and conditions and to the same extent that such proceeding could have been discontinued or modified if this subtitle had not been enacted.
"(c) SUITS.—This subtitle shall not affect suits commenced before the effective date of this subtitle, and in all such suits, proceedings shall be had, appeals taken, and judgments rendered in the same manner and with the same effect as if this subtitle had not been enacted.

"(d) NONABATEMENT OF ACTIONS.—No suit, action, or other proceeding commenced by or against the Department of Commerce, the Secretary of Commerce, or by or against any individual in the official capacity of such individual as an officer or employee of an office transferred by this subtitle, shall abate by reason of the enactment of this subtitle.

"(e) CONTINUANCE OF SUITS.—If any Government officer in the official capacity of such officer is party to a suit with respect to a function of the officer, and under this subtitle such function is transferred to any other officer or office, then such suit shall be continued with the other officer or the head of such other office, as applicable, substituted or added as a party.

"(f) ADMINISTRATIVE PROCEEDING AND JUDICIAL REVIEW.—Except as otherwise provided by this subtitle, any statutory requirements relating to notice, hearings, action upon the record, or administrative or judicial review that apply to any function transferred by this subtitle shall apply to the exercise of such function by the head of the Federal agency, and other officers and employees of the agency, to which such function is transferred by this subtitle.

"SEC. 4744. TRANSFER OF ASSETS.

"Except as otherwise provided in this subtitle, so much of the personnel, property, records, and unexpended balances of appropriations, allocations, and other funds employed, used, held, available, or to be made available in connection with a function transferred to an official or agency by this subtitle shall be available to the official or the head of that agency, respectively, at such time or times as the Director of the Office of Management and Budget directs for use in connection with the functions transferred.

"SEC. 4745. DELEGATION AND ASSIGNMENT.

"Except as otherwise expressly prohibited by law or otherwise provided in this subtitle, so much of the functions transferred under this subtitle (including the head of any office to which functions are transferred under this subtitle) may delegate any of the functions so transferred to such officers and employees of the office of the official as the official may designate, and may authorize successive redelegations of such functions as may be necessary or appropriate. No delegation of functions under this section or under any other provision of this subtitle shall relieve the official to whom a function is transferred under this subtitle of responsibility for the administration of the function.

"SEC. 4746. AUTHORITY OF DIRECTOR OF THE OFFICE OF MANAGEMENT AND BUDGET WITH RESPECT TO FUNCTIONS TRANSFERRED.

"(a) DETERMINATIONS.—If necessary, the Director of the Office of Management and Budget shall make any determination of the functions that are transferred under this subtitle.

"(b) INCIDENTAL TRANSFERS.—The Director of the Office of Management and Budget, at such time or times as the Director shall provide, may make such determinations as may be necessary with regard to the functions transferred by this subtitle, and to make such additional incidental dispositions of personnel, assets, liabilities, grants, contracts, property, records, and unexpended balances of appropriations, authorizations, allocations, and other funds, held, used, arising from available to, or to be made available in connection with such functions, as may be necessary to carry out the provisions of this subtitle. The Director shall provide for the termination of the affairs of all entities terminated by this subtitle and for such further measures and dispositions as may be necessary to effectuate the purposes of this subtitle.

"SEC. 4747. CERTAIN VESTING OF FUNCTIONS CONSIDERED TRANSFERS.

"For purposes of this subtitle, the vesting of a function in a department or office pursuant to reestablishment of an office shall be considered to be the transfer of the function.

"SEC. 4748. AVAILABILITY OF EXISTING FUNDS.

"Existing appropriations and funds available for the performance of functions, programs, and activities terminated pursuant to this subtitle shall remain available, for the duration of their period of availability, for necessary expenses in connection with the termination and resolution of such functions, programs, and activities, subject to the submission of a plan to the Committees on Appropriations of the House and Senate in accordance with the procedures set forth in section 605 of the Departments of Commerce, Justice, and State, the Judiciary, and Related Agencies Appropriations Act, 1999, as contained in Public Law 105–277 [112 Stat. 2681–111].

"SEC. 4749. DEFINITIONS.

"For purposes of this subtitle—

"(1) the term ‘function’ includes any duty, obligation, power, authority, responsibility, right, privilege, activity, or program; and

"(2) the term ‘office’ includes any office, administration, agency, bureau, institute, council, unit, organizational entity, or component thereof.’’

SATELITE OFFICES


"(a) ESTABLISHMENT.—Subject to available resources, the Director [Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] shall, by not later than the date that is 3 years after the date of the enactment of this Act (Sept. 16, 2011), establish 3 or more satellite offices in the United States to carry out the responsibilities of the [United States Patent and Trademark] Office.

"(b) PURPOSES.—The purposes of the satellite offices established under subsection (a) are to—

"(1) increase outreach activities to better connect patent filers and innovators with the Office;

"(2) enhance patent examiner retention;

"(3) improve recruitment of patent examiners;

"(4) decrease the number of patent applications waiting for examination; and

"(5) improve the quality of patent examination.

"(c) REQUIRED CONSIDERATIONS.—

"(1) IN GENERAL.—In selecting the location of each satellite office to be established under subsection (a), the Director—

"(A) shall ensure geographic diversity among the offices, including by ensuring that such offices are established in different States and regions throughout the Nation;

"(B) may rely upon any previous evaluations by the Office of potential locales for satellite offices, including any evaluations prepared as part of the Office’s Nationwide Workforce Program that resulted in the 2010 selection of Detroit, Michigan, as the first satellite office of the Office;

"(C) shall evaluate and consider the extent to which the purposes of satellite offices listed under subsection (b) will be achieved;

"(D) shall consider the availability of scientific and technically knowledgeable personnel in the region from which to draw new patent examiners at minimal recruitment cost; and

"(E) shall consider the economic impact to the region.

"(2) OPEN SELECTION PROCESS.—Nothing in paragraph (1) shall constrain the Office to only consider its evaluations in selecting the Detroit, Michigan, satellite office.

"(d) REPORT TO CONGRESS.—Not later than the end of the third fiscal year that begins after the date of the enactment of this Act (Sept. 16, 2011), the Director shall submit a report to Congress on—

"(1) the rationale of the Director in selecting the location of any satellite office required under sub-
section (a), including an explanation of how the selected location will achieve the purposes of satellite offices listed under subsection (b) and how the required considerations listed under subsection (c) were met;

"(2) the progress of the Director in establishing all such satellite offices; and

"(3) whether the operation of existing satellite offices is achieving the purposes under subsection (b)."

DESIGNATION OF DETROIT SATELLITE OFFICE

Pub. L. 112–29, §2, Sept. 16, 2011, 125 Stat. 238, provided that:

"(a) DESIGNATION.—The satellite office of the United States Patent and Trademark Office to be located in Detroit, Michigan, shall be known and designated as the 'Elijah J. McCoy United States Patent and Trademark Office'.

"(b) REFERENCES.—Any reference in a law, map, regulation, document, paper, or other record of the United States to the satellite office of the United States Patent and Trademark Office to be located in Detroit, Michigan, referred to in subsection (a) shall be deemed to be a reference to the 'Elijah J. McCoy United States Patent and Trademark Office'."

FEDERAL AGENCY STATUS FOR PATENT AND TRADEMARK OFFICE

Pub. L. 101–508, title X, § 5501(a), Nov. 5, 1990, 104 Stat. 1388–392, provided that: "For the purposes of Federal law, the Patent and Trademark Office shall be considered a Federal agency. In particular, the Patent and Trademark Office shall be subject to all Federal laws pertaining to the procurement of goods and services that would apply to a Federal agency using appropriated funds, including the Federal Property and Administrative Services Act of 1949 [now chapters 1 to 11 of Title 41, Public Buildings, Property, and Works, and division C (except sections 3302, 3507(c), 3509, 3906, 4710, and 4711) of subtitle I of Title 41, Public Contracts] and the Office of Federal Procurement Policy Act [now division B (except sections 1123, 2303, 2304, and 2313) of subtitle I of Title 41]."

§ 2. Powers and duties

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

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

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

(b) SPECIFIC POWERS.—The Office—

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

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

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

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

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

(D) may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office;

(E) shall recognize the public interest in continuing to safeguard broad access to the United States patent system through the reduced fee structure for small entities under section 41(h)(1);

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

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

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

(4)(A) may make such purchases, contracts for the construction, maintenance, or management and operation of facilities, and contracts for supplies or services, without regard to the provisions of subtitle I and chapter 33 of title 40, division C (except sections 3302, 3507(b), 3509, 3906, 4710, and 4711) of subtitle I of title 41, and the McKinney-Vento Homeless Assistance Act (42 U.S.C. 11301 et seq.); and

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Historical and Revision Notes


“Certificates of trade-mark registrations” is added, see note under section 1. Changes in language are made and the specific date eliminated.

References in Text


Amendments


Property and Administrative Services Act of 1949 (41 U.S.C. 251 et seq.).

Subsec. (b)(11), Pub. L. 112–29, §21(a), inserted ; 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 after world).


1999—Pub. L. 106–113 amended section catchline and text generally. Prior to amendment, text read as follows: The Patent and Trademark Office shall have a seal with which letters patent, certificates of trademark registrations, and papers issued from the Office shall be authenticated.


**Effective Date of 2011 Amendment**

Pub. L. 112–274, §1(g), Jan. 14, 2013, 126 Stat. 2457, provided that: ‘Notwithstanding section 35 of the Leahy-Smith America Invents Act (35 U.S.C. 1 note), the amendments made by section 21 of the Leahy-Smith America Invents Act (Public Law 112–29; 125 Stat. 335) [amending this section and section 3 of this title] shall be effective as of September 16, 2011.’’

Pub. L. 112–29, §20(l), Sept. 16, 2011, 125 Stat. 335, provided that: ‘The amendments made by this section [amending this section and sections 3, 12, 32, 41, 103, 104, 111, 116, 119 to 123, 132, 133, 143, 145, 146, 155, 157, 159, 162, 172, 182 to 186, 202, 206, 207, 209, 210, 213, 253, 256, 257, 267, 282, 284, 287, 288, 291, 294, 302 to 307, 328, 363, 365, 368, and 371 to 375 of this title and repealing sections 153 and 155A 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 proceedings commenced on or after that effective date.’’

Except as otherwise provided in Pub. L. 112–29, 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 on or after that effective date, see section 35 of Pub. L. 112–29, set out as a note under section 1 of this title.

**Effective Date of 2003 Amendment**


**Effective Date of 1999 Amendment**


**Effective Date of 1975 Amendment**


**Patent Ombudsman Program for Small Business Concerns**


**Pro Bono Programs**


(b) Effective Date.—This section take effect on the date of the enactment of this Act [Sept. 16, 2011].’’

**Electronic Filing and Processing of Patent and Trademark Applications**


(1) is user friendly; and

(2) includes the necessary infrastructure—

(A) to allow examiners and applicants to send all communications electronically; and

(B) to allow the Office to process, maintain, and search electronically the contents and history of each application.

(b) Authorization of Appropriations.—Amounts authorized under section 13102 [set out as a note under section 42 of this title], there is authorized to be appropriated to carry out subsection (a) of this section not more than $50,000,000 for each of fiscal years 2003, 2004, and 2005. Amounts made available pursuant to this subsection shall remain available until expended.’’

**§3. Officers and employees**

(a) Under Secretary and Director.—

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

(2) Duties.—

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

(B) Consulting with the Public Advisory Committees.—The Director shall consult with the Patent Public Advisory Committee established in section 5 on a regular basis on matters relating to the patent operations of the Office, shall consult with the Trademark Public Advisory Committee established in section 5 on a regular basis on matters relat-
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ing to the trademark operations of the Office, and shall consult with the respective Public Advisory Committee before submitting budgetary proposals to the Office of Management and Budget or changing or proposing to change patent or trademark user fees or patent or trademark regulations which are subject to the requirement to provide notice and opportunity for public comment under section 533 of title 5, as the case may be.

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

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

(b) OFFICERS AND EMPLOYEES OF THE OFFICE.—

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

(2) COMMISSIONERS.—

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

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

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

(3) OTHER OFFICERS AND EMPLOYEES.—The Director shall—

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

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

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

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

(5) NATIONAL SECURITY POSITIONS.—The Director, in consultation with the Director of the Office of Personnel Management, shall maintain a program for identifying national security positions and providing for appropriate security clearances, in order to maintain the secrecy of certain inventions, as described in section 181, and to prevent disclosure of sensitive and strategic information in the interest of national security.

(6) ADMINISTRATIVE PATENT JUDGES AND ADMINISTRATIVE TRADEMARK JUDGES.—The Director may fix the rate of basic pay for the administrative patent judges appointed pursuant
to section 6 and the administrative trademark judges appointed pursuant to section 17 of the Trademark Act of 1946 (15 U.S.C. 1067) at not greater than the rate of basic pay payable for level III of the Executive Schedule under section 5314 of title 5. The payment of a rate of basic pay under this paragraph shall not be subject to the pay limitation under section 5306(e) or 5373 of title 5.

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

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

(e) Carryover of personnel.—

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

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

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

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

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

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

(f) Transition provisions.—

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

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

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


Historical and revision notes


The temporary designation of the assistant commissioner as Commissioner in case of a vacancy in office is added. This will eliminate complications since present applicable general statutes (5 U.S.C., 1946 ed., § 7) permit a vacancy to be temporarily filled only for not more than 30 days.

Changes in language are made. “Assistant commissioners” is used in the second sentence (and elsewhere in the bill) as referring to all three assistants.

This entire title is subject to Reorganization Plan No. 5 of 1950 (64 Stat. 1263) which vests all functions of the Patent Office in the Secretary of Commerce and authorizes delegation by him. It has been found impractical to so word the various sections of the title, and a general provision has been inserted as the second paragraph of this section of the bill, leaving the wording of various sections of the title in terms of officers previously specified and to whom the functions presently stand delegated.

References in text


Amendments


6. Amendment


Secretary of Commerce instead of the President, and
sec. (a), redesignated first assistant commissioner as a
third pars. as subsecs. (b) and (c), respectively.

Deputy Commissioner, granted authority for appoint -
ment of not more than fifteen examiners-in-chief to
merce to fix compensation of examiners-in-chief.

struck out '', United States Code'' before period at end,
and in text, struck out "United States Code,'' after
''title 5,''.

mark Office'' for ''Patent Office'', and ''Commissioner
of Patents and Trademarks'' for ''Commissioner of Pat-
employees.
ance with law shall appoint all other officers and em-
appointed by the President, by and with the advice and
missioner, and the Assistant Commissioners shall be
appointed during a vacancy in that office until the
Commissioner is appointed and takes office. The Com-
missioner of Patents and Trademarks, the Deputy Com-
misioner, and the Assistant Commissioners shall be
appointed by the President, by and with the advice and
commendation of the Senate. The Secretary of Commerce
upon the nomination of the Commissioner, in accord-
ance with law shall appoint all other officers and em-
ployees.

(b) The Secretary of Commerce may vest in himself
the functions of the Patent and Trademark Office and
its officers and employees specified in this title and
may from time to time authorize their performance by
any other officer or employee.

(c) The Secretary of Commerce is authorized to fix
the per annum rate of basic compensation of each ex-
aminer-in-chief in the Patent and Trademark Office at
not in excess of the maximum scheduled rate provided
for positions in grade 17 of the General Schedule of the
Classification Act of 1949, as amended.

(d) The Commissioner of Patents and Trademarks
shall be an Assistant Secretary of Commerce and shall
receive compensation at the rate in effect for level III
of the Executive Schedule under section 3314 of title 5,
United States Code.

The members of the 'Trademark' Trial and Appeal
Board of the Patent and Trademark Office shall each be
paid at a rate not to exceed the maximum rate of basic
pay payable for GS–16 of the General Schedule under
section 5332 of title 5.


1988—Subsec. (d). Pub. L. 105–304 substituted "in effec-
t for level III of the Executive Schedule under sec-
3314 of title 5, United States Code' for "prescribed by
law for Assistant Secretaries of Commerce.''

than fifteen" after "two Assistant Commissioners,
and", and inserted "appointed under section 7 of this
title" after "examiners-in-chief".

1975—Pub. L. 93–3601 designated first par. as sub-
sect. (a), redesignated first assistant commissioner as a
Deputy Commissioner, granted authority for appoint-
ment of not more than fifteen examiners-in-chief to
Secretary of Commerce instead of the President, and
struck out provision relating to performance by assist-
ants' commissioners of duties assigned by Commissioner.

Subsecs. (b), (c), (d), (e), Pub. L. 93–361 designated second and
third pars. as subsecs. (b) and (c), respectively.

1964—Pub. L. 88–426 repealed provisions which pre-
scribed annual rate of compensation. Commissioner.
1959—Pub. L. 86–370 authorized Secretary of Com-
merce to fix compensation of examiners-in-chief.

1958—Pub. L. 85–933 increased number of examiners-
in-chief from nine to not more than fifteen and speci-
cified annual compensation of Commissioner.

Notwithstanding section 35 of Pub. L. 112–29 (set out as a
note under section 1 of this title), amendment by
section 21 of Pub. L. 112–29 effective as of Sept. 16, 2011,
see section 1(g) of Pub. L. 112–274, set out as a note
under section 2 of this title.

Amendment by section 201(a)(1) of Pub. L. 112–29 effec-
tive upon the expiration of the 1-year period beginning
on Sept. 16, 2011, and applicable to proceedings com-
menced on or after that effective date, see section 201(l)
of Pub. L. 112–29, set out as a note under section 2 of
this title.

Amendment by Pub. L. 106–113 reenacted section catchline
without change and amended text generally. Prior to
amendment, text read as follows:

“(a) There shall be in the Patent and Trademark Of-
ference a Commissioner of Patents and Trademarks, a Dep-
uty Commissioner, two Assistant Commissioners, and
examiners-in-chief appointed under section 7 of this
title. The Deputy Commissioner, or, in the event of a
vacancy in that office, the Assistant Commissioner sen-
ior in date of appointment shall fill the office of Com-
missoner during a vacancy in that office until the
Commissioner is appointed and takes office. The Com-
missioner of Patents and Trademarks, the Deputy Com-
missioner, and the Assistant Commissioners shall be
appointed by the President, by and with the advice and
commendation of the Senate. The Secretary of Commerce
upon the nomination of the Commissioner, in accord-
ance with law shall appoint all other officers and em-
ployees.

(b) The Secretary of Commerce may vest in himself
the functions of the Patent and Trademark Office and
its officers and employees specified in this title and
may from time to time authorize their performance by
any other officer or employee.

(c) The Secretary of Commerce is authorized to fix
the per annum rate of basic compensation of each ex-
aminer-in-chief in the Patent and Trademark Office at
not in excess of the maximum scheduled rate provided
for positions in grade 17 of the General Schedule of the
Classification Act of 1949, as amended.

(d) The Commissioner of Patents and Trademarks
shall be an Assistant Secretary of Commerce and shall
receive compensation at the rate in effect for level III
of the Executive Schedule under section 3314 of title 5,
United States Code.

The members of the 'Trademark' Trial and Appeal
Board of the Patent and Trademark Office shall each be
paid at a rate not to exceed the maximum rate of basic
pay payable for GS–16 of the General Schedule under
section 5332 of title 5.


1988—Subsec. (d). Pub. L. 105–304 substituted "in effec-
t for level III of the Executive Schedule under sec-
3314 of title 5, United States Code' for "prescribed by
law for Assistant Secretaries of Commerce.''

than fifteen" after "two Assistant Commissioners,
and", and inserted "appointed under section 7 of this
title" after "examiners-in-chief".

1975—Pub. L. 93–3601 designated first par. as sub-
sect. (a), redesignated first assistant commissioner as a
Deputy Commissioner, granted authority for appoint-
ment of not more than fifteen examiners-in-chief to
Secretary of Commerce instead of the President, and
struck out provision relating to performance by assist-
ants' commissioners of duties assigned by Commissioner.

Subsecs. (b), (c), (d), (e), Pub. L. 93–361 designated second and
third pars. as subsecs. (b) and (c), respectively.

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scribed annual rate of compensation. Commissioner.
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merce to fix compensation of examiners-in-chief.

1958—Pub. L. 85–933 increased number of examiners-
in-chief from nine to not more than fifteen and speci-
cified annual compensation of Commissioner.
§ 4. Restrictions on officers and employees as to interest in patents

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


HISTORICAL AND REVISION NOTES


The language is revised and inability to apply for a patent, included in the original language, is made explicit.

The period of disability is increased to include one year after leaving the Office.

The further restriction, that no priority date earlier than one year after leaving the Office can be claimed, is added.

The one year period is made inapplicable to applications which may be pending when the revised title goes into effect by section (g) of the bill.

AMENDMENTS


EFFECTIVE DATE OF 1975 AMENDMENT


§ 5. Patent and Trademark Office Public Advisory Committees

(a) Establishment of Public Advisory Committees.—

(1) Appointment.—The United States Patent and Trademark Office shall have a Patent Public Advisory Committee and a Trademark Public Advisory Committee, each of which shall have nine voting members who shall be appointed by the Secretary of Commerce and serve at the pleasure of the Secretary of Commerce. In each year, 3 members shall be appointed to each Advisory Committee for 3-year terms that shall begin on December 1 of that year. Any vacancy on an Advisory Committee shall be filled within 90 days of its occurrence. A new member who is appointed to fill a vacancy shall be appointed to serve for the remainder of the predecessor’s term.

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

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

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

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

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

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

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

(d) Duties.—Each Advisory Committee shall—

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

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

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

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

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

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

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

(c) APPLICABILITY OF CERTAIN ETHICS LAWS.—Members of each Advisory Committee shall be special Government employees within the meaning of section 202 of title 18.

(h) INAPPLICABILITY OF FEDERAL ADVISORY COMMITTEE ACT.—The Federal Advisory Committee Act (5 U.S.C. App.) shall not apply to each Advisory Committee.

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

(j) INAPPLICABILITY OF PATENT PROHIBITION.—Section 4 shall not apply to voting members of the Advisory Committees.


REFERENCES IN TEXT

The Federal Advisory Committee Act, referred to in subsec. (b), is Pub. L. 92–463, Oct. 6, 1972, 86 Stat. 770, as amended, which is set out in the Appendix to Title 5, Government Organization and Employees.

PRIOR PROVISIONS


AMENDMENTS

2013—Subsec. (a)(1). Pub. L. 112–274, §1(j)(1)(A), substituted "in each year, 3 members shall be appointed to each Advisory Committee for 3-year terms that shall begin on December 1 of that year. Any vacancy on an Advisory Committee shall be filled within 90 days after it occurs. A new member who is appointed to fill a vacancy shall be appointed to serve for the remainder of the predecessor's term." for "Members of each Public Advisory Committee shall be appointed for a term of 3 years, except that of the members first appointed, three shall be appointed for a term of 1 year, and three shall be appointed for a term of 2 years. In making appointments to each Committee, the Secretary of Commerce shall consider the risk of loss of competitive advantage in international commerce or other harm to United States companies as a result of such appointments."

Subsec. (a)(2). Pub. L. 112–274, §1(j)(1)(B), added par. (2) and struck out former par. (2). Prior to amendment, text read as follows: "The Secretary shall designate a chair of each Advisory Committee, whose term as chair shall be for 3 years."

Subsec. (a)(3). Pub. L. 112–274, §1(j)(1)(C), struck out par. (3). Text read as follows: "Initial appointments to each Advisory Committee shall be made within 3 months after the effective date of the Patent and Trademark Office Efficiency Act. Vacancies shall be filled within 3 months after they occur."


§ 6. Patent Trial and Appeal Board

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

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

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

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

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

(4) conduct inter partes reviews and post-grant reviews pursuant to chapters 31 and 32.
§ 7

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

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


REFERENCES IN TEXT

The date of the enactment of this subsection, referred to in subsec. (d), probably means the date of enactment of Pub. L. 112–29, which amended this section generally and was approved Sept. 16, 2011.

PRIOR PROVISIONS


AMENDMENTS


2008—Subsec. (a). Pub. L. 110–313, §1(a)(1)(A), (B), substituted “Deputy Director” for “Deputy Commissioner” in second sentence and “Secretary of Commerce, in consultation with the Director” for “Director” in last sentence.

Subsecs. (c), (d). Pub. L. 110–313, §1(a)(1)(C), which directed addition of subsecs. (c) and (d) at end of subsec. (a), was executed by adding subsecs. (c) and (d) at end of section to reflect the probable intent of Congress.

2002—Subsec. (a). Pub. L. 107–273, which directed amendment of subsec. (a) by inserting “the Deputy Commissioner,” after “Commissioner,” was executed by making the insertion after “The Director,” to reflect the probable intent of Congress.

EFFECTIVE DATE OF 2011 AMENDMENT

Pub. L. 112–29, §(e), Sept. 16, 2011, 125 Stat. 315, provided that: “The amendments made by this section [amending this section, sections 194, 141, and 143 of this title, section 1295 of Title 32, Judiciary and Judicial Procedure, section 2182 of Title 28, Judiciary and Judicial Procedure, and section 20135 of Title 51, National and Commercial Space Programs] 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 proceedings commenced on or after that effective date, except that—

“(1) the extension of jurisdiction to the United States Court of Appeals for the Federal Circuit to entertain appeals of decisions of the Patent Trial and Appeal Board in reexaminations under the amendment made by subsection (c)(2) [amending section 1295 of Title 32] shall be deemed to take effect on the date of the enactment of this Act and shall extend to any decision of the Board of Patent Appeals and Interferences with respect to a reexamination that is entered before, on, or after the date of the enactment of this Act;

“(2) the provisions of sections 6, 134, and 141 of title 35, United States Code, as in effect on the day before the effective date of the amendments made by this section shall continue to apply to inter partes reexaminations that are requested under section 311 of such title before such effective date;

“(3) the Patent Trial and Appeal Board may be deemed to be the Board of Patent Appeals and Interferences for purposes of appeals of inter partes reexaminations that are requested under section 311 of title 35, United States Code, before the effective date of the amendments made by this section; and

“(4) the Director’s Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office [right under the fourth sentence of section 145 of title 35, United States Code, as amended by subsection (c)(3) of this section, to intervene in an appeal from a decision entered by the Patent Trial and Appeal Board shall be deemed to extend to inter partes reexaminations that are requested under section 311 of such title before the effective date of the amendments made by this section.”

EFFECTIVE DATE

Section effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106–113, set out as an Effective Date of 1999 Amendment note under section 1 of this title.

§ 7. Library

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


HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §10 (R.S. 486). Some change in language has been made. "Purchased" is changed to "maintained" to include the existing library and keeping it up by additions. The phrase "and other" is added to include legal works. The last phrase of the corresponding section of the existing statute is omitted as unnecessary.

PRIOR PROVISIONS


AMENDMENTS


Pub. L. 106–113, §1000(a)(9) [title IV, §4717(1)], renumbered section 8 of this title as this section.


EFFECTIVE DATE OF 1999 AMENDMENT


EFFECTIVE DATE OF 1975 AMENDMENT


§ 8. Classification of patents

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


HISTORICAL AND REVISION NOTES


Changes in language are made.

PRIOR PROVISIONS

A prior section 8 was renumbered section 7 of this title.

AMENDMENTS


Pub. L. 106–113, §1000(a)(9) [title IV, §4717(1)], renumbered section 9 of this title as this section.

EFFECTIVE DATE OF 1999 AMENDMENT


EFFECTIVE DATE OF 1975 AMENDMENT


§ 10. Publications

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

1. Patents and published applications for patents, including specifications and drawings, together with copies of the same. The Patent and Trademark Office may print the headings of the drawings for patents for the purpose of photolithography.

2. Certificates of trade-mark registrations, including statements and drawings, together with copies of the same.


4. Annual indexes of patents and patentees, and of trade-marks and registrants.

5. Annual volumes of decisions in patent and trade-mark cases.

6. Pamphlet copies of the patent laws and rules of practice, laws and rules relating to trade-marks, and circulars or other publications relating to the business of the Office.

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

A prior section 10 was renumbered section 9 of this title.


1999—Pub. L. 106–113, §1000(a)(9) [title IV, §4717(1)], renumbered section 11 of this title as this section.

Subsec. (b). Pub. L. 106–113, §1000(a)(9) [title IV, §404(b)], as amended by Pub. L. 107–273, §13206(b)(3)(A), which directed the general amendment of the introductory provisions of subsec. (a) of section 10 of this title to read “The Director may publish in printed, typewritten, or electronic form, the following:’”, was executed to this section, which was section 11 of this title, to reflect the probable intent of Congress. This section was subsequently renumbered section 10 of this title by Pub. L. 106–113, §1000(a)(9) [title IV, §4717(1)]. Prior to amendment, introductory provisions of subsec. (a) read as follows: “‘The Commissioner may print, or cause to be printed, the following:’”. See note above and Effective Date of 1999 Amendment note below.


Effective Date of 1999 Amendment
Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4508], Nov. 29, 1999, 113 Stat. 5356, 5358, 5366, as amended by Pub. L. 107–273, div. C, title III, §13205(3), Nov. 2, 2002, 116 Stat. 1903, 2006, provided that: “Except as otherwise provided in this section, sections 4502 through 4504 and 4506 through 4507 [amending sections 10 to 12, 119, 120, 122, 125, 154, 181, 232, 284, and 374 of this title and enacting provisions set out as notes under sections 41 and 122 of this title], and the amendments made by such sections, shall be effective as of November 29, 2000, and shall apply only to applications (including international applications designating the United States) filed on or after that date. The amendments made by section 4504 [amending section 154 of this title] shall additionally apply to any pending application filed before November 29, 2000, if such pending application is published pursuant to a request of the applicant under such procedures as may be established by the Director. Except as otherwise provided in this section, the amendments made by section 4505 [amending section 102 of this title] shall be effective as of November 29, 2000 and shall apply to all patents and all applications for patents pending on or filed after November 29, 2000. Patents resulting from an international application filed before November 29, 2000 and applications published pursuant to section 122(b) [probably means section 122(b) of title 35] or Article 21(2) of the treaty defined in section 351(a) [probably means section 351(a) of title 35] resulting from an international application filed before November 29, 2000 shall not be effective as prior art as of the filing date of the international application; however, such patents shall be effective as prior art in accordance with section 102(e) in effect on November 28, 2000.” Amendments by section 1000(a)(9) [title IV, §§4717(1), 4732(a)(10)(A)] of Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106–113, set out as a note under section 111 of Title 15, Commerce and Trade.

Effective Date of 1975 Amendment
Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 111 of Title 15, Commerce and Trade.

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

The Director may exchange copies of specifications and drawings of United States patents and published applications for patents for those of foreign countries. The Director shall not enter into an agreement to provide such copies of specifications and drawings of United States patents and applications to a foreign country, other than a NAFTA country or a WTO member country, without the express authorization of the Secretary of Commerce. For purposes of this section, the terms ‘‘NAFTA country’’ and ‘‘WTO member country’’ have the meanings given those terms in section 104(b).1


Historical and Revision Notes

Section is amplified to list the publications of the Patent Office, based on 44 U.S.C., 1946 ed., §§283, 283a. The second sentence of item 1 of the revised section is a provision appearing annually in appropriation acts to enable the Patent Office to maintain a small printing press to place headings on drawings before the drawings are reproduced. Language is changed.

Prior Provisions
A prior section 10 was renumbered section 9 of this title.

Amendments

1 See References in Text note below.

1999—Pub. L. 106–113, §1000(a)(9) [title IV, §4808], inserted at end “The Director shall not enter into an agreement to provide such copies of specifications and drawings of United States patents and applications to a foreign country, other than a NAFTA country or a WTO member country, without the express authorization of the Secretary of Commerce. For purposes of this section, the terms ‘NAFTA country’ and ‘WTO member country’ have the meanings given those terms in section 104(b).”


Pub. L. 106–113, §1000(a)(9) [title IV, §4717(1)], renumbered section 12 of this title as this section.


Effective Date of 1999 Amendment
Amendment by section 1000(a)(9) [title IV, §4507(2)] of Pub. L. 106–113 effective Nov. 29, 2000, and applicable only to applications (including international applications designating the United States) filed on or after that date, see section 1000(a)(9) [title IV, §4508] of Pub. L. 106–113, as amended, set out as a note under section 10 of this title.


§12. Copies of patents and applications for public libraries

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


Historical and Revision Notes


Prior Provisions

A prior section 12 was renumbered section 11 of this title.

Amendments


1999—Pub. L. 106–113, §1000(a)(9) [title IV, §4732(a)(10)(A)], as amended by Pub. L. 107–273, §13206(b)(3)(B), which directed amendment of section 12 of this title by substituting “copies of specifications and drawings of patents in printed or electronic form” for “printed copies of specifications and drawings of patents”, was executed to this section, which was section 13 of this title, to reflect the probable intent of Congress. This section was subsequently renumbered section 12 of this title by Pub. L. 106–113, §1000(a)(9) [title IV, §4717(1)]. See note above and Effective Date of 1999 Amendment note below.


Pub. L. 106–113, §1000(a)(9) [title IV, §4717(1)], renumbered section 13 of this title as 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 proceedings commenced on or after that effective date, see section 29(k) of Pub. L. 112–29, set out as a note under section 2 of this title.

Effective Date of 1999 Amendment
Amendment by section 1000(a)(9) [title IV, §4507(3)] of Pub. L. 106–113 effective Nov. 29, 2000, and applicable only to applications (including international applications designating the United States) filed on or after that date, see section 1000(a)(9) [title IV, §4508] of Pub. L. 106–113, as amended, set out as a note under section 10 of this title.


Effective Date of 1982 Amendment

§13. Annual report to Congress

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


Historical and Revision Notes

Language is changed. The lists referred to in the corresponding section of existing statute, and which are omitted from the revised section, are the indexes provided for in section 11(a)(4). The month of reporting is omitted. The report contemplated by R.S. 494 has been discontinued since 1925 under authority of 44 U.S.C., 1946 ed., § 212.

PRIOR PROVISIONS
A prior section 13 was renumbered section 12 of this title.

AMENDMENTS
1999—Pub. L. 106–113 renumbered section 14 of this title as text and amended section catchline and text generally. Prior to amendment, text read as follows:—"The Commissioner shall report to Congress annually the moneys received and expended, statistics concerning the work of the Office, and other information relating to the Office as may be useful to the Congress or the public."

EFFECTIVE DATE OF 1999 AMENDMENT

REPORT TO CONGRESS
Pub. L. 100–703, title I, § 103(c), Nov. 19, 1988, 102 Stat. 4674, provided that: "The Secretary of Commerce shall, on the day on which the President submits the annual budget to the Congress, provide to the Committees on the Judiciary of the Senate and the House of Representatives—"

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

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

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

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

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

Similar provisions were contained in the following:


COMPUTERIZED DATA AND RETRIEVAL SYSTEM: REPORT TO CONGRESS
Pub. L. 96–517, § 9, Dec. 12, 1980, 94 Stat. 3028, directed the Commissioner of Patents and Trademarks to report to Congress, within two years after Dec. 12, 1980, a plan to identify, and if necessary develop or have developed, computerized data and retrieval systems equivalent to the latest state of the art which could be applied to all aspects of the operation of the Patent and Trademark Office, and particularly to the patent search file, the patent classification system, and the trademark search file. The report was to specify the cost of implementing the plan, and how rapidly the plan could be implemented by the Patent and Trademark Office, without regard to the availability of future funding.

[§ 14. Renumbered § 13]

CHAPTER 2—PROCEEDINGS IN THE PATENT AND TRADEMARK OFFICE

Sec. 21. Filing date and day for taking action.
22. Printing of papers filed.
23. Testimony in Patent and Trademark Office cases.

25. Declaration in lieu of oath.
27. Revival of applications; reinstatement of re-examination proceedings.

AMENDMENTS

§ 21. Filing date and day for taking action

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

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

(HISTORY AND REVISION NOTES

"Fixed by statute" is omitted from the corresponding section of the existing statute as unnecessary. Saturday is added as a day on which action need not be taken.

AMENDMENTS
1982—Pub. L. 97–247 substituted "Filing date and day for taking action" for "Day for taking action falling on Saturday, Sunday, or holiday" as section catchline, added subsec. (a), redesignated existing provisions as subsec. (b) and inserted "Federal" after "Sunday, or a".

EFFECTIVE DATE OF 1999 AMENDMENT

EFFECTIVE DATE OF 1992 AMENDMENT
Amendment by Pub. L. 97–247 effective six months after Aug. 27, 1982, see section 17(c) of Pub. L. 97–247, set
out as an Effective Date note under section 294 of this title.

Effective Date of 1975 Amendment

Emergency Relief from Postal Situation Affecting Patent Cases

Relief as to filing date of patent application or patent and excusal of delayed fees or actions affected by postal situation beginning on Mar. 18, 1970, and ending on or about Mar. 30, 1970, see note set out under section 111 of this title.

§ 22. Printing of papers filed

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


Historical and Revision Notes
Based on Title 35, U.S.C., 1946 ed., § 12 (R.S. 488). Language is changed and “or typewritten” is added after “printed”.

Amendments


Effective Date of 1999 Amendment

Effective Date of 1975 Amendment

§ 24. Subpoenas, witnesses

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

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

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


Historical and Revision Notes

Three sections of the existing statute are combined with some changes in language and placed in part 1 since they apply to trade-mark cases in the Patent Office as well as to patent cases. Reference to a repealed statute in the first paragraph is replaced by reference to the Federal Rules of Civil Procedure and certain rules are made applicable.
§ 25. Declaration in lieu of oath

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

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


AMENDMENTS


EFFECTIVE DATE OF 1999 AMENDMENT


EFFECTIVE DATE OF 1975 AMENDMENT


§ 27. Revival of applications; reinstatement of re-examination proceedings

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


EFFECTIVE DATE


“(a) In general.—The amendments made by this title [enacting this section and section 151 of this title, amending sections 41, 111, 119, 120, 122, 131, 171, 361, 364, 365, and 371 of this title, and repealing section 151 of this title]—

“(1) shall take effect on the date that is 1 year after the date of the enactment of this Act [Dec. 18, 2012]; and

“(2) shall apply to—

“(A) any patent issued before, on, or after the effective date set forth in paragraph (1); and

“(B) any application for patent that is pending on or filed after the effective date set forth in paragraph (1).

“(b) Exceptions.—

“(1) Section 201(a).—The amendments made by section 201(a) [amending section 111 of this title] shall apply only to applications that are filed on or after the effective date set forth in subsection (a)(1).

“(2) Patents in litigation.—The amendments made by this title shall have no effect with respect to any patent that is the subject of litigation in an action commenced before the effective date set forth in subsection (a)(1).

CHAPTER 3—PRACTICE BEFORE PATENT AND TRADEMARK OFFICE

Sec. [31. Repealed.]

32. Suspension or exclusion from practice.

33. Unauthorized representation as practitioner.

AMENDMENTS


Commissioner to prescribe regulations for agents and attorneys.

**Effective Date of Repeal**

Repeal effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, § 4731] of Pub. L. 106–113, set out as an Effective Date of 1999 Amendment note under section 1 of this title.

§ 32. Suspension or exclusion from practice

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

**Historical and Revision Notes**


**Amendments**


Pub. L. 106–113, §1000(a)(9) [title IV, §4719], inserted before last sentence “The Director shall have the discretion to designate any attorney who is an officer or employee of the United States Patent and Trademark Office to conduct the hearing required by this section.”


**Effective Date of 2011 Amendment**

Pub. L. 112–29, §3(k)(3), Sept. 16, 2011, 125 Stat. 291, provided that: “The amendment made by paragraph (1) [amending this section] shall apply in any case in which the time period for instituting a proceeding under section 32 of title 35, United States Code, had not lapsed before the date of the enactment of this Act (Sept. 16, 2011).”

Amendment by section 9(a) of Pub. L. 112–29 effective Sept. 16, 2011, and applicable to any civil action commenced on or after that date, see section 9(b) of Pub. L. 112–29, set out as a note under section 1071 of Title 15, Commerce and Trade. Amendment by section 20(j) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112–29, set out as a note under section 2 of this title.

**Effective Date of 1999 Amendment**


**Effective Date of 1975 Amendment**


**Report to Congress**

Pub. L. 112–29, §3(k)(2), Sept. 16, 2011, 125 Stat. 291, provided that: “The Director [Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] shall provide on a biennial basis to the Judiciary Committees of the Senate and House of Representatives a report providing a short description of incidents made known to an officer or employee of the [United States Patent and Trademark] Office as prescribed in the regulations established under section 2(b)(2)(D) of title 35, United States Code, that reflect substantial evidence of misconduct before the Office but for which the Office was barred from commencing a proceeding under section 32 of title 35, United States Code, by the time limitation established by the fourth sentence of that section.”

§ 33. Unauthorized representation as practitioner

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

**Historical and Revision Notes**

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This is a criminal statute. The language has been considerably simplified and the upper limit of the penalty is increased.

AMENDMENTS

Effective Date of 1975 Amendment

CHAPTER 4—PATENT FEES; FUNDING; SEARCH SYSTEMS

Sec.
41. Patent fees; patent and trademark search systems.
42. Patent and Trademark Office funding.

AMENDMENTS

§ 41. Patent fees; patent and trademark search systems

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

(1) Filing and Basic National Fees.—

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

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

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

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

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

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

(G) In addition, excluding any sequence listing or computer program listing filed in an electronic medium as prescribed by the Director, for any application the specification and drawings of which exceed 100 sheets of paper (or equivalent as prescribed by the Director if filed in an electronic medium), $1,190 for each additional 50 sheets of paper (or equivalent as prescribed by the Director if filed in an electronic medium) or fraction thereof.

(2) Excess Claims Fees.—

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

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

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

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

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

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

(3) Examination Fees.—

(A) In General.—

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

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

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

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

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

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

(4) Issue Fees.—

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

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

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

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

(5) Disclaimer Fee.—On filing each disclaimer, $140.

(6) Appeal Fees.—

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

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

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

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

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

(B) on filing a second petition, $390; and

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

(b) Maintenance Fees.—

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

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

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

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

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

(3) No Maintenance Fee for Design or Plant Patent.—No fee may be established for maintaining a design or plant patent in force.

(c) Delays in Payment of Maintenance Fees.—

(1) Acceptance.—The Director may accept the payment of any maintenance fee required by subsection (b) after the 6-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional. The Director may require the payment of the fee specified in subsection (a)(7) as a condition of accepting payment of any maintenance fee required by subsection (b) after the 6-month grace period but prior to the acceptance of a maintenance fee under this subsection.

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

(d) Patent Search and Other Fees.—

(1) Patent search fees.—

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

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

(i) $540 for each application for an original patent, except for design, plant, provisional, or international applications;

(ii) $100 for each application for an original design patent;

(iii) $330 for each application for an original plant patent;

(iv) $540 for the national stage of each international application; and

(v) $540 for each application for the reissue of a patent.

(C) Applicability of Other Provisions.—

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

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

(2) Other Fees.—

(A) In General.—The Director shall establish fees for all other processing, services, or materials relating to patents not specified in

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1 So in original. Probably should be followed by a period.
this section to recover the estimated average cost to the Office of such processing, services, or materials, except that the Director shall charge the following fees for the following services: (i) For recording a document affecting title, $40 per property. (ii) For each photocopy, $2.25 per page. (iii) For each black and white copy of a patent, $3.

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

(c) WAIVER OF FEES; COPIES REGARDING NOTICE.—The Director may waive the payment of any fee for any service or material related to patents in connection with an occasional or incidental request made by a department or agency of the Government, or any officer thereof. The Director may provide any applicant issued a notice under section 132 with a copy of the specifications and drawings of the Government, or any officer thereof.

(3) ACCESS FEES.—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.

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

NOTE

The yearly fee for providing a library specified in section 205. An omnibus item to take care of miscellaneous minor fees is added; in view of this, two items in the present schedule are omitted.

The fee for reprinting applications is changed slightly.

REFERENCES IN TEXT
Section 3 of the Small Business Act, referred to in subsec. (b)(1), is classified to section 632 of Title 15, Commerce and Trade.

AMENDMENTS
2012—Subsec. (a)(7). Pub. L. 112–211, § 202(b)(1)(A), added par. (7) and struck out former par. (7). Prior to amendment, text read as follows: “On filing each petition for the revival of an unintentionally abandoned application for a patent, 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.”

Subsec. (c)(1). Pub. L. 112–211, § 202(b)(1)(B), added par. (1) and struck out former par. (1). Prior to amendment, text read as follows: “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 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.”

2011—Subsecs. (a), (b). Pub. L. 112–29, § 11(a), amended subsecs. (a) and (b) generally. Prior to amendment, subsecs. (a) and (b) required the Director to charge certain fees for filing applications, disclaimers, petitions, and appeal documents, presenting claims, and issuing patents, and to charge certain fees for maintaining in force patents based on applications filed on or after Dec. 12, 1980, respectively.

Subsec. (c). Pub. L. 112–29, § 11(b), inserted subsec. heading and headings of pars. (1) and (2).

Subsec. (d). Pub. L. 112–29, § 11(c), amended subsec. (d) generally. Prior to amendment, subsec. (d) read as follows: “The Director shall establish fees for all other patents, services, or materials relating to patents, except that the Director shall charge the following fees for the following services:”

“(1) For recording a document affecting title, $40 per property.’’

“(2) For each photocopy, $0.25 per page.’’

“(3) For each black and white copy of a patent, $3. The yearly fee for providing a library specified in section 13 of this title with uncertified printed copies of the specifications and drawings for all patents in that year shall be $50.’’


Subsec. (g). Pub. L. 112–29, § 11(e)(3), struck out subsec. (g) which read as follows: “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.’’

Subsec. (h). Pub. L. 112–29, § 11(d), amended subsec. (h) generally. Prior to amendment, subsec. (h) read as follows:

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

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

Subsec. (i). Pub. L. 112–29, § 11(d), inserted subsec. heading and headings of pars. (1) to (4).


Subsec. (a)(7). Pub. L. 106–113, § 1000(a)(9) [title IV, § 4605(a)], amended par. (7) generally. Prior to amendment, par. (7) read as follows: “On filing each petition for the revival of an unintentionally abandoned application for a patent or for the unintentionally delayed payment of the fee for issuing each patent, $1,210, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be $30.”


Subsec. (a)(10). Pub. L. 106–113, § 1000(a)(9) [title IV, § 4202(c)], substituted “$590” for “$790”.


Subsec. (b)(1). Pub. L. 106–113, § 1000(a)(9) [title IV, § 4202(d)], substituted “$530” for “$590”.

Subsecs. (c) to (g). Pub. L. 106–113, § 1000(a)(9) [title IV, § 4732(a)(10)(A)], substituted “Director” for “Commissioner” wherever appearing.

Subsec. (h)(1). Pub. L. 106–113, § 1000(a)(9) [title IV, § 4732(a)(5)], substituted “Director” for “Commissioner of Patents and Trademarks”.

Subsec. (i)(1). Pub. L. 106–113, § 1000(a)(9) [title IV, § 4804(d)(1)], substituted “microform, or electronic” for “paper or microform”.


1999—Subsec. (a). Pub. L. 105–358, § 3(a), added subsec. (a) and struck out former subsec. (a) which listed fees for patent services.

Subsec. (b). Pub. L. 105–358, § 3(b), added subsec. (b) and struck out former subsec. (b) which read as follows: “The Commissioner shall charge the following fees for maintaining in force all patents based on applications filed on or after December 12, 1980:

“(1) 3 years and 6 months after grant, $650.

“(2) 7 years and 6 months after grant, $1,310.

“(3) 11 years and 6 months after grant, $1,980. 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 six months thereafter, the patent will expire as of the last day of such grace period. The Commissioner may require the payment of a surcharge as a condition of accepting within such six-month grace period the late payment of an applicable maintenance fee. No fee will be established for maintaining a design or plant patent in force.”


Subsec. (c)(2). Pub. L. 103–465, § 533(b)(1), amended par. (2) generally. Prior to amendment, par. (2) read as fol-
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1992—Subsec. (c)(1). Pub. L. 102–444 inserted after "section" in first sentence "which is made within twenty-four months after the six-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 six-month grace period but prior to the acceptance of a maintenance fee under this subsection."

1992—Subsec. (c)(1). Pub. L. 102–444 inserted after "section" in first sentence "which is made within twenty-four months after the six-month grace period but before the acceptance of a maintenance fee under this subsection, and it may also provide for the continued practice of any process, practiced, or for the practice of which substantial preparation was made after the six-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 six-month grace period but prior to the acceptance of a maintenance fee under this subsection."

Subsec. (a). Pub. L. 102–204, §5(a)(1), amended subsec. (a) generally. Prior to amendment, subsec. (a) read as follows: "The Commissioner shall charge the following fees:

1. On filing each application for an original patent, except in design or plant cases, $300; in addition, on filing or on presentation at any other time, $30 for each claim in independent form which is in excess of three, $10 for each claim (whether independent or dependent) which is in excess of twenty, and $100 for each application containing a multiple dependent claim. For the purpose of computing fees, a multiple dependent claim as referred to in section 112 of this title or any claim depending therefrom shall be considered as separate dependent claims in accordance with the number of claims to which reference is made. Errors in payment of the additional fees may be rectified in accordance with regulations of the Commissioner.

2. For issuing each original or reissue patent, except in design or plant cases, $500.

3. In design and plant cases:

a. On filing each design application, $125.

b. On filing each plant application, $200.

c. On issuing each design patent, $175.

d. On issuing each plant patent, $250.

e. On filing each application for the reissue of a patent, $30; in addition, on filing or on presentation at any other time, $30 for each claim in independent form which is in excess of the number of independent claims of the original patent, and $10 for each claim (whether independent or dependent) which is in excess of twenty and also in excess of the number of claims of the original patent. Errors in payment of the additional fees may be rectified in accordance with regulations of the Commissioner.

5. On filing each disclaimer, $50.

6. On filing an appeal from the examiner to the Board of Patent Appeals and Interferences, $115; in addition, on filing a brief in support of the appeal, $115, and on requesting an oral hearing in the appeal before the Board of Patent Appeals and Interferences, $100.

7. On filing each petition for the revival of an unintentionally abandoned application for a patent or for the unintentionally delayed payment of the fee for issuance of a patent, $500, unless the petition is filed under sections 133 or 151 of this title, in which case the fee shall be $30.

8. For petitions for one-month extensions of time to take actions required by the Commissioner in an application:

- On filing a first petition, $50.
- On filing a second petition, $100.
- On filing a third or subsequent petition, $200.

Subsec. (b). Pub. L. 102–204, §5(a)(2), substituted "in force" for "in force all patents based on applications filed on or after December 12, 1980:"

1. Three years and six months after grant, $650.
2. Seven years and six months after grant, $1,510.
3. Eleven years and six months after grant, $1,880.

Subsec. (d). Pub. L. 102–204, §5(a)(3), amended subsec. (d) generally. Prior to amendment, subsec. (d) read as follows: "The Commissioner will establish fees for all other processing, services, or materials related to patents not specified above to recover the estimated average cost to the Office of such processing, services, or materials. The yearly fee for providing a library specified in section 13 of this title with uncertified printed copies of the specifications and drawings for all patents issued in that year will be $50."

Subsec. (f). Pub. L. 102–204, §5(b), substituted "on October 1, 1992, and every year thereafter, to reflect any fluctuations occurring during the previous 12 months" for "on October 1, 1985, and every third year thereafter, to reflect any fluctuations occurring during the previous three years."

Subsec. (g). Pub. L. 102–204, §5(c)(1), amended subsec. (g) generally. Prior to amendment, subsec. (g) read as follows: "No fee established by the Commissioner under this section will take effect prior to sixty days following notice in the Federal Register."


Subsec. (d). Pub. L. 102–204, §5(c)(1), amended subsec. (d) generally. Prior to amendment, subsec. (d) read as follows: "The Commissioner will establish fees for all other processing, services, or materials related to patents not specified above to recover the estimated average cost to the Office of such processing, services, or materials. The yearly fee for providing a library specified in section 13 of this title with uncertified printed copies of the specifications and drawings for all patents issued in that year will be $50."

Subsec. (f). Pub. L. 102–204, §5(b), substituted "on October 1, 1992, and every year thereafter, to reflect any fluctuations occurring during the previous 12 months" for "on October 1, 1985, and every third year thereafter, to reflect any fluctuations occurring during the previous three years."

Subsec. (g). Pub. L. 102–204, §5(c)(1), amended subsec. (g) generally. Prior to amendment, subsec. (g) read as follows: "No fee established by the Commissioner under this section will take effect prior to sixty days following notice in the Federal Register."


Subsec. (a). Pub. L. 97–247, §3(a), substituted provisions setting a schedule of fees for provisions which had directed that the Commissioner establish fees for the processing of an application for a patent, from filing through disposition by issuance or abandonment, for maintaining a patent in force, and for providing all other services and materials related to patents and that fee would be established for maintaining a design patent in force.

Subsec. (b). Pub. L. 97–247, §3(b), substituted provisions setting a fee schedule for maintaining a patent in force for provisions which had directed that, fees for the actual processing of an application for a patent, other than for a design patent, from filing through disposition by issuance or abandonment, were to recover in aggregate 50 per centum of the estimated average cost to the Office of such processing and that fees for the processing of an application for a design patent, from filing through disposition by issuance or abandonment, were to recover in aggregate 50 per centum of the estimated average cost to the Office of such processing.

Pub. L. 97–256, §101(1), struck out "of "Patents" after "Commissioner".

Subsec. (c). Pub. L. 97–247, §3(c), substituted maintenance provisions for provisions which had directed that fees for maintaining patents in force were to recover 50 per centum of the estimated cost to the Office, for the year in which such maintenance fees were received, of the actual processing all applications for patents, other than for design patents, from filing through disposition by issuance or abandonment, that fees for maintaining a patent in force would be due three years and six
months, seven years and six months, and eleven years and six months after the grant of the patent, that unless payment of the applicable maintenance fee was received in the Patent and Trademark Office on or before the date the fee was due or within a grace period of six months thereafter, the patent would expire as of the end of such grace period, and that the Commissioner could require the payment of a surcharge as a condition of accepting within such six-month grace period the late payment of an applicable maintenance fee.

Pub. L. 97–256, §101(3), substituted “October 1, 1996,” for “the fifteenth fiscal year following the date of enactment of this Act”.

Subsec. (d). Pub. L. 97–247, §3(d), substituted provisions relating to fees for all other processing services or materials relating to patents not previously specified for provisions directing that fees for all other services or materials related to patents were to recover the estimated average cost to the Office of performing the service or furnishing the material.

Pub. L. 97–256, §101(4), substituted “October 1, 1982,” for “the first day of the first fiscal year beginning on or after one calendar year after enactment”.

Subsec. (f). Pub. L. 97–247, §3(e), substituted provisions relating to the adjustment of fees to reflect CPI fluctuations for provisions directing that fees were to be adjusted by the Commissioner to achieve the level of recovery specified in this section but that no patent application processing fee or fee for maintaining a patent in force was to be adjusted more than once every three years.

1980—Pub. L. 96–517 in revising fee provisions by substituting subsec. (a) (to (g) for prior subsecs. (a) to (c), required the Commissioner to establish fees based on recovery of estimated average cost of processing applications, performing miscellaneous services and providing material, required fees for maintenance of patents in force and provided for expiration of patents for non-payments, prescribed $50 library fee for copies of specifications and drawings, authorized triennial adjustments, prescribed effective date for fees, and incorporated in subsec. (e) waiver provision of former subsec. (c).

1975—Subsec. (a). Pub. L. 94–131 inserted sentence respecting consideration of a multiple dependent claim as referred to in section 112 of this title or any claim depending therefrom as separate dependent claims in accordance with the number of claims to which reference is made for the purpose of computing fees.


1965—Subsec. (a). Pub. L. 89–83, §1, increased the filing fee for original patents from $30 to $65, changed the additional fee from $1 for each claim in excess of twenty to $10 for each claim in independent form which is in excess of one and $2 for each claim (whether independent or dependent) which is in excess of ten, and permitted the Commissioner to establish a charge not to exceed $1 per copy for patents in excess of twenty-five pages of drawings and specifications and for plant patents printed in color and to provide applicants, without charge, with copies of specifications and drawings when referred to in a section 132 notice.

Subsec. (a)(2). Pub. L. 89–83, §1, changed the recording fee from $3 for every document not exceeding six pages and $1 for each additional two pages or less to a flat $20 fee for every document, and substituted a $3 fee for each additional item where the document relates to more than one patent or application for a $50 cents additional fee for each additional patent or application included in one writing where more than one is so included.


Note: Contributory patent application proceedings pending on or filed after that effective date, and not effective with respect to patents in litigation commenced before that effective date, see section 203 of Pub. L. 112–211, set out as an Effective Date note under section 27 of this title.

Effective Date of 2011 Amendment

Pub. L. 112–29, §11(j), Sept. 16, 2011, 125 Stat. 325, provided that: “Except as otherwise provided in this section [amending this section and enacting and amending provisions set out as notes under this section], this section and the amendments made by this section shall take effect on the date of the enactment of this Act [Sept. 16, 2011].”

Amendment by section 20(j) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112–29, set out as a note under section 2 of this title.

Effective Date of 1999 Amendment


(a) In General.—Except as provided in subsection (b), the amendments made by this subtitle [amending this section and section 42 of this title] shall take effect on the date of the enactment of this Act [Nov. 29, 1999].

(b) Section 4202.—The amendments made by section 4202 [amending this section] of this subtitle shall take effect 30 days after the date of the enactment of this Act.]

“(a) IN GENERAL.—Subject to subsection (b), this sub-
title [enacting chapter 31 of this title, amending this
section and sections 100, 134, 141, 143, and 145 of this
section, and enacting provisions set out as notes under
sections 1, 311, and 315 of this title] and the amend-
ments made by this subtitle shall take effect on the date
of the enactment of this Act (Nov. 29, 1999) and shall
apply to any patent that issue from an original
application filed in the United States on or after that
date.

“(b) SECTION 4065(a).—The amendments made by sec-
tion 4065(a) [amending this section] shall take effect on
the date that is 1 year after the date of the enactment of
this Act.”

Amendment by section 1006(a)(9) [title IV, §§4732(a)(9)
of Pub. L. 106–113 effective 4 months after Nov. 29, 1999,
see section 1006(a)(9) [title IV, §4731] of Pub. L. 106–113,
set out as a note under section 1 of this title.

EFFECTIVE DATE OF 1998 AMENDMENT
vided that: “This Act [amending this section and sec-
tion 42 of this title and enacting provisions set out as
a note under section 1 of this title] and the amend-
ments made by this Act shall take effect on October 1,
1998.”

EFFECTIVE DATE OF 1994 AMENDMENT
Amendment by section 532(b)(2) of Pub. L. 103–465 ef-
fective 6 months after Dec. 8, 1994, and applicable to all
patent applications filed in the United States on or
after that effective date, with provisions relating to
earliest filed patent application, see section 538(b)(1),
(3) of Pub. L. 103–465, set out as a note under section 154
of this title.

Amendment by section 538(b)(1) of Pub. L. 103–465 ef-
fective 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 538(a),
(b) of Pub. L. 103–465, set out as a note under section 154
of this title.

EFFECTIVE DATE OF 1992 AMENDMENT
vided that: “The amendment made by section 1
[amending this section] shall take effect on the date of
the enactment of this Act (Oct. 23, 1992).”

EFFECTIVE DATE OF 1991 AMENDMENT
vided that: “This Act [amending this section, sections
6, 42, 202, 371, and 376 of this title, and section 1113
of Title 15, Commerce and Trade, enacting provisions set
out as notes under this section, section 6 of this title,
and section 1113 of Title 15, and amending and repealing
provisions set out as notes under this section] takes ef-
fect on the date of the enactment of this Act [Dec. 10,
1991] except that the fees established by the amend-
ment made by section 5(a) [amending this section] shall
take effect on or after 1 day after such fees are pub-
lished in the Federal Register.”

EFFECTIVE DATE OF 1984 AMENDMENT
Pub. L. 98–422, title II, §207, Nov. 8, 1984, 98 Stat. 3389,
provided that: “Section 206 of this Act [98 Stat. 3388]
and the amendments made by this title [amending this
section, sections 7, 134, 135, 141, 145, 146, and 305 of this
section, title 1295 of Title 28, Judiciary and Judicial
Procedure, and sections 2182 and 2457 of Title 42, The
Public Health and Welfare] shall take effect three
months after the date of the enactment of this Act
[Nov. 8, 1984].”

EFFECTIVE DATE OF 1982 AMENDMENT
Pub. L. 97–247, §17(a), Aug. 27, 1982, 96 Stat. 322, pro-
vided that: “Sections 1, 2, 4, 7, and 13 through 15 of this
Act [amending sections 3, 6, 13, 115, and 261 of this title
and section 1061 of Title 15, Commerce and Trade] shall
take effect on the date of enactment of this Act [Aug.
27, 1982]. Sections 3 and 16 of this Act [amending this
section, sections 42 and 173 of this title, and section 113
of Title 15] shall take effect on October 1, 1982. The
maintenance fees provided for in section 3(b) of this
Act [amending this section] shall not apply to patents
applied for prior to the date of enactment of this Act.
Each patent applied for on or after the date of enact-
ment of this Act shall be subject to the maintenance
fees established pursuant to section 3(b) of this Act or
to maintenance fees hereafter established by law, as to
the amounts paid and the number and timing of the
payments.”

EFFECTIVE DATE OF 1980 AMENDMENT
that:

“(a) Sections 2, 4, and 5 of this Act [amending this
section, section 154 of this title, and section 1113
of Title 15, Commerce and Trade] will take effect upon en-
actment [Dec. 12, 1980].

“(b) Section 1 of this Act [enacting sections 301 to 307
of this title] will take effect on the first day of the sev-
enth month beginning after its enactment [Dec. 12,
1980] and will apply to patents in force as of that date or
issued thereafter.

“(c) Section 3 of this Act [amending section 42 of this
title] will take effect on the first day of the first fiscal
year beginning on or after one calendar year after en-
actment [Dec. 12, 1980]. However, until section 3
takes effect, the Commissioner may credit the Patent and
Trademark Office appropriation account in the Treas-
ury of the United States with the revenues from col-
llected reexamination fees, which will be available to
pay the costs to the Office of reexamination pro-
derings.

“(d) Any fee in effect as of the date of enactment of
this Act [Dec. 12, 1980] will remain in effect until a cor-
responding fee established under section 41 of title 35,
United States Code, or section 1113 of title 15, United
States Code, takes effect.

“(e) Fees for maintaining a patent in force will not be
applicable to patents applied for prior to the date of en-
actment of this Act [Dec. 12, 1980].

“(f) Sections 6 and 7 of this Act [enacting sections 200
to 211 of this title and amending sections 2166, 2457, and
5908 of Title 42, The Public Health and Welfare] will
take effect on the first day of the seventh month begin-
ing after its enactment [Dec. 12, 1980]. Implementing
regulations may be issued earlier.

“(g) Sections 8 and 9 [enacting this note and provi-
sion set out as a note under section 14 of this title] will
take effect on the date of enactment of this Act [Dec.
12, 1980].”

EFFECTIVE DATE OF 1975 AMENDMENTS
Amendment by Pub. L. 94–131 effective Jan. 24, 1975,
and applicable on and after that date to patent applica-
tions filed in the United States and to international ap-
plications, where applicable, see section 11 of Pub. L.
94–131, set out as an Effective Date note under section
351 of this title.

Amendment by Pub. L. 93–596 effective Jan. 2, 1975,
see section 4 of Pub. L. 93–596, set out as a note under
section 1111 of Title 15, Commerce and Trade.

EFFECTIVE DATE OF 1965 AMENDMENT
that:

“(a) This Act [amending this section, sections 112,
151, 154, and 262 of this title, and section 113 of Title
15, Commerce and Trade] shall take effect three
months after its enactment [July 24, 1965].

“(b) Items 1, 3, and 4 of section 41(a) of title 35,
United States Code, as amended by section 1 of this
Act, do not apply in further proceedings in applications
filed prior to the effective date of this Act.”
Termination of Reporting Requirements

For termination, effective May 15, 2000, of provisions in subsec. (i)(4) of this section relating to annual reports, see section 3003 of Pub. L. 101–66, as amended, set out as a note under section 1113 of Title 31, Money and Finance, and page 55 of House Document No. 103–7.

Fee Setting Authority

Pub. L. 112–29, § 10, Sept. 16, 2011, 125 Stat. 316, provided that:

"(a) Fee Setting.—

"(1) IN GENERAL.—The Director [Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] may set or adjust by rule any fee established, authorized, or charged under title 35, United States Code, or the Trademark Act of 1946 (15 U.S.C. 1051 et seq.), for any services performed by or materials furnished by, the [United States Patent and Trademark] Office, subject to paragraph (2).

"(2) FEES TO RECOVER COSTS.—Fees may be set or adjusted under paragraph (1) only to recover costs of the Office with respect to such patent or trademark fees, including administrative costs of the Office with respect to such patent or trademark fees (as the case may be).

"(b) SMALL AND MICRO ENTITIES.—The fees set or adjusted under subsection (a) for filing, searching, examining, issuing, appealing, and maintaining patent applications and patents shall be reduced by 75 percent with respect to the application of such fees to any micro entity as defined in section 123 of title 35, United States Code, or for a mark under the Trademark Act of 1946; or

"(c) REDUCTION OF FEES IN CERTAIN FISCAL YEARS.—In each fiscal year, the Director—

"(1) shall consult with the Patent Public Advisory Committee and the Trademark Public Advisory Committee on the advisability of reducing any fees described in subsection (a); and

"(2) after the consultation required under paragraph (1), may reduce such fees.

"(d) ROLE OF THE PUBLIC ADVISORY COMMITTEE.—The Director shall—

"(1) not less than 45 days before publishing any proposed fee under subsection (a) in the Federal Register, submit the proposed fee to the Patent Public Advisory Committee or the Trademark Public Advisory Committee, or both, as appropriate;

"(2) (A) provide the relevant advisory committee described in paragraph (1) a 30-day period following the submission of any proposed fee, in which to deliberate, consider, and comment on such proposal;

"(B) require that, during that 30-day period, the relevant advisory committee hold a public hearing relating to such proposal; and

"(C) assist the relevant advisory committee in carrying out that public hearing, including by offering the use of the resources of the Office to notify and promote the hearing to the public and interested stakeholders;

"(3) require the relevant advisory committee to make available to the public a written report setting forth in detail the comments, advice, and recommendations of the committee regarding the proposed fee; and

"(4) consider and analyze any comments, advice, or recommendations received from the relevant advisory committee before setting or adjusting (as the case may be) the fee.

"(e) PUBLICATION IN THE FEDERAL REGISTER.—

"(1) PUBLICATION AND RATIONALE.—The Director shall—

"(A) publish any proposed fee change under this section in the Federal Register;

"(B) include, in such publication, the specific rationale and purpose for the proposed change, including the possible expectations or benefits resulting from the proposed change; and

"(C) notify, through the Chair and Ranking Member of the Committees on the Judiciary of the Senate and the House of Representatives, the Congress of the proposed change not later than the date on which the proposed change is published under subparagraph (A).

"(2) PUBLIC COMMENT PERIOD.—The Director shall, in the publication under paragraph (1), provide the public a period of not less than 45 days in which to submit comments on the proposed change in fees.

"(3) PUBLICATION OF FINAL RULE.—The final rule setting or adjusting a fee under this section shall be published in the Federal Register and in the Official Gazette of the Patent and Trademark Office.

"(4) CONGRESSIONAL COMMENT PERIOD.—A fee set or adjusted under subsection (a) may not become effective—

"(A) before the end of the 45-day period beginning on the day after the date on which the Director publishes the final rule adjusting or setting the fee under paragraph (3); or

"(B) if a law is enacted disapproving such fee.

"(5) RULE OF CONSTRUCTION.—Rules prescribed under this section shall not diminish—

"(A) the rights of an applicant for a patent under title 35, United States Code, or for a mark under the Trademark Act of 1946; or

"(B) any rights under a ratified treaty.

"(f) RETENTION OF AUTHORITY.—The Director retains the authority under subsection (a) to set or adjust fees only during such period as the Patent and Trademark Office remains an agency within the Department of Commerce.

"(g) MICRO ENTITY DEFINED.—[Enacted section 123 of this title and amended analysis of this chapter.]

"(h) ELECTRONIC FILING INCENTIVE.—

"(1) IN GENERAL.—Notwithstanding any other provision of this section, an additional fee of $50 shall be established for each application for an original patent, except for a design, plant, or provisional application, that is not filed by electronic means as prescribed by the Director. The fee established by this subsection shall be reduced by 50 percent for small entities that qualify for reduced fees under section 41(h)(1) of title 35, United States Code. All fees paid under this subsection shall be deposited in the Treasury as an offsetting receipt that shall not be available for obligation or expenditure.

"(2) EFFECTIVE DATE.—This subsection shall take effect upon the expiration of the 60-day period beginning on the date of the enactment of this Act [Sept. 16, 2011].

"(i) EFFECTIVE DATE: SUNSET.—

"(1) EFFECTIVE DATE.—Except as provided in subsection (h), this section [enacting section 123 of this title] and the amendments made by this section shall take effect on the date of the enactment of this Act [Sept. 16, 2011].

"(2) SUNSET.—The authority of the Director to set or adjust any fee under subsection (a) shall terminate
upon the expiration of the 7-year period beginning on the date of the enactment of this Act.

(3) PRIOR REGULATIONS NOT AFFECTED.—The termination of authority under this subsection shall not affect any regulations issued under this section before the effective date of such termination or any rulemaking proceeding for the issuance of regulations under this section that is pending on such date.

[For definitions of terms used in section 10 of Pub. L. 112–29, set out above, see section 2 of Pub. L. 112–29, set out as a Definitions note under section 1 of this title.]

Prioritized Examination Fee

Pub. L. 112–29, § 11(h), Sept. 16, 2011, 125 Stat. 324, provided that:

"(1) IN GENERAL.—

"(A) Fee.—

"(1) PRIORITIZED EXAMINATION FEE.—A fee of $4,800 shall be established for filing a request, pursuant to section 2(b)(2)(G) of title 35, United States Code, for prioritized examination of a nonprovisional application for an original utility or plant patent.

"(ii) ADDITIONAL FEES.—In addition to the prioritized examination fee under clause (i), the fees due on an application for which prioritized examination is being sought are the filing, search, and examination fees (including any applicable excess claims and application size fees), processing fee, and publication fee for that application.

"(B) REGULATIONS; LIMITATIONS.—

"(1) REGULATIONS.—The Director [Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] may by regulation prescribe conditions for acceptance of a request under subparagraph (A) and a limit on the number of filings for prioritized examination that may be accepted.

"(2) LIMITATION ON CLAIMS.—Until regulations are prescribed under clause (1), no application for which prioritized examination is requested may contain or be amended to contain more than 4 independent claims or more than 30 total claims.

"(ii) LIMITATION ON TOTAL NUMBER OF REQUESTS.—The Director may not accept in any fiscal year more than 10,000 requests for prioritization until regulations are prescribed under this subparagraph setting another limit.

"(2) REDUCTION IN FEES FOR SMALL ENTITIES.—The Director shall reduce fees for providing prioritized examination of nonprovisional applications for original utility or plant patent fees by 50 percent for small entities that qualify for reduced fees under section 41(h)(1) of title 35, United States Code.

"(3) DEPOSIT OF FEES.—All fees paid under this subsection shall be credited to the United States Patent and Trademark Office Appropriation Account, shall remain available until expended, and may be used only for the purposes specified in section 42(c)(3)(A) of title 35, United States Code.

"(4) EFFECTIVE DATE AND TERMINATION.—

"(A) EFFECTIVE DATE.—This subsection shall take effect on the date that is 10 days after the date of the enactment of this Act [Sept. 16, 2011].

"(B) TERMINATION.—The fee imposed under paragraph (1)(A)(i), and the reduced fee under paragraph (2), shall terminate on the effective date of the setting or adjustment of the fee under paragraph (1)(A)(i) pursuant to the exercise of the authority under section 10 [enacting section 123 of this title] and provisions set out as a note under this section] for the first time with respect to that fee.

Appropriation Account Transition Fees

Pub. L. 112–29, § 11(i), Sept. 16, 2011, 125 Stat. 325, provided that:

"(1) SURCHARGE.—

"(A) IN GENERAL.—There shall be a surcharge of 15 percent, rounded by standard arithmetic rules, on all fees charged or authorized by subsections (a), (b), and (d)(1) of section 41, and section 132(b), of title 35, United States Code. Any surcharge imposed under this subsection is, and shall be construed to be, separate from and in addition to any other surcharge imposed under this Act [see Short Title of 2011 Amendment note set out under section 1 of this title] or any other provision of law.

"(B) DEPOSIT OF AMOUNTS.—Amounts collected pursuant to the surcharge imposed under subparagraph (A) shall be credited to the United States Patent and Trademark Appropriation Account, shall remain available until expended, and may be used only for the purposes specified in section 42(c)(3)(A) of title 35, United States Code.

"(2) EFFECTIVE DATE AND TERMINATION OF SURCHARGE.—The surcharge provided for in paragraph (1)—

"(A) shall take effect on the date that is 10 days after the date of the enactment of this Act [Sept. 16, 2011]; and

"(B) shall terminate, with respect to a fee to which paragraph (1)(A) applies, on the effective date of the setting or adjustment of that fee pursuant to the exercise of the authority under section 10 [enacting section 123 of this title and provisions set out as a note under this section] for the first time with respect to that fee.

Authority of PTO Director to Use Trademark Funds

Pub. L. 111–45, § 1, Aug. 7, 2009, 123 Stat. 1968, provided that:

"(A) AUTHORITY.—

"(1) IN GENERAL.—The Director of the United States Patent and Trademark Office—

"(A) may use funds made available for fiscal year 2009, pursuant to section 31 of the Trademark Act of 1946 (15 U.S.C. 1113), under the heading ‘Department of Commerce—United States Patent and Trademark Office—Salaries and Expenses’ in title I of division B of the Omnibus Appropriations Act, 2009 (Public Law 111–8), up to $70,000,000, to support the processing of patents and other activities, services, and materials relating to patents, notwithstanding section 42(c) of title 35, United States Code; and

"(B) notwithstanding any other provision of law, shall, upon the exercise of the authority under subparagraph (A), establish a surcharge, in amounts up to $70,000,000, on patent fees in effect under title 35, United States Code, to repay any funds drawn down pursuant to subparagraph (A), if the Director certifies in writing to the Congress that the use of the funds described in subparagraph (A) is reasonably necessary to avoid furloughs or a reduction-in-force, or both, in the United States Patent and Trademark Office, and does not create a substantial risk of a furlough or reduction-in-force of personnel working in the Trademark Operation of the United States Patent and Trademark Office.

"(2) SURCHARGES DEPOSITED IN TREASURY.—All surcharges paid under paragraph (1)(B) shall be deposited in the Treasury as an offsetting receipt that shall not be available for obligation or expenditure.

"(b) LIMITATIONS ON AUTHORITY.—The authority under subsection (a)(1)(A) shall terminate on June 30, 2011. The surcharge established under subsection (a)(1)(B) shall take effect no later than September 30, 2011, and all funds drawn down pursuant to subsection (a)(1)(A) shall be repaid pursuant to subsection (a)(1)(B) no later than September 30, 2014.

"(c) DEFINITIONS.—In this section:

"(1) DIRECTOR.—The terms ‘Director of the United States Patent and Trademark Office’ and ‘Director’ mean the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

"(2) TRADEMARK ACT OF 1946.—The term ‘Trademark Act of 1946’ means the Act entitled ‘An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of cer-
tain international conventions, and for other purposes" approved July 5, 1946 (15 U.S.C. 1051 et seq.).”

**PATENT AND TRADEMARK FEES IN CERTAIN FISCAL YEARS AFTER 2005**


“SEC. 801. FEES FOR PATENT SERVICES.

“(a) GENERAL PATENT FEES.—During fiscal years 2005, 2006, and 2007, subsection (a) of section 41 of title 35, United States Code, shall be administered as though that subsection reads as follows:

“(a) GENERAL FEES.—The Director shall charge the following fees:

“(1) FILING AND BASIC NATIONAL FEES.—

“(A) On filing each application for an original patent, except for design, plant, or provisional applications, $300.

“(B) On filing each application for an original design patent, $200.

“(C) On filing each application for an original plant patent, $200.

“(D) On filing each provisional application for an original patent, $200.

“(E) On filing each application for the reissue of a patent, $300.

“(F) The basic national fee for each international application filed under the treaty defined in section 351(a) of this title entering the national phase under section 371 of this title, $300.

“(G) In addition, excluding any sequence listing or computer program listing filed in an electronic medium as prescribed by the Director, for any application the specification and drawings of which exceed 100 sheets of paper (or equivalent as prescribed by the Director if filed in an electronic medium), $350 for each additional 50 sheets of paper (or equivalent as prescribed by the Director if filed in an electronic medium) or fraction thereof.

“(2) EXCESS CLAIMS FEES.—In addition to the fee specified in paragraph (1)–

“(A) On filing or on presentation at any other time, $200 for each claim in independent form in excess of 3;

“(B) On filing or on presentation at any other time, $50 for each claim (whether dependent or independent) in excess of 20; and

“(C) for each application containing a multiple dependent claim, $300.

For the purpose of computing fees under this paragraph, a multiple dependent claim referred to in section 112 of this title or any claim depending therefrom shall be considered as separate dependent claims in accordance with the number of claims to which reference is made. The Director may by regulation provide for a refund of any part of the fee specified in this paragraph 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 of this title. Errors in payment of the additional fees under this paragraph may be rectified in accordance with regulations prescribed by the Director.

“(3) EXAMINATION FEES.—

“(A) For examination of each application for an original patent, except for design, plant, provisional, or international applications, $200.

“(B) For examination of each application for an original design patent, $130.

“(C) For examination of each application for an original plant patent, $150.

“(D) For examination of the national stage of each international application, $200.

“(E) For examination of each application for the reissue of a patent, $600.

The provisions of section 111(a) of this title 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) of this title. The provisions of section 371(d) of this title 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.

“(4) ISSUE FEES.—

“(A) For issuing each original patent, except for design or plant patents, $1,400.

“(B) For issuing each original design patent, $800.

“(C) For issuing each original plant patent, $1,100.

“(D) For issuing each reissue patent, $1,400.

“(5) DISCLAIMER FEES.—On filing each disclaimer, $350.

“(6) APPEAL FEES.—

“(A) On filing an appeal from the examiner to the Board of Patent Appeals and Interferences, $500.

“(B) In addition, on filing a brief in support of the appeal, $500, and on requesting an oral hearing in the appeal before the Board of Patent Appeals and Interferences, $1,000.

“(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, $1,500, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be $500.

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

“(A) on filing a first petition, $120;

“(B) on filing a second petition, $330; and

“(C) on filing a third or subsequent petition, $570.

“(b) PATENT MAINTENANCE FEES.—During fiscal years 2005, 2006, and 2007, subsection (b) of section 41 of title 35, United States Code, shall be administered as though that subsection reads as follows:

“(b) MAINTENANCE FEES.—The Director shall charge the following fees for maintaining in force all patents based on applications filed on or after December 12, 1999:

“(1) 3 years and 6 months after grant, $900.

“(2) 7 years and 6 months after grant, $2,300.

“(3) 11 years and 6 months after grant, $3,800.

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

“(c) PATENT SEARCH FEES.—During fiscal years 2005, 2006, and 2007, subsection (d) of section 41 of title 35, United States Code, shall be administered as though that subsection reads as follows:

“(d) PATENT SEARCH AND OTHER FEES.—

“(1) PATENT SEARCH FEES.—

“(A) The Director shall charge a fee for the search of each application for a patent, except for provisional applications. The Director shall establish the fees charged under this paragraph to recover an amount not to exceed the estimated average cost to the Office of searching applications for patent either by acquiring a search report from a qualified search authority, or by causing a search by Office personnel to be made, of each application for patent. For the 3-year period beginning on the date of enactment of this Act, the fee for a search by a qualified search authority of a patent application described in clause (i), (iv), or (v) of this paragraph (B) may not exceed $500, of a patent application described in clause (ii) of paragraph (B)
may not exceed $100, and of a patent application
described in clause (iii) of subparagraph (B) may not
exceed $300. The Director may not increase any
such fee by more than 20 percent in each of the next
three 1-year periods, and the Director may not in-
crease any such fee thereafter.
(B) For purposes of determining the fees to be
established under this paragraph, the cost to the
Office of causing a search of an application to be
made by Office personnel shall be deemed to be—
(i) $500 for each application for an original patent,
except for design, plant, provisional, or international applications;
(ii) $100 for each application for an original design patent;
(iii) $300 for each application for an original patent;
(iv) $500 for the national stage of each international application; and
(v) $500 for each application for the reissue of a patent.
(C) The provisions of section 111(a)(3) of this title
title 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) of this title.
The provisions of section 371(d) of this title relating
to the payment of the national fee shall apply to
the payment of the fee specified in this paragraph
with respect to an international application.
(D) The Director may by regulation provide for
a refund of any part of the fee specified in this para-
graph for any applicant who files a written declara-
tion of express abandonment as prescribed by the
Director before an examination has been made of
the application under section 131 of this title, and
for any applicant who provides a search report that
meets the conditions prescribed by the Director.
(E) For purposes of subparagraph (A), a "qualified
search authority" may not include a commer-
cial entity unless—
(i) the Director conducts a pilot program
of limited scope, conducted over a period of not
more than 18 months, which demonstrates that
searches conducted by and used by the Patent
and Trademark Office during the patent exam-
ination process;
(ii) the Director submits a report on the re-
sults of the pilot program to Congress and the
Patent Public Advisory Committee that in-
cludes—
(I) a description of the scope and duration
of the pilot program;
(II) the identity of each commercial entity
participating in the pilot program;
(III) an explanation of the methodology
used to evaluate the accuracy and quality of
the search reports; and
(IV) an assessment of the effects that the
pilot program, as compared to searches con-
ducted by the Patent and Trademark Office,
had and will have on—
(aa) patentability determinations;
(bb) productivity of the Patent and Trade-
mark Office;
(cc) costs to the Patent and Trademark
Office;
(dd) costs to patent applicants; and
(ee) other relevant factors;
(iii) the Patent Public Advisory Committee
reviews and analyzes the Director’s report under
clause (ii) and the results of the pilot program
and submits a separate report on its analysis to
the Director and the Congress under clause (iii),
including—
(I) an independent evaluation of the effects
that the pilot program, as compared to searches
classified information may only be
conducted by Office personnel.
(F) A search of an application that is the sub-
ject of a secrecy order under section 181 or other-
wise involves classified information may only be
conducted by Office personnel.
(G) For recording a document affecting title,$40
per property.
(H) For each photocopy, $.25 per page.
(I) For each black and white copy of a patent,
$.30.
(J) For providing a library specified in sec-
tion 12 of this title with uncertified printed copies of
the specifications and drawings for all patents in
that year shall be $50.

(4) ADJUSTMENTS.—During fiscal years 2005, 2006, and
2007, subsection (f) of section 41 of title 35, United States Code, shall apply to the fees established under
this section.

(5) FEES FOR SMALL ENTITIES.—During fiscal years
2005, 2006, and 2007, subsection (h) of section 41 of title
35, United States Code, shall be administered as though
that subsection is amended—
(1) in paragraph (1), by striking ‘‘Fees charged
under subsection (a) or (b)’ and inserting ‘‘Subject to
paragraph (3), fees charged under subsections (a), (b),
and (d)(1);’’ and
(2) by adding at the end of the following new para-
graph:
(3) The fee charged under subsection (a)(1)(A)
shall be reduced by 75 percent with respect to its ap-
plication to any entity to which paragraph (1) ap-
pplies, if the application is filed by electronic means
as prescribed by the Director.’’

SEC. 802. ADJUSTMENT OF TRADEMARK FEES.

(a) FEE FOR FILING APPLICATION.—Until such time
as the Director sets or adjusts the fees otherwise, under
such conditions as may be prescribed by the Director,
the fee under section 31(a) of the Trademark Act of 1946
(15 U.S.C. 1113(a)) for:
(1) the filing of a paper application
for the registration of a trademark shall be $375;
(2) the filing of an electronic application shall be $325; and
(3) the filing of an electronic application meeting
certain additional requirements prescribed by the Di-
rector shall be $275. The provisions of the second and third sentences of section 31(a) of the Trademark Act of 1946 shall apply to the fees established under this section.

"(b) Reference to Trademark Act of 1946.—For purposes of this section, the 'Trademark Act of 1946' refers to the Act entitled 'An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes.', approved July 5, 1946 (15 U.S.C. 1051 et seq.)."

"SEC. 803. EFFECTIVE DATE, APPLICABILITY, AND TRANSITIONAL PROVISION.

"(a) Effective Date.—Except as otherwise provided in this title (including this section), the provisions of this section shall take effect on the date of the enactment of this Act [Dec. 8, 2004]."

"(b) Applicability.—

"(1) Except as provided in subparagraphs (B) and (C), the provisions of section 801 shall apply to all patents, whenever granted, and to all patent applications pending on or filed after the effective date set forth in subsection (a) of this section.

"(B)(i) Except as provided in clause (ii), subsections (a)(1) and (3) and (d)(1) of section 41 of title 35, United States Code, as administered as provided in this title, shall apply only to—

"(II) international applications entering the national stage under section 371 of title 35, United States Code, for which the basic national fee specified in section 41 of title 35, United States Code, was not paid before the effective date set forth in subsection (a) of this section.

"(ii) Section 41(a)(1)(D) of title 35, United States Code, as administered as provided in this title, shall apply only to applications for patent filed under section 111 of title 35, United States Code, on or after the effective date set forth in subsection (a) of this section, and

"(III) international applications entering the national stage under section 371 of title 35, United States Code, for which the basic national fee specified in section 41 of title 35, United States Code, was paid before the effective date set forth in subsection (a) of this section.

"(c) Section 41(a)(2) of title 35, United States Code, as administered as provided in this title, shall apply only to the extent that the number of excess claims, after giving effect to any cancellation of claims, is in excess of the number of claims for which the excess claims fee specified in section 41 of title 35, United States Code, was paid before the effective date set forth in subsection (a) of this section.

"(2) The provisions of section 802 shall apply to all applications for the registration of a trademark filed on or after the effective date set forth in subsection (a) of this section.

"(3) Translational Provisions.—

"(1) Search Fees.—During fiscal years 2005, 2006, and 2007, the Director shall charge—

"(A) for the search of each application for an original patent, except for design, plant, provisional, or international application, $500; and

"(B) for the search of each application for an original design patent, $100; and

"(C) for the search of each application for an original plant patent, $300; and

"(E) for the search of each application for the registration of a trademark, $500.

"(2) Timing of Fees.—The provisions of section 111(a)(3) of title 35, United States Code, relating to the payment of the fee for filing the application shall apply to the payment of the fee specified in paragraph (1) with respect to an application filed under section 111(a) of title 35, United States Code. The provisions of section 371(d) of title 35, United States Code, relating to the payment of the national fee shall apply to the payment of the fee specified in paragraph (1) with respect to an international application.

"SEC. 804. DEFINITION.

"In this title, the term 'Director' means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.'"
1997, as rural States under section 1501(b) of the Omnibus Crime Control and Safe Streets Act of 1968 (42 U.S.C. 3790(b) (3796bb(b)))."

WAIVER OF CERTAIN RESTRICTIONS

Pub. L. 102–204, §2(c), Dec. 10, 1991, 105 Stat. 1636, provided that: ""Surcharges established for fiscal year 1992 under section 10101(c) of the Omnibus Budget Reconciliation Act of 1990 [Pub. L. 101–508, set out below] may take effect on or after one day after such surcharges are published in the Federal Register. Section 553 of title 5, United States Code, shall not apply to the establishment of such surcharges for fiscal year 1992."

UNSPECIFIED PATENT FEES FOR FISCAL YEAR 1992; EFFECTIVE DATE CONTINGENT UPON PUBLICATION IN FEDERAL REGISTER

Pub. L. 102–204, §5(c)(2), Dec. 10, 1991, 105 Stat. 1639, provided that fees established by the Commissioner of Patents and Trademarks under subsec. (d) of this section during fiscal year 1992 could take effect on or after one day after being published in the Federal Register, and that former subsec. (g) of this section and section 553 of title 5 were not to apply to the establishment of such fees during fiscal year 1992.

PATENT INFORMATION DISSEMINATION


SURCHARGES ON PATENT FEES


B) Any fees that are collected under section 31 of the Trademark Act of 1946, and any surcharges on such fees, may only be used for expenses of the Office relating to the processing of trademark registrations and for other activities, services, and materials relating to trademarks and to cover a proportionate share of the administrative costs of the Office.

D) The Director may refund any fee paid by mistake or any amount paid in excess of that required.
(e) The Secretary of Commerce shall, on the day each year on which the President submits the annual budget to the Congress, provide to the Committees on the Judiciary of the Senate and the House of Representatives—

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

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

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

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

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


HISTORICAL AND Revision Notes


Language has been changed.

REFERENCES in TEXT

Section 31 of the Trademark Act of 1946, referred to in subsec. (c)(3)(B), is classified to section 1113 of Title 15, Commerce and Trade.

AMENDMENTS

2013—Subsec. (c)(3)(A). Pub. L. 112–274, §1(j)(1), substituted “this title,” for “sections 41, 42, and 376,” and “a proportionate share of the administrative costs of the Office for “a share of the administrative costs of the Office relating to patents”.

Subsec. (c)(3)(B). Pub. L. 112–274, §1(j)(2), substituted “a proportionate share of the administrative costs of the Office for “a share of the administrative costs of the Office relating to trademark registrations”.

2011—Subsec. (c). Pub. L. 112–29 designated existing provisions as par. (1), substituted “shall, subject to paragraph (3), be available” for “shall be available”, struck out at end “All fees available to the Director under section 31 of the Trademark Act of 1946 shall be used only for the processing of trademark registrations and for other activities, services, and materials relating to trademark registrations and to cover a proportionate share of the administrative costs of the Patent and Trademark Office.”, and added pars. (2) and (3).


2001—Subsec. (c). Pub. L. 106–113 substituted “the Code of Federal Regulations as a note under section 5 of this title.”.

1998—Pub. L. 106–113 redesignated existing provision relating to payment of patent fees as subsec. (a) and struck out provision that, except as provided in sections 361(b) and 376(b) of this title, the Commissioner deposit fees paid in the Treasury of the United States, shall be used exclusively for the processing of trademark registrations and for other services and materials related to trademark registrations.

1982—Pub. L. 96–517 designated existing provision relating to payment of patent fees as subsec. (a) and struck out provision that, except as provided in sections 361(b) and 376(b) of this title, the Commissioner deposit fees paid in the Treasury of the United States, shall be used exclusively for the processing of trademark registrations and for other services and materials related to trademark registrations.

1975—Pub. L. 94–131 inserted “except as provided in sections 361(b) and 376(b) of this title.”.

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(m) of Pub. L. 112–274, set out as a note under section 5 of this title.

EFFECTIVE DATE OF 2011 AMENDMENT


EFFECTIVE DATE OF 1999 AMENDMENT


EFFECTIVE DATE OF 1998 AMENDMENT


EFFECTIVE DATE OF 1982 AMENDMENT


EFFECTIVE DATE OF 1980 AMENDMENT

Amendment by Pub. L. 96–517 effective on first day of first fiscal year beginning on or after one calendar year after Dec. 22, 1980, subject to authorization of appropriation account credits from collected reexamination fees prior to the effective date, made available for payment of reexamination proceedings costs, see section
8(c) of Pub. L. 96-517, set out as a note under section 41 of this title.

**Effective Date of 1975 Amendment**

Amendment by Pub. L. 94-131 effective Jan. 24, 1978, and applicable on and after that date to patent applications filed in the United States and to international applications, where applicable, see section 11 of Pub. L. 94-131, set out as an Effective Date note under section 351 of this title.

**Authorization of Amounts Available to the Patent and Trademark Office**


“(a) In General.—There are authorized to be appropriated to the United States Patent and Trademark Office for salaries and necessary expenses for each of the fiscal years 2003 through 2008 an amount equal to the fees estimated by the Secretary of Commerce to be collected in each such fiscal year, respectively, under—

“(1) title 35, United States Code; and

“(2) the Act entitled ‘An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes’, approved July 5, 1946 (15 U.S.C. 1051 et seq.) (commonly referred to as the Trademark Act of 1946).

(b) Estimates.—Not later than February 15, of each fiscal year, the Undersecretary of Commerce for Intellectual Property and the Director of the Patent and Trademark Office shall submit an estimate of all fees referred to under subsection (a) to be collected in the next fiscal year to the chairman and ranking member of—

“(1) the Committees on Appropriations and Judiciary of the Senate; and

“(2) the Committees on Appropriations and Judiciary of the House of Representatives.”

**Appropriations Authorized To Be Carried Over**

Pub. L. 100-703, title I, §102, Nov. 19, 1988, 102 Stat. 4674, provided that: “Amounts appropriated under this Act and such fees as may be collected under title 35, United States Code, and the Trademark Act of 1946 (15 U.S.C. 1051 and following) may remain available until expended.”

Similar provisions were contained in the following prior authorization act:


**PART II—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS**

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**Amendments**


**Chapter 10—Patentability of Inventions**

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**Amendments**

2011—Pub. L. 112-29, §3(b)(3)(A), Sept. 16, 2011, 125 Stat. 267, substituted item 102 “Conditions for patentability; novelty” for “Conditions for patentability; novelty and loss of right to patent” and struck out item 104 “Invention made abroad”.


**$100. Definitions**

When used in this title unless the context otherwise indicates—

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

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

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

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

(e) The term “third-party requester” means a person requesting ex parte reexamination under section 302 who is not the patent owner.

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

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

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

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

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

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

1 So in original. Does not conform to chapter heading.
(2) The effective filing date for a claimed invention in an application for reissue or reissued patent shall be determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought.

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


AMENDMENT OF SUBSECTION (i)(1)(B) Pub. L. 112–211, title I, §§102(1), 103, Dec. 18, 2012, 126 Stat. 1531, 1532, provided that, effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, with certain exceptions, subsection (i)(1)(B) of this section is amended by substituting "right of priority under section 119, 365(a), 365(b), 365(c), or 365(d) or to the benefit of an earlier filing date under section 120, 121, 365(a), or 365(c)" for "right of priority under section 119, 365(a), 365(b), 365(c) or 365(d) or to the benefit of an earlier filing date under section 120, 121, 365(a), or 365(c)". See 2012 Amendment note below.

HISTORICAL AND REVISION NOTES
Paragraph (a) is added only to avoid repetition of the phrase "invention or discovery" and its derivatives throughout the revised title. The present statutes use the phrase "invention or discovery" and derivatives.

Paragraph (b) is noted under section 101.

Paragraphs (c) and (d) are added to avoid the use of long expressions in various parts of the revised title.

AMENDMENTS
2012—Subsec. (i)(1)(B). Pub. L. 112–211 substituted "right of priority under section 119, 365(a), 365(b), 365(c), or 365(d) or to the benefit of an earlier filing date under section 120, 121, 365(a), or 365(c)" for "right of priority under section 119, 365(a), 365(b), or 365(c) or to the benefit of an earlier filing date under section 120, 121, or 365(c)".

2011—Subsec. (e). Pub. L. 112–29, §3(a)(1), struck out "or inter partes reexamination under section 311" after "'501'.


EFFECTIVE DATE OF 2012 AMENDMENT
Pub. L. 112–211, title I, §103, Dec. 18, 2012, 126 Stat. 1532, provided that:

"(a) IN GENERAL.—The amendments made by this title (enacting part V of this title and amending this title) shall take effect on the later of—

"(1) the date that is 1 year after the date of the enactment of this Act [Dec. 18, 2012]; or

"(2) the date of entry into force of the treaty with respect to the United States.

(b) APPLICABILITY OF AMENDMENTS.—

"(1) IN GENERAL.—Subject to paragraph (2), the amendments made by this title shall apply only to international design applications, international applications, and national applications filed on and after the effective date set forth in subsection (a), and patents issuing thereon.

"(2) EXCEPTION.—Sections 100(i) and 102(d) of title 35, United States Code, as amended by this title, shall not apply to an application, or any patent issuing thereon, unless it is described in section 386(b) or to the benefit of an earlier filing date under section 120, 121, or 365(c) of title 35, United States Code.

"(c) DEFINITIONS.—For purposes of this section:

"(1) the terms 'treaty' and 'international design application' have the meanings given those terms in section 381 of title 35, United States Code, as added by this title;

"(2) the term 'international application' has the meaning given that term in section 351(c) of title 35, United States Code;

"(3) the term 'national application' means 'national application' within the meaning of chapter 38 of title 35, United States Code, as added by this title."

EFFECTIVE DATE OF 2011 AMENDMENT; SAVINGS PROVISIONS
Pub. L. 112–29, §3(n), Sept. 16, 2011, 125 Stat. 293, provided that:

"(1) IN GENERAL.—Except as otherwise provided in this section (amending this section and sections 32, 102, 103, 111, 119, 120, 134, 135, 145, 146, 154, 172, 202, 287, 291, 305, 363, 374, and 376 of this title, repealing sections 104 and 157 of this title, and enacting provisions set out as notes under sections 32, 102, and 111 of this title), the amendments made by this section shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act [Sept. 16, 2011], and shall apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time:

"(A) a claim to a claimed invention that has an effective filing date as defined in section 100(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.

"(2) INTERFERING PATENTS.—The provisions of sections 102(g), 135, and 291 of title 35, United States Code, as in effect on the day before the effective date set forth in paragraph (1) of this subsection, shall apply to each claim of an application for patent, and any patent issued thereon, for which the amendments made by this section also apply, if such application or patent contains or contained at any time such a claim.

EFFECTIVE DATE OF 1999 AMENDMENT
Amendment by Pub. L. 106–113 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 a note under section 41 of this title.

§ 101. Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

(July 19, 1952, ch. 950, 66 Stat. 797.)

HISTORICAL AND REVISION NOTES
§ 102. Conditions for patentability; novelty

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

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

(2) the claimed invention was described in a patent issued under section 316 or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) Exceptions.

(1) Disclosures Made 1 Year or Less Before the Effective Filing Date of the Claimed Invention.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

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

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

(2) Disclosures Appearing in Applications and Patents.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

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

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

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

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

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

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

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

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

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

(2) if the patent or application for patent is entitled to claim a right of priority under section 119(a), or 365(a), 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.


Amendment of subsection (d)(2) (Pub. L. 112-211, title I, §§102(2), 103, Dec. 18, 2012, 126 Stat. 1531, 1532; provided that, effec-
tive on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, with certain exceptions, subsection (d)(2) of this section is amended by substituting “to claim a right of priority under section 119, 365(a), 365(b), 366(a), or 366(b), or to claim the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c)” for “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, 365(c), or 386(c)”. See 2012 Amendment note below.

HISTORICAL AND REVISION NOTES


The section has been changed so that the prior foreign patent is not a bar unless it was granted before the filing of the application in the United States.

Paragraph (e) is new and enacts the rule of Milburn v. Davis-Bournonville, 270 U.S. 390, by reason of which a United States patent disclosing an invention dates from the date of filing the application for the purpose of anticipating a subsequent inventor.

Paragraph (f) indicates the necessity for the inventor as the party applying for patent. Subsequent sections permit certain persons to apply in place of the inventor under special circumstances.


Language relating specifically to designs is omitted for inclusion in subsequent sections.

AMENDMENTS

2012—Subsec. (d)(2). Pub. L. 112–211 substituted “to claim a right of priority under section 119, 365(a), 365(b), 366(a), or 366(b), or to claim the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c)” for “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, 365(c), or 386(c)”. See 2012 Amendment note below.


“(1) an application for patent, published under section 122(b), by another filed in the United States be-
tions filed in the United States and to international applications, where applicable, see section 11 of Pub. L. 94–131, set out as an Effective Date note under section 351 of this title.

Effective Date of 1972 Amendment
Pub. L. 92–358, §3(b)(3), July 28, 1972, 86 Stat. 502, provided that: ‘‘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 108–465; see Short Title of 2004 Amendment note set out under section 1 of this title), the amendments of which are stricken by subsection (c) of this section (amending section 103 of this title). 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.’’

Tax Strategies Deemed Within the Prior Art
Pub. L. 112–29, §14, Sept. 16, 2011, 125 Stat. 327, provided that: ‘‘(a) IN GENERAL.—For purposes of evaluating an invention under section 102 or 103 of title 35, United States Code, any strategy for reducing, avoiding, or deferring tax liability, whether known or unknown at the time of the invention or application for patent, shall be deemed insufficient to differentiate a claimed invention from the prior art.

(b) DEFINITION.—For purposes of this section, the term ‘tax liability’ refers to any liability for a tax, under any Federal, State, or local law, or the law of any foreign jurisdiction, including any statute, rule, regulation, or ordinance that levies, imposes, or authorizes taxation or from a flash of genius.

(c) EXCLUSIONS.—This section does not apply to that part of an invention that—

‘‘(1) is a method, apparatus, technology, computer program product, or system, that is used solely for preparing a tax or information return or other tax filing, including one that records, transmits, transfers, or organizes data related to such filing; or

‘‘(2) is a method, apparatus, technology, computer program product, or system used solely for financial management, to the extent that it is severable from any tax strategy or does not limit the use of any tax strategy by any taxpayer or tax advisor.

(d) RULE OF CONSTRUCTION.—Nothing in this section shall be construed to imply that other business methods are patentable or that other business method patents are not invalid.

(e) EFFECTIVE DATE; APPLICABILITY.—This section shall take effect on the date of the enactment of this Act (Sept. 16, 2011) and shall apply to any patent application that is pending on, or filed on or after, that date, and to any patent that is issued on or after that date.’’

Emergency Relief from Postal Situation Affecting Patent Filing
Relief as to filing date of patent application or patent affected by postal situation beginning on Mar. 18, 1970, and ending on or about Mar. 30, 1970, but patents issued with earlier filing dates not effective as prior art under subsec. (e) of this section as of such earlier filing dates, see section 1(a) of Pub. L. 92–34, formerly set out in a note under section 111 of this title.

Conditions for Patentability; Non-obvious Subject Matter
A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.


Historical and Revision Notes
There is no provision corresponding to the first sentence explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850. This paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect, and also to preserve as a basis for the addition at a later time of some criteria which may be worked out.

The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius.

Amendments

Prior to amendment, section consisted of subsecs. (a) to (c) and related to conditions for patentability: non-obvious subject matter.

Subsecs. (a), (c)(1). Pub. L. 112–29, §20(j), struck out ‘‘of this title’’ after ‘‘102’’.

2004—Subsec. (c). Pub. L. 108–463 amended subsec. (c) generally. Prior to amendment, subsec. (c) read as follows: ‘‘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 invention was made, owned by the same person or subject to an obligation of assignment to the same person.’’

1999—Subsec. (c). Pub. L. 106–113 substituted ‘‘one or more of subsections (e), (f), and (g)’’ for ‘‘subsection (f) or (g)’’.
1995—Pub. L. 104–41 designated first and second pars. as subsecs. (a) and (c), respectively, and added subsec. (b).

1984—Pub. L. 98–622 inserted “Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section after the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

**Effective Date of 2011 Amendment**

Amendment by section 3(c) of Pub. L. 112–29 effective upon the expiration of the 18-month period beginning on Sept. 16, 2011, and applicable to certain applications for patent and any patents issuing thereon, see section 3(n) of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title.

Amendment by section 20(j) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(b) of Pub. L. 112–29, set out as a note under section 2 of this title.

**Effective Date of 2004 Amendment**


“(a) IN GENERAL.—The amendments made by this Act [amending this section] shall apply to any patent granted on or after the date of the enactment of this Act [Dec. 10, 2004].

“(b) SPECIAL RULE.—The amendments made by this Act shall not affect any final decision of a court or the United States Patent and Trademark Office rendered before the date of the enactment of this Act, and shall not affect the right of any party in any action pending before the United States Patent and Trademark Office for a patent on the date of the enactment of this Act to have that party’s rights determined on the basis of the provisions of title 35, United States Code, in effect on the day before the date of the enactment of this Act.”

**Effective Date of 1999 Amendment**


“The amendment made by this section [amending this section] shall apply to any application for patent filed on or after the date of the enactment of this Act [Nov. 29, 1999].”

**Effective Date of 1995 Amendment**

Pub. L. 104–41, §3, Nov. 1, 1995, 109 Stat. 352, provided that:

“The amendments made by section 1 [amending this section] shall apply to any application for patent filed on or after the date of enactment of this Act [Nov. 1, 1995] and to any application for patent pending on such date of enactment, including (in either case) an application for the reissuance of a patent.”

**Effective Date of 1984 Amendment**

Pub. L. 98–622, title I, §106, Nov. 8, 1984, 98 Stat. 3385, provided that:

“(a) Subject to subsections (b), (c), (d), and (e) of this section, the amendments made by this Act [probably should be “this title”], meaning title I of Pub. L. 98–622, enacting section 157 of this title, amending this section and sections 116, 120, 135, and 271 of this title, and enacting a provision set out as a note under section 157 of this title] shall apply to all United States patents granted before, on, or after the date of enactment of this Act [Nov. 8, 1984], and to all applications for United States patents pending on or filed after the date of enactment.

“(b) The amendments made by this Act shall not affect any final decision made by the court or the Patent and Trademark Office before the date of enactment of this Act [Nov. 8, 1984], with respect to a patent or application for patent, if no appeal from such decision is pending and the time for filing an appeal has expired.

“(c) Section 271(f) of title 35, United States Code, added by section 101 of this Act shall apply only to the supplying, or causing to be supplied, of any component or components of a patented invention after the date of enactment of this Act [Nov. 8, 1984].

“(d) No United States patent granted before the date of enactment of this Act [Nov. 8, 1984] shall abridge or affect the right of any person or his successors in business who made, purchased, or used prior to such effective date anything protected by the patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased, or used, if the patent claims were invalid or otherwise unenforceable on a ground obviated by section 103 or 104 of this Act [amending this section and sections 116 and 120 of this title] and the person made, purchased, or used the specific thing in reasonable reliance on such invalidity or unenforceability. If a person reasonably relied on such invalidity or unenforceability, the court before which such matter is in question may provide for the continued manufacture, use, or sale of the thing so made, purchased, or used as specified, or for the manufacture, use, or sale of which substantial preparation was made before the date of enactment of this Act, and it may also provide for the continued practice of any process, practiced, or for the practice of which substantial preparation was made, prior to the date of enactment, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the date of enactment.

“(e) The amendments made by this Act shall not affect the right of any party in any case pending in court on the date of enactment [Nov. 8, 1984] to have their rights determined on the basis of the substantive law in effect prior to the date of enactment.”

§105. Inventions in outer space

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

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


EFFECTIVE DATE; SPECIAL RULES

Pub. L. 101–580, §2, Nov. 15, 1990, 104 Stat. 2863, provided that:

“(a) EFFECTIVE DATE.—Subject to subsections (b), (c), and (d) of this section, the amendments made by the first section of this Act (enacting this section) shall apply to all United States patents granted before, on, or after the date of enactment of this Act [Nov. 15, 1990], and to all applications for United States patents pending on or filed on or after such date of enactment,

“(b) FINAL DECISIONS.—The amendments made by the first section of this Act [enacting this section] shall not affect any final decision made by a court or the Patent and Trademark Office on the date of enactment of this Act [Nov. 15, 1990] with respect to a patent or an application for a patent, if no appeal from such decision is pending and the time for filing an appeal has expired.

“(c) PENDING CASES.—The amendments made by the first section of this Act [enacting this section] shall not affect the right of any party in any case pending on or after the date of enactment of this Act [Nov. 15, 1990] to have the party’s rights determined on the basis of the substantive law in effect before such date of enactment.

“(d) NON-APPLICABILITY.—The amendments made by the first section of this Act [enacting this section] shall not apply to any process, machine, article of manufacture, or composition of matter, an embodiment of which was launched prior to the date of enactment of this Act [Nov. 15, 1990].”

CHAPTER 11—APPLICATION FOR PATENT

Sec. 111. Application.

112. Specification.

113. Drawings.

114. Models, specimens.

115. Inventor’s oath or declaration.

116. Inventors.

117. Death or incapacity of inventor.

118. Filing by other than inventor.

119. Benefit of earlier filing date; right of priority.

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

121. Divisional applications.

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

123. Micro entity defined.

AMENDMENTS

2011—Pub. L. 112–29, §108(g)(2), Sept. 16, 2011, 125 Stat. 319, which directed adding item 123 at the end of this chapter, was executed by adding the item at the end of the table of sections of this chapter, to reflect the probable intent of Congress.


§111. Application

(a) IN GENERAL.—

(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.

(2) CONTENTS.—Such application shall include—

(A) a specification as prescribed by section 112;

(B) a drawing as prescribed by section 113; and

(C) an oath or declaration as prescribed by section 115.

(3) FEE, OATH OR DECLARATION, AND CLAIMS.—The application shall be accompanied by the fee required by law, oath or declaration, and 1 or more claims may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the fee, oath or declaration, and 1 or more claims within such prescribed period, the application shall be regarded as abandoned.

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

(b) PROVISIONAL APPLICATION.—

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

(A) a specification as prescribed by section 112(a); and

(B) a drawing as prescribed by section 113.

(2) CLAIM.—A claim, as required by subsections (b) through (e) of section 112, shall not be required in a provisional application.

(3) FEE.—The application shall be accompanied by the fee required by law. The fee may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned.

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

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

(6) Other Basis for Provisional Application.—Subject to all the conditions in this subsection and section 119(e), and as prescribed by the Director, an application for patent filed under subsection (a) may be treated as a provisional application for patent.

(7) No Right of Priority or Benefit of Earliest Filing Date.—A provisional application shall not be entitled to the right of priority of any earlier application under section 119 or 365(a) or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c).

(8) Applicable Provisions.—The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 131 and 135. (c) Prior Filed Application.—Notwithstanding the provisions of subsection (a), the Director may prescribe the conditions, including the payment of a surcharge, under which a reference made upon the filing of an application under subsection (a) to a previously filed application, specifying the previously filed application by application number and the intellectual property authority or country in which the application was filed, shall constitute the specification and any drawings of the subsequent application for purposes of a filing date. A copy of the specification and any drawings of the previously filed application shall be submitted within such period and under such conditions as may be prescribed by the Director. A failure to submit the copy of the specification and any drawings of the previously filed application within the prescribed period shall result in the application being regarded as abandoned. Such application shall be treated as having never been filed, unless

1. the application is revived under section 27;
2. a copy of the specification and any drawings of the previously filed application are submitted to the Director.


Amendment of Section

Pub. L. 112–211, title I, §§102(3), 103, Dec. 18, 2012, 126 Stat. 1351, 1352, provided that, effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issued thereon, subsection (b)(7) of this section is amended by substituting ‘‘section 119, 365(a), or 366(a)’’ for ‘‘section 119 or 365(a)’’ and ‘‘section 120, 121, 365(c), or 366(c)’’ for ‘‘section 120, 121, or 365(c)’’. See 2012 Amendment note below.

Historical and Revision Notes

Based on Title 35, U.S.C. 1946 ed., §33 (R.S. 4888, amended (1) Mar. 3, 1915, ch. 94, §1, 38 Stat. 958; (2) May 21, 1930, ch. 312, §2, 46 Stat. 376). The corresponding section of existing statute is divided into an introductory section relating to the application generally (this section) and a section on the specification (sec. 112).

The parts of the application are specified and the requirement for signature is placed in this general section so as to ensure that only one signature will suffice.

Amendments

2012—Subsec. (a)(3), (4). Pub. L. 112–211, §201(a)(1), added pars. (3) and (4) and struck out former pars. (3) and (4) which related to fee and oath or declaration and failure to submit.

Subsec. (b)(3), (4). Pub. L. 112–211, §201(a)(2), added pars. (3) and (4) and struck out former pars. (3) and (4) which related to fee and filing date of a provisional application.

Subsec. (b)(7). Pub. L. 112–211, §102(3), substituted ‘‘section 119, 365(a), or 366(a)’’ for ‘‘section 119 or 365(a)’’ and ‘‘section 120, 121, 365(c), or 366(c)’’ for ‘‘section 120, 121, or 365(c)’’.


Subsec. (b)(2). Pub. L. 112–29, §20(j), struck out ‘‘of this title’’ after ‘‘119(e)’’.

Subsec. (b)(7). Pub. L. 112–29, §20(j), struck out ‘‘of this title’’ after ‘‘365(a)’’ and after ‘‘365(c)’’.


Pub. L. 112–29, §20(j), substituted ‘‘sections 131 and 135’’ for ‘‘sections 115, 131, 135, and 157’’.


Subsec. (b)(5). Pub. L. 106–113, §1000(a)(9) [title IV, §480(a)], amended heading and text of par. (5) generally. Prior to amendment, text read as follows: ‘‘The provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival thereafter.’’

1994—Pub. L. 103–465 amended section generally. Prior to amendment, section read as follows: “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 Commissioner. Such application shall include (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. 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 conditions, including the payment of a surcharge, as may be prescribed by the Commissioner. 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 Commissioner that the delay in submitting the fee and oath was unavoidable. 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.’’

1982—Pub. L. 97–247 inserted ‘‘, or authorized to be made,’’ after ‘‘shall be made’’, struck out ‘‘signed by the applicant’’ and after ‘‘The application’’, inserted provisions that the fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Commissioner, that 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 Commissioner that the delay in submitting the fee and oath was unavoidable, and that 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.

Effective Date of 2012 Amendment
Amendment by section 102(3) of Pub. L. 112–211 effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, see section 103 of Pub. L. 112–211, set out as a note under section 100 of this title.

Amendment by section 201(a) of Pub. L. 112–211 effective on the date that is 1 year after Dec. 18, 2012, applicable to certain patents and applications for patents, and not effective with respect to patents in litigation commenced before the effective date, see section 203 of Pub. L. 112–211, set out as an Effective Date note under section 27 of this title.

Effective Date of 2011 Amendment
Pub. L. 112–29, §3(e)(3), Sept. 16, 2011, 123 Stat. 238, provided that: ‘‘The amendments made by this subsection (amending this section and repealing section 157 of this title) shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act (Sept. 16, 2011), and shall apply to any request for a statutory invention registration filed on or after that effective date.’’

Pub. L. 112–29, §4(e), Sept. 16, 2011, 123 Stat. 297, provided that: ‘‘The amendments made by this subsection (amending this section and sections 112, 115, 118, 121, and 251 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 application that is filed on or after that effective date.’’

Amendment by section 20(1) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, applicable to proceedings commenced on or after that effective date, see section 20(1) of Pub. L. 112–29, set out as a note under section 2 of this title.
(f) ELEMENT IN CLAIM FOR A COMBINATION.—An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.


HISTORICAL AND REVISION NOTES


The sentence relating to signature of the specification is omitted in view of the general requirement for a signature in section 111.

The last sentence is omitted for inclusion in the chapter relating to plant patents.

The clause relating to machines is omitted as unnecessary and the requirement for disclosing the best mode of carrying out the invention is stated as generally applicable to all types of invention (derived from Title 35, U.S.C., 1946 ed., § 69, first defense). The clause relating to the claim is made a separate paragraph to emphasize the distinction between the description and the claim or definition, and the language is modified.

A new paragraph relating to functional claims is added.

AMENDMENTS

2011—Pub. L. 112–29 designated first to sixth pars. as subsecs. (a) to (f), respectively, inserted headings, in subsec. (a), substituted “or joint inventor of carrying out the invention” for “of carrying out his invention”, in subsec. (b), substituted “inventor or a joint inventor regards as the invention” for “applicant regards as his invention”, and in subsec. (d), substituted “Subject to subsection (e),” for “Subject to the following paragraph.”.

1975—Pub. L. 94–131 substituted provision authorizing the writing of claims, if the nature of the case admits, in dependent or multiple dependent form for prior provision for writing claims in dependent form, required claims in dependent form to contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed, substituted text respecting construction of a claim in dependent form so as to incorporate by reference all the limitations of the claim to which it refers for prior text for construction of a dependent claim to include all the limitations of the claim incorporated by reference into the dependent claim, and inserted paragraph respecting certain requirements for claims in multiple dependent form.

1965—Pub. L. 89–83 permitted a claim to be written in independent or dependent form, and if in dependent form, required it to be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

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 application that is filed on or after that effective date, see section 4(e) of Pub. L. 112–29, set out as a note under section 111 of this title.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 94–131 effective Jan. 24, 1978, and applicable on and after that date to patent applications filed in the United States and to international applications, where applicable, see section 11 of Pub. L. 94–131, set out as an Effective Date note under section 351 of this title.

EFFECTIVE DATE OF 1965 AMENDMENT

Amendment by Pub. L. 89–83 effective three months after July 24, 1965, see section 7(a) of Pub. L. 89–83, set out as a note under section 41 of this title.

§ 113. Drawings

The applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented. When the nature of such subject matter admits of illustration by a drawing and the applicant has not furnished such a drawing, the Director may require its submission within a time period of not less than two months from the sending of a notice thereof. Drawings submitted after the filing date of the application may not be used (1) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (2) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.


HISTORICAL AND REVISION NOTES


The requirement for signature in the corresponding section of existing statute is omitted; regulations of the Patent Office can take care of any substitute. A redundant clause is omitted.

AMENDMENTS


EFFECTIVE DATE OF 1999 AMENDMENT


EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 94–131 effective Jan. 24, 1978, and applicable on and after that date to patent applications filed in the United States and to international applications, where applicable, see section 11 of Pub. L. 94–131, set out as an Effective Date note under section 351 of this title.

§ 114. Models, specimens

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

When the invention relates to a composition of matter, the Director may require the appli-
§115. Inventor's oath or declaration

(a) NAMING THE INVENTOR; INVENTOR'S OATH OR DECLARATION.—An application for patent that is filed under section 111(a) or commences the national stage under section 371 shall include, or be amended to include, the name of the inventor for any invention claimed in the application. Except as otherwise provided in this section, each individual who is the inventor or a joint inventor of a claimed invention in an application for patent shall execute an oath or declaration in connection with the application.

(b) REQUIRED STATEMENTS.—An oath or declaration under subsection (a) shall contain statements that—

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

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

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

(d) SUBSTITUTE STATEMENT.—

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

(2) PERMITTED CIRCUMSTANCES.—A substitute statement under paragraph (1) is permitted with respect to any individual who—

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

(i) is deceased;

(ii) is under legal incapacity; or

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

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

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

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

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

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

(e) MAKING REQUIRED STATEMENTS IN ASSIGNMENT OF RECORD.—An individual who is under an obligation of assignment of an application for patent may include the required statements under subsections (b) and (c) in the assignment executed by the individual, in lieu of filing such statements separately.

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

(g) EARLIER-FILED APPLICATION CONTAINING REQUIRED STATEMENTS OR SUBSTITUTE STATEMENT.—

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

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

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

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

(2) COPIES OF OATHS, DECLARATIONS, STATEMENTS, OR ASSIGNMENTS.—Notwithstanding paragraph (1), the Director may require that a copy of the executed oath or declaration, the substitute statement, or the assignment filed in connection with the earlier-filed application be included in the later-filed application.

(h) SUPPLEMENTAL AND CORRECTED STATEMENTS; FILING ADDITIONAL STATEMENTS.—

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

(a) Joint Inventions.—When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.
(b) OMITTED INVENTOR.—If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Director, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

(c) CORRECTION OF ERRORS IN APPLICATION.—Whenever through error a person is named in an application for patent as the inventor, or through error an inventor is not named in an application, the Director may permit the application to be amended accordingly, under such terms as he prescribes.


§117. Death or incapacity of inventor

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


§118. Filing by other than inventor

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


AMENDMENTS


HISTORICAL AND REVISION NOTES

The first paragraph is implied in the present statutes, and the part of the last paragraph relating to omission of an erroneously joined inventor is in the Patent Office rules. The remainder is new and provides for the correction of a mistake in erroneously joining a person as inventor, and for filing an application when one of several joint inventors cannot be found. This section is ancillary to section 256.

AMENDMENTS

2011—Pub. L. 112–29 designated first to third paras. as subsecs. (a) to (c), respectively, inserted headings, and, in subsec. (c), struck out “and such error arose without any deceptive intention on his part,” before “the Director.”


1984—Pub. L. 98–622 amended first par. generally, striking out “and each shall sign the application” after “patent jointly” and inserting sentence beginning “Inventors may apply”.

1982—Pub. L. 97–247 substituted “Inventors” for “Joint inventors’ as section catchline, and substituted “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” for “a person is joined in an application for patent as joint inventor through error, or a joint inventor is not included in an application through error”.

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 proceedings commenced on or after the effective date, see section 281 of Pub. L. 112–29, set out as a note under section 1 of this title.

EFFECTIVE DATE OF 1999 AMENDMENT

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

(a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within 12 months from the earliest date on which such foreign application was filed. The Director may prescribe regulations, including the requirement for payment of the fee specified in section 41(a)(7), pursuant to which the 12-month period set forth in this subsection may be extended by an additional 2 months if the delay in filing the application in this country within the 12-month period was unintentional.

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

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

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

(c) In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in the same foreign country instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

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

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

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

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

(g) As used in this section—
   (1) the term “WTO member country” has the same meaning as the term is defined in section 104(b)(2); and
   (2) the term “UPOV Contracting Party” means a member of the International Convention for the Protection of New Varieties of Plants.


HISTORICAL AND REVISION NOTES


The first paragraph is the same as the present law with changes in language. The references to designs have been removed for inclusion in another section and the opening clause has been modified to accord with actual practice and the requirements of the International Convention for the Protection of Industrial Property.

The second paragraph is new, making an additional procedural requirement for obtaining the right of priority. The papers of the foreign prosecution on which the right of priority is based are required so that the record of the United States patent will be complete in this country.

REFERENCES IN TEXT

The Stockholm Revision of the Paris Convention, referred to in subsec. (d), means the Convention revising the Union of Paris of Mar. 20, 1883, as revised, for the protection of industrial property, done at Stockholm July 14, 1967, entered into force for the United States Sept. 5, 1970, with the exception of Articles 1 through 12 which entered into force for the United States Aug. 25, 1973. See 21 UST 1583; 24 UST 2140; TIAS 6293, 7727.

AMENDMENTS

2012—Subsec. (a). Pub. L. 112–211, §201(c)(1)(A), substituted “12” for “twelve” and inserted at end “The Director may prescribe regulations, including the requirement for payment of the fee specified in section 41(a)(7)”, pursuant to which the 12-month period set forth in this subsection may be extended by an additional 2 months if the delay in filing the application in this country within the 12-month period was unintentional.

Subsec. (b)(2). Pub. L. 112–211, §202(b)(2), substituted “including the requirement for payment of the fee specified in section 41(a)(7)” for “including the payment of a surcharge”.

Subsec. (e)(1). Pub. L. 112–211, §201(c)(1)(B)(i), inserted “The Director may prescribe regulations, including the requirement for payment of the fee specified in section 41(a)(7), pursuant to which the 12-month period set forth in this subsection may be extended by an additional 2 months if the delay in filing the application in this country within the 12-month period was unintentional,” after “reference to the provisional application,” and, in last sentence, substituted “including the payment of the fee specified in section 41(a)(7)” for “including the payment of a surcharge” and struck out “during the pendency of the application” before period at end.

Subsec. (e)(3). Pub. L. 112–211, §201(c)(1)(B)(ii), inserted at end “For an application for patent filed under section 363 in a Receiving Office other than the Patent and Trademark Office, the 12-month and additional 2-month period set forth in this subsection shall be extended as provided under the treaty and Regulations as defined in section 351.”

2011—Subsec. (a). Pub. L. 112–29, §3(g)(6), struck out “; 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” before “the period at the end.”


Pub. L. 112–29, §15(b), substituted “section 112(a) (other than the requirement to disclose the best mode)” for “the first paragraph of section 112 of this title”.

Subsec. (e)(2). Pub. L. 112–29, §20(j), struck out “of this title” after “111(b)” and after “41(a)(1)”.

Subsec. (g)(1), Pub. L. 112–29, §20(j), struck out “of this title” after “104(b)(2)”.


Subsec. (b). Pub. L. 106–113, §1000(a)(9) [title IV, §450(a)], amended subsec. (b) generally. Prior to amendment, subsec. (b) read as follows: “No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent and Trademark Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he deems necessary.”

Subsec. (e)(1). Pub. L. 106–113, §1000(a)(9) [title IV, §450(b)(2)], inserted at end: “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 amendment of an amendment under this subsection during the pendency of the application.”
Subsec. (e)(2), Pub. L. 106–113, §1000(a)(9) [title IV, §4803(c)], struck out before period at end “and the provision
al application was pending on the filing date of the application for patent under section 111(a) or section 363 of this title”.
Subsec. (e)(3), Pub. L. 106–113, §1000(a)(9) [title IV, §4803(b)], added par. (3).
Subsecs. (f), (g), Pub. L. 106–113, §1000(a)(9) [title IV, §4802(2)], added subsecs. (f) and (g).
1994—Pub. L. 103–465, in section catchline, struck out “in foreign country” after “date”, designated four un-
designated paragraphs as subsecs. (a) to (d), and added subsec. (e).
1975—Pub. L. 93–596 substituted “Patent and Trade-
mark Office” for “Patent Office”.
1972—Pub. L. 92–538 inserted last paragraph providing that
under certain circumstances, applications for inventors’ certificate filed in a foreign country would be
given the same priority as applications for patents, if the
applicants are entitled to the benefits of the Stock-
mol复习 of the Paris Convention at the time of
filing.
1961—Pub. L. 87–333 authorized the right provided by
this section to be based upon a subsequent application
in the same foreign country, instead of the first appli-
cation, provided that any foreign application filed prior
to such subsequent one was withdrawn, or otherwise
disposed of, without having been open to public inspection
and without leaving any rights outstanding, nor any
basis for claiming priority.

Effective Date of 2012 Amendment
Amendment by Pub. L. 112–211 effective on the date that is 1 year after Dec. 18, 2012, applicable to patents issued before, on, or after that effective date and patent applications pending on or filed after that effective date, and not effective with respect to patents in litiga-
tion commenced before that effective date, see section
203 of Pub. L. 112–211, set out as an Effective Date note
under section 27 of this title.

Effective Date of 2011 Amendment
Amendment by section 3(g)(6) of Pub. L. 112–29 effective
upon the expiration of the 18-month period beginning on
Sept. 16, 2011, and applicable to certain applica-
tions for patent and any patents issuing thereon, see
section 3(n) of Pub. L. 112–29, set out as an Effective Date note
under section 100 of this title.

Effective Date of 2011 Amendment; Savings Provisions note
under section 100 of this title.

Effective Date of 2009 Amendment
Amendment by section 1001(a)(9) [title IV, §4503(a), (b)(2)] of Pub. L. 106–113 effective Nov. 29, 2000, and
applicable only to applications (including international applications designating the United States) filed on or
after that date, see section 1001(a)(9) [title IV, §4508] of
Pub. L. 106–113, as amended, set out as a note under sec-
tion 10 of this title.

“[the amendments made by this section (amending this section and section 111 of this title) shall take effect on the
date of the enactment of this Act [Nov. 29, 1999] and shall apply to any provisional application filed on or
after June 8, 1995, except that the amendments made by
subsections (b) and (c) (amending this section) shall have no effect with respect to any patent which is the
subject of litigation in an action commenced before such date of enactment.”

Effective Date of 1994 Amendment
Amendment by Pub. L. 103–465 effective 6 months after
Dec. 8, 1994, and applicable to all patent applica-
tions filed in the United States on or after that effective
date, with provisions relating to earliest filed patent
application, see section 344(b)(1), (3) of Pub. L. 103–465, set out as a note under section 154 of this title.

Effective Date of 1975 Amendment
Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see
section 4 of Pub. L. 93–596, set out as a note under section
1111 of Title 15, Commerce and Trade.

Effective Date of 1972 Amendment
Pub. L. 92–358, §3(a), July 28, 1972, 86 Stat. 502, pro-
vided that: “Section 1 of this Act [amending this section]
shall take effect on the date when Articles 1–12 of the Paris Convention of March 20, 1883, for the Protec-
tion of Industrial Property, as revised at Lisbon, Oct. 31, 1958, comes into force with respect to the
United States [Aug. 25, 1973] and shall apply only to applica-
tions thereafter filed in the United States.”

Effective Date of 1961 Amendment
Amendment by Pub. L. 87–333 effective on the date when
the Convention of Paris for the Protection of Indus-
trial Property of March 20, 1883, as revised at Stoc-
holm, Oct. 31, 1958, comes into force with respect to the
United States [Jan. 4, 1962] and shall apply only to appli-
cations thereafter filed in the United States by persons
entitled to the benefit of said convention, as re-
vised at the time of such filing, see section 3 of Pub. L.
87–333, set out as a note under section 1126 of Title 15,
Commerce and Trade.

Japanese and Certain German Nationals;
Temporary Extension of Priority Rights
Act Aug. 23, 1954, ch. 823, 68 Stat. 764, provided that
the priority rights specified in section 101 of former
Title 35, Patents, which arose before Apr. 1, 1950, were
extended, with respect to inventions made subsequent
to Jan. 1, 1946, in favor of certain Japanese and German
nationals, to a date nine months after Aug. 23, 1954,
extended, with respect to inventions made subsequent
to Jan. 1, 1946, in favor of certain Japanese and German
nationals, to a date nine months after Aug. 23, 1954,
subject to conditions and limitations specified in sec-
tions 104, 110, 112, and 114 of former title 35.

§120. Benefit of earlier filing date in the United
States
An application for patent for an invention dis-
closed in the manner provided by section 112(a)
(other than the requirement to disclose the best
mode) in an application previously filed in the
United States, or as provided by section 363,
which names an inventor or joint inventor in
the previously filed application shall have the
same effect, as to such invention, as though
filed on the date of the prior application. If filed
before the patenting or abandonment of or ter-
mination 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 applica-
tion. No application shall be entitled to the ben-
et of an earlier filed application under this section
unless an amendment containing the spec-
cific 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 requirement for payment of the fee specified

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in section 41(a)(7), to accept an unintentionally delayed submission of an amendment under this section.


AMENDMENT OF SECTION

Pub. L. 112–211, title I, §§102(5), 103, Dec. 18, 2012, 126 Stat. 1531, 1532, provided that, effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, this section is amended in the first sentence by substituting “section 363 or 385” for “section 363”. See 2012 Amendment note below.

HISTORICAL AND REVISION NOTES

This section represents present law not expressed in the statute, except for the added requirement that the first application must be specifically mentioned in the second.

AMENDMENTS

2012—Pub. L. 112–211, §202(b)(3), substituted “including the requirement for payment of the fee specified in section 41(a)(7)” for “including the payment of a surcharge”.

Pub. L. 112–211, §102(5), substituted “section 363 or 385” for “section 363”.

2011—Pub. L. 112–29, §20(d), struck out “of this title” after “363”.

Pub. L. 112–29, §15(b), substituted “section 112(a) (other than the requirement to disclose the best mode)” for “the first paragraph of section 112 of this title”.

Pub. L. 112–29, §3(f), substituted “which names an inventor or joint inventor” for “which is filed by an inventor or inventors named”.

1999—Pub. L. 106–113 inserted at end “No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.”

1984—Pub. L. 98–622 substituted “which is filed by an inventor or inventors named in the previously filed application” for “by the same inventor”.

1975—Pub. L. 94–131 inserted “, or as provided by section 363 of this title,” after “filed in the United States”.

EFFECTIVE DATE OF 2012 AMENDMENT

Amendment by section 102(5) of Pub. L. 112–211 effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, see section 103 of Pub. L. 112–211, set out as a note under section 100 of this title.

Amendment by section 202(b)(3) of Pub. L. 112–211 effective on the date that is 1 year after Dec. 18, 2012, applicable to patents issued before on, or after that effective date and patent applications pending on or filed after that effective date, and not effective with respect to patents in litigation commenced before that effective date, see section 203 of Pub. L. 112–211, set out as an Effective Date note under section 27 of this title.

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 3(f) of Pub. L. 112–29 effective upon the expiration of the 18-month period beginning on Sept. 16, 2011, and applicable to certain applications for patent and any patents issuing thereon, see section 3(n) of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title.

Amendment by section 15(b) of Pub. L. 112–29 effective on Sept. 16, 2011, and applicable to proceedings commenced on or after that date, see section 15(c) of Pub. L. 112–29, set out as a note under section 119 of this title.

Amendment by section 20(j) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(k) of Pub. L. 112–29, set out as a note under section 2 of this title.

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106–113 effective Nov. 29, 2000, and applicable only to applications (including international applications designating the United States) filed on or after that date, see section 100(a)(9) [title IV, §4508] of Pub. L. 106–113, as amended, set out as a note under section 10 of this title.

EFFECTIVE DATE OF 1984 AMENDMENT

Amendment by Pub. L. 98–622 applicable to all United States patents granted before, on, or after Nov. 8, 1984, and to all applications for United States patents pending on or filed after that date, except as otherwise provided, see section 106 of Pub. L. 98–622, set out as a note under section 103 of this title.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 94–131 effective Jan. 24, 1978, and applicable on and after that date to patent applications filed in the United States and to international applications, where applicable, see section 11 of Pub. L. 94–131, set out as an Effective Date note under section 351 of this title.

§ 121. Divisional applications

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.
§ 122. Confidential status of applications; publication of patent applications

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

(b) PUBLICATION.—

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

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

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

(2) EXCEPTIONS.—(A) An application shall not be published if that application is—

(i) no longer pending;

(ii) subject to a secrecy order under section 181;

(iii) a provisional application filed under section 111(b); or

(iv) an application for a design patent filed under chapter 16.

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

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

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

(iv) If an applicant rescinds a request made under clause (i) or notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).

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

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

(d) NATIONAL SECURITY.—No application for patent shall be published under subsection (b)(1) if the publication or disclosure of such invention would be detrimental to the national security. The Director shall establish appropriate procedures to ensure that such applications are promptly identified and the secrecy of such inventions is maintained in accordance with chapter 17.

(e) PREISSUANCE SUBMISSIONS BY THIRD PARTIES.—

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

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

      (i) 6 months after the date on which the application for patent is first published under section 122 by the Office, or
      (ii) the date of the first rejection under section 132 of any claim by the examiner during the examination of the application for patent.

2. OTHER REQUIREMENTS.—Any submission under paragraph (1) shall—

   (A) set forth a concise description of the asserted relevance of each submitted document;
   (B) be accompanied by such fee as the Director may prescribe; and
   (C) include a statement by the person making such submission affirming that the submission was made in compliance with this section.


HISTORICAL AND REVISION NOTES

This section enacts the Patent Office rule of secrecy of applications.

AMENDMENTS

2012—Subsec. (b)(2)(B)(iii). Pub. L. 112–211 struck out ‘‘, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional’’ after ‘‘regarded as abandoned’’.


Subsec. (d). Pub. L. 112–29, § 20(j), struck out ‘‘of this title’’ after ‘‘17’’.


1999—Pub. L. 106–113 amended section catchline and text generally. Prior to amendment, text read as follows: ‘‘Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.’’


EFFECTIVE DATE OF 2012 AMENDMENT

Amendment by Pub. L. 112–211 effective on the date that is 1 year after Dec. 18, 2012, applicable to patents issued before, on, or after that effective date and patent applications pending on, or filed after that effective date, and not effective with respect to patents in litigation commenced before that effective date, see section 203 of Pub. L. 112–211, set out as an Effective Date note under section 27 of this title.

EFFECTIVE DATE OF 2011 AMENDMENT

Pub. L. 112–29, § 20(j), Sept. 16, 2011, 125 Stat. 316, provided that: ‘‘The amendments made by this section [amending this section] 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 application filed before, on, or after that effective date.’’

Amendment by section 20(j) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112–29, set out as a note under section 2 of this title.

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106–113 effective Nov. 29, 2000, and applicable only to applications (including international applications designating the United States) filed on or after that date, and applications published pursuant to subsec. (b) of this section resulting from an international application filed before Nov. 29, 2000 not to be effective as prior art as of the filing date of the international application, but to be effective as prior art in accordance with section 102(e) of this title in effect on Nov. 28, 2000, see section 1000(a)(9) [title IV, § 4508] of Pub. L. 106–113, as amended, set out as a note under section 10 of this title.

EFFECTIVE DATE OF 1975 AMENDMENT


STUDY OF APPLICANTS FILING ONLY IN UNITED STATES


‘‘(1) IN GENERAL.—The Comptroller General shall conduct a 3-year study of the applicants who file only in the United States on or after the effective date of this subtitle [see section 1000(a)(9) [title IV, § 4508] of Pub. L. 106–113, set out as an Effective Date of 1999 Amendment note under section 10 of this title] and shall provide the results of such study to the Judiciary Committees of the House of Representatives and the Senate.

‘‘(2) CONTENTS.—The study conducted under paragraph (1) shall—
“(A) consider the number of such applicants in relation to the number of applicants who file in the United States and outside of the United States;

(B) examine how many domestic-only filers request at the time of filing not to be published;

(C) examine how many such filers rescind that request or later choose to file abroad;

(D) examine the status of the entity seeking an application and any correlation that may exist between such status and the publication of patent applications; and

(E) examine the abandonment/issuance ratios and length of application pendency before patent issuance or abandonment for published versus unpublished applications.”

§ 123. Micro entity defined

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

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

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

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

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

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

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

(d) INSTITUTIONS OF HIGHER EDUCATION.—For purposes of this section, a micro entity shall include an applicant who certifies that—

1 So in original. Probably should be “paragraph”.

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

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

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


REFERENCES IN TEXT

Section 61(a) of the Internal Revenue Code of 1986, referred to in subsec. (a)(3), (4), is classified to section 61(a) of Title 26, Internal Revenue Code.

AMENDMENTS


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 10(j) of Pub. L. 112–274, set out as a note under section 5 of this title.

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 20(j) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 10(j) of Pub. L. 112–29, set out as a note under section 2 of this title.

EFFECTIVE DATE

Section effective on Sept. 16, 2011, see section 10(j)(1) of Pub. L. 112–29, set out as a Fee Setting Authority note under section 41 of this title.

CHAPTER 12—EXAMINATION OF APPLICATION

Sec. 131. Examination of application.
132. Notice of rejection; reexamination.
133. Time for prosecuting application.
134. Appeal to the Patent Trial and Appeal Board.
135. Derivation proceedings.

AMENDMENTS

‘‘Appeal to the Patent Trial and Appeal Board’’ for ‘‘Appeal to the Board of Patent Appeals and Interferences’’ in item 134 and ‘‘Derivation proceedings’’ for ‘‘Interferences’’ in item 135.


§ 131. Examination of application

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


HISTORICAL AND REVISION NOTES


The first part is revised in language and amplified. The phrase ‘“and that the invention is sufficiently useful and important”’ is omitted as unnecessary, the requirements for patentability being stated in sections 101, 102 and 103.

AMENDMENTS


§ 132. Notice of rejection; reexamination

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

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


HISTORICAL AND REVISION NOTES


The first paragraph of the corresponding section of existing statute is revised in language and amplified to incorporate present practice; the second paragraph of the existing statute is placed in section 135.

The last sentence relating to new matter is added but represents no departure from present practice.

AMENDMENTS

2011—Subsec. (b). Pub. L. 112–29 struck out ‘‘of this title’’ after ‘‘41(h)(1)’’.


Pub. L. 106–113, §1000(a)(9) [title IV, §4403], designated existing provisions as subsec. (a) and added subsec. (b).

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 proceedings commenced on or after that effective date, see section 28(b) of Pub. L. 112–29, set out as a note under section 2 of this title.

EFFECTIVE DATE OF 1999 AMENDMENT


§ 133. Time for prosecuting application

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


HISTORICAL AND REVISION NOTES


The opening clause of the corresponding section of existing statute is omitted as having no present day meaning or value and the last two sentences are omitted for inclusion in section 267. The notice is stated as given or mailed. Language is revised.

AMENDMENTS

2012—Pub. L. 112–211 struck out ‘‘unless it be shown to the satisfaction of the Director that such delay was unavoidable’’ before period at end.
§ 134. Appeal to the Patent Trial and Appeal Board

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

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


HISTORICAL AND REVISION NOTES


Reference to reissues is omitted in view of the general provision in section 251. Minor changes in language are made.

AMENDMENTS


Subsec. (b). Pub. L. 112–29, §7(b)(1), substituted “re-examination proceeding” for “reexamination proceeding”.


Prior to amendment, text read as follows: “A third-party requester in an inter 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.”

2002—Subsecs. (a), (b), Pub. L. 107–273, §13202(b)(1), substituted “primary examiner” for “administrative patent judge”.

Subsec. (c). Pub. L. 107–273, §13106(b), struck out at end “The third-party requester may not appeal the decision of the Board of Patent Appeals and Interferences.”

1999—Pub. L. 106–113 reenacted section catchline without change and amended text generally. Prior to amendment, text read as follows: “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.”


EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 3(j)(1), (3) of Pub. L. 112–29 effective upon the expiration of the 18-month period beginning on Sept. 16, 2011, and applicable to certain applications for patent and any patents issuing thereon, see section 3(n) of Pub. L. 112–29, set out as an Effective Date note under section 100 of this title.

Amendment by section 7(b) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to reexamination proceedings commenced on or after that effective date, with certain exceptions, see section 7(e) of Pub. L. 112–29, set out as a note under section 6 of this title.

EFFECTIVE DATE OF 2002 AMENDMENT


EFFECTIVE DATE OF 1999 AMENDMENT

Pub. L. 107–273, div. C, title III, §13202(d), Nov. 2, 2002, 116 Stat. 1602, provided that: “The amendments made by section 4685(b), (c), and (e) of the Intellectual Property and Communications Omnibus Reform Act, as enacted by section 1000(a)(9) of Public Law 106–113 [amending this section and sections 141 and 145 of this title], shall apply to any reexamination filed in the United States Patent and Trademark Office on or after the date of enactment of Public Law 106–113 [Nov. 29, 1999].”

Amendment by Pub. L. 106–113 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 a note under section 41 of this title.

EFFECTIVE DATE OF 1984 AMENDMENT

Amendment by Pub. L. 98–622 effective three months after Nov. 8, 1984, see section 207 of Pub. L. 98–622, set out as a note under section 41 of this title.

§ 135. Derivation proceedings

(a) INSTITUTION OF PROCEEDING.—

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

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

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

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

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

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

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

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

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

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

Historical and Revision Notes

The first paragraph states the existing corresponding statute with a few changes in language. An explicit statement that the Office decision on priority constitutes a final refusal by the Office of the claims involved, is added. The last sentence is new and provides that judgment adverse to a patentee constitutes cancellation of the claims of the patent involved after the judgment becomes final, the patentee has a right of appeal (sec. 141) and is given a right of review by civil action (sec. 146).


Amendments
2013—Subsec. (a). Pub. L. 112–274, §1(k)(1), amended subsec. (a) generally. Prior to amendment, text read as follows: “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 in-
vention was filed. Any such petition may be filed only within the 1-year period beginning on the date of the first publication of a claim to an invention that is the same or substantially the same as the earlier application's claim to the invention, shall be made under oath, and shall be supported by substantial evidence. Whenever the Director determines that a petition filed under this subsection demonstrates that the standards for instituting a derivation proceeding are met, the Director may institute a derivation proceeding. The determination by the Director whether to institute a derivation proceeding shall be final and nonappealable.

Subsec. (e). Pub. L. 112–274, §1(e)(1), substituted "correct inventor" for "correct inventors".


Subsec. (b)(2). Pub. L. 112–29, §20(2), struck out "of this title" after "122(b)".


Subsec. (b). Pub. L. 106–113, §1000(a)(9) [title IV, §4507(11)], designated existing provisions as par. (1) and added par. (2).


1984—Subsec. (a). Pub. L. 98–622, §1202, amended subsec. (a) generally, substituting "an interference may be declared and the Commissioner shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be" for "he shall give notice thereof to the applicants, or applicant and patentee, as the case may be" and substituting provisions vesting jurisdiction for determining questions of interference in the Board of Patent Appeals and Interferences for provisions vesting such jurisdiction in a board of patent interferences.


1962—Pub. L. 87–631 designated first and second pars. as subsecs. (a) and (b) and added subsec. (c).

**Effective Date of 2013 Amendment**

Pub. L. 112–274, §1(e)(2), Jan. 14, 2013, 126 Stat. 2456, provided that: "The provision made by paragraph (1) [amending this section] shall be effective as if included in the amendment made by section 3(i) of the Leahy-Smith America Invents Act [Pub. L. 112–29]."

**Effective Date of 2011 Amendment**

Amendment by section 3(i) of Pub. L. 112–29 effective upon the expiration of the 18-month period beginning on Sept. 16, 2011, and applicable to certain applications for patent and any patents issuing thereon, see section 3(n) of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title.

**Amendment by section 200(i) of Pub. L. 112–29** effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 200(l) of Pub. L. 112–29, set out as a note under section 2 of this title.

**Effective Date of 1999 Amendment**

Amendment by section 1000(a)(9) [title IV, §4507(11)] of Pub. L. 106–113 effective Nov. 29, 2000, and applicable only to applications (including international applications designating the United States) filed on or after that date, see section 1000(a)(9) [title IV, §4508] of Pub. L. 106–113, as amended, set out as a note under section 10 of this title.


**Effective Date of 1984 Amendment**

Amendment by section 105 of Pub. L. 98–622 applicable to all United States patents granted before, on, or after Nov. 8, 1984, and to all applications for United States patents pending on or filed after that date, except as otherwise provided, see section 106 of Pub. L. 98–622, set out as a note under section 103 of this title.


**Effective Date of 1975 Amendment**

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1110 of Title 15, Commerce and Trade.

**Savings Provisions**

Pub. L. 112–274, §1(k)(3), Jan. 14, 2013, 126 Stat. 2458, provided that: "The provisions of sections 6 and 141 of title 35, United States Code, and section 1295(a)(4)(A) of title 28, United States Code, as in effect on September 15, 2012, shall apply to interference proceedings that are declared after September 15, 2012, under section 135 of title 35, United States Code, as in effect before the effective date under section 3(n) of the Leahy-Smith America Invents Act [Pub. L. 112–29, set out as a note under section 100 of this title]. The Patent Trial and Appeal Board may be deemed to be the Board of Patent Appeals and Interferences for purposes of such interference proceedings."

Provisions of 35 U.S.C. 133, as in effect on the day before the expiration of the 18-month period beginning on Sept. 16, 2011, apply to each claim of certain applications for patent, and certain patents issued thereon, for which the amendments made by section 3 of Pub. L. 112–29 also apply, see section 3(n)(2) of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title.

**CHAPTER 13—REVIEW OF PATENT AND TRADEMARK OFFICE DECISIONS**

Sec. 141. Appeal to Court of Appeals for the Federal Circuit.

142. Notice of appeal.

143. Proceedings on appeal.

144. Decision on appeal.

145. Civil action to obtain patent.

146. Civil action in case of derivation proceeding.

**Amendments**


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

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

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

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

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


HISTORICAL AND REVISION NOTES


Changes in language are made.

AMENDMENTS


Pub. L. 107–273, §13106(c), inserted "or a third-party requester in an inter partes reexamination proceeding, who is "after "patent owner" in third sentence.


Pub. L. 106–113, §1000(a)(9) [title IV, §4605(c)], inserted after second sentence "A patent owner 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."


Pub. L. 98–622, §203(a)(1)(B), substituted "By filing such an appeal the applicant waives his or her right" for "by waiving his right" in first sentence.


Pub. L. 98–622, §203(a)(2)(B), substituted "in accordance with " for "according to " in second sentence.


EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 18, 2011, and applicable to proceedings commenced on or after that effective date, with certain exceptions, see section 7(c) of Pub. L. 112–29, set out as a note under section 6 of this title.

EFFECTIVE DATE OF 2002 AMENDMENT

Amendment by section 13106(c) 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.

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by section 1000(a)(9) [title IV, §4605(c)] of Pub. L. 106–113 applicable to any reexamination filed in the United States Patent and Trademark Office on or after Nov. 2, 2002, see section 13202(d) of Pub. L. 107–273, set out as a note under section 134 of this title.

Amendment by section 1000(a)(9) [title IV, §4605(c)] of Pub. L. 106–113 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 402 of Pub. L. 97–164, set out as a note under section 134 of this title.

Amendment by section 1000(a)(9) [title IV, §4605(c)] of Pub. L. 106–113 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, §4605(c)] of Pub. L. 106–113, set out as a note under section 41 of this title.


EFFECTIVE DATE OF 1994 AMENDMENT

Amendment by Pub. L. 98–622 effective three months after Nov. 8, 1984, see section 207 of Pub. L. 98–622, set out as a note under section 41 of this title.

EFFECTIVE DATE OF 1982 AMENDMENT


§ 142. Notice of appeal

When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the

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Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.


HISTORICAL AND REVISION NOTES


Changes in language are made.

AMENDMENTS


1984—Pub. L. 98–620 amended section generally, substituting “the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Commissioner, within such time after the date of the decision from which the appeal is taken as the Commissioner prescribes, but in no case less than 60 days after that date” for “the appellant shall give notice thereof to the Commissioner, and shall file in the Patent and Trademark Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints”.


EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) (title IV, §4731) of Pub. L. 106–113, set out as a note under section 1 of this title.

EFFECTIVE DATE OF 1984 AMENDMENT

Pub. L. 98–620, title IV, §414(c), Nov. 8, 1984, 98 Stat. 3364, provided that: “The amendments made by this section [amending this section, sections 143 and 144 of this title, and section 1071 of Title 15, Commerce and Trade] shall apply to proceedings pending in the Patent and Trademark Office on the date of the enactment of this Act (Nov. 8, 1984) and to appeals pending in the United States Court of Appeals for the Federal Circuit on such date.”

EFFECTIVE DATE OF 1982 AMENDMENT


EFFECTIVE DATE OF 1975 AMENDMENT


§ 143. Proceedings on appeal

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


HISTORICAL AND REVISION NOTES


Language is changed. The requirement that the Commissioner notify the parties is omitted and a requirement that the court notify the parties is added. The statement relating to filing the papers and testimony is made more explicit.

AMENDMENTS


Pub. L. 112–28, §7(c)(3), substituted “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 involved 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.” for “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 of the issues involved in the appeal.” and struck out second occurrence of “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.” at the end.


Pub. L. 107–273, §13206(b)(2), amended third sentence generally and added fourth sentence identical to existing fourth (now fifth) sentence. Prior to amendment, third sentence read as follows: “In 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 of the issues involved in the appeal.”

1999—Pub. L. 106–113, §1000(a)(9) [title IV, §4732(a)(10)(A)], as amended by Pub. L. 107–273, §13206(b)(1)(B), substituted “Director” for “Commissioner” the first, second, and fourth places appearing. Pub. L. 106–113, §1000(a)(9) [title IV, §4605(d)], amended third sentence generally. Prior to amendment, third sentence read as follows: “The Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all of the issues raised in the appeal. The Director shall have the right to intervene in an appeal from a decision entered by the Patent Trial and Appeal Board in a derivation proceeding under section 135 or in an inter partes or post-grant review under chapter 31 or 32. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.”
§ 144. Decision on appeal

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Director of the Patent Office (with the decision to be confined to the points set forth in the reasons of appeal) and, upon its determination, to return to the Commissioner a certificate of its proceedings and decision.


Effective Date of 1999 Amendment

Amendment by section 1000(a)(9) [title IV, § 4605(d)] of Pub. L. 106–113 applicable to proceedings pending in the Patent and Trademark Office on Nov. 29, 1999, and to appeals pending in the United States Court of Appeals for the Federal Circuit on such date, see section 414(c) of Pub. L. 98–620, set out as a note under section 142 of this title.

Effective Date of 1982 Amendment


Effective Date of 1975 Amendment

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 111 of Title 15, Commerce and Trade.

§ 145. Civil action to obtain patent

An applicant dissatisfied with the decision of the Patent Trial and Appeal Board in an appeal under section 134(a) may, unless appeal has been taken to the United States Court of Appeals for the Federal Circuit, have remedy by civil action against the Director in the United States District Court for the Eastern District of Virginia if commenced within such time after such decision, not less than sixty days, as the Director appoints. The court may adjudge that such ap-
pplicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Patent Trial and Appeal Board, as the fact in the case may appear and such adjudication shall authorize the Director to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.


HISTORICAL AND REVISION NOTES


Bill equity is changed to civil action and the section is restricted to exclude interferences which are covered by the next section. The time for filing the action is changed to the same as the time for appeal. The requirement for the applicant to file a copy of the decision in the Patent Office is omitted.

Language is changed.

AMENDMENTS

2011—Pub. L. 112–29, §20(j), struck out “of this title” after “‘134(a)’.


Pub. L. 106–113, §1000(a)(9) [title IV, §4605(e)], inserted “‘(a)’ after “‘section 134’.”


§146. Civil action in case of derivation proceeding

Any party to a derivation proceeding dissatisfied with the decision of the Patent Trial and Appeal Board on the derivation proceeding, may have remedy by civil action, if commenced within 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 Eastern District of Virginia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Director shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene.
Judgment of the court in favor of the right of an applicant to a patent shall authorize the Director to issue such patent on the filing in the Patent and Trademark Office of a certified copy of the judgment and on compliance with the requirements of law.

Effective Date of 2011 Amendment; Savings Provisions

1975 A

1982 A

1999 A

Effective Date of 1999 Amendment

Amendment by Pub. L. 112–29 effective on or after that date, see section 9(a) of Pub. L. 112–29, set out as a note under section 1071 of Title 15, Commerce and Trade.

Effective Date of 2013 Amendment

Amendment by section 9(a) of Pub. L. 112–29 effective on or after that date, see section 9(b) of Pub. L. 112–29, set out as a note under section 1071 of Title 15, Commerce and Trade.

Effective Date of 1982 Amendment


Effective Date of 1975 Amendment


CHAPTER 14—ISSUE OF PATENT

Sec.

151. Issue of patent.

152. Issue of patent to assignee.


154. Contents and term of patent; provisional rights.

154. Contents and term of patent; provisional rights.

155. Extension of patent term.


AMENDMENTS

2011—Pub. L. 112–29, §20(j), struck out “of this title” after “141”.

Pub. L. 112–29, §9(a), substituted “United States District Court for the Eastern District of Virginia” for “United States District Court for the District of Columbia”.


Effective Date of 2011 Amendment

Amendment by section 3(j)(1), (2)(A), (4) of Pub. L. 112–29 effective upon the expiration of the 18-month period beginning on Sept. 16, 2011, and applicable to certain applications for patent and any patents issuing thereon, see section 3(n) of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title.

§ 151. Issue of patent

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

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


PRIOR PROVISIONS


EFFECTIVE DATE

Section effective on the date that is 1 year after Dec. 18, 2012, applicable to patents issued before, on, or after that date and patent applications pending on or filed after that date, and not effective with respect to patents in litigation commenced before that date, see section 203 of Pub. L. 112–211, set out as a note under section 27 of this title.

§152. Issue of patent to assignee

Patents may be granted to the assignee of the inventor of record in the Patent and Trademark Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.


HISTORICAL AND REVISION NOTES


Language is changed and the reference to reissue is omitted in view of the general provision in section 251.

AMENDMENTS


EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 111 of Title 15, Commerce and Trade.

§153. How issued

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


HISTORICAL AND REVISION NOTES


The phrases referring to the attesting officers and to the recording of the patents are broadened.

AMENDMENTS


Pub. L. 107–273, §13203(c), struck out “and attested by an officer of the Patent and Trademark Office designated by the Director,” after “signature placed thereon”.


EFFECTIVE DATE OF 1999 AMENDMENT


EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 111 of Title 15, Commerce and Trade.

§154. Contents and term of patent; provisional rights

(a) IN GENERAL.—

(1) CONTENTS.—Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, of the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States, and, if the invention is a process, the right to exclude others from using, offering for sale or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof.

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

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

(4) SPECIFICATION AND DRAWING.—A copy of the specification and drawing shall be annexed to the patent and be a part of such patent.

(b) ADJUSTMENT OF PATENT TERM.—

(1) PATENT TERM GUARANTEES.—

(A) GUARANTEE OF PROMPT PATENT AND TRADemark OFFICE RESPONSES.—Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

(i) provide at least one of the notifications under section 313 or a notice of allowance under section 151 not later than 14 months after—

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

(II) the date of commencement of the national stage under section 371 in an international application;

(ii) respond to a reply under section 313, or to an appeal taken under section 314,
§ 154

(1) The term of the patent shall be extended 1 day for each day after the end of the period specified in clause (i), (ii), (iii), or (iv), as the case may be, until the action described in such clause is taken.

(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.—Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application under section 131(a) in the United States or, in the case of an international application, the date of commencement of the national stage under section 371 in the international application, not including—

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

(ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 161, or any time consumed by appellate review by the Patent Trial and Appeal Board or by a Federal court; or

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

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

(C) GUARANTEE OF ADJUSTMENTS FOR DELAYS DUE TO DERIVATION PROCEEDINGS, SECRECY ORDERS, AND APPEALS.—Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to—

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

(ii) the imposition of an order under section 161; or

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

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

(2) LIMITATIONS.—

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

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

(C) REDUCTION OF PERIOD OF ADJUSTMENT.—

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

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

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

(3) PROCEDURES FOR PATENT TERM ADJUSTMENT DETERMINATION.—

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

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

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

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

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

(D) The Director shall proceed to grant the patent after completion of the Director’s determination of a patent term adjustment under the procedures established under this subsection, notwithstanding any appeal taken by the applicant of such determination.
(A) An applicant dissatisfied with the Director's decision on the applicant's request for reconsideration under paragraph (3)(B)(ii) shall have exclusive remedy by a civil action against the Director filed in the United States District Court for the Eastern District of Virginia within 180 days after the date of the Director's decision on the applicant's request for reconsideration. 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 Director, and the Director shall thereafter alter the term of the patent to reflect such change.

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

(c) Continuation.—

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

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

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

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

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

(d) Provisional Rights.—

(1) In General.—In addition to other rights provided by this section, a patent shall include the right to obtain a reasonable royalty from any person who, during the period beginning on and after that effective date and patents is—

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

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

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

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

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

(4) Requirements for International Applications.—

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

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

(AMENDMENT OF SECTION)

Pub. L. 112–211, title I, §§102(6), 103, Dec. 18, 2012, 126 Stat. 1351, 1352, provided that, effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, this section is amended as follows:

(1) in subsection (a)(2), by substituting "section 120, 121, 365(c), or 386(c)" for "section 120, 121, or 365(c)";
(2) in subsection (a)(2), by substituting “section 119, 365(a), 365(b), 386(a), or 386(b)” for “section 119, 365(a), or 365(b)”;

and

(3) in subsection (d)(1), by inserting “or an international design application filed under the treaty defined in section 381(a)(1) designating the United States under Article 5 of such treaty” after “Article 21(2)(a) of such treaty”.

See 2012 Amendment notes below.

HISTORICAL AND REVISION NOTES


The reference to plants is omitted for inclusion in another section and the reference to the title is shortened since the title is of no legal significance.

The wording of the granting clause is changed to “the right to exclude others from making, using, or selling”, following language used by the Supreme Court, to render the meaning clearer.

“United States” is defined in section 100.

REFERENCES IN TEXT

The date of the enactment of the Uruguay Round Agreements Act, referred to in subsec. (c)(1), (2)(A), is the date of enactment of Pub. L. 103–465, which was approved Dec. 8, 1994.

AMENDMENTS

2013—Subsec. (b)(1)(A)(i)(II). Pub. L. 112–274, § 1(h)(1)(A), which directed substitution of “of commencement of the national stage under section 371 in an international application” for “on which an international application fulfilled the requirements of section 371 of this title”, was executed by making the substitution for “on which an international application fulfilled the requirements of section 371”, to reflect the probable intent of Congress and the intervening amendment by Pub. L. 112–29, § 14. See 2011 Amendment note below.

Subsec. (b)(1)(B). Pub. L. 112–274, § 1(h)(1)(B), substituted “the application under section 111(a) in the United States or, in the case of an international application, the date of commencement of the national stage under section 371 in the international application” for “the application in the United States” in introductory provisions.

Subsec. (b)(3)(B)(i). Pub. L. 112–274, § 1(h)(2), substituted “no later than the date of issuance of the patent” for “with the written notice of allowance of the application under section 151”.

Subsec. (b)(4)(A). Pub. L. 112–274, § 1(h)(3), substituted “the Director’s decision on the applicant’s request for reconsideration under paragraph (3) shall have exclusive remedy” for “a determination made by the Director under paragraph (3) shall have remedy” and “the date of the Director’s decision on the applicant’s request for reconsideration” for “the grant of the patent”.

2012—Subsec. (a)(2). Pub. L. 112–211, § 1026(a)(1), substituted “section 120, 121, 366(c), or 366(c)” for “section 120, 121, or 366(c)”. Subsec. (a)(3). Pub. L. 112–211, § 1026(a)(2), substituted “section 119, 365(a), 365(b), 386(a), or 386(b)” for “section 119, 365(a), or 365(b)”. Subsec. (d)(1). Pub. L. 112–211, § 1026(b), inserted “or an international design application filed under the treaty defined in section 381(a)(1) designating the United States under Article 5 of such treaty” after “Article 21(2)(a) of such treaty” in introductory provisions.


Subsec. (b). Pub. L. 106–113, § 1000(a)(9) [title IV, § 4402(a)], amended heading and text of subsec. (b) generally. Prior to amendment, text provided for interference delay or secrecy orders, extensions for appellate review, a limitations period, and a maximum period of 5 years duration for all extensions.


1994—Pub. L. 103–465 amended section catchline and text generally. Prior to amendment, text read as follows: “Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, subject to the payment of fees as provided for in this title, of the right to exclude others from making, using, or selling the invention throughout the United States, products made by that process, of the right to exclude others from using or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.”

1988—Pub. L. 100–418 inserted “and, if the invention is a process, of the right to exclude others from using or selling throughout the United States, or importing into the United States, products made by that process,” after “United States”. 1980—Pub. L. 96–517 substituted “payment of fees” for “payment of issue fees”. 1965—Pub. L. 89–43 added “subject to the payment of issue fees as provided for in this title”.

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(m) of Pub. L. 112–274, set out as a note under section 5 of this title.

EFFECTIVE DATE OF 2012 AMENDMENT

Amendment by Pub. L. 112–211 effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed
on and after that effective date and patents issuing thereon, see section 103 of Pub. L. 112-211, set out as a note under section 100 of this title.

**Effective Date of 2011 Amendment**

Amendment by section 3(j)(1), (2)(B) of Pub. L. 112-29 effective upon the expiration of the 18-month period beginning on Sept. 16, 2011, and applicable to certain applications for patent and any patents issuing thereon, see section 3(n) of Pub. L. 112-29, set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title.

Amendment by section 8(a) of Pub. L. 112-29 effective Sept. 16, 2011, and applicable to any civil action commenced on or after that date, see section 1071 of Title 15, Commerce and Trade. Amendment by section 20(k) of Pub. L. 112-29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(k) of Pub. L. 112-29, set out as a note under section 2 of this title.

**Effective Date of 1999 Amendment**

Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §405(a)], Nov. 29, 1999, 113 Stat. 1356, 1501A-560, provided that: "The amendments made by sections 4402 and 4404 [amending this section, sections 156 and 282 of this title, and section 1295 of Title 28, Judiciary and Judicial Procedure] shall take effect on the date that is 6 months after the date of the enactment of this Act [Nov. 29, 1999] and, except for a design patent application filed under chapter 18 of title 35, United States Code, shall apply to any application filed on or after that date that is 6 months after the date of the enactment of this Act."

Amendment by section 1000(a)(9) [title IV, §4504] of Pub. L. 106-113 effective Nov. 29, 2000, applicable only to applications (including international applications designating the United States) filed on or after that date, and additionally applicable to any pending application filed before Nov. 29, 2000, if such pending application is published pursuant to a request of the applicant under such procedures as may be established by the Director, see section 1000(a)(9) [title IV, §4508] of Pub. L. 106-113, as amended, set out as a note under section 10 of this title.

**Effective Date of 1994 Amendment**


"(a) In General.—Subject to subsection (b), the amendments made by this subtitle (subtitle C (§§531-534) of title V of Pub. L. 103-465, amending this section and sections 101, 104, 111, 119, 156, 172, 173, 252, 262, 271, 272, 297, 299, 307, 385, and 373 of this title) take effect on the date that is 6 months after the date of the enactment of this Act [Dec. 8, 1994] and shall apply to all patent applications filed in the United States on or after the effective date.

(2) Section 105(a)(1).—Section 105(a)(1) of title 35, United States Code, as amended by section 532(a)(1) of this Act, shall take effect on the effective date described in subsection (a).

(3) Earliest Filing.—The term of a patent granted on an application that is filed on or after the effective date described in subsection (a) and that contains a specific reference to an earlier application filed under the provisions of section 120, 121, or 365(c) of title 35, United States Code, shall be measured from the filing date of the earliest filed application."

**Effective Date of 1988 Amendment**

Amendment by Pub. L. 100-418 effective 6 months after Aug. 23, 1988, and, subject to enumerated exceptions, applicable only with respect to products made or imported after such effective date, see section 9006 of Pub. L. 100-418, set out as a note under section 271 of this title.

**Effective Date of 1980 Amendment**

Amendment by Pub. L. 96-517 effective Dec. 12, 1980, see section 8(a) of Pub. L. 96-517, set out as a note under section 41 of this title.

**Effective Date of 1965 Amendment**

Amendment by Pub. L. 89-83 effective three months after July 24, 1965, see section 7(a) of Pub. L. 89-83, set out as a note under section 41 of this title.

**Regulations**

Pub. L. 103-465, title V, §532(a)(2), Dec. 8, 1994, 108 Stat. 4985, authorized the Commissioner of Patents and Trademarks to prescribe regulations for further limited reexamination of applications pending 2 years or longer and for examination of more than 1 independent and distinct invention in applications pending 3 years or longer, as of the effective date of section 154(a)(2) of this title, and to establish appropriate related fees.


**Effective Date of Repeal**

Repeal effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(k) of Pub. L. 112-29, set out as an Effective Date of 2011 Amendment note under section 2 of this title.

**§156. Extension of patent term**

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

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

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

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

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

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

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

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

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

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

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

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

(b) Except as provided in subsection (d)(5)(F), the rights derived from any patent the term of which is extended under this section shall be limited to any use approved for

the approved product and the significant dates under which the applicable regulatory review occurred;

(A) the identity of the approved product and

(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;

(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);

(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 to such activities; and

(3) in the case of a patent which claims a method of manufacturing a product, be limited to the method of manufacturing as used to make—

(A) the approved product, or

(B) the product if it has been subject to a regulatory review period described in paragraph (1), (4), or (5) of subsection (g).

As used in this subsection, the term "product" includes an approved product.

(c) The term of a patent eligible for extension under subsection (a) shall be extended by the time equal to the regulatory review period for the approved product which period occurs after the date the patent is issued, except that—

(1) each period of the regulatory review period shall be reduced so that the total of both such periods does not exceed forty-four years,

(2) in no event shall more than one patent be extended under subsection (e)(1) for the same regulatory review period for any product.

(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 such regulatory review occurred when added to the regulatory review period as revised under paragraphs (1) and (2) exceeds fourteen years, the period of extension shall be reduced so that the total of both such periods does not exceed forty-four years.

(2) 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;
(E) such patent or other information as the Director may require.

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.

(2)(A) Within 60 days of the submittal of an application for extension of the term of a patent under paragraph (1), the Director shall notify—

(i) the Secretary of Agriculture if the patent claims a drug product or a method of using or manufacturing a drug product and the drug product is subject to the Virus-Serum-Toxin Act, and

(ii) the Secretary of Health and Human Services if the patent claims any other drug product, a medical device, or a food additive or a color additive or a method of using or manufacturing such a product, device, or additive and if the product, device, and additive are subject to the Federal Food, Drug, and Cosmetic Act.

of the extension application and shall submit to the Secretary who is so notified a copy of the application. Not later than 30 days after the receipt of an application from the Director, the Secretary receiving the application shall review the dates contained in the application pursuant to paragraph (1)(C) and determine the applicable regulatory review period, shall notify the Director of the determination, and shall publish in the Federal Register a notice of such determination.

(B)(i) If a petition is submitted to the Secretary making the determination under subparagraph (A), upon which it may reasonably be determined that the applicant did not act with due diligence during the applicable regulatory review period, the Secretary making the determination shall, in accordance with regulations promulgated by such Secretary, determine if the applicant acted with due diligence during the applicable regulatory review period. The Secretary making the determination shall make such determination not later than 90 days after the completion of the hearing, such determination shall affirm or revise the determination which was the subject of the hearing and shall notify the Director of any revision of the determination and shall publish any such revision in the Federal Register.

(3) For the purposes of paragraph (2)(B), the term "due diligence" means that degree of attention, continuous directed effort, and timeliness as may reasonably be expected from, and are ordinarily exercised by, a person during a regulatory review period.

(4) An application for the extension of the term of a patent is subject to the disclosure requirements prescribed by the Director.

(5)(A) If the owner of record of the patent or its agent reasonably expects that the applicable regulatory review period described in paragraph (1)(B)(ii), (2)(B)(ii), (3)(B)(ii), (4)(B)(ii), or (5)(B)(ii) of subsection (g) that began for a product that is the subject of such patent may extend beyond the expiration of the patent term in effect, the owner or its agent may submit an application to the Director for an interim extension during the period beginning 6 months, and ending 15 days, before such term is due to expire. The application shall contain—

(i) the identity of the product subject to regulatory review and the Federal statute under which such review is occurring;

(ii) the identity of the patent for which interim extension is being sought and the identity of each claim of such patent which claims the product under regulatory review or a method of using or manufacturing the product;

(iii) information to enable the Director to determine under subsection (a)(1), (2), and (3) the eligibility of a patent for extension;

(iv) a brief description of the activities undertaken by the applicant during the applicable regulatory review period to date with respect to the product under review and the significant dates applicable to such activities; and

(v) such patent or other information as the Director may require.

(B) If the Director determines that, except for permission to market or use the product commercially, the patent would be eligible for an extension of the patent term under this section, the Director shall publish in the Federal Register a notice of such determination, including
the identity of the product under regulatory review, and shall issue to the applicant a certificate of interim extension for a period of not more than 1 year.

(C) The owner of record of a patent, or its agent, for which an interim extension has been granted under subsection (B), may apply for not more than 4 subsequent interim extensions under this paragraph, except that, in the case of a patent subject to subsection (g)(6)(C), the owner of record of the patent, or its agent, may apply for only 1 subsequent interim extension under this paragraph. Each such subsequent application shall be made during the period beginning 60 days before, and ending 30 days before, the expiration of the preceding interim extension.

(D) Each certificate of interim extension under this paragraph shall be recorded in the official file of the patent and shall be considered part of the original patent.

(E) Any interim extension granted under this paragraph shall terminate at the end of the 60-day period beginning on the date on which the product involved receives permission for commercial marketing or use, except that, if within that 60-day period the applicant notifies the Director of such permission and submits any additional information under paragraph (1) of this subsection not previously contained in the application for interim extension, the patent shall be further extended, in accordance with the provisions of this section—

(i) for not to exceed 5 years from the date of expiration of the original patent term; or

(ii) if the patent is subject to subsection (g)(6)(C), from the date on which the product involved receives approval for commercial marketing or use.

(F) The rights derived from any patent the term of which is extended under this paragraph shall, during the period of interim extension—

(i) in the case of a patent which claims a product, be limited to any use then under regulatory review;

(ii) in the case of a patent which claims a method of using a product, be limited to any use claimed by the patent then under regulatory review; and

(iii) in the case of a patent which claims a method of manufacturing a product, be limited to the method of manufacturing as used to make the product then under regulatory review.

(e)(1) A determination that a patent is eligible for extension may be made by the Director solely on the basis of the representations contained in the application for the extension. If the Director determines that a patent is eligible for extension under subsection (a) and that the requirements of paragraphs (1) through (4) of subsection (d) have been complied with, the Director shall issue to the applicant for the extension of the term of the patent a certificate of extension, under seal, for the period prescribed by subsection (c). Such certificate shall be recorded in the official file of the patent and shall be considered as part of the original patent.

(2) If the term of a patent for which an application has been submitted under subsection (d)(1) would expire before a certificate of extension is issued or denied under paragraph (1) respecting the application, the Director shall extend, until such determination is made, the term of the patent for periods of up to one year if he determines that the patent is eligible for extension.

(f) For purposes of this section:

(1) The term “product” means:

(A) A drug product.

(B) Any medical device, food additive, or color additive subject to regulation under the Federal Food, Drug, and Cosmetic Act.

(2) The term “drug product” means the active ingredient of—

(A) a new drug, antibiotic drug, or human biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Public Health Service Act), or

(B) a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Virus-Serum-Toxin Act) which is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques, including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient.

(3) The term “major health or environmental effects test” means a test which is reasonably related to the evaluation of the health or environmental effects of a product, which requires at least six months to conduct, and the data from which is submitted to receive permission for commercial marketing or use. Periods of analysis or evaluation of test results are not to be included in determining if the conduct of a test required at least six months.

(4)(A) Any reference to section 351 is a reference to section 351 of the Public Health Service Act.

(B) Any reference to section 503, 505, 512, or 515 is a reference to section 503, 505, 512, or 515 of the Federal Food, Drug, and Cosmetic Act.

(C) Any reference to the Virus-Serum-Toxin Act is a reference to the Act of March 4, 1913 (21 U.S.C. 151–158).

(5) The term “informal hearing” has the meaning prescribed for such term by section 201(y) of the Federal Food, Drug, and Cosmetic Act.

(6) The term “patent” means a patent issued by the United States Patent and Trademark Office.

(7) The term “date of enactment” as used in this section means September 24, 1984, for a human drug product, a medical device, food additive, or color additive.

(8) The term “date of enactment” as used in this section means the date of enactment of the Generic Animal Drug and Patent Term Restoration Act for an animal drug or a veterinary biological product.

(g) For purposes of this section, the term “regulatory review period” has the following meanings:

See References in Text note below.
(1)(A) In the case of a product which is a new drug, antibiotic drug, or human biological product, the term means the period described in subparagraph (B) to which the limitation described in paragraph (6) applies.

(B) The regulatory review period for a new drug, antibiotic drug, or human biological product is the sum of—

(i) the period beginning on the date an exemption under subsection (i) of section 505 or subsection (d) of section 507 became effective for the approved product and ending on the date an application was initially submitted for such drug product under section 351, 505, or 507 and

(ii) the period beginning on the date the application was initially submitted for the approved product under section 351, subsection (b) of section 505, or section 507 and ending on the date such application was approved under such section.

(2)(A) In the case of a product which is a food additive or color additive, the term means the period described in subparagraph (B) to which the limitation described in paragraph (6) applies.

(B) The regulatory review period for a food or color additive is the sum of—

(i) the period beginning on the date a major health or environmental effects test on the additive was initiated and ending on the date a petition was initially submitted with respect to the product under the Federal Food, Drug, and Cosmetic Act requesting the issuance of a regulation for use of the product, and

(ii) the period beginning on the date a petition was initially submitted with respect to the product under the Federal Food, Drug, and Cosmetic Act requesting the issuance of a regulation for use of the product, and ending on the date such regulation became effective or, if objections were filed to such regulation, ending on the date such objections were resolved and marketing was permitted or, if commercial marketing was permitted and later revoked pending further proceedings as a result of such objections, ending on the date such proceedings were finally resolved and commercial marketing was permitted.

(3)(A) In the case of a product which is a medical device, the term means the period described in subparagraph (B) to which the limitation described in paragraph (6) applies.

(B) The regulatory review period for a medical device is the sum of—

(i) the period beginning on the date a clinical investigation on humans involving the device was begun and ending on the date an application was initially submitted with respect to the device under section 515, and

(ii) the period beginning on the date an application was initially submitted with respect to the device under section 515 and ending on the date such application was approved under such Act or the period beginning on the date such application was approved under such Act and ending on the date the protocol was declared completed under section 515(f)(6).

(4)(A) In the case of a product which is a new animal drug, the term means the period described in subparagraph (B) to which the limitation described in paragraph (6) applies.

(B) The regulatory review period for a new animal drug product is the sum of—

(i) the period beginning on the earlier of the date a major health or environmental effects test on the drug was initiated or the date an exemption under subsection (i) of section 512 became effective for the approved new animal drug product and ending on the date an application was initially submitted for such animal drug product under section 512, and

(ii) the period beginning on the date the application was initially submitted for the approved animal drug product under subsection (b) of section 512 and ending on the date such application was approved under such section.

(5)(A) In the case of a product which is a veterinary biological product, the term means the period described in subparagraph (B) to which the limitation described in paragraph (6) applies.

(B) The regulatory period for a veterinary biological product is the sum of—

(i) the period beginning on the date the authority to prepare an experimental biological product under the Virus-Serum-Toxin Act became effective and ending on the date an application for a license was submitted under the Virus-Serum-Toxin Act, and

(ii) the period beginning on the date an application for a license was initially submitted for approval under the Virus-Serum-Toxin Act and ending on the date such license was issued.

(6) A period determined under any of the preceding paragraphs is subject to the following limitations:

(A) If the patent involved was issued after the date of the enactment of this section, the period of extension determined on the basis of the regulatory review period determined under any such paragraph may not exceed five years.

(B) If the patent involved was issued before the date of the enactment of this section and—

(i) no request for an exemption described in paragraph (1)(B) or (4)(B) was submitted and no request for the authority described in paragraph (5)(B) was submitted,

(ii) no major health or environmental effects test described in paragraph (2)(B) or (4)(B) was initiated and no petition for a regulation or application for registration described in such paragraph was submitted, or

(iii) no clinical investigation described in paragraph (3) was begun or product development protocol described in such paragraph was submitted,

before such date for the approved product the period of extension determined on the
basis of the regulatory review period determined under any such paragraph may not exceed five years.

(C) If the patent involved was issued before the date of the enactment of this section and if an action described in subparagraph (B) was taken before the date of the enactment of this section with respect to the approved product and the commercial marketing or use of the product has not been approved before such date, the period of extension determined on the basis of the regulatory review period determined under such paragraph may not exceed two years or in the case of an approved product which is a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act or the Virus-Serum-Toxin Act), three years.

(h) The Director may establish such fees as the Director determines appropriate to cover the costs to the Office of receiving and acting upon applications under this section.


AMENDMENTS


1999—Subsec. (a). Pub. L. 106–113, §1000(a)(9) [title IV, §4404], in introductory provisions, inserted “, which shall include any patent term extension granted under section 154(b),” after “the original expiration date of the patent”.


1994—Subsec. (a)(2). Pub. L. 103–465 inserted “under subsection (e)(1) of this section” after “extended”.


Subsec. (b). Pub. L. 100–670, §201(b), amended subsec. (b) generally. Prior to amendment, subsec. (b) read as follows: “The rights derived from any patent the term of which is extended under this section shall during the period during which the patent is extended—

(1) in the case of a patent which claims a product, be limited to any use approved for the approved product before the expiration of the term of the patent under the provision of law under which the applicable regulatory review occurred; and

(2) in the case of a patent which claims a method of using a product, be limited to any use claimed by the patent holder.

REFERENCES IN TEXT

The Virus-Serum-Toxin Act, referred to in subsecs. (d)(2)(A)(1), (B)(1), (f)(2)(B), (4)(C), and (g)(5)(B), (6)(C), is the eighth paragraph under the heading “Bureau of Animal Industry” of act Mar. 4, 1913, ch. 145, 37 Stat. 828, as classified generally to chap. 351 oftitle 35—PATENTS
the patent and approved for the approved product before the expiration of the term of the patent under the provision of law under which the applicable regulatory review occurred:

‘‘(3) in the case of a patent which claims a method of manufacturing a product, be limited to the method of manufacturing as used to make the approved product.’’

Subsec. (c)(2). Pub. L. 100–670, § 201(c), substituted ‘‘(3)(B)(i), (4)(B)(i), and (5)(B)(i)’’ for ‘‘and (3)(B)(i)’’.

Subsec. (d)(1)(C). Pub. L. 100–670, § 201(d), inserted ‘‘the Secretary of Agriculture’’ after ‘‘and Human Services’’.

Subsec. (d)(2)(A). Pub. L. 100–670, § 201(e), amended subpar. (A) generally. Prior to amendment, subpar. (A) read as follows: ‘‘Within sixty days of the submittal of an application for extension of the term of a patent under paragraph (1), the Commissioner shall notify the Secretary of Health and Human Services if the patent claims any human drug product, a medical device, or a food additive or color additive or a method of using or manufacturing such a product, device, or additive and if the product, device, and additive are subject to the Federal Food, Drug, and Cosmetic Act, of the extension application and shall submit to the Secretary a copy of the application. Not later than thirty days after the receipt of an application from the Commissioner, the Secretary shall review the dates contained in the application pursuant to paragraph (1)(C) and determine the applicable regulatory review period, shall notify the Commissioner of the determination, and shall publish in the Federal Register a notice of such determination.’’

Subsec. (d)(3)(B). Pub. L. 100–670, § 201(f), amended subpar. (B) generally. Prior to amendment, subpar. (B) read as follows: ‘‘(1) If a petition is submitted to the Secretary under subparagraph (A), not later than one hundred and eighty days after the publication of the determination under subparagraph (A), upon which it may reasonably be determined that the applicant did not act with due diligence during the applicable regulatory review period, the Secretary shall, in accordance with regulations promulgated by the Secretary determine if the applicant acted with due diligence during the applicable regulatory review period. The Secretary shall make such determination not later than ninety days after the receipt of such a petition. The Secretary may not delegate the authority to make the determination prescribed by this subparagraph to an office below the Office of the Commissioner of Food and Drugs.

‘‘(ii) The Secretary shall notify the Commissioner of the determination and shall publish in the Federal Register a notice of such determination together with the factual and legal basis for such determination. Any interested person may request, within the sixty-day period beginning on the publication of a determination, the Secretary to hold an informal hearing on the determination. If such a request is made within such period, the Secretary shall hold such hearing not later than thirty days after the date of the request, or at the request of the person making the request, not later than sixty days after such date. The Secretary shall provide notice of the hearing to the owner of the patent involved and to any interested person and provide the owner and any interested person an opportunity to participate in the hearing. Within thirty days after the completion of the hearing, the Secretary shall affirm or revise the determination which was the subject of the hearing and notify the Commissioner of any revision of the determination and shall publish any such revision in the Federal Register.’’

Subsec. (f)(1)(A). Pub. L. 100–670, § 201(g)(1), struck out ‘‘human drug product’’ before ‘‘drug product’’. Subsec. (f)(2). Pub. L. 100–670, § 201(g)(1), amended par. (2) generally. Prior to amendment, par. (2) read as follows: ‘‘The term ‘human drug product’ means the active ingredient of a new drug, antibiotic drug, or human biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Public Health Service Act) including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient.’’

Subsec. (f)(4)(B), (C). Pub. L. 112–29, § 201(g)(2), which directed general amendment of subpars. (B) and (C) of par. (4), was executed by amending subpar. (B) generally, and adding subpar. (C) (as probable intent of Congress in light of absence of subpar. (C) in par. (4). Prior to amendment, subpar. (B) read as follows: ‘‘Any reference to section 503, 505, 507, or 515 is a reference to section 503, 505, 507, or 515 of the Federal Food, Drug, and Cosmetic Act.’’

Subsec. (f)(7). (8). Pub. L. 100–670, § 201(g)(3), added pars. (7) and (8).


Subsec. (g)(2)(A), (3)(A). Pub. L. 100–670, § 201(h)(3), substituted ‘‘paragraph (6)’’ for ‘‘paragraph (4)’’.

Subsec. (g)(4)(A), (5). Pub. L. 100–670, § 201(h)(4), added pars. (4) and (5). Former par. (4) redesignated (6).


Subsec. (g)(6)(B)(1). Pub. L. 100–670, § 201(h)(5)(A), substituted ‘‘paragraph (1)(B) or (4)(B) was submitted and no request for the authority described in paragraph (5)(B) was submitted’’ for ‘‘paragraph (1)(B) was submitted’’.

Subsec. (g)(6)(B)(1)(I). Pub. L. 100–670, § 201(h)(5)(B), substituted ‘‘paragraph (2)(B) or (4)(B)’’ for ‘‘paragraph (2)’’.

Subsec. (g)(6)(C). Pub. L. 100–670, § 201(h)(5)(C), inserted ‘‘or in the case of an approved product which is a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act or the Virus-Serum-Toxin Act), three years’’ after ‘‘exceed two years’’.

Effective Date of 2011 Amendment

Pub. L. 112–29, § 37(b), Sept. 16, 2011, 125 Stat. 341, provided that: ‘‘The amendment made by subsection (a) [amending this section] shall apply to any application for extension of a patent term under section 156 of title 35, United States Code, 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 the enactment of this Act [Sept. 16, 2011].’’

Effective Date of 1999 Amendment

Amendment by section 1000(a)(9) [title IV, § 4404] of Pub. L. 106–113 effective on date that is 6 months after Nov. 29, 1999, and, except for design patent application filed under chapter 16 of this title, applicable to any application filed on or after such date, see section 1000(a)(9) [title IV, § 4405(a)] of Pub. L. 106–113, set out as a note under section 154 of this title.


Effective Date of 1994 Amendment

Amendment by Pub. L. 103–456 effective 6 months after Dec. 8, 1994, and applicable to all patent applications filed in the United States on or after that effective date, with provisions relating to earliest filed patent application, see section 534(b)(1). (3) of Pub. L. 103–456, set out as a note under section 154 of this title.

§ 160. Assistance of Department of Agriculture.

§ 161. Patents for plants.

Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids, and newly found seedlings, other than a tuber propagated plant or a plant found in an uncultivated state, may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided.


§ 162. Description, claim

No plant patent shall be declared invalid for noncompliance with section 112 if the description is as complete as is reasonably possible.

The claim in the specification shall be in formal terms to the plant shown and described.

sexually reproduced plants under the Plant Variety Protection Act (7 U.S.C. 2321 et seq.), as amended by the Plant Variety Protection Act Amendments of 1994 (Public Law 103-349); and

"(3) to strengthen the ability of United States plant patent holders to enforce their patent rights with regard to importation of plant parts produced from plants protected by United States plant patents, which are propagated without the authorization of the patent holder."

§ 164. Assistance of Department of Agriculture

The President may by Executive order direct the Secretary of Agriculture, in accordance with the requests of the Director, for the purpose of carrying into effect the provisions of this title with respect to plants (1) to furnish available information of the Department of Agriculture, (2) to conduct through the appropriate bureau or division of the Department research upon special problems, or (3) to detail to the Director officers and employees of the Department.


HISTORICAL AND REVISION NOTES


Language is changed.

AMENDMENTS


EFFECTIVE DATE OF 1999 AMENDMENT


TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Agriculture, with certain exceptions, to Secretary of Agriculture, with power to delegate, see Reorg. Plan No. 2 of 1953, §1, eff. June 4, 1953, 18 F.R. 3219, 67 Stat. 633, set out in the Appendix to Title 5, Government Organization and Employees.

CHAPTER 16—DESIGNS

Sec. 171. Patents for designs.

172. Right of priority.

173. Term of design patent.

§ 171. Patents for designs

(a) IN GENERAL.—Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

(b) APPLICABILITY OF THIS TITLE.—The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

(c) FILING DATE.—The filing date of an application for patent for design shall be the date on which the specification as prescribed by section 112 and any required drawings are filed.


HISTORICAL AND REVISION NOTES


The list of conditions specified in the corresponding section of existing statute is omitted as unnecessary in view of the general inclusion of all conditions applying to other patents. Language is changed.

AMENDMENTS

2012—Pub. L. 112–211 designated first and second pars. as subssecs. (a) and (b), respectively, inserted headings, and added subsec. (c).

EFFECTIVE DATE OF 2012 AMENDMENT

Amendment by Pub. L. 112–211 effective on the date that is 1 year after Dec. 18, 2012, applicable to patents issued before, on, or after that effective date and patent applications pending on or filed after that effective date, and not effective with respect to patents in litigation commenced before that effective date, see section 203 of Pub. L. 112–211, set out as an Effective Date note under section 27 of this title.

§ 172. Right of priority

The right of priority provided for by subsections (a) through (d) of section 119 shall be six months in the case of designs. The right of priority provided for by subsection 119(e) shall not apply to designs.


HISTORICAL AND REVISION NOTES


This provision is taken from R.S. 4887 (see section 119) and made a separate section.

AMENDMENTS

2011—Pub. L. 112–29, §20(j), struck out “of this title” after “119” and after “119(e)”.

Pub. L. 112–29, §3(g)(1), struck out “(and the time specified in section 102(d))” before “shall be six months”.

1994—Pub. L. 103–465 substituted “subsections (a) through (d) of section 119” for “section 119” and inserted at end “The right of priority provided for by section 119(e) of this title shall not apply to designs.”

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 3(g)(1) of Pub. L. 112–29 effective upon the expiration of the 18-month period beginning on Sept. 16, 2011, and applicable to certain applications for patent and any patents issuing thereon, see section 3(n) of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title.

Amendment by section 20(j) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112–29, set out as a note under section 2 of this title.

EFFECTIVE DATE OF 1994 AMENDMENT

Amendment by Pub. L. 103–465 effective 6 months after Dec. 8, 1994, and applicable to all patent applica-
§ 173. Term of design patent


AMENDMENT OF SECTION

Pub. L. 112–211, title I, §§102(7), 103, Dec. 18, 2012, 126 Stat. 1532, provided that, effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, this section is amended by substituting “15 years” for “fourteen years”. See 2012 Amendment note below.

HISTORICAL AND REVISION NOTES


AMENDMENTS

2012—Pub. L. 112–211 substituted “15 years” for “fourteen years”.

1994—Pub. L. 103–465 inserted “from the date of grant” after “years”.

1982—Pub. L. 97–247 substituted “Patents for designs shall be granted for the term of fourteen years” for “Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant, in his application, elects”.

EFFECTIVE DATE OF 2012 AMENDMENT

Amendment by Pub. L. 112–211 effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, see section 103 of Pub. L. 112–211, set out as a note under section 100 of this title.

EFFECTIVE DATE OF 1994 AMENDMENT

Amendment by Pub. L. 103–465 effective 6 months after Dec. 8, 1994, and applicable to all patent applications filed in the United States on or after that effective date, with provisions relating to earliest filed patent application, see section 532(b)(1), (3) of Pub. L. 103–465, set out as a note under section 154 of this title.

EFFECTIVE DATE OF 1982 AMENDMENT


CHAPTER 17—SECRECY OF CERTAIN INVENTIONS AND FILING APPLICATIONS IN FOREIGN COUNTRY

Sec. 181. Secrecy of certain inventions and withholding of patent.

§ 181. Secrecy of certain inventions and withholding of patent

Whenever publication or disclosure by the publication of an application or by the granting of a patent on an invention in which the Government has a property interest might, in the opinion of the head of the interested Government agency, be detrimental to the national security, the Commissioner of Patents upon being so notified shall order that the invention be kept secret and shall withhold the publication of the application or the grant of a patent therefor under the conditions set forth hereinafter.

Whenever the publication or disclosure of an invention by the publication of an application or by the granting of a patent, in which the Government does not have a property interest, might, in the opinion of the Commissioner of Patents, be detrimental to the national security, he shall make the application for patent in which such invention is disclosed available for inspection to the Atomic Energy Commission, the Secretary of Defense, and the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States.

Each individual to whom the application is disclosed shall sign a dated acknowledgment thereof, which acknowledgment shall be entered in the file of the application. If, in the opinion of the Atomic Energy Commission, the Secretary of a Defense Department, or the chief officer of another department or agency so designated, the publication or disclosure of the invention by the publication of an application or by the granting of a patent therefor would be detrimental to the national security, the Atomic Energy Commission, the Secretary of a Defense Department, or such other chief officer shall notify the Commissioner of Patents and the Commissioner of Patents shall order that the invention be kept secret and shall withhold the publication of the application or the grant of a patent for such period as the national interest requires, and notify the applicant thereof. Upon proper showing by the head of the department or agency who caused the secrecy order to be issued that the examination of the application might jeopardize the national interest, the Commissioner of Patents shall thereupon maintain the application in a sealed condition and notify the applicant thereof. The owner of an application which has been placed under a secrecy order shall have a right to appeal from the order to the Secretary of Commerce under rules prescribed by him.

An invention shall not be ordered kept secret and the publication of the application or the
grant of a patent withheld for a period of more than one year. The Commissioner of Patents shall renew the order at the end thereof, or at the end of any renewal period, for additional periods of one year upon notification by the head of the department or the chief officer of the agency who caused the order to be issued that an affirmative determination has been made that the national interest continues so to require. An order in effect, or issued, during a time when the United States is at war, shall remain in effect for the duration of hostilities and one year following cessation of hostilities. An order in effect, or issued, during a national emergency declared by the President shall remain in effect for the duration of the national emergency and six months thereafter. The Commissioner of Patents may rescind any order upon notification by the heads of the departments and the chief officers of the agencies who caused the order to be issued that the publication or disclosure of the invention is no longer deemed detrimental to the national security.


HISTORICAL AND REVISION NOTES


Language is changed.

**AMENDMENTS**


Pub. L. 106–113, §1000(a)(9) [title IV, §4507(7)(A)], in first par., inserted “by the publication of an application or” after “‘disclosure’” and “‘the publication of the application or’ after ‘withhold’.”

Pub. L. 106–113, §1000(a)(9) [title IV, §4507(7)(B)], inserted “by the publication of an application or” after “‘disclosure of an invention’ in second par.

Pub. L. 106–113, §1000(a)(9) [title IV, §4507(7)(C)], in third par., inserted “by the publication of the application or” after “‘disclosure of the invention’ and “‘the publication of the application or’ after ‘withhold’.”

Pub. L. 106–113, §1000(a)(9) [title IV, §4507(7)(D)], inserted “the publication of an application or” after “‘kept secret and’ in first sentence of fourth par.

**EFFECTIVE DATE OF 1999 AMENDMENT**

Amendment by section 1000(a)(9) [title IV, §4507(7)] of Pub. L. 106–113 effective Nov. 29, 2000, and applicable only to applications (including international applications designating the United States) filed on or after that date, see section 1000(a)(9) [title IV, §4508] of Pub. L. 106–113, as amended, set out as a note under section 10 of this title.


**TRANSFER OF FUNCTIONS**

Atomic Energy Commission abolished and functions transferred by sections 5814 and 5841 of Title 42, The Public Health and Welfare. See, also, Transfer of Functions notes set out under those sections.

**DEFENSE AGENCIES**

Department of Homeland Security designated as a defense agency of United States for purposes of this chapter by Executive Order No. 13286, §§5, Feb. 28, 2003, 68 F.R. 10632.

**§182. Abandonment of invention for unauthorized disclosure**

The invention disclosed in an application for patent subject to an order made pursuant to section 181 may be held abandoned upon its being established by the Commissioner of Patents that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent of the Commissioner of Patents. The abandonment shall be held to have occurred as of the time of violation. The consent of the Commissioner of Patents shall not be given without the concurrence of the heads of the departments and the chief officers of the agencies who caused the order to be issued. A holding of abandonment shall constitute forfeiture by the applicant, his successors, assigns, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention.


HISTORICAL AND REVISION NOTES


Language is changed.

**AMENDMENTS**

2011—Pub. L. 112–29 struck out “of this title” after “181”.


**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 proceedings commenced on or after that date, see section 20(l) of Pub. L. 112–29, set out as a note under section 2 of this title.

**EFFECTIVE DATE OF 1999 AMENDMENT**


**§183. Right to compensation**

An applicant, his successors, assigns, or legal representatives, whose patent is withheld as herein provided, shall have the right, beginning at the date the applicant is notified that, except for such order, his application is otherwise in condition for allowance, or February 1, 1952, whichever is later, and ending six years after a patent is issued thereon, to apply to the head of any department or agency who caused the order to be issued for compensation for the damage caused by the order of secrecy and/or for the use of the invention by the Government, resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of
the invention by the Government. The head of the department or agency is authorized, upon the presentation of a claim, to enter into an agreement with the applicant, his successors, assigns, or legal representatives, in full settlement for the damage and/or use. This settlement agreement shall be conclusive for all purposes notwithstanding any other provision of law to the contrary. If full settlement of the claim cannot be effected, the head of the department or agency may award and pay to such applicant, his successors, assigns, or legal representatives, a sum not exceeding 75 per centum of the sum which the head of the department or agency considers just compensation for the damage and/or use. A claimant may bring suit against the United States in the United States Court of Federal Claims or in the District Court of the United States for the district in which such claimant is a resident for an amount which when added to the award shall constitute just compensation for the damage and/or use of the invention by the Government. The owner of any patent issued upon an application that was subject to a secrecy order issued pursuant to section 181, who did not apply for compensation as above provided, shall have the right, after the date of issuance of such patent, to bring suit in the United States Court of Federal Claims for just compensation for the damage caused by reason of the order of secrecy and/or use by the Government of the invention resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. In a suit under the provisions of this section the United States may avail itself of all defenses it may plead in an action under section 1498 of title 28. This section shall not confer a right of action on anyone or his successors, assigns, or legal representatives who, while in the full-time employment or service of the United States, discovered, invented, or developed the invention on which the claim is based.


HISTORICAL AND REVISION NOTES


Language is changed.

Amendments


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 proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112–29, set out as a note under section 171 of Title 28, Judiciary and Judicial Procedure.

Effective Date of 1992 Amendment


$184. Filing of application in foreign country

(a) FILING IN FOREIGN COUNTRY.—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 order pursuant to section 181 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 the application does not disclose an invention within the scope of section 181.

(b) APPLICATION.—The term “application” when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

(c) SUBSEQUENT MODIFICATIONS, AMENDMENTS, AND SUPPLEMENTS.—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 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 section 181.


HISTORICAL AND REVISION NOTES


Language is changed.

Amendments

2011—Pub. L. 112–29 designated first to third pars. as subsecs. (a) to (c), respectively, inserted headings, in
subsec. (a), struck out “of this title” after “‘181’” in two places and struck out “and without deceptive intent” after “‘through error’,” and, in subsec. (c), struck out “of this title” after “under section 181” in first sentence.


Pub. L. 100–418, § 9101(b)(1)(B), added third par. relating to scope of a license.

**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 proceedings commenced on or after that effective date, see section 20(c) of Pub. L. 112–29, set out as a note under section 2 of this title.

**Effective Date of 1999 Amendment**


**Effective Date of 1988 Amendment**

Pub. L. 100–418, title IX, § 9101(d), Aug. 23, 1988, 102 Stat. 1568, provided that:

“(1) Subject to paragraphs (2), (3), and (4) of this subsection, the amendments made by this section [amending sections 184 to 186 of this title] shall apply to all United States patents granted before, on, or after the date of enactment of this section [Aug. 23, 1988], to all applications for United States patents pending on or filed after such date of enactment, and to all licenses under section 184 granted before, on, or after the date of enactment of this section.

“(2) The amendments made by this section shall not affect any final decision made by a court or the Patent and Trademark Office before the date of enactment of this section.

“(3) No United States patent granted before the date of enactment of this section [Aug. 23, 1988] with respect to a patent or application for patent, if no appeal from such decision is pending and the time for filing an appeal has expired.

“(4) The amendments made by this section shall not affect the right of any party in any case pending in court on the date of enactment of this section, and it may also provide for the continued practice of any process practiced, or for the practice of which substantial preparation was made, prior to the date of enactment of this section, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before such date of enactment.

“(5) The amendments made by this section shall not affect the right of any party in any case pending in court on the date of enactment of this section [Aug. 23, 1988] to have its rights or liabilities—

“(A) under any patent before the court, or

“(B) under any patent granted after such date of enactment which is related to the patent before the court by deriving priority rights under section 120 or 121 of title 35, United States Code, from a patent or an application for patent common to both patents, determined on the basis of the substantive law in effect before the date of enactment of this section.”

**Promulgation of Regulations**

Pub. L. 100–418, title IX, § 9101(c), Aug. 23, 1988, 102 Stat. 1568, directed Commissioner of Patents and Trademarks to prescribe such regulations as necessary to implement the amendments made by section 9101 (amending sections 184 to 186 of this title).

**§ 185. Patent barred for filing without license**

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, 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 the patent does not disclose subject matter within the scope of section 181.


**Historical and Revision Notes**


Language is changed.

**Amendments**

2011—Pub. L. 112–29 struck out “of this title” after “‘184’” and after “‘181’” and struck out “and without deceptive intent” after “‘error’”.

2002—Pub. L. 107–273 struck out second period at end. 1988—Pub. L. 100–418 inserted before period at end “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.”

**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 proceedings commenced on or after that effective date, see section 20(i) of Pub. L. 112–29, set out as a note under section 2 of this title.

**Effective Date of 1988 Amendment**

Amendment by Pub. L. 100–418 applicable, subject to certain qualifications and exceptions, to all United States patents, and to all licenses under section 184 of this title, regardless of the date such patents or licenses are granted, and to all applications for such patents pending on or filed after Aug. 23, 1988, see section 9101(d) of Pub. L. 100–418, set out as a note under section 184 of this title.

**§ 186. Penalty**

Whoever, during the period or periods of time an invention has been ordered to be kept secret and the grant of a patent thereon withheld pursuant to section 181, shall, with knowledge of such order and without due authorization, willfully publish or disclose or authorize or cause to
be published or disclosed the invention, or material information with respect thereto, or whoever willfully, in violation of the provisions of section 184, shall file or cause or authorize to be filed in any foreign country an application for patent or for the registration of a utility model, industrial design, or model in respect of any invention made in the United States, shall, upon conviction, be fined not more than $10,000 or imprisoned for not more than two years, or both.


HISTORICAL AND REVISION NOTES

Language is changed.

AMENDMENTS
2011—Pub. L. 112–29 struck out ‘‘of this title’’ after ‘‘181’’ and after ‘‘184’’. 1988—Pub. L. 100–418, which directed the insertion of ‘‘willfully’’ after second reference to ‘‘whoever’’, was executed by making the insertion after ‘‘or whoever’’, as the probable intent of Congress.

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 proceedings commenced on or after that effective date, see section 29(f) of Pub. L. 112–29, set out as a note under section 2 of this title.

EFFECTIVE DATE OF 1988 AMENDMENT
Amendment by Pub. L. 100–418 applicable, subject to certain qualifications and exceptions, to all United States patents, and to all licenses under section 184 of this title, regardless of the date such patents or licenses are granted, and to all applications for such patents pending on or filed after Aug. 23, 1988, see section 9101(d) of Pub. L. 100–418, set out as a note under section 184 of this title.

§187. Nonapplicability to certain persons
The prohibitions and penalties of this chapter shall not apply to any officer or agent of the United States acting within the scope of his authority, nor to any person acting upon his written instructions or permission.

(July 19, 1952, ch. 950, 66 Stat. 808.)

HISTORICAL AND REVISION NOTES

Language is changed.

§188. Rules and regulations, delegation of power
The Atomic Energy Commission, the Secretary of a defense department, the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States, and the Secretary of Commerce, may separately issue rules and regulations to enable the respective department or agency to carry out the provisions of this chapter, and may delegate any power conferred by this chapter.

(July 19, 1952, ch. 950, 66 Stat. 808.)

HISTORICAL AND REVISION NOTES

Language is changed.

TRANSFER OF FUNCTIONS
Atomic Energy Commission abolished and functions transferred by sections 5814 and 5841 of Title 42, The Public Health and Welfare. See, also, Transfer of Functions notes set out under those sections.

DEFENSE AGENCIES
Department of Justice designated as a defense agency of United States for purposes of this chapter by Executive Order No. 10457, May 27, 1953, 18 F.R. 3083.

CHAPTER 18—PATENT RIGHTS IN INVENTIONS MADE WITH FEDERAL ASSISTANCE

§200. Policy and objective
It is the policy and objective of the Congress to use the patent system to promote the utilization of inventions arising from federally supported research or development; to encourage maximum participation of small business firms in federally supported research and development efforts; to promote collaboration between commercial concerns and nonprofit organizations, including universities; to ensure that inventions made by nonprofit organizations and small business firms are used in a manner to promote free competition and enterprise without unduly encumbering future research and discovery; to promote the commercialization and public availability of inventions made in the United States by United States industry and labor; to ensure that the Government obtains sufficient rights in federally supported inventions to meet the needs of the Government and protect the public against nonuse or unreasonable use of inventions; and to minimize the costs of administering policies in this area.

(Added Pub. L. 96–517, §6(a), Dec. 12, 1980, 94 Stat. 3018, comprising sections 200 to 211, as chapter 18, and transferred chapter 18, as so redesignated, to end of this part from end of part IV.)

§200. Policy and objective
It is the policy and objective of the Congress to use the patent system to promote the utilization of inventions arising from federally supported research or development; to encourage maximum participation of small business firms in federally supported research and development efforts; to promote collaboration between commercial concerns and nonprofit organizations, including universities; to ensure that inventions made by nonprofit organizations and small business firms are used in a manner to promote free competition and enterprise without unduly encumbering future research and discovery; to promote the commercialization and public availability of inventions made in the United States by United States industry and labor; to ensure that the Government obtains sufficient rights in federally supported inventions to meet the needs of the Government and protect the public against nonuse or unreasonable use of inventions; and to minimize the costs of administering policies in this area.


AMENDMENTS
2000—Pub. L. 106–404 substituted ‘‘enterprise without unduly encumbering future research and discovery;’’ for ‘‘enterprise;’’.
Chapter effective July 1, 1981, but implementing regulations authorized to be issued earlier, see section 8(f) of Pub. L. 96–517, set out as an Effective Date of 1980 Amendment note under section 41 of this title.

This chapter is popularly known as the Bayh-Dole Act and also as the University Amendments to title 35, United States Code, Set Out as Effective Date of 1980 Amendments Defined

This chapter, popularly known as the Bayh-Dole Act, Section 6(a) of Pub. L. 96–517, Dec. 12, 1980, 94 Stat. 3018, which enacted this chapter, is also popularly known as the Bayh-Dole Act and also as the University Amendments to title 35, United States Code, Set Out as Effective Date of 1980 Amendments Defined.

§ 201. Definitions

As used in this chapter—
(a) The term “Federal agency” means any executive agency as defined in section 105 of title 5, and the military departments as defined by section 102 of title 5.
(b) The term “funding agreement” means any contract, grant, or cooperative agreement entered into between any Federal agency, or any person or organization, and any contractor for the performance of experimental, developmental, or research work in whole or in part by the Federal Government. Such term includes any assignment, substitution of parties, or subcontract of any type entered into for the performance of experimental, developmental, or research work under a funding agreement as herein defined.
(c) The term “contractor” means any person, small business firm, or nonprofit organization that is a party to a funding agreement.
(d) The term “invention” means any invention or discovery which is or may be patentable or otherwise protectable under this title or any novel variety of plant which is or may be protectable under the Plant Variety Protection Act (7 U.S.C. 2321 et seq.).
(e) The term “subject invention” means any invention of the contractor conceived or first actually reduced to practice in the performance of work under a funding agreement; Provided, That in the case of a variety of plant, the date of determination (as defined in section 41(d) of the Plant Variety Protection Act (7 U.S.C. 2401(d))) must also occur during the period of contract performance.
(f) The term “practical application” means to manufacture in the case of a composition or product, to practice in the case of a process or method, or to operate in the case of a machine or system; and, in each case, under such conditions as to establish that the invention is being utilized and that its benefits are to the extent permitted by law or Government regulations available to the public on reasonable terms.
(g) The term “made” when used in relation to any invention means the conception or first actual reduction to practice of such invention.
(h) The term “small business firm” means a small business concern as defined at section 2 of Public Law 85–536 (15 U.S.C. 632) and implementing regulations of the Administrator of the Small Business Administration.

1 See References in Text note below.
pulsion or weapons related programs and all
funding agreement limitations under this sub-
paragraph on the contractor's right to elect
title to a subject invention are limited to inven-
tions occurring under the above two programs of
the Department of Energy. The rights of the
nonprofit organization or small business firm
shall be subject to the provisions of paragraph
c) of this section and the other provisions of
this chapter.

(b)(1) The rights of the Government under sub-
section (a) shall not be exercised by a Federal
agency unless it first determines that at least
one of the conditions identified in clauses (i)
through (iv) of subsection (a) exists. Except in
the case of subsection (a)(iii), the agency shall
file with the Secretary of Commerce, within
thirty days after the award of the applicable
funding agreement, a copy of such determina-
tion. In the case of a determination under sub-
section (a)(ii), the statement shall include an
analysis justifying the determination. In the
case of determinations applicable to funding
agreements with small business firms, copies
shall also be sent to the Chief Counsel for Ad-
vocacy of the Small Business Administration. If
the Secretary of Commerce believes that any in-
dividual determination or pattern of determina-
tions is contrary to the policies and objectives
of this chapter or otherwise not in conformance
with this chapter, the Secretary shall so advise
the head of the agency concerned and the Ad-
mistrator of the Office of Federal Procure-
ment Policy, and recommend corrective actions.

(2) Whenever the Administrator of the Office
of Federal Procurement Policy has determined
that one or more Federal agencies are utilizing
the authority of clause (i) or (ii) of subsection
(a) of this section in a manner that is contrary
to the policies and objectives of this chapter,
the Administrator is authorized to issue regula-
tions describing classes of situations in which
agencies may not exercise the authorities of
those clauses.

(3) If the contractor believes that a determina-
tion is contrary to the policies and objectives
of this chapter or constitutes an abuse of discre-
tion by the agency, the determination shall be
subject to section 203(b).

(c) Each funding agreement with a small busi-
ness firm or nonprofit organization shall con-
tain appropriate provisions to effectuate the fol-
lowing:

(1) That the contractor disclose each subject
invention to the Federal agency within a rea-
sonable time after it becomes known to con-
tactor personnel responsible for the adminis-
tration of patent matters, and that the Fed-
eral Government may receive title to any sub-
ject invention not disclosed to it within such
time.

(2) That the contractor make a written elec-
tion 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 the 1-year period referred to in section
102(b) would end before the end of that 2-year
period, the period for election may be short-
ened by the Federal agency to a date that is
not more than sixty days before the end of
that 1-year 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 time.

(3) That a contractor electing rights in a
subject invention agrees to file a patent appli-
cation prior to the expiration of the 1-year pe-
riod referred to in section 102(b), and shall
thereafter file corresponding patent applica-
tions 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 in-
vention within such times.

(4) With respect to any invention in which
the contractor elects rights, the Federal agen-
cy shall have a nonexclusive, nontrans-
ferrable, irrevocable, paid-up license to prac-
tice or have practiced for or on behalf of the
United States any subject invention through-
out the world: Provided, That the funding
agreement may provide for such additional
rights, including the right to assign or have
assigned foreign patent rights in the subject
invention, as are determined by the agency as
necessary for meeting the obligations of the
United States under any treaty, international
agreement, arrangement of cooperation,
memorandum of understanding, or similar ar-
rangement, including military agreement re-
lating to weapons development and produc-
tion.

(5) The right of the Federal agency to re-
quire periodic reporting on the utilization or
efforts at obtaining utilization that are being
made by the contractor or his licensees or as-
signees: Provided, That any such information
as well as any information on utilization or ef-
forts at obtaining utilization obtained as part
of a proceeding under section 203 of this chap-
ter shall be treated by the Federal agency as
commercial and financial information ob-
tained from a person and privileged and con-
fidential and not subject to disclosure under
section 552 of title 5.

(6) An obligation on the part of the contrac-
tor, in the event a United States patent appli-
cation is filed by or on its behalf or by any as-
signee of the contractor, to include within the
specification of such application and any pat-
et issued thereon, a statement specifying
that the invention was made with Government
support and that the Government has certain
rights in the invention.

(7) In the case of a nonprofit organization,
(A) a prohibition upon the assignment of
rights to a subject invention in the United
States without the approval of the Federal
agency, except where such assignment is made
to an organization which has as one of its pri-
mary functions the management of inventions
(provided that such assignee shall be subject
to the same provisions as the contractor); (B)
a requirement that the contractor share royal-
ities with the inventor; (C) except with respect
to a funding agreement for the operation of a
Government-owned-contractor-operated facili-
ity, a requirement that the balance of any royalties or income earned by the contractor with respect to subject inventions, after payment of expenses (including payments to inventors) incident to the administration of subject inventions, be utilized for the support of scientific research or education; (D) a requirement that, 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; and (E) with respect to a funding agreement for the operation of a Government-owned-contractor-operated facility, requirements (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 15 percent of such excess shall be paid to the Treasury of the United States and the remaining 85 percent shall be used for the same purposes described above in this clause; and (ii) that, to the extent it provides the most effective technology transfer, the licensing of subject inventions shall be administered by contractor employees on location at the facility.

(8) The requirements of sections 203 and 204 of this chapter.

(d) If a contractor does not elect to retain title to a subject invention in cases subject to this section, the Federal agency may consider and after consultation with the contractor grant requests for retention of rights by the inventor after consultation with the contractor grant retention of rights by the inventor in cases subject to this chapter unless the party from whom the non-Federal inventor, the Federal agency employed such coinventor may, for the purpose of consolidating rights in the invention and if it finds that it would expedite the development of the invention—

(1) license or assign whatever rights it may acquire in the subject invention to the non-profit organization, small business firm, or non-Federal inventor in accordance with the provisions of this chapter or

(2) acquire any rights in the subject invention from the non-profit organization, small business firm, or non-Federal inventor, the Federal agency employing such coinventor may, for the purpose of consolidating rights in the invention and if it finds that it would expedite the development of the invention—

(f)(1) No funding agreement with a small business firm or nonprofit organization shall contain a provision allowing a Federal agency to require the licensing to third parties of inventions owned by the contractor that are not subject inventions unless such provision has been approved by the head of the agency and a written justification has been signed by the head of the agency. Any such provision shall clearly state whether the licensing may be required in connection with the practice of a subject invention, a specifically identified work object, or both. The head of the agency may not delegate the authority to approve provisions or sign justifications required by this paragraph.

(2) A Federal agency shall not require the licensing of third parties under any such provision unless the head of the agency determines that the use of the invention by others is necessary for the practice of a subject invention or for the use of a work object of the funding agreement and that such action is necessary to achieve the practical application of the subject invention or work object. Any such determination shall be on the record after an opportunity for an agency hearing. Any action commenced for judicial review of such determination shall be brought within sixty days after notification of such determination.


REFERENCES IN TEXT

This Act, referred to in subsec. (d), probably means Pub. L. 96–517, Dec. 12, 1980, 94 Stat. 3015, which enacted sections 41, 42, and 154 of this title, section 1113 of Title 15, Commerce and Trade, sections 101 and 117 of Title 17, Copyrights, and sections 2186 and 5908 and former section 2457 of Title 42, The Public Health and Welfare, and enacted provisions set out as notes under sections 13 and 41 of this title. For complete classification of this Act to the Code, see Tables.

AMENDMENTS


Subsec. (c)(2). Pub. L. 112–29, §3(g)(7)(A), substituted “the 1-year period referred to in section 102(b) would end before the end of that 2-year period” for “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” and “before the end of that 1-year” for “prior to the end of the statute”.

Subsec. (c)(3). Pub. L. 112–29, §3(g)(7)(B), substituted “the expiration of the 1-year period referred to in section 102(b)” for “any statutory bar date that may occur under this title due to publication, on sale, or public use.”

Subsec. (c)(7)(D). Pub. L. 112–29, §20(l)(2)(B), substituted “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; and” for “except where it proves infeasible after a reasonable inquiry, in the licensing of sub-
ject inventions shall be given to small business firms; and"

Subsec. (c)(7)(E). Pub. L. 98–620, § 501(8), redesignated cl. (C) as (B). Former cl. (B), relating to a prohibition on the contractor to persons other than small business firms for periods in excess of certain specified periods and relating to commercial sales, was struck out.


Subsec. (c)(7)(E). Pub. L. 98–620, § 501(8), redesignated former cl. (D) as (E) and inserted provisions placing a limit on the amount of royalties that the contract operators of Government-owned laboratories are entitled to retain after paying patent administrative expenses and a share of the royalties to inventors, requiring payment of amounts in excess of such limits to the United States Treasury, and requiring that, to the extent it provides the most effective technology transfer, the licensing of subject inventions shall be administered by contractor employees on location at the facility.

**Effective Date of 2011 Amendment**

Amendment by section 3(g)(7) of Pub. L. 112–29 effective upon the expiration of the 18-month period beginning on Sept. 16, 2011, and applicable to certain applications for patent and any patents issuing thereon, see section 3(n) of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment; Saving Provisions note under section 100 of this title.

**Effective Date of 1999 Amendment**

Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, § 4731]
§ 203. March-in rights

(a) With respect to any subject invention in which a small business firm or nonprofit organization has acquired title under this chapter, the Federal agency under whose funding agreement the subject invention was made shall have the right, in accordance with such procedures as are provided in regulations promulgated hereunder to require the contractor, an assignee or exclusive licensee of a subject invention to grant a nonexclusive, partially exclusive, or exclusive license in any field of use to a responsible applicant or applicants, upon terms that are reasonable under the circumstances, and if the contractor, assignee, or exclusive licensee refuses such request, to grant such a license itself, if the Federal agency determines that such—

(1) action is necessary because the contractor or assignee has not taken, or is not expected to take within a reasonable time, effective steps to achieve practical application of the subject invention in such field of use;

(2) action is necessary to alleviate health or safety needs which are not reasonably satisfied by the contractor, assignee, or their licensees;

(3) action is necessary to meet requirements for public use specified by Federal regulations and such requirements are not reasonably satisfied by the contractor, assignee, or licensees; or

(4) action is necessary because the agreement required by section 204 has not been obtained or waived or because a licensee of the subject invention was made shall have the right to use or sell any subject invention in the United States in breach of its agreement obtained pursuant to section 204.

(b) A determination pursuant to this section or section 202(b)(4) shall not be subject to chapter 71 of title 41. An administrative appeals procedure shall be established by regulations promulgated in accordance with section 206. Additionally, any contractor, inventor, assignee, or exclusive licensee adversely affected by a determination under this section may, at any time within sixty days after the determination is issued, file a petition in the United States Court of Federal Claims, which shall have jurisdiction to determine the appeal on the record and to affirm, reverse, remand or modify, as appropriate, the determination of the Federal agency. In cases described in paragraphs (1) and (3) of subsection (a), the agency’s determination shall be held in abeyance pending the exhaustion of appeals or petitions filed under the preceding sentence.

(Added Pub. L. 96–517, § 6(a), Dec. 12, 1980, 94 Stat. 3367; Pub. L. 102–572, substituted ‘‘paragraphs (1) and (3) of subsection (a)’’ for ‘‘paragraphs (a) and (c)’’).

1992—Par. (2). Pub. L. 102–572 substituted ‘‘Chapter 71 of Title 41’’ for ‘‘chapter 71 of title 41’’.

1984—Pub. L. 98–620 designated existing provisions as par. (1) and added par. (2).

Effective Date of 1992 Amendment


§ 204. Preference for United States industry

Notwithstanding any other provision of this chapter, no small business firm or nonprofit organization which receives title to any subject invention and no assignee of any such small business firm or nonprofit organization shall grant to any person the exclusive right to use or sell any subject invention in the United States unless such person agrees that any products embodying the subject invention or produced through the use of the subject invention will be manufactured substantially in the United States. However, in individual cases, the requirement for such an agreement may be waived by the Federal agency under whose funding agreement the invention was made upon a showing by the small business firm, nonprofit organization, or assignee that reasonable but unsuccessful efforts have been made to grant licenses on similar terms to potential licensees that would be likely to manufacture substantially in the United States or that under the circumstances domestic manufacture is not commercially feasible.


§ 205. Confidentiality

Federal agencies are authorized to withhold from disclosure to the public information disclosing any invention in which the Federal Government owns or may own a right, title, or interest (including a nonexclusive license) for a reasonable time in order for a patent application to be filed. Furthermore, Federal agencies shall not be required to release copies of any document which is part of an application for patent filed with the United States Patent and Trademark Office or with any foreign patent office.


§ 206. Uniform clauses and regulations

The Secretary of Commerce may issue regulations which may be made applicable to Federal agencies by—

References in Text


Amendments

2011—Subsec. (b). Pub. L. 111–350 substituted ‘‘chapter 71 of title 41’’ for ‘‘the Contract Disputes Act (41 U.S.C. §601 et seq.)’’. 2002—Pub. L. 107–273 redesignated par. (1) as subsec. (a) and former subpars. (a) to (d) as pars. (1) to (4), respectively, redesignated former par. (2) as subsec. (b), struck out quotation marks and commas before ‘‘as appropriate’’, and substituted ‘‘paragraphs (1) and (3) of subsection (a)’’ for ‘‘paragraphs (a) and (c)’’. 1992—Par. (2). Pub. L. 102–572 substituted ‘‘United States Court of Federal Claims’’ for ‘‘United States Claims Court’’. 1984—Pub. L. 98–620 designated existing provisions as par. (1) and added par. (2).
agencies implementing the provisions of sections 202 through 204 of this chapter and shall establish standard funding agreement provisions required under this chapter. The regulations and the standard funding agreement shall be subject to public comment before their issuance.


**AMENDMENTS**

1984—Pub. L. 98–620 amended section generally. Prior to amendment, section read as follows: "The Office of Federal Procurement Policy, after receiving recommendations of the Office of Science and Technology Policy, may issue regulations which may be made applicable to Federal agencies implementing the provisions of sections 202 through 204 of this chapter and the Office of Federal Procurement Policy shall establish standard funding agreement provisions required under this chapter.''

§207. Domestic and foreign protection of federally owned inventions

(a) Each Federal agency is authorized to—

(1) apply for, obtain, and maintain patents or other forms of protection in the United States and in foreign countries on inventions in which the Federal Government owns a right, title, or interest;

(2) grant nonexclusive, exclusive, or partially exclusive licenses under federally owned inventions, royalty-free or for royalties or other consideration, and on such terms and conditions, including the grant to the licensee of the right of enforcement pursuant to the provisions of chapter 29 as determined appropriate in the public interest;

(3) undertake all other suitable and necessary steps to protect and administer rights to federally owned inventions on behalf of the Federal Government either directly or through contract, including acquiring rights for and administering royalties to the Federal Government in any invention, but only to the extent the party from whom the rights are acquired voluntarily enters into the transaction, to facilitate the licensing of a federally owned invention after "or through contract".

1984—Pub. L. 98–620 designated existing provisions as subsec. (a) and added subsec. (b).

**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 proceedings commenced on or after that effective date, see section 28(i) of Pub. L. 112–29, set out as a note under section 2 of this title.

**EX. ORD. NO. 9424. ESTABLISHMENT OF A REGISTER OF GOVERNMENT INTERESTS IN PATENTS**

Ex. Ord. No. 9424, Feb. 18, 1944, 9 F.R. 1959, provided:

1. The Secretary of Commerce shall cause to be established in the United States Patent Office [now Patent and Trademark Office] a separate register for the recording of all rights and interests of the Government in or under patents and applications for patents.

2. The several departments and other executive agencies of the Government, including Government-owned or Government-controlled corporations, shall forward promptly to the Commissioner of Patents [now Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] for recording in the separate register provided for in paragraph 1 hereof all licenses, assignments, or other interests of the Government in or under patents or applications for patents, in accordance with such rules and regulations as may be prescribed pursuant to paragraph 4 hereof; but the lack of recordation in such register of any right or interest of the Government in or under any patent or application therefor shall not prejudice in any way the assertion of such right or interest by the Government.

3. The register shall be open to inspection except as to such entries or documents which, in the opinion of the department or agency submitting them for recordation, should be maintained in secrecy: Provided, however, That the right of inspection may be restricted to authorized representatives of the Government pending the final report to the President by the National Patent Planning Commission under Executive Order No. 8977 of December 12, 1941, and action thereon by the President.

4. The Commissioner of Patents [now Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office], with the approval of the Secretary of Commerce, shall prescribe such rules and regulations as he may deem necessary to effectuate the purposes of this order.

**EX. ORD. NO. 9865. PATENT PROTECTION ABROAD OF INVENTIONS RESULTING FROM RESEARCH FINANCED BY THE GOVERNMENT**


1. All Government departments and agencies shall, whenever practicable, acquire the title to file foreign patent applications on inventions resulting from research conducted or financed by the Government.

2. All Government departments and agencies which have or may hereafter acquire title to inventions or the
right to file patent applications abroad thereon, shall fully and continuously inform the Chairman of Government Patents Board [now Secretary of Commerce. See Ex. Ord. No. 10930 set out as a note below] concerning such inventions, except as provided in section 6 hereof, and shall make recommendations to the Chairman of Government Patents Board as to which of such inventions should receive patent protection by the United States abroad and the foreign jurisdictions in which such patent protection should be sought. The recommendations of such departments and agencies shall indicate the immediate or future industrial, commercial or other value of the invention concerned, including its value to public health.

The Chairman of Government Patents Board shall determine whether, and in what foreign jurisdictions, the United States should seek patents for such inventions, and, to the extent of appropriations available therefor, shall procure patent protection for such inventions, taking all action, consistent with existing law, necessary to acquire and maintain patent rights abroad. Such determinations of the said Department shall be made after full consultation with United States industry and commerce, with the Department of State, and with other Government agencies familiar with the technical, scientific, industrial, commercial or other economic or social factors affecting the invention involved, and after consideration of the availability of valid patent protection in the countries determined to be in the United States, the United Nations and other major markets for, or producers of, the products, processes, or services covered by or relating to the invention.

The Chairman of Government Patents Board shall administer foreign patents acquired by the United States under the terms of this order and shall issue licenses thereunder in accordance with law under such rules and regulations as he shall prescribe. Nationals of the United States shall be granted licenses on a non-exclusive royalty-free basis except in such cases as he shall determine and proclaim it to be inconsistent with the public interest to issue such licenses on a nonexclusive royalty-free basis.

The Department of State, in consultation with the Chairman of Government Patents Board, shall negotiate with governments under which each government and its nationals shall have access to the foreign patents of the other participating governments. Patents relating to matters of public health, safety, or welfare, the following basic policy is established for all Government with respect to inventions made by Government employees, it is hereby ordered as follows:

1. The following basic policy is established for all Government agencies with respect to inventions hereafter made by any Government employee:

(a) The Government shall obtain the entire right, title, and interest in and to all inventions made by any Government employee (1) during working hours, or (2) with a contribution by the Government of facilities, equipment, materials, funds, or information, or of time or services of other Government employees on official duty, or (3) which bear a direct relation to or are made in consequence of the official duties of the inventor.

(b) In any case where the contribution of the Government, as measured by any one or more of the criteria set forth in paragraph (a) last above, to the invention, is insufficient equitably to justify a requirement of assignment to the Government of the entire right, title and interest in such invention, or in any case where the Government has insufficient interest in an invention to obtain entire right, title and interest therein, the Government could obtain some under paragraph (a), above, the Government agency concerned, subject to the approval of the Chairman of the Government Patents Board [now Secretary of Commerce. See Ex. Ord. No. 10930 set out as a note below] (provided for in paragraph 3 of this order and hereinafter referred to as the Chairman), leave title to such invention in the employee, subject, however, to the reservation to the Government of a non-exclusive, irrevocable, royalty-free license in the invention with power to grant licenses for all governmental purposes, such reservation, in the terms thereof, to appear, where practicable, in any patent, domestic or foreign, which may issue on such invention.

(c) In applying the provisions of paragraphs (a) and (b), above, to the facts and circumstances relating to the making of any particular invention, it shall be presumed that an invention made by an employee who is employed or assigned (1) to invent or improve or perfect any art, machine, manufacture, or composition of matter, (ii) to conduct or perform research, development work, or both, (iii) to supervise, direct, coordinate, or review Government financed or conducted research, development work, or both, (iv) to act in a liaison capacity among governmental or nongovernmental agencies or individuals engaged in such work, or made by an employee included within any other category of employees specified by regulations issued pursuant to section 4(b) hereof, falls within the provisions of paragraph (a), above, and it shall be presumed that any invention made by any other employee falls within the provisions of paragraph (b), above. Either presumption may be rebutted by the facts or circumstances attendant upon the conditions under which any particular invention is made and, notwithstanding the foregoing, shall not preclude a determination that the invention falls within the provisions of paragraph (d) next below.

(d) In any case wherein the Government neither (1) pursuant to the provisions of paragraph (a) above, obtains entire right, title and interest in and to an invention nor (2) pursuant to the provisions of paragraph (b) above, reserves a non-exclusive, irrevocable, royalty-free license in the invention with power to grant licenses for all governmental purposes, the Government shall leave the entire right, title and interest in and to the invention in the Government employee, subject to law.

(e) Actions taken, and rights acquired, under the foregoing provisions of this section, shall be reported to the Chairman in accordance with procedures established by him.

2. Subject to considerations of national security, or public health, safety, or welfare, the following basic
policy is established for the collection, and dissemination to the public, of information concerning inventions resulting from Government research and development activities:

(a) When an invention is made under circumstances defined in paragraph 1(a) of this order giving the United States the right to title thereto, the Government agency concerned shall either prepare and file an application for patent therefor in the United States Patent Office [now Patent and Trademark Office] or make a full disclosure of the invention promptly to the Chairman, who may, if he determines the Government interest so requires, cause application for patent to be filed or cause the invention to be fully disclosed by publication thereof: Provided, however, That, consistent with present practice of the Department of Agriculture, no application for patent shall, without the approval of the Secretary of Agriculture, be filed in respect of any variety of plant invented by any employee of that Department.

(b) [Revoked. Ex. Ord. No. 10930, Mar. 24, 1961, 26 F.R. 2583]

3. (a) [Revoked. Ex. Ord. No. 10930, Mar. 24, 1961, 26 F.R. 2583]

(b) The Government Patents Board shall advise and confer with the Chairman concerning the operation of those aspects of the Government's patent policy which are affected by the provisions of this order or of Executive Order No. 9865 [set out above], and suggest modifications or improvements where necessary.

(c) [Revoked. Ex. Ord. No. 10930, Mar. 24, 1961, 26 F.R. 2583]

(d) The Chairman shall establish such committees and other working groups as may be required to advise or assist him in the performance of any of his functions.

(e) The Chairman of the Government Patents Board and the Chairman of the Interdepartmental Committee on Scientific Research and Development (provided for by Executive Order No. 9912 of December 24, 1947), shall establish and maintain such mutual consultation as will effect the proper coordination of affairs of common concern.

4. With a view to obtaining uniform application of the policies set out in this order and uniform operations thereunder, the Chairman is authorized and directed:

(a) To consult and advise with Government agencies concerning the application and operation of the policies outlined herein;

(b) After consultation with the Government Patents Board, to formulate and submit to the President for approval such proposed rules and regulations as may be necessary or desirable to implement and effectuate the above policies, together with the recommendations of the Government Patents Board thereon;

(c) To submit annually a report to the President concerning the operation of such policies, and from time to time such recommendations for modification thereof as may be deemed desirable;

(d) To determine with finality any controversies or disputes between any Government agency and its employees, to the extent submitted by any party to the dispute, concerning the ownership of inventions made by such employees or rights therein; and

(e) To perform such other or further functions or duties as may from time to time be prescribed by the President or by statute.

5. The functions and duties of the Secretary of Commerce and the Department of Commerce under the provisions of Executive Order No. 9865 of June 14, 1947 [set out above] are hereby transferred to the Chairman and the whole or any part of such functions and duties may be delegated by him to any Government agency or officer: Provided, That said Executive Order No. 9865 shall not be deemed to be amended or affected by any provision of this Executive order other than this paragraph 5.

6. Each Government agency shall take all steps appropriate to effectuate this order, including the promulgation of necessary regulations which shall not be inconsistent with this order or with regulations issued pursuant to paragraph 4(b) hereof.

7. As used in this Executive order, the next stated terms, in singular and plural, are defined as follows for the purposes hereof:

(a) "Government agency" includes any executive department and any independent commission, board, office, agency, authority, or other establishment of the Executive Branch of the Government of the United States (including any such independent regulatory commission or board, any such wholly-owned corporation, and the Smithsonian Institution), but excludes the Atomic Energy Commission.

(b) "Government employee" includes any officer or employee, civilian or military, of any Government agency, except such part-time consultants or employees as may be excluded by regulations promulgated pursuant to paragraph 4(b) hereof.

(c) "Invention" includes, machine, manufacture, design, or composition of matter, or any new and useful improvement thereof, or any variety of plant, which is or may be patentable under the patent laws of the United States.

EX. ORD. No. 10695. TRANSFER OF RECORDS TO DEPARTMENT OF COMMERCE

Section 2 of Ex. Ord. 10695, Jan. 16, 1957, 22 F.R. 365, provided that: "The Chairman of the Government Patents Board is hereby authorized to transfer to the Department of Commerce any or all of the records herebefore prepared by the Board pursuant to paragraph 2(b) of Executive Order No. 10096 [set out above]."

EX. ORD. No. 10930. ABOLITION OF GOVERNMENT PATENTS BOARD

Ex. Ord. No. 10930, Mar. 24, 1961, 26 F.R. 2583, provided: By virtue of the authority vested in me as President of the United States, it is ordered as follows:

SECTION 1. The Government Patents Board, established by section 3(a) of Executive Order No. 10096 of January 23, 1950 [set out above], and all positions established thereunder or pursuant thereto are hereby abolished.

SIC. 2. All functions of the Government Patents Board and of the Chairman thereof under the said Executive Order No. 10096, except the functions of conference and consultation between the Board and the Chairman, are hereby transferred to the Secretary of Commerce, who may provide for the performance of such transferred functions by such officer, employee, or agency of the Department of Commerce as he may designate.

SIC. 3. The Secretary of Commerce shall make such provision as may be necessary and consonant with law for the disposition or transfer of property, personnel, records, and funds of the Government Patents Board.

SIC. 4. Except to the extent that they may be inconsistent with this order, all determinations, regulations, rules, rulings, orders, and other actions made or issued by the Government Patents Board, or by any Government agency with respect to any function transferred by this order, shall continue in full force and effect until amended, modified, or revoked by appropriate authority.

SIC. 5. Subsections (a) and (c) of section 3 of Executive Order No. 10096 are hereby revoked, and all other provisions of that order are hereby amended to the extent that they are inconsistent with the provisions of this order.

JOHN F. KENNEDY.

§ 208. Regulations governing Federal licensing

The Secretary of Commerce is authorized to promulgate regulations specifying the terms and conditions upon which any federally owned invention, other than inventions owned by the Tennessee Valley Authority, may be licensed on a nonexclusive, partially exclusive, or exclusive basis.
§ 209. Licensing federally owned inventions

(a) AUTHORITY.—A Federal agency may grant an exclusive or partially exclusive license on a federally owned invention under section 207(a)(2) only if—

(1) granting the license is a reasonable and necessary incentive to—

(A) call forth the investment capital and expenditures needed to bring the invention to practical application; or

(B) otherwise promote the invention's utilization by the public;

(2) the Federal agency finds that the public will be served by the granting of the license, as indicated by the applicant's intentions, plans, and ability to bring the invention to practical application or otherwise promote the invention's utilization by the public, and that the proposed scope of exclusivity is not greater than reasonably necessary to provide the incentive for bringing the invention to practical application, as proposed by the applicant, or otherwise to promote the invention's utilization by the public;

(3) the applicant makes a commitment to achieve practical application of the invention within a reasonable time, which time may be extended by the agency upon the applicant's request and the applicant's demonstration that the refusal of such extension would be unreasonable;

(4) granting the license will not tend to substantially lessen competition or create or maintain a violation of the Federal antitrust laws; and

(5) in the case of an invention covered by a foreign patent application or patent, the interests of the Federal Government or United States industry in foreign commerce will be enhanced.

(b) MANUFACTURE IN UNITED STATES.—A Federal agency shall normally grant a license under section 207(a)(2) to use or sell any federally owned invention in the United States only to a licensee who agrees that any products embodying the invention or produced through the use of the invention will be manufactured substantially in the United States.

(c) SMALL BUSINESS.—First preference for the granting of any exclusive or partially exclusive licenses under section 207(a)(2) shall be given to small business firms having equal or greater likelihood as other applicants to bring the invention to practical application within a reasonable time.

(d) TERMS AND CONDITIONS.—Any licenses granted under section 207(a)(2) shall contain such terms and conditions as the granting agency considers appropriate, and shall include provisions—

(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;

(2) requiring periodic reporting on utilization of the invention, and utilization efforts, by the licensee, but only to the extent necessary to enable the Federal agency to determine whether the terms of the license are being complied with, except that any such report shall be treated by the Federal agency as commercial and financial information obtained from a person and privileged and confidential and not subject to disclosure under section 552 of title 5; and

(3) empowering the Federal agency to terminate the license in whole or in part if the agency determines that—

(A) the licensee is not executing its commitment to achieve practical application of the invention, including commitments contained in any plan submitted in support of its request for a license, and the licensee cannot otherwise demonstrate to the satisfaction of the Federal agency that it has taken, or can be expected to take within a reasonable time, effective steps to achieve practical application of the invention;

(B) the licensee is in breach of an agreement described in subsection (b);

(C) termination is necessary to meet requirements for public use specified by Federal regulations issued after the date of the license, and such requirements are not reasonably satisfied by the licensee; or

(D) the licensee has been found by a court of competent jurisdiction to have violated the Federal antitrust laws in connection with its performance under the license agreement.

(e) PUBLIC NOTICE.—No exclusive or partially exclusive license may be granted under section 207(a)(2) unless public notice of the intention to grant an exclusive or partially exclusive license on a federally owned invention has been provided in an appropriate manner at least 15 days before the license is granted, and the Federal agency has considered all comments received before the end of the comment period in response to that public notice. This subsection shall not apply to the licensing of inventions made under a cooperative research and development agreement entered into under section 12 of the Stevenson-Wydler Technology Innovation Act of 1980 (15 U.S.C. 3710a).

(f) PLAN.—No Federal agency shall grant any license under a patent or patent application on a federally owned invention unless the person requesting the license has supplied the agency with a plan for development or marketing of the invention, except that any such plan shall be treated by the Federal agency as commercial and financial information obtained from a person and privileged and confidential and not subject to disclosure under section 552 of title 5.


AMENDMENTS

1984—Pub. L. 98–620 substituted ‘‘Secretary of Commerce’’ for ‘‘Administrator of General Services’’.
§ 210

Precedence of chapter

(a) This chapter shall take precedence over any other Act which would require a disposition of rights in subject inventions of small business firms or nonprofit organizations contractors in a manner that is inconsistent with this chapter, including but not necessarily limited to the following:

1. section 10(a) of the Act of June 29, 1935, as added by title I of the Act of August 14, 1946; (7 U.S.C. 4271(a); 60 Stat. 1085;
2. section 203(a) of the Act of August 14, 1946; (7 U.S.C. 1624(a); 60 Stat. 1990);
3. section 501(c) of the Federal Mine Safety and Health Act of 1977; (30 U.S.C. 951(c); 83 Stat. 742);
4. section 30168(e) of title 49;
5. section 12 of the National Science Foundation Act of 1950; (42 U.S.C. 1871(a); 82 Stat. 360);
6. section 152 of the Atomic Energy Act of 1954; (42 U.S.C. 2182; 68 Stat. 943);
7. section 20135 of title 51;
8. section 6 of the Coal Research and Development Act of 1960; (30 U.S.C. 666; 74 Stat. 337);
9. section 4 of the Helium Act Amendments of 1960; (50 U.S.C. 167(h); 74 Stat. 290);
10. section 32 of the Arms Control and Disarmament Act of 1961; (22 U.S.C. 2572; 75 Stat. 634);
11. section 9 of the Federal Nonnuclear Energy Research and Development Act of 1974; (42 U.S.C. 5908; 88 Stat. 1878);
12. section 5(d) of the Consumer Product Safety Act; (15 U.S.C. 2054(d); 86 Stat. 1211);
13. section 3 of the Act of April 5, 1944; (30 U.S.C. 323; 58 Stat. 191); 1
14. section 8001(c)(3) of the Solid Waste Disposal Act; (42 U.S.C. 6981(e); 90 Stat. 2629);
15. section 219 of the Foreign Assistance Act of 1961; (22 U.S.C. 2179; 83 Stat. 806);
16. section 427(b) of the Federal Mine Health and Safety Act of 1977; (30 U.S.C. 937(b); 86 Stat. 155);
17. section 306(d) of the Surface Mining and Reclamation Act of 1977; (30 U.S.C. 1226(d); 91 Stat. 455); 1
18. section 21(d) of the Federal Fire Prevention and Control Act of 1974; (15 U.S.C. 2218(d); 88 Stat. 1548);
19. section 6(b) of the Solar Photovoltaic Energy Research Development and Demonstration Act of 1978; (42 U.S.C. 5585(b); 92 Stat. 2516);

1 See References in Note text below.

The Act creating this chapter shall be construed to take precedence over any future Act unless that Act specifically cites this Act and provides that it shall take precedence over this Act.

(b) Nothing in this chapter is intended to alter the effect of the laws cited in paragraph (a) of this section or any other laws with respect to the disposition of rights in inventions made in the performance of funding agreements with persons other than nonprofit organizations or small business firms.

(c) Nothing in this chapter is intended to limit the authority of agencies to agree to the disposition of rights in inventions made in the performance of work under funding agreements with persons other than nonprofit organizations or small business firms in accordance with the Statement of Government Patent Policy issued on February 18, 1983, agency regulations, or other applicable regulations or to otherwise limit the authority of agencies to allow such persons to retain ownership of inventions except that all funding agreements, including those with other than small business firms and nonprofit organizations, shall include the requirements established in section 202(c)(4) and section 203. Any disposition of rights in inventions made in accordance with the Statement or implementing regulations, including any disposition occurring before enactment of this section, are hereby authorized.

(d) Nothing in this chapter shall be construed to require the disclosure of intelligence sources or methods or to otherwise affect the authority granted to the Director of Central Intelligence by statute or Executive order for the protection of intelligence sources or methods.

(e) The provisions of the Stevenson-Wydler Technology Innovation Act of 1999 shall take precedence over the provisions of this chapter to the extent that they permit or require a disposition of rights in subject inventions which is inconsistent with this chapter.

13 and 41 of this title. For complete classification of this Act to the Code, see Tables.


Section 12 of the National Science Foundation Act of 1950 (42 U.S.C. 1871(a); 82 Stat. 360), referred to in subsec. (a)(5), was amended by Pub. L. 99–159, title I, §109(c), Nov. 22, 1985, 99 Stat. 889, by striking out subsec. (b) and designating subsec. (a) as the entire section.

Section 3 of the Act of April 5, 1944 (30 U.S.C. 323; 58 Stat. 191), referred to in subsec. (a)(13), was omitted from the Code.

Section 306(d) of the Surface Mining and Reclamation Act, referred to in subsec. (a)(17), was classified to section 1226d of Title 30, Mineral Lands and Mining, prior to enactment of Pub. L. 98–409, which enacted a new section 1226d of Title 30. See section 1226e(c) of Title 30.


For complete classification of this Act to the Code, see Short Title note set out under section 3701 of Title 15 and Tables.

**AMENDMENTS**

2011—Subsec. (c). Pub. L. 112–29 struck out “of this title” after “‘303’.”


1998—Subsec. (a)(11) to (22). Pub. L. 105–339 redesignated pars. (12) to (21) as (11) to (20), respectively, and struck out former par. (11) which read as follows: “subsection (e) of section 302 of the Appalachian Regional Development Act of 1965 (40 U.S.C. App. §302(c); 79 Stat. 5)”.


1984—Subsec. (c). Pub. L. 98–620 substituted “February 18, 1983” for “August 23, 1971 (56 Fed. Reg. 16687)” and inserted provision that all funding agreements, including those with other than small business firms and nonprofit organizations, shall include the requirements established in paragraph 302(c)(4) and section 303 of this title.

**CHANGE OF NAME**

Reference to the Director of Central Intelligence or the Director of the Central Intelligence Agency in the Director’s capacity as the head of the intelligence community deemed to be a reference to the Director of National Intelligence. Reference to the Director of Central Intelligence or the Director of the Central Intelligence Agency in the Director’s capacity as the head of the Central Intelligence Agency deemed to be a reference to the Director of the Central Intelligence Agency. See section 1081(a), (b) of Pub. L. 108–458, set out as a note under section 3001 of Title 50, War and National Defense.

**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 proceedings commenced on or after that effective date, see section 280(f) of Pub. L. 112–29, set out as a note under section 2 of this title.

**§ 211. Relationship to antitrust laws**

Nothing in this chapter shall be deemed to convey to any person immunity from civil or criminal liability, or to create any defenses to actions, under any antitrust law.


**§ 212. Disposition of rights in educational awards**

No scholarship, fellowship, training grant, or other funding agreement made by a Federal agency primarily to an awardee for educational purposes will contain any provision giving the Federal agency any rights to inventions made by the awardee.


**PART III—PATENTS AND PROTECTION OF PATENT RIGHTS**

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**AMENDMENTS**

2011—Pub. L. 112–29, §6(b), (e), Sept. 16, 2011, 125 Stat. 304, 311, added items for chapters 31 and 32 and struck out former item for chapter 31 “Optional Inter Partes Reexamination of Patents”.


**CHAPTER 25—AMENDMENT AND CORRECTION OF PATENTS**

Sec. 251. Reissue of defective patents.
§ 251. Reissue of defective patents

(a) In GENERAL.—Whenever any patent is, through error, 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 unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

(b) MULTIPLE REISSUED PATENTS.—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.

(c) APPLICABILITY OF THIS TITLE.—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 in the original patent. No new matter shall be introduced into the application for reissue.

(d) REISSUE PATENT ENLARGING SCOPE OF CLAIMS.—No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the date of the original patent.


§ 252. Effect of reissue

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are substantially identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are substantially identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

A reissued patent shall not abridge or affect the right of any person or that person’s successors in business who, prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to the extent that its claims are substantially identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.
specified, or for the manufacture, use, offer for sale, or sale in the United States of which substantial preparation was made before the grant of the reissue, and the court may also provide for the continued practice of any process practiced by the original patentee, or for the practice of which substantial preparation was made, before the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.


HISTORICAL AND Revision Notes


The first paragraph follows the present section with some rearrangement in language. The second paragraph adds new provisions for the protection of intervening rights, and the court is given discretion to protect legitimate activities which would be adversely affected by the grant of a reissue and things made before the grant of the reissue are not subject to the reissue unless a claim of the original patent which is repeated in the reissue is infringed.

AMENDMENTS


1994—Pub. L. 103–465 amended second par. generally. Prior to amendment, second par. read as follows: “No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practice, or for the practice of which substantial preparation was made, prior to the grant of the reissue to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.”

EFFECTIVE Date of 1999 Amendment

Amendment by Pub. L. 106–113 effective Nov. 29, 2000, and applicable only to applications (including international applications designating the United States) filed on or after that date, see section 100(a)(9) (title IV, §4508) of Pub. L. 106–113, as amended, set out as a note under section 10 of this title.

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 334(a), (b)(3) of Pub. L. 103–465, set out as a note under section 154 of this title.

§ 253. Disclaimer

(a) In GENERAL.—Whenever a claim of a patent is invalid the remaining claims shall not there-
§ 255

TITLE 35—PATENTS

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HISTORICAL AND REVISION NOTES


The last sentence of the present section is omitted as obsolete. A sentence is added similar to a provision in the corresponding section in the trade-mark law, 15 U.S.C., 1946 ed., §1057(f), and provides that the Commissioner may issue a corrected patent instead of a certificate of correction.

AMENDMENTS


§ 256. Correction of named inventor

(a) CORRECTION.—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, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

(b) PATENT VALID IF ERROR CORRECTED.—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.

1999—Pub. L. 106–113, as amended by Pub. L. 107–273, substituted “Correction of named inventor” for “Misjoinder of inventor” as section catchline and, in text, substituted “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” after “not named in an issued patent”.


EFFECTIVE DATE OF 1999 AMENDMENT


EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 111 of Title 15, Commerce and Trade.

§ 255. Certificate of correction of applicant’s mistake

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

1999—Pub. L. 106–113, as amended by Pub. L. 107–273, substituted “Correction of named inventor” for “Misjoinder of inventor” as section catchline and, in text, substituted “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” after “not named in an issued patent”.


HISTORICAL AND REVISION NOTES

This section is new and is companion to section 116. The first two paragraphs provide for the correction of the inadvertent joining or nonjoining of a person as a joint inventor. The third paragraph provides that a patent shall not be invalid for such cause, and also provides that a court may order correction of a patent; the two sentences of this paragraph are independent.

AMENDMENTS

2011—Pub. L. 112–29 designated first and second pars. as subsecs. (a) and (b), respectively, inserted headings, and, in subsec. (a), struck out “and such error arose without any deceptive intention on his part” after “not named in an issued patent”.


1982—Pub. L. 97–247 substituted “Correction of named inventor” for “Misjoinder of inventor” as section catchline and, in text, substituted “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” after “not named in an issued patent”.


any deceptive intention, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent.”, substituted “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” for “Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate adding his name to the patent as a joint inventor”, and struck out provision that the misjoinder or nonjoinder of joint inventors not invalidate a patent, if such error could be corrected as provided in 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 proceedings commenced on or after that effective date, see section 20(f) of Pub. L. 112–29, set out as a note under section 2 of this title.

Effective Date of 1999 Amendment

Effective Date of 1982 Amendment
Amendment by Pub. L. 97–247 effective six months after Aug. 27, 1982, see section 17(c) of Pub. L. 97–247, set out as an Effective Date note under section 294 of this title.

§ 257. Supplemental examinations to consider, reconsider, or correct information
(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.

(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 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.

(c) Effect.—

(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), or the absence thereof, shall not be relevant to enforceability of the patent under section 282.

(2) Exceptions.—

(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 552((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.

(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, paragraph (1) shall not apply to any defense raised in the action that is based upon information that was considered, reconsidered, or 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.

(d) Fees and regulations.—

(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.

(2) Regulations.—The Director shall issue regulations governing the form, content, and other requirements of requests for supplemental examination, and establishing procedures for reviewing information submitted in such requests.

(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 charges a person with a criminal offense in connection with such referral.

(f) Rule of construction.—Nothing in this section shall be construed—
(1) to preclude the imposition of sanctions based upon criminal or antitrust laws (including section 1011(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);

(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

(3) to limit the authority of the Director to issue regulations under chapter 3 relating to sanctions for misconduct by representatives practicing before the Office.

(Added and amended Pub. L. 112–29, §§12(a), 20(j), Sept. 16, 2011, 125 Stat. 325, 335.)

REFERENCES IN TEXT

The first section of the Clayton Act, referred to in subsec. (f)(1), is classified to section 12 of Title 15, Commerce and Trade, and section 53 of Title 29, Labor.

Section 5 of the Federal Trade Commission Act, referred to in subsec. (f)(1), is classified to section 45 of Title 15, Commerce and Trade.

AMENDMENTS


EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 20(j) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112–29, set out as a note under section 2 of this title.

EFFECTIVE DATE

Pub. L. 112–29, §12(c), Sept. 16, 2011, 125 Stat. 327, provided that: “The amendments made by this section [enacting this section] 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.”

CHAPTER 26—OWNERSHIP AND ASSIGNMENT

Sec. 261. Ownership; assignment.

262. Joint owners.

§ 261. Ownership; assignment

Subject to the provisions of this title, patents shall have the attributes of personal property. The Patent and Trademark Office shall maintain a register of interests in patents and applications for patents and shall record any document related thereto upon request, and may require a fee therefor.

Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States, or, in a foreign country, of a diplomatic or consular officer of the United States or an officer authorized to administer oaths whose authority is proved by a 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, shall be prima facie evidence of the execution of an assignment, grant or conveyance of a patent or application for patent.

An interest that constitutes an assignment, grant or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.


HISTORICAL AND REVISION NOTES


The first paragraph is new but is declaratory only. The second paragraph is the same as in the corresponding section of existing statute. The third paragraph is from the existing statute, a specific reference to another statute is omitted. The fourth paragraph is the same as the existing statute but language has been changed.

AMENDMENTS

2012—Pub. L. 112–211 inserted “The Patent and Trademark Office shall maintain a register of interests in patents and applications for patents and shall record any document related thereto upon request, and may require a fee therefor.” at end of first par. and substituted “An interest that constitutes an assignment” for “An assignment” in fourth par.

1982—Pub. L. 97–247 inserted “; 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”.


EFFECTIVE DATE OF 2012 AMENDMENT

Amendment by Pub. L. 112–211 effective on the date that is 1 year after Dec. 18, 2012, applicable to patents issued before, on, or after that effective date and patent applications pending on or filed after that effective date, and not effective with respect to patents in litigation commenced before that effective date, see section 203 of Pub. L. 112–211, set out as an Effective Date note under section 27 of this title.

EFFECTIVE DATE OF 1982 AMENDMENT


EFFECTIVE DATE OF 1975 AMENDMENT


§ 282. Joint owners

In the absence of any agreement to the contrary, each of the joint owners of a patent may
make, use, offer to sell, or sell the patented invention within the United States, or import the patented invention into the United States, without the consent of and without accounting to the other owners.


HISTORICAL AND REVISION NOTES
This section states a condition in existing law not expressed in the existing statutes.

Amendments
1994—Pub. L. 103–465 substituted “use, offer to sell, or sell” for “use or sell” and inserted “within the United States, or import the patented invention into the United States” after “invention”.

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, as one year after date on which the WTO Agreement enters into force with respect to the United States, or import the patented invention into the United States, 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 27—GOVERNMENT INTERESTS IN PATENTS

Sec. 266. [Repealed.]
267. Time for taking action in Government applications.

Amendments


Section, act July 19, 1952, ch. 950, §1, 66 Stat. 811, provided for issuance of patents to government employees without fees.

EFFECTIVE DATE OF REPEAL
Repeal effective three months after July 24, 1965, see section 7(a) of Pub. L. 89–83, set out as an Effective Date of 1965 Amendment note under section 41 of this title.

§267. Time for taking action in Government applications

Notwithstanding the provisions of sections 133 and 151, the Director may extend the time for taking any action to three years, when an application has become the property of the United States and the head of the appropriate department or agency of the Government has certified to the Director that the invention disclosed therein is important to the armament or defense of the United States.


HISTORICAL AND REVISION NOTES

This provision, which appears as the last two sentences of the corresponding section of the present statute (see note to section 133) is made a separate section and rewritten in simpler form.

Amendments
2011—Pub. L. 112–29 struck out “of this title” after “151”.


EFFECTIVE DATE OF 2011 AMENDMENT
Amendment by section 20(j) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112–29, set out as a note under section 2 of this title.

EFFECTIVE DATE OF 1999 AMENDMENT

CHAPTER 28—INFRINGEMENT OF PATENTS

Sec. 271. Infringement of patent.
272. Temporary presence in the United States.
273. Defense to infringement based on prior commercial use.

Amendments


§271. Infringement of patent

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, in the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from
acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement; (4) refused to license or use any rights to the patent; or (5) conditioned the license of any rights to the patent or the sale of the patented product on the acquisition of a license to rights in another patent or purchase of a separate product, unless, in view of the circumstances, the patent owner has market power in the relevant market for the patent or patented product on which the license or sale is conditioned.

(e)(1) It shall not be an act of infringement to make, use, offer to sell, or sell within the United States a patented invention (other than a new animal drug or veterinary biological product (as those terms are defined under the Federal Food, Drug, and Cosmetic Act and the Act of March 4, 1913 (21 U.S.C. 151–158)) which is primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques) solely for uses reasonably related to the development and submission of information under a Federal law which regulates the manufacture, use, or sale of drugs or veterinary biological products.

(2) It shall be an act of infringement to submit—

(A) an application under section 505(j) of the Federal Food, Drug, and Cosmetic Act described in section 505(b)(2) of such Act for a drug claimed in a patent or the use of which is claimed in a patent,

(B) an application under section 512 of such Act for a drug or veterinary biological product which is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques and which is claimed in a patent or the use of which is claimed in a patent,

(C)(i) with respect to a patent that is identified in the list of patents described in section 351(l)(3) of the Public Health Service Act (including as provided under section 351(l)(7) of such Act), an application seeking approval of a biological product, or

(ii) if the applicant for the application fails to provide the application and information required under section 351(l)(2)(A) of such Act, an application seeking approval of a biological product for a patent that could be identified pursuant to section 351(l)(3)(A)(i) of such Act, if the purpose of such submission is to obtain approval under such Act to engage in the commercial manufacture, use, or sale of a drug, veterinary biological product, or biological product claimed in a patent or the use of which is claimed in a patent before the expiration of such patent

(3) In any action for patent infringement brought under this section, no injunctive or other relief may be granted which would prohibit the making, using, offering to sell, or selling within the United States or importing into the United States of a patented invention under paragraph (1).

(4) For an act of infringement described in paragraph (2)—

(A) the court shall order the effective date of any approval of the drug or veterinary biological product involved in the infringement to be a date which is not earlier than the date of the expiration of the patent which has been infringed,

(B) injunctive relief may be granted against an infringer to prevent the commercial manufacture, use, offer to sell, or sale within the United States or import into the United States of a patented drug, veterinary biological product, or biological product,

(C) damages or other monetary relief may be awarded against an infringer only if there has been commercial manufacture, use, offer to sell, or sale within the United States or importation into the United States of an approved drug, veterinary biological product, or biological product, and

(D) the court shall order a permanent injunction prohibiting any infringement of the patent by the biological product involved in the infringement until a date which is not earlier than the date of the expiration of the patent that has been infringed under paragraph (2)(C), provided the patent is the subject of a final court decision, as defined in section 351(k)(6) of the Public Health Service Act, in an action for infringement of the patent under section 351(l)(6) of such Act, and the biological product has not yet been approved because of section 351(k)(7) of such Act.

The remedies prescribed by subparagraphs (A), (B), (C), and (D) are the only remedies which may be granted by a court for an act of infringement described in paragraph (2), except that a court may award attorney fees under section 285.

(5) Where a person has filed an application described in paragraph (2) that includes a certification under subsection (b)(2)(A)(iv) or (j)(2)(A)(vii)(IV) of section 505 of the Federal Food, Drug, and Cosmetic Act (21 U.S.C. 355), and neither the owner of the patent that is the subject of the certification nor the holder of the approved application under subsection (b) of such section for the drug that is claimed by the patent or a use of which is claimed by the patent brought an action for infringement of such patent before the expiration of 45 days after the date on which the notice given under subsection (b)(3) or (j)(2)(B) of such section was received, the courts of the United States shall, to the extent consistent with the Constitution, have subject matter jurisdiction in any action brought by such person under section 2201 of title 28 for a declaratory judgment that such patent is invalid or not infringed.

(6)(A) Subparagraph (B) applies, in lieu of paragraph (4), in the case of a patent—

(i) that is identified, as applicable, in the list of patents described in section 351(l)(4) of the Public Health Service Act or the list of patents described in section 351(l)(5)(B) of such Act with respect to a biological product; and
(ii) for which an action for infringement of the patent with respect to the biological product—

(I) was brought after the expiration of the 30-day period described in subparagraph (A) or (B), as applicable, of section 351(a)(6) of such Act; or

(II) was brought before the expiration of the 30-day period described in subclause (I), but which was dismissed without prejudice or was not prosecuted to judgment in good faith.

(B) In an action for infringement of a patent described in subparagraph (A), the sole and exclusive remedy that may be granted by a court, upon a finding that the making, using, offering to sell, selling, or importation into the United States of the biological product that is the subject of the action infringed the patent, shall be a reasonable royalty.

(C) The owner of a patent that should have been included in the list described in section 351(l)(A) of the Public Health Service Act, including as provided under section 351(l)(B) of such Act for a biological product, but was not timely included in such list, may not bring an action under this section for infringement of the patent with respect to the biological product.

(1) Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

(2) Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, where such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

(h) As used in this section, the term “whoever” includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this title in the same manner and to the same extent as any nongovernmental entity.

(i) As used in this section, an “offer for sale” or an “offer to sell” by a person other than the patentee, or any designee of the patentee, that in which the sale will occur before the expiration of the term of the patent.


HISTORICAL AND REVISION NOTES

The first paragraph of this section is declaratory only, defining infringement.

Paragraphs (b) and (c) define and limit contributory infringement of a patent and paragraph (d) is ancillary to these paragraphs, see preliminary general description of bill. One who actively induces infringement as by aiding and abetting the same is liable as an infringer, and so is one who sells a component part of a patented invention or material or apparatus for use therein knowing the same to be especially made or especially adapted for use in the infringement of the patent except in the case of a staple article or commodity of commerce having other uses. A patentee is not deemed to have misused his patent solely by reason of doing anything authorized by the section.

REFERENCES IN TEXT

The Federal Food, Drug, and Cosmetic Act, referred to in subsec. (e)(1), (2), is act June 25, 1906, ch. 498, 34 Stat. 765, which is classified generally to chapter 9 (§301 et seq.) of Title 21, Food and Drugs. Sections 505 and 512 of the Act are classified to sections 355 and 360b, respectively, of Title 21. For complete classification of this Act to the Code, see section 301 of Title 21 and Tables.

Act of March 4, 1913, referred to in subsec. (e)(1), (2), is act Mar. 4, 1913, ch. 145, 37 Stat. 838. The provisions of such act relating to viruses, etc., applicable to domestic animals, popularly known as the Virus-Serum-Toxin Act, are contained in the eighth paragraph under the heading “Bureau of Animal Industry” of act Mar. 4, 1913, at 37 Stat. 832, and are classified generally to chapter 5 (§151 et seq.) of Title 21, Food and Drugs. For complete classification of this Act to the Code, see Short Title note set out under section 151 of Title 21 and Tables.

Section 351 of the Public Health Service Act, referred to in subsec. (e)(2)(C), (D), (E)(A), (C), is classified to section 262 of Title 42, The Public Health and Welfare.

AMENDMENTS


Effective Date of 1988 Amendment

Amendment by Pub. L. 100–703 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 2541 of Title 7, Agriculture.

Effective Date of 1984 Amendment

Amendment by Pub. L. 98–622 applicable only to the supplying, or causing to be supplied, of any component or notes of components of a patented invention after Nov. 8, 1984, see section 106(c) of Pub. L. 98–622, set out as a note under section 103 of this title.

Reports to Congress; Effective on Domestic Industries of Process Patent Amendments Act of 1988

Amendment by Pub. L. 100–418, title IX, §9007, Aug. 23, 1988, 102 Stat. 1566, provided that: "The amendments made by this title [amending this section] shall not apply to cases filed on or after the date of the enactment of this title [Aug. 23, 1988]."

Temporary Presence in the United States

The use of any invention in any vessel, aircraft or vehicle of any country which affords similar privileges to vessels, aircraft or vehicles of the United States, entering the United States temporarily or accidentally, shall not constitute infringement of any patent, if the invention is used exclusively for the needs of the vessel, aircraft or vehicle and is not offered for sale or sold in or used for the manufacture of anything to be sold in or exported from the United States.
§ 273. Defense to infringement based on prior commercial use

(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—

(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

(2) such commercial use occurred at least 1 year before the earlier of either—

(A) the effective filing date of the claimed invention; or

(B) the date on which the claimed invention was disclosed to the public in a manner that qualified for the exception from prior art under section 102(b).

(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.

(c) ADDITIONAL COMMERCIAL USES.—

(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.

(2) NONPROFIT LABORATORY USE.—A use of subject matter by a nonprofit research laboratory or other 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.

(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.

(e) LIMITATIONS AND EXCEPTIONS.—

(1) PERSONAL DEFENSE.—

(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.

(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.

(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 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.

(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.

(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 patent.

(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.

(5) UNIVERSITY EXCEPTION.—

(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 Edu-
CHAPTER 29—REMEDIES FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

Sec.
281. Remedy for infringement of patent.
282. Presumption of validity; defenses.
283. Injunction.
284. Damages.
285. Attorney fees.
286. Time limitation on damages.
287. Limitation on damages and other remedies; marking and notice.
288. Action for infringement of a patent containing an invalid claim.
289. Additional remedy for infringement of design patent.
290. Notice of patent suits.
291. Derived patents.
292. False marking.
293. Nonresident patentee, service and notice.  

Note: The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(a) In General.—A patent shall 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. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.

(b) Defenses.—The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement or unenforceability.

(2) Invalidity of the patent or any claim in suit on any ground specified in part II as a condition for patentability.

(3) Invalidity of the patent or any claim in suit for failure to comply with—

(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

(B) any requirement of section 251.
(4) Any other fact or act made a defense by this title.

(c) NOTICE OF ACTIONS; ACTIONS DURING EXTENSION OF PATENT TERM.—In an action 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 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. Invalidity of the extension of a patent term or any portion thereof under section 154(b) or 156 because of the material failure—

(1) by the applicant for the extension, or
(2) by the Director,


HISTORICAL AND REvision NOTES


The third paragraph, relating to notice of prior patents, publications and uses, is based on part of the last paragraph of R.S. 4920 which was superseded by the Federal Rules of Civil Procedure but which is reinstated with modifications.

AMENDMENTS

2011—Pub. L. 112–29, §20(g)(1), (2)(A), (C), (3), (j), designated first to third paras. as subsec. (a) to (c), respectively, inserted headings, in subsec. (a), struck out third sentence which read “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)(4), the process shall no longer be considered nonobvious solely on the basis of section 103(b)(1),” in par. (2) of subsec. (b), struck out “of this title” after “156” and substituted “in an action involving the validity or infringement of a patent” for “in an action involving the validity or infringement of a patent” and “Court of Federal Claims” for “Claims Court”.

Pub. L. 112–29, §20(g)(2)(B), which directed substitution of “unenforceability,” for “unforceability,” in par. (1) of former second par. which was designated subsec. (b), was executed by making the substitution for “unenforceability,” to reflect the probable intent of Congress.

Pub. L. 112–29, §15(a), amended second par. by substituting “(3) Invalidity of the patent or any claim in suit for failure to comply with—

“(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
“(B) any requirement of section 282,”

for “(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 282 of this title,”.


Pub. L. 106–113, §1000(a)(9) [title IV, §4402(b)(1)], as amended by Pub. L. 107–273, §13206(b)(4), substituted “154(b) or 156 of this title” for “156 of this title”.

1995—First par. Pub. L. 104–41 inserted after second sentence “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),”.

1994—Pub. L. 98–417 inserted provision at end that the invalidity of the extension of a patent term or any portion thereof under section 156 of this title because of the material failure by the applicant for the extension, or by the Commissioner, to comply with the requirements of such section shall be a defense in any action involving the infringement of a patent during the period of the extension of its term and shall be pleaded, and that a due diligence determination under section 156(d)(2) is not subject to review in such an action.


1975—First par. Pub. L. 94–131 made presumption of validity applicable to claim of a patent in multiple dependent form and multiple dependent claims and substituted—asserting such invalidity” for “asserting it”.

1965—Pub. L. 89–83 made presumption of validity applicable to claim of a patent in multiple dependent form and multiple dependent claims and substitute—asserting such invalidity” for “asserting it”.

1952—Pub. L. 89–83 required each claim of a patent to be presumed valid independently of the validity of other claims and required dependent claims to be presumed valid even though dependent upon an invalid claim.

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 15(a) of Pub. L. 112–29 effective on Sept. 16, 2011, and applicable to proceedings commenced on or after that date, see section 15(c) of Pub. L. 112–29, set out as a note under section 119 of this title.

Amendment by section 20(g), (j) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112–29, set out as a note under section 2 of this title.

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by section 1000(a)(9) [title IV, §4402(b)(1)] of Pub. L. 106–113 effective on date that is 6 months
after Nov. 29, 1999, and, except for design patent application filed under chapter 16 of this title, applicable to any application filed on or after such date, see section 1000(a)(9) [title IV, §446(a)] of Pub. L. 106–113, set out as a note under section 154 of this title.


**Effective Date of 1982 Amendment**

**Effective Date of 1975 Amendment**
Amendment by Pub. L. 94–131 effective Jan. 24, 1976, and applicable on and after that date to patent applications filed in the United States and to international applications, where applicable, see section 11 of Pub. L. 94–131, set out as an Effective Date note under section 351 of this title.

**Effective Date of 1965 Amendment**
Amendment by Pub. L. 89–83 effective, on such terms as the court deems reasonable, on such terms as the court deems reasonable.

(July 19, 1952, ch. 950, 66 Stat. 812.)

**Historical and Revision Notes**

This section is the same as the provision which opens § 4921 with minor changes in language.

§ 283. Injunction

The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.

(July 19, 1952, ch. 950, 66 Stat. 812.)

**Historical and Revision Notes**

This section is the same as the provision which opens R.S. 4921 with minor changes in language.

§ 284. Damages

Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event more than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed. Increased damages under this paragraph shall not apply to provisional rights under section 154(d).

The court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances.


**Historical and Revision Notes**

This section consolidates the provisions relating to damages in R.S. 4919 and 4921, with some changes in language.

**Amendments**

2011—Second par, Pub. L. 112–29 struck out "of this title" after "154(d)".

1999—Second par, Pub. L. 106–113 inserted at end "Increased damages under this paragraph shall not apply to provisional rights under section 154(d) of this title."

**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 proceedings commenced on or after that effective date, see section 28(k) of Pub. L. 112–29, set out as a note under section 2 of this title.

**Effective Date of 1999 Amendment**
Amendment by Pub. L. 106–113 effective Nov. 29, 2000, and applicable only to applications (including international applications designating the United States) filed on or after that date, see section 1000(a)(9) [title IV, §4508] of Pub. L. 106–113, as amended, set out as a note under section 10 of this title.

§ 285. Attorney fees

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

(July 19, 1952, ch. 950, 66 Stat. 813.)

**Historical and Revision Notes**

This section is substantially the same as the corresponding provision in R.S. 4921; "in exceptional cases" has been added as expressing the intention of the present statute as shown by its legislative history and as interpreted by the courts.

§ 286. Time limitation on damages

Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.

In the case of claims against the United States Government for use of a patented invention, the period before bringing suit, up to six years, between the date of receipt of a written claim for compensation by the department or agency of the Government having authority to settle such claim, and the date of mailing by the Government of a notice to the claimant that his claim has been denied shall not be counted as part of the period referred to in the preceding paragraph.

(July 19, 1952, ch. 950, 66 Stat. 813.)

**Historical and Revision Notes**

The first paragraph is the same as the provision in R.S. 4921 with minor changes in language, with the added provision relating to the date for counterclaims for infringement.

The second paragraph is new and relates to extending the period of limitations with respect to suits in the Court of Claims in certain instances when administrative consideration is pending.
§ 287. Limitation on damages and other remedies; marking and notice

(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 patent, 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, 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.

(b)(1) An infringer under section 271(g) shall be subject to all the provisions of this title relating to damages and injunctions except to the extent those remedies are modified by this subsection or section 9006 of the Process Patent Amendments Act of 1988. The modifications of remedies provided in this subsection shall not be available to any person who—

(A) practiced the patented process;
(B) owns or controls, or is owned or controlled by, the person who practiced the patented process; or
(C) had knowledge before the infringement that a patented process was used to make the product the importation, use, offer for sale, or sale of which constitutes the infringement.

(2) No remedies for infringement under section 271(g) shall be available with respect to any product in the possession of, or in transit to, the person subject to liability under such section before that person had notice of infringement with respect to that product. The person subject to liability shall bear the burden of proving any such possession or transit.

(3)(A) In making a determination with respect to the remedy in an action brought for infringement under section 271(g), the court shall consider—

(i) the good faith demonstrated by the defendant with respect to a request for disclosure;
(ii) the good faith demonstrated by the plaintiff with respect to a request for disclosure, and
(iii) the need to restore the exclusive rights secured by the patent.

(B) For purposes of subparagraph (A), the following are evidence of good faith:

(i) a request for disclosure made by the defendant;
(ii) a response within a reasonable time by the person receiving the request for disclosure; and
(iii) the submission of the response by the defendant to the manufacturer, or if the manufacturer is not known, to the supplier, of the product to be purchased by the defendant, together with a request for a written statement that the process claimed in any patent disclosed in the response is not used to produce such product.

The failure to perform any acts described in the preceding sentence is evidence of absence of good faith unless there are mitigating circumstances. Mitigating circumstances include the case in which, due to the nature of the product, the number of sources for the product, or like commercial circumstances, a request for disclosure is not necessary or practicable to avoid infringement.

(4)(A) For purposes of this subsection, a “request for disclosure” means a written request made to a person then engaged in the manufacture of a product to identify all process patents owned by or licensed to that person, as of the time of the request, that the person reasonably believes could be asserted to be infringed under section 271(g) if that product were imported into, or sold, offered for sale, or used in, the United States by an unauthorized person. A request for disclosure is further limited to a request—

(i) which is made by a person regularly engaged in the United States in the sale of the same type of products as those manufactured by the person to whom the request is directed, or which includes facts showing that the person making the request plans to engage in the sale of such products in the United States;
(ii) which is made by such person before the person’s first importation, use, offer for sale, or sale of units of the product produced by an infringing process and before the person had notice of infringement with respect to the product; and
(iii) which includes a representation by the person making the request that such person will promptly submit the patents identified pursuant to the request to the manufacturer, or if the manufacturer is not known, to the supplier, of the product to be purchased by the person making the request, and will request from that manufacturer or supplier a written statement that none of the processes claimed in those patents is used in the manufacture of the product.

(B) In the case of a request for disclosure received by a person to whom a patent is licensed, that person shall either identify the patent or promptly notify the licensor of the request for disclosure.

(C) A person who has marked, in the manner prescribed by subsection (a), the number of the process patent on all products made by the patented process which have been offered for sale or sold by that person in the United States, or imported by the person into the United States, before a request for disclosure is received is not required to respond to the request for disclosure. For purposes of the preceding sentence, the term “all products” does not include products made before the effective date of the Process Patent Amendments Act of 1988.
§ 287

(5)(A) For purposes of this subsection, notice of infringement means actual knowledge, or receipt by a person of a written notification, or a combination thereof, of information sufficient to persuade a reasonable person that it is likely that a product was made by a process patented in the United States.

(B) A written notification from the patent holder charging a person with infringement shall specify the patented process alleged to have been used and the reasons for a good faith belief that such process was used. The patent holder shall include in the notification such information as is reasonably necessary to explain fairly the patent holder’s belief, except that the patent holder is not required to disclose any trade secret information.

(C) A person who receives a written notification described in subparagraph (B) or a written response to a request for disclosure described in paragraph (4) shall be deemed to have notice of infringement with respect to any patent referred to in such written notification or response unless that person, absent mitigating circumstances—

(i) promptly transmits the written notification or response to the manufacturer or, if the manufacturer is not known, to the supplier, of the product purchased or to be purchased by that person; and

(ii) receives a written statement from the manufacturer or supplier which on its face sets forth a well grounded factual basis for a belief that the identified patents are not infringed.

(D) For purposes of this subsection, a person who obtains a product made by a process patented in the United States in a quantity which is abnormally large in relation to the volume of business of such person or an efficient inventory level shall be rebuttably presumed to have actual knowledge that the product was made by such patented process.

(6) A person who receives a response to a request for disclosure under this subsection shall pay to the person to whom the request was made a reasonable fee to cover actual costs incurred in complying with the request, which may not exceed the cost of a commercially available automated patent search of the matter involved, but in no case more than $500.

(c)(1) With respect to a medical practitioner’s performance of a medical activity that constitutes an infringement under section 271(a) or (b), the provisions of sections 281, 283, 284, and 285 shall not apply against the medical practitioner or against a related health care entity with respect to such medical activity.

(2) For the purposes of this subsection:

(A) the term “medical activity” means the performance of a medical or surgical procedure on a body, but shall not include (i) the use of a patented machine, manufacture, or composition of matter in violation of such patent, (ii) the practice of a patented use of a composition of matter in violation of such patent, or (iii) the practice of a process in violation of a biotechnology patent.

(B) the term “medical practitioner” means any natural person who is licensed by a State to provide the medical activity described in subsection (c)(1) or who is acting under the direction of such person in the performance of the medical activity.

(C) the term “related health care entity” shall mean an entity with which a medical practitioner has a professional affiliation under which the medical practitioner performs the medical activity, including but not limited to a nursing home, hospital, university, medical school, health maintenance organization, group medical practice, or a medical clinic.

(D) the term “professional affiliation” shall mean staff privileges, medical staff membership, employment or contractual relationship, partnership or ownership interest, academic appointment, or other affiliation under which a medical practitioner provides the medical activity on behalf of, or in association with, the health care entity.

(E) the term “body” shall mean a human body, organ or cadaver, or a nonhuman animal used in medical research or instruction directly relating to the treatment of humans.

(F) the term “patented use of a composition of matter” does not include a claim for a method of performing a medical or surgical procedure on a body that recites the use of a composition of matter where the use of that composition of matter does not directly contribute to achievement of the objective of the claimed method.

(G) the term “State” shall mean any State or territory of the United States, the District of Columbia, and the Commonwealth of Puerto Rico.

(3) This subsection does not apply to the activities of any person, or employee or agent of such person (regardless of whether such person is a tax exempt organization under section 501(c) of the Internal Revenue Code), who is engaged in the commercial development, manufacture, sale, importation, or distribution of a machine, manufacture, or composition of matter or the provision of pharmacy or clinical laboratory services (other than clinical laboratory services provided in a physician’s office), where such activities are:

(A) directly related to the commercial development, manufacture, sale, importation, or distribution of a machine, manufacture, or composition of matter or the provision of pharmacy or clinical laboratory services (other than clinical laboratory services provided in a physician’s office), and

(B) regulated under the Federal Food, Drug, and Cosmetic Act, the Public Health Service Act, or the Clinical Laboratories Improvement Act.

(4) This subsection shall not apply to any patent issued based on an application which has an effective filing date before September 30, 1996.
HISTORICAL AND REVISION NOTES
Language is changed. The proviso in the corresponding section of existing statute is omitted as being temporary in character and now obsolete.

REFERENCES IN TEXT


Section 501(c) of the Internal Revenue Code, referred to in subsec. (c)(3), is classified to section 501(c) of Title 26, Internal Revenue Code.
The Federal Food, Drug, and Cosmetic Act, referred to in subsec. (c)(3)(B), is act June 25, 1938, ch. 675, 52 Stat. 1040, as amended, which is classified generally to chapter 9 (§ 301 et seq.) of Title 21, Food and Drugs. For complete classification of this Act to the Code, see section 301 of Title 21 and Tables.
The Public Health Service Act, referred to in subsec. (c)(3)(B), is act July 1, 1944, ch. 373, 58 Stat. 682, as amended, which is classified generally to chapter 6A (§ 2301 et seq.) of Title 42, The Public Health and Welfare. For complete classification of this Act to the Code, see Short Title note set out under section 201 of Title 42 and Tables.
The Clinical Laboratories Improvement Act, referred to in subsec. (c)(3)(B), probably means the Clinical Laboratories Improvement Act of 1967, section 5 of Pub. L. 90–174, Dec. 2, 1967, 81 Stat. 536, which enacted section 263a of Title 42 and enacted provisions set out as notes under section 263a of Title 42. For complete classification of this Act to the Code, see Short Title note set out under section 263a of Title 42 and Tables.

AMENDMENTS
2011—Subsec. (a). Pub. L. 112–29, § 16(a)(1), substituted “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, or when,” for “or when.”
Subsec. (b)(2). Pub. L. 112–29, § 29(j), struck out “of this title” after “271(g)”.
Subsec. (c)(1). Pub. L. 112–29, § 31(j), struck out “of this title” after “271(a) or (b)” and after “285”.
Subsec. (c)(4). Pub. L. 112–29, § 32(g)(2), substituted “which has an effective filing date before” for “the earliest effective filing date of which is prior to”.
1999—Subsec. (c)(4). Pub. L. 106–113 substituted “based on an application the earliest effective filing date of which is prior to September 30, 1996” for “before the date of enactment of this subsection”.
Provisions inserted “making, offering for sale, or selling within the United States” for “making or selling” and inserted “or importing any patented article into the United States” after “under them.”
Subsec. (b)(1)(C). Pub. L. 103–465, § 533(b)(5)(B)(i), substituted “use, offer for sale, or sale” for “use, or sale”.
Subsec. (b)(4)(C). Pub. L. 103–465, § 533(b)(5)(B)(iv), substituted “have been offered for sale or sold” for “have been sold” and “United States, or imported by the person into the United States, before” for “United States before”.
1986—Pub. L. 100–418 inserted “and other remedies” in section catchline, designated existing provisions as subsec. (a), and added subsec. (b).

EFFECTIVE DATE OF 2011 AMENDMENT
Amendment by section 3(g)(2) of Pub. L. 112–29 effective upon the expiration of the 18-month period beginning on Sept. 16, 2011, and applicable to certain applications for patent and any patents issuing thereon, see section 3(n) of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title.
Pub. L. 112–29, § 16(a)(2), Sept. 16, 2011, 125 Stat. 328, provided that: “The amendment made by this subsection (amending this section) shall apply to any case that is pending on, or commenced on or after, the date of the enactment of this Act (Sept. 16, 2011).”
Amendment by section 261(4)(j) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 29(b) of Pub. L. 112–29, set out as a note under section 2 of this title.

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, 1996], 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.

EFFECTIVE DATE OF 1988 AMENDMENT
Amendment by Pub. L. 100–418 effective 6 months after Aug. 23, 1988, and subject to enumerated exceptions, applicable only with respect to products made or imported after such effective date, see section 9006 of Pub. L. 100–418, set out as a note under section 271 of this title.

§ 288. Action for infringement of a patent containing an invalid claim
Whenever 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 to recover on valid claims is established. See section 233. Language is changed.

AMENDMENTS

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 proceedings commenced on or after that effective date, see section 29(b) of Pub. L. 112–29, set out as a note under section 2 of this title.

EFFECTIVE DATE OF 1975 AMENDMENT
§ 289. Additional remedy for infringement of design patent

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than $250, recoverable in any United States district court having jurisdiction of the parties.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.

(July 19, 1952, ch. 950, 66 Stat. 813.)

HISTORICAL AND REVISION NOTES


Language is changed.

§ 290. Notice of patent suits

The clerks of the courts of the United States, within one month after the filing of an action under this title shall give notice thereof in writing to the Director, setting forth so far as known the names and addresses of the parties, name of the inventor, and the designating number of the patent upon which the action has been brought. If any other patent is subsequently included in the action he shall give notice thereof within one month after the decision is rendered or a judgment issued the clerk of the court shall give notice thereof to the Director. The Director shall, on receipt of such notices, enter the same in the file of such patent.


HISTORICAL AND REVISION NOTES


This is the last sentence of R.S. 4921, third paragraph, with minor changes in language.

AMENDMENTS


EFFECTIVE DATE OF 1999 AMENDMENT


§ 291. Derived patents

(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 section.

(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.


Prior to amendment, text read as follows: “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 shall apply to actions brought under this section.”

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 3(h)(1) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to certain applications for patent and any patents issuing thereon, see section 3(n) of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title.

Amendment by section 20(j) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112–29, set out as a note under section 2 of this title.

SAVINGS PROVISIONS

Provisions of 35 U.S.C. 291, as in effect on the day before the expiration of the 18-month period beginning on Sept. 16, 2011, apply to each claim of certain applications for patent, and certain patents issued thereon, in which the amendments made by section 3 of Pub. L. 112–29 also apply, see section 3(n)(2) of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title.

§ 292. False marking

(a) Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with any unpatented
article, the word “patent” or any word or number importing that 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. Only the United States may sue for the penalty authorized by this subsection.

(b) A person who has 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.

(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.


HISTORICAL AND REVISION NOTES


This is a criminal provision. The first two paragraphs of the corresponding section of existing statute are consolidated, a new paragraph relating to false marking of “patent applied for” is added, and false advertising is included in all the offenses. The minimum fine whithered has been increased by the injuries as a maximum, is replaced by a higher maximum. The informer action is included as additional to an ordinary criminal action.

AMENDMENTS

2011—Subsec. (a). Pub. L. 112–29, § 16(b)(1), inserted at end “Only the United States may sue for the penalty authorized by this subsection.”

Subsec. (b). Pub. L. 112–29, § 16(b)(2), amended subsec. (b) generally. Prior to amendment, subsec. (b) read as follows: “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.”


1994—Subsec. (a). Pub. L. 103–465, in first par., substituted “used, offered for sale, or sold by such person within the United States, or imported by the person into the United States for ‘used, or sold by him’ and ‘made, offered for sale, sold, or imported into the United States for ‘made or sold’.”

HISTORICAL AND REVISION NOTES

This section provides for service on non-resident patentees.

AMENDMENTS


EXEMPLARY DATE OF 2011 AMENDMENT

Amendment by Pub. L. 112–29 effective Sept. 16, 2011, and applicable to any civil action commenced on or after that date, see section 9(b) of Pub. L. 112–29, set out as a note under section 1071 of Title 15, Commerce and Trade.

EXEMPLARY DATE OF 1975 AMENDMENT


§ 294. Voluntary arbitration

(a) A contract involving a patent or any right under a patent may contain a provision requiring arbitration of any dispute relating to patent validity or infringement arising under the contract. In the absence of such a provision, the parties to an existing patent validity or infringement dispute may agree in writing to settle such dispute by arbitration. Any such provision or agreement shall be valid, irrevocable, and enforceable, except for any grounds that exist at law or in equity for revocation of a contract.

(b) Arbitration of such disputes, awards by arbitrators and confirmation of awards shall be governed by title 9, to the extent such title is not inconsistent with this section. In any such arbitration proceeding, the defenses provided for under section 282 shall be considered by the arbitrator if raised by any party to the proceeding.

(c) An award by an arbitrator shall be final and binding between the parties to the arbitration but shall have no force or effect on any other person. The parties to an arbitration may agree that in the event a patent which is the subject matter of an award is subsequently determined to be invalid or unenforceable in a judgment rendered by a court of competent jurisdiction from which no appeal can or has been

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 Eastern District of Virginia shall have jurisdiction and 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.


HISTORICAL AND REVISION NOTES

This section provides for service on non-resident patentees.

AMENDMENTS


EXEMPLARY DATE OF 2011 AMENDMENT

Amendment by Pub. L. 112–29 effective Sept. 16, 2011, and applicable to any civil action commenced on or after that date, see section 9(b) of Pub. L. 112–29, set out as a note under section 1071 of Title 15, Commerce and Trade.

EXEMPLARY DATE OF 1975 AMENDMENT


§ 293. Nonresident patentee; service and notice

Every patentee not residing in the United States may file in the Patent and Trademark
taken, such award may be modified by any court of competent jurisdiction upon application by any party to the arbitration. Any such modification shall govern the rights and obligations between such parties from the date of such modification.

(d) When an award is made by an arbitrator, the patentee, his assignee or licensee shall give notice thereof in writing to the Director. There shall be a separate notice prepared for each patent involved in such proceeding. Such notice shall set forth the names and addresses of the parties, the name of the inventor, and the name of the patent owner, shall designate the number of the patent, and shall contain a copy of the award. If an award is modified by a court, the party requesting such modification shall give notice of such modification to the Director. The Director shall, upon receipt of either notice, enter the same in the record of the prosecution of such patent. If the required notice is not filed with the Director, any party to the proceeding may provide such notice to the Director.

(e) The award shall be unenforceable until the notice required by subsection (d) is received by the Director.


AMENDMENTS


Subsec. (c). Pub. L. 107–273, §13206(a)(19)(B), substituted “rendered by a court of” for “rendered by a court to”.


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 proceedings commenced on or after that effective date, see section 26(l) of Pub. L. 112–29, set out as a note under section 2 of this title.

EFFECTIVE DATE OF 1999 AMENDMENT


EFFECTIVE DATE

Pub. L. 97–247, §17(c), Aug. 27, 1982, 96 Stat. 323, provided that: “Sections 5, 6, 8 through 12, and 17(b) of this Act [enacting this section and amending sections 21, 111, 116, and 256 of this title and sections 1058, 1063, 1064, 1065, and 1066 of Title 15, Commerce and Trade] shall take effect six months after enactment [Aug. 27, 1982].”

§ 295. Presumption: Product made by patented process

In actions alleging infringement of a process patented on the importation, sale, offer for sale, or use of a product which is made from a process patented in the United States, if the court finds—

(1) that a substantial likelihood exists that the product was made by the patented process, and

(2) that the plaintiff has made a reasonable effort to determine the process actually used in the production of the product and was unable to so determine,

the product shall be presumed to have been so made, and the burden of establishing that the product was not made by the process shall be on the party asserting that it was not so made.


AMENDMENTS

1994—Pub. L. 103–465 substituted “sale, offer for sale, or use” for “sale, or use” in introductory provisions.

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, 1996], with provisions relating to earliest filed patent application, see section 539(a), (b)(3) of Pub. L. 103–465, set out as a note under section 154 of this title.

EFFECTIVE DATE

Section effective 6 months after Aug. 23, 1988, and, subject to enumerated exceptions, applicable only with respect to products made or imported after such effective date, see section 9006 of Pub. L. 100–418, set out as an Effective Date of 1988 Amendment note under section 271 of this title.

§ 296. Liability of States, instrumentalities of States, and State officials for infringement of patents

(a) IN GENERAL.—Any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his official capacity, shall not be immune, under the eleventh amendment of the Constitution of the United States or under any other doctrine of sovereign immunity, from suit in Federal court by any person, including any governmental or nongovernmental entity, for infringement of a patent under section 271, or for any other violation under this title.

(b) REMEDIES.—In a suit described in subsection (a) for a violation described in that subsection, remedies (including remedies both at law and in equity) are available for the violation to the same extent as such remedies are available for such a violation in a suit against any private entity. Such remedies include damages, interest, costs, and treble damages under section 284, attorney fees under section 285, and the additional remedy for infringement of design patents under section 289.


CONSTITUTIONALITY

For information regarding constitutionality of this section, as added by section 2(a)(2) of Pub. L. 102–560, see Congressional Research Service, The Constitution of the United States of America: Analysis and Interpre-
§ 297. Improper and deceptive invention promotion

(a) IN GENERAL.—An invention promoter shall have a duty to disclose the following information to a customer in writing, prior to entering into a contract for invention promotion services:

(1) the total number of inventions evaluated by the invention promoter for commercial potential in the past 5 years, as well as the number of those inventions that received positive evaluations, and the number of those inventions that received negative evaluations;

(2) the total number of customers who have contracted with the invention promoter in the past 5 years, not including customers who have purchased trade show services, research, advertising, or other nonmarketing services from the invention promoter, or who have defaulted in their payment to the invention promoter;

(3) the total number of customers known by the invention promoter to have received a net financial profit as a direct result of the invention promotion services provided by such invention promoter;

(4) the total number of customers known by the invention promoter to have received license agreements for their inventions as a direct result of the invention promotion services provided by such invention promoter; and

(5) the names and addresses of all previous invention promotion companies with which the invention promoter or its officers have collectively or individually been affiliated in the previous 10 years.

(b) CIVIL ACTION.—(1) Any customer who enters into a contract with an invention promoter and who is found by a court to have been injured by any material false or fraudulent statement or representation, or any omission of material fact, by that invention promoter (or any agent, employee, director, officer, partner, or independent contractor of such invention promoter), or by the failure of that invention promoter to disclose such information as required under subsection (a), may recover in a civil action against the invention promoter (or the officers, directors, or partners of such invention promoter), in addition to reasonable costs and attorneys' fees—

(A) the amount of actual damages incurred by the customer; or

(B) at the election of the customer at any time before final judgment is rendered, statutory damages in a sum of not more than $5,000, as the court considers just.

(2) Notwithstanding paragraph (1), in a case where the customer sustains the burden of proof, and the court finds, that the invention promoter intentionally misrepresented or omitted a material fact to such customer, or willfully failed to disclose such information as required under subsection (a), with the purpose of deceiving that customer, the court may increase damages to not more than three times the amount awarded, taking into account past complaints made against the invention promoter that resulted in regulatory sanctions or other corrective actions based on those records compiled by the Commissioner of Patents under subsection (d).

(c) DEFINITIONS.—For purposes of this section—

(1) a “contract for invention promotion services” means a contract by which an invention promoter undertakes invention promotion services for a customer;

(2) a “customer” is any individual who enters into a contract with an invention promoter for invention promotion services;

(3) the term “invention promoter” means any person, firm, partnership, corporation, or other entity who offers to perform or performs invention promotion services for, or on behalf of, a customer, and who holds itself out through advertising in any mass media as providing such services, but does not include—

(A) any department or agency of the Federal Government or of a State or local government;

(B) any nonprofit, charitable, scientific, or educational organization, qualified under applicable State law or described under section 170(b)(1)(A) of the Internal Revenue Code of 1986;

(C) any person or entity involved in the evaluation to determine commercial potential of, or offering to license or sell, a utility patent or a previously filed nonprovisional utility patent application;

(D) any party participating in a transaction involving the sale of the stock or assets of a business; or

(E) any party who directly engages in the business of retail sales of products or the distribution of products; and

(4) the term “invention promotion services” means the procurement or attempted procurement for a customer of a firm, corporation, or other entity to develop and market products or services that include the invention of the customer.

(d) RECORDS OF COMPLAINTS.—

(1) RELEASE OF COMPLAINTS.—The Commissioner of Patents shall make all complaints received by the Patent and Trademark Office involving invention promoters publicly available, together with any response of the invention promoters. The Commissioner of Patents shall notify the invention promoter of a complaint and provide a reasonable opportunity to reply prior to making such complaint publicly available.

(2) REQUEST FOR COMPLAINTS.—The Commissioner of Patents may request complaints relating to invention promotion services from any Federal or State agency and include such complaints in the records maintained under paragraph (1), together with any response of the invention promoters.
§ 298. Advice of counsel

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.

(Added Pub. L. 112–29, §17(a), Sept. 16, 2011, 125 Stat. 329.)

§ 299. Joinder of parties

(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 consolidated for trial, only if—

(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

(2) questions of fact common to all defendants or counterclaim defendants will arise in the action.

(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.


REMARKS IN TEXT


EFFECTIVE DATE

Pub. L. 106–113, div. B, §1000(a)(9) [title IV, subtitle A, §4103], Nov. 29, 1999, 113 Stat. 1536, 1501A–554, provided that: “This subtitle [enacting this section and provisions set out as notes under section 1 of this title] and the amendments made by this subtitle shall take effect 60 days after the date of the enactment of this Act [Nov. 29, 1999].”

§ 298. Advice of counsel

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.

(Added Pub. L. 112–29, §17(a), Sept. 16, 2011, 125 Stat. 329.)

EFFECTIVE DATE

Pub. L. 112–29, §17(a), Jan. 14, 2013, 126 Stat. 2456, provided that: “Notwithstanding section 299 of the Leahy-Smith America Invents Act [Pub. L. 112–29, §17(a), Sept. 16, 2011, 125 Stat. 329.], this subtitle [enacting this section and provisions set out as notes under section 1 of this title] and the amendments made by this subtitle shall take effect 60 days after the date of the enactment of this Act [Jan. 14, 2013].”

Except as otherwise provided in Pub. L. 112–29, section effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any civil action commenced on or after that date, see section 1(n) of Pub. L. 112–29, set out as a note under section 5 of this title.

§ 299. Joinder of parties

(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 consolidated for trial, only if—

(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

(2) questions of fact common to all defendants or counterclaim defendants will arise in the action.

(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.
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 file of the patent.

(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.

(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.

(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.

Amendments 2011—Pub. L. 112–29 struck out “of this title” after “301” and after “41”.


Effective Date of 2011 Amendment
Amendment by Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 18, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(b) of Pub. L. 112–29, set out as a note under section 2 of this title.

Effective Date of 1999 Amendment

§ 303. Determination of issue by Director

(a) Within three months following the filing of a request for reexamination under the provisions of section 302, 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 or 302. 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.

(b) A record of the Director’s determination under subsection (a) of this section will be placed in the official file of the patent, and a copy promptly will be given or mailed to the owner of record of the patent and to the person requesting reexamination, if any.

(c) A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302.

§ 304. Reexamination order by Director

If, in a determination made under the provisions of subsection 303(a), the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date of the determination, in which to file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed.


AMENDMENTS


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.”


AMENDMENTS
2011—Pub. L. 112–29 struck out “of this title” after “303(a)” and after “302.”


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 proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112–29, set out as a note under section 2 of this title.

EFFECTIVE DATE OF 2011 AMENDMENT

§ 305. Conduct of reexamination proceedings

After the times for filing the statement and reply provided for by section 304 have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. 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, 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 Patent Trial and Appeal Board, will be conducted with special dispatch within the Office.

amended or new claim determined to be patentable.

(b) Any proposed amended or new claim determined to be patentable and incorporated into a patent following a reexamination proceeding will 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 for the same, prior to issuance of a certificate under the provisions of subsection (a) of this section.


AMENDMENTS


1994—Subsec. (b). Pub. L. 103–465 substituted “used within the United States, or imported into the United States, anything” for “used anything”.

effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112–29, set out as a note under section 2 of this title.

effective upon the expiration of the 18-month period beginning on Sept. 16, 2011, and applicable to certain applications for patent and any patents issuing thereon, see section 3(n) of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title.

Effective Date of 2011 Amendment

Amendment by section 3(n) of Pub. L. 112–29 effective on or after that effective date, see section 20(j) of Pub. L. 112–29, struck out “of this title” after “304”, after “133”, and after “301”.


Effective Date of 1984 Amendment

Amendment by Pub. L. 98–622 effective three months after Nov. 8, 1984, see section 207 of Pub. L. 98–622, set out as a note under section 41 of this title.

§ 306. Appeal

The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 144 to the Patent Trial and Review Board or the Director will 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 amendment or new claim determined to be patentable.

(a) In a reexamination proceeding under this chapter, when the time for appeal has expired or any appeal proceeding has terminated, the Director will 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 amendment or new claim determined to be patentable.

(b) Any proposed amended or new claim determined to be patentable and incorporated into a patent following a reexamination proceeding will 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 for the same, prior to issuance of a certificate under the provisions of subsection (a) of this section.


AMENDMENTS


1994—Subsec. (b). Pub. L. 103–465 substituted “used within the United States, or imported into the United States, anything” for “used anything”.

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 proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112–29, set out as a note under section 2 of this title.

Effective Date of 1999 Amendment


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

Sec.

311. Inter partes review.

312. Petitions.

313. Preliminary response to petition.

314. Institution of inter partes review.

315. Relation to other proceedings or actions.

316. Conduct of inter partes review.

317. Settlement.

318. Decision of the Board.

319. Appeal.

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
§ 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.


AMENDMENTS

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


§ 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

REPORT TO CONGRESS

Pub. L. 112–29, §6(c)(1), Sept. 16, 2011, 125 Stat. 304, provided that: “(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;
(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.


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), 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 determination shall include an order for inter partes reexamination of 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.”


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.”


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.”

§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
§ 315. Relation to other proceedings or actions

(a) INFRINGER’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.


AMENDMENTS


Subsec. (b), 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) INFRINGER’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.

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


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 patentee 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).”


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

§ 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 notifies 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.


AMENDMENTS


§ 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 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 person on a showing of good cause.


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.”


§ 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 314(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.


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.”

§ 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 reissue patent (as the case may be).

§ 321. Post-grant review

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 and Trademark Office 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.
328. Decision of the Board.
329. Appeal.

§ 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 reissue patent (as the case may be).

(Added Pub. L. 112–29, § 6(d), 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 a note under section 311 of this title.
method patent unless the person or the person's real party in interest or privy has been sued for infringement of the patent or has been charged with infringement under that patent.

"(C) A petitioner in a transitional proceeding who challenges the validity of 1 or more claims in a covered business method patent on a ground raised under section 102 or 103 of title 35, United States Code, as in effect on the day before the effective date set forth in section 3(n)(1) [set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title], may support such ground only on the basis of—

"(i) prior art that is described by section 102(a) of such title (as in effect on the day before such effective date); or

"(ii) prior art that—

"(I) discloses the invention more than 1 year before the date of the application for patent in the United States; and

"(II) would be described by section 102(a) of such title (as in effect on the day before the effective date set forth in section 3(n)(1)) if the disclosure had been made by another before the invention thereof by the applicant for patent.

"(D) The petitioner in a transitional proceeding that results in a final written decision under section 328(a) of title 35, United States Code, with respect to a claim in a covered business method patent, or the petitioner's real party in interest, may not assert, either in a civil action arising in whole or in part under section 1338 of title 28, United States Code, or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 (19 U.S.C. 1337), that the claim is invalid on any ground that the petitioner raised during that transitional proceeding.

"(E) The Director may institute a transitional proceeding only for a patent that is a covered business method patent.

"(2) EFFECTIVE DATE.—The regulations issued under paragraph (1) 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 the 1-year period beginning on the date of the enactment thereof.

"(3) SUNSET.—

"(A) IN GENERAL.—This subsection, and the regulations issued under this section, shall be repealed effective upon the expiration of the 8-year period beginning on the date that the regulations issued under [sic] paragraph (1) take effect.

"(B) APPLICABILITY.—Notwithstanding subparagraph (A), this subsection and the regulations issued under this subsection shall continue to apply, after the date of the repeal under subparagraph (A), to any petition for a transitional proceeding that is filed before the date of such repeal.

"(b) REQUEST FOR STAY.—

"(1) IN GENERAL.—If a party seeks a stay of a civil action alleging infringement of a patent under section 281 of title 35, United States Code, relating to a transitional proceeding for that patent, the court shall decide whether to enter a stay based on—

"(A) whether a stay, or the denial thereof, will simplify the issues in question and streamline the trial;

"(B) whether discovery is complete and whether a trial date has been set;

"(C) whether a stay, or the denial thereof, would unduly prejudice the nonmoving party or present a clear tactical advantage for the moving party; and

"(D) whether a stay, or the denial thereof, will reduce the burden of litigation on the parties and on the court.

"(2) REVIEW.—A party may take an immediate interlocutory appeal from a district court's decision under paragraph (1). The United States Court of Appeals for the Federal Circuit shall review the district court's decision to ensure consistent application of established precedent, and such review may be de novo.

"(e) RULE OF CONSTRUCTION.—Nothing in this section shall be construed as amending section 101 of title 35, United States Code, to include patents for technological inventions.

§ 322. Petitions

(a) REQUIREMENTS OF PETITION.—A petition filed under section 321 may be considered only if—

(1) the petition is accompanied by payment of the fee established by the Director under section 321;

(2) the petition identifies all real parties in interest;

(3) the petition identifies, in writing and with particularity, each claim challenged, 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 other factual evidence or 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 321, the Director shall make the petition available to the public.

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

EFFECTIVE DATE

Section effective upon the expiration of the 1-year period beginning Sept. 16, 2011, and applicable only to patents described in section 3(n)(1) of Pub. L. 112–29 (35 U.S.C. 100 note), with certain exceptions and limita-


§ 323. Preliminary response to petition

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.

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

Effective Date

Section effective upon the expiration of the 1-year period beginning Sept. 16, 2011, and applicable only to patents described in section 3(a)(1) of Pub. L. 112–29 (35 U.S.C. 100 note), with certain exceptions and limitations, see section 6(f)(2), (3) of Pub. L. 112–29, set out as a note under section 321 of this title.

§ 324. Institution of post-grant review

(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.

(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 important to other patents or patent applications.

(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—

(1) receiving a preliminary response to the petition under section 323; or

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

(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.

(e) No appeal.—The determination by the Director whether to institute a post-grant review under this section shall be final and nonappealable.

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

Effective Date

Section effective upon the expiration of the 1-year period beginning Sept. 16, 2011, and applicable only to patents described in section 3(a)(1) of Pub. L. 112–29 (35 U.S.C. 100 note), with certain exceptions and limitations, see section 6(f)(2), (3) of Pub. L. 112–29, set out as a note under section 321 of this title.

§ 325. Relation to other proceedings or actions

(a) Infringer’s civil action.—

(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.

(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—

(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) 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.

(c) Joining.—If more than 1 petition for a post-grant review under this chapter is 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.

(d) Multiple proceedings.—Notwithstanding sections 133(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 art or arguments previously were presented to the Office.

(e) Estoppel.—

(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 330(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.
§ 326 

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 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.

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.

(Added Pub. L. 112–29, §6(d), Sept. 16, 2011, 125 Stat. 307.)

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.

EFFECTIVE DATE

Section effective upon the expiration of the 1-year period beginning Sept. 16, 2011, and applicable only to patents described in section 3(n)(1) of Pub. L. 112–29 (35 U.S.C. 100 note), with certain exceptions and limitations.

§ 326. Conduct of post-grant 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 subsections (a) and (b) of section 324;

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

(4) establishing and governing a post-grant 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 evidence directly related to factual assertions advanced by either party in the proceeding;

(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 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;

(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 any post-grant review be issued not later than 1 year after the date on which the Director notifies 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

(12) 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 post-grant review instituted under this chapter.

(d) AMENDMENT OF THE PATENT.—

(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:

(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 327, or upon the request of the patent owner for good cause shown.

(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) EVIDENTIAL 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.

(Added Pub. L. 112–29, §6(d), Sept. 16, 2011, 125 Stat. 308.)
§ 329. Appeal

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.

(Added Pub. L. 112–29, § 6(d), Sept. 16, 2011, 125 Stat. 311.)
$§ 351$

**TITLe 35—PATENTS**

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with Federal Assistance”. Title 35 did not contain a table of chapters, and section 6(b) of Pub. L. 96–517 and the purported amendment made by it were repealed by Pub. L. 97–238. See chapter 18 (§ 200 et seq.) of this title.

**CHAPTER 35—DEFINITIONS**

Sec. 351. Definitions.

**§ 351. Definitions.**

When used in this part unless the context otherwise indicates—


(b) The term “Regulations”, when capitalized, means the Regulations under the treaty, done at Washington on the same date as the treaty. The term “regulations”, when not capitalized, means the regulations established by the Director under this title.

(c) The term “international application” means an application filed under the treaty.

(d) The term “international application originating in the United States” means an international application filed in the Patent and Trademark Office when it is acting as a Receiving Office under the treaty, irrespective of whether or not the United States has been designated in that international application.

(e) The term “international application designating the United States” means an international application specifying the United States as a country in which a patent is sought, regardless where such international application is filed.

(f) The term “Receiving Office” means a national patent office or intergovernmental organization which receives and processes international applications as prescribed by the treaty and the Regulations.

(g) The terms “International Searching Authority” and “International Preliminary Examining Authority” mean a national patent office or intergovernmental organization as appointed under the treaty which processes international applications as prescribed by the treaty and the Regulations.

(h) The term “International Bureau” means the international intergovernmental organization which is recognized as the coordinating body under the treaty and the Regulations.

(i) Terms and expressions not defined in this part are to be taken in the sense indicated by the treaty and the Regulations.


**AMENDMENTS**


Subsec. (b). Pub. L. 99–616, §2(b), struck out “excluding part C thereof” after “under the treaty”.


**EFFECTIVE DATE OF 1999 AMENDMENT**


**EFFECTIVE DATE OF 1986 AMENDMENT**

Pub. L. 99–616, §9, Nov. 6, 1986, 100 Stat. 3487, provided that: “Sections 2 through 8 of this Act [amending this section and sections 361, 362, 364, 368, 371, and 376 of this title] shall come into force on the same day as the effective date of entry into force of chapter II of the Patent Cooperation Treaty with respect to the United States, by virtue of the withdrawal of the declaration under article 64(1)(a) of the Patent Cooperation Treaty. It shall apply to all international applications pending before or after its effective date.”

[The Patent Cooperation Treaty became effective for the United States on Jan. 24, 1978. The United States, however, was one of six countries (out of the 40 countries who have ratified or acceded to the Treaty) which had reservations not to be bound by Chapter II. The document removing the reservation as to Chapter II was deposited with the Director General of the World Intellectual Property Organization on Apr. 1, 1987. Accordingly, Chapter II of the Treaty for the United States of America and Pub. L. 99–616 became effective 3 months later on July 1, 1987. See 52 F.R. 20038, 20041, May 28, 1987.]

**EFFECTIVE DATE OF 1984 AMENDMENT**

Pub. L. 98–622, title IV, §406(a), Nov. 8, 1984, 98 Stat. 3393, provided that: “Section 404 of this Act [set out as a note under section 41 of this title] and the amendments made by section 403 of this Act [amending this section and sections 104, 361, 362, 363, 364, 365, 368, 371, 372, 373, and 376 of this title] shall take effect on the date of the enactment of this Act [Nov. 8, 1984].”

**EFFECTIVE DATE**

Pub. L. 94–131, §11, Nov. 14, 1975, 89 Stat. 692, provided that:

“(a) Section 1 of this Act [enacting this part] shall come into force on the same day as the entry into force of the Patent Cooperation Treaty with respect to the United States. It shall apply to international and national applications filed on and after this effective date, even though entitled to the benefit of an earlier filing date, and to patents issued on such applications.

“(b) Sections 2 to 10 of this Act [amending sections 6, 41, 42, 102, 104, 112, 113, 120, and 282 of this title] shall take effect on the same day as section 1 of this Act [enacting this part] and shall apply to all applications for patent actually filed in the United States on and after this effective date, as well as to international applications where applicable.

“(c) Applications for patent on file in the Patent Office [now the Patent and Trademark Office] on the effective date of this Act, and patents issued on such applications, shall be governed by the provisions of title 35, United States Code, in effect immediately prior to the effective date of this Act.”

[The Patent Cooperation Treaty entered into force with respect to the United States on Jan. 24, 1978, with the exception of Chapter II.]

**SHORT TITLE OF 1986 AMENDMENT**

Pub. L. 99–616, §1, Nov. 6, 1986, 100 Stat. 3485, provided: “That this Act [amending this section and sections 361,
CHAPTER 36—INTERNATIONAL STAGE

§ 361. Receiving Office

(a) The Patent and Trademark Office shall act as a Receiving Office for international applications filed by nationals or residents of the United States. In accordance with any agreement made between the United States and another country, the Patent and Trademark Office may also act as a Receiving Office for international applications filed by residents or nationals of such country who are entitled to file international applications.

(b) The Patent and Trademark Office shall perform all acts connected with the discharge of duties required of a Receiving Office, including the collection of international fees and their transmittal to the International Bureau.

(c) International applications filed in the Patent and Trademark Office shall be filed in the English language, or an English translation shall be filed within such later time as may be fixed by the Director.

(d) The international fee, and the transmittal and search fees prescribed under section 376(a) of this part, shall either be paid on filing of an international application or within such later time as may be fixed by the Director.


AMENDMENTS

2012—Subsec. (c). Pub. L. 112–211 added subsec. (c) and struck out former subsec. (c) which read as follows: "International applications filed in the Patent and Trademark Office shall be in the English language.


1986—Subsec. (d). Pub. L. 99–616 amended subsec. (d) generally. Prior to amendment, subsec. (d) read as follows: "The basic fee portion of the international fee, and the transmittal and search fees prescribed under section 376(a) of this section, shall either be paid on filing of an international application or within such later time as may be fixed by the Director. Payment of designation fees may be made on filing and shall be made not later than one year from the priority date of the international application."


Subsec. (d). Pub. L. 98–622, §401(a), inserted "or within one month after the date of such filing" after "application".

EFFECTIVE DATE OF 2012 AMENDMENT

Amendment by Pub. L. 112–211 effective on the date that is 1 year after Dec. 18, 2012, applicable to patents issued before, on, or after that effective date and patent applications pending on or filed after that effective date, and not effective with respect to patents in litigation commenced before that effective date, see section 203 of Pub. L. 112–211, set out as an Effective Date note under section 27 of this title.

EFFECTIVE DATE OF 1999 AMENDMENT


EFFECTIVE DATE OF 1986 AMENDMENT

Amendment by Pub. L. 99–616 effective July 1, 1987, and applicable to all international applications pending before or after that date, see section 9 of Pub. L. 99–616, set out as a note under section 351 of this title.

EFFECTIVE DATE OF 1984 AMENDMENT

Amendment by section 401(a) of Pub. L. 98–622 effective six months after Nov. 8, 1984, see section 406(b) of Pub. L. 98–622, set out as a note under section 3 of this title.

Amendment by section 403(a) of Pub. L. 98–622 effective Nov. 8, 1984, see section 406(a) of Pub. L. 98–622, set out as a note under section 351 of this title.

EFFECTIVE DATE

Chapter effective Jan. 24, 1978, and applicable to international and national applications filed on and after that date, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

§ 362. International Searching Authority and International Preliminary Examining Authority

(a) The Patent and Trademark Office may act as an International Searching Authority and International Preliminary Examining Authority with respect to international applications in accordance with the terms and conditions of an agreement which may be concluded with the International Bureau, and may discharge all duties required of such Authorities, including the collection of handling fees and their transmittal to the International Bureau.

(b) The handling fee, preliminary examination fee, and any additional fees due for international preliminary examination shall be paid within such time as may be fixed by the Director.

§ 363. International application designating the United States: Effect

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.


AMENDMENTS


EFFECTIVE DATE OF 1986 AMENDMENT


EFFECTIVE DATE OF 1999 AMENDMENT


EFFECTIVE DATE OF 2012 AMENDMENT

Amendment by Pub. L. 112–211 effective on the date that is 1 year after Dec. 18, 2012, applicable to patents issued before, on, or after that effective date and patent applications pending on or filed after that effective date, and not effective with respect to patents in litigation commenced before that effective date, see section 203 of Pub. L. 112–211, set out as an Effective Date note under section 27 of this title.

EFFECTIVE DATE OF 1999 AMENDMENT


EFFECTIVE DATE OF 1986 AMENDMENT

Amendment by Pub. L. 99–616 effective July 1, 1987, and applicable to all international applications pending before or on that date, see section 9 of Pub. L. 99–616, set out as a note under section 351 of this title.

EFFECTIVE DATE OF 1984 AMENDMENT


EFFECTIVE DATE OF 1991 AMENDMENT

Amendment by Pub. L. 102–325 effective July 1, 1991, applicable to all international applications pending before or on that date, see section 1 of Pub. L. 102–325, set out as a note under section 351 of this title.
§ 365. Right of priority; benefit of the filing date of a prior application

(a) In accordance with the conditions and requirements of subsections (a) through (d) of section 119, a national application shall be entitled to the right of priority based on a prior filed international application which designated at least one country other than the United States. In accordance with the conditions and requirement of section 119(a) and the treaty and the Regulations, an international application designating the United States shall be entitled to the right of priority based on a prior foreign application, or a prior international application designating at least one country other than the United States. The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed claim for priority under the treaty and the Regulations, and to accept a priority claim that pertains to an application that was not filed within the priority period specified in the treaty and Regulations, but was filed within the additional 2-month period specified under section 119(a) or the treaty and Regulations.

(b) In accordance with the conditions and requirements of section 120, an international application designating the United States shall be entitled to the benefit of the filing date of a prior national application or a prior international application designating the United States, and a national application shall be entitled to the benefit of the filing date of a prior international application designating the United States. If any claim for the benefit of an earlier filing date is based on a prior international application which designated but did not originate in the United States, the Director may require the filing in the Patent and Trademark Office of a certified copy of such application together with a translation thereof into the English language, if it was filed in another language.


AMENDMENT OF SUBSECTION (c)

Pub. L. 112–211, title I, §§ 102(b), 103, Dec. 18, 2012, 126 Stat. 1532, provided that, effective on the date that it is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, see section 103 of Pub. L. 112–211, set out as a note under section 100 of this title.

Amendment by section 102(c)(2) of Pub. L. 112–211 effective on the date that is 1 year after Dec. 18, 2012, applicable to patents issued before, on, or after that effective date and patent applications pending on or filed after that effective date, and not effective with respect to patents in litigation commenced before that effective date, see section 203 of Pub. L. 112–211, set out as an Effective Date note under section 27 of this title.

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 proceedings commenced on or after that effective date, see section 20(a)(1) of Pub. L. 112–29, set out as a note under section 2 of this title.

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, § 4731]
of Pub. L. 106–113, set out as a note under section 1 of this title.

**Effective Date of 1994 Amendment**

Amendment by Pub. L. 103–465 effective 6 months after Dec. 8, 1994, and applicable to all patent applications filed in the United States on or after that effective date, with provisions relating to earliest filed patent application, see section 354(c)(1), (3) of Pub. L. 103–465, set out as a note under section 154 of this title.

**Effective Date of 1984 Amendment**


§ 366. Withdrawn international application

Subject to section 367 of this part, if an international application designating the United States is withdrawn or considered withdrawn, either generally or as to the United States, under the conditions of the treaty and the Regulations, before the applicant has complied with the applicable requirements prescribed by section 371(c) of this part, the designation of the United States shall have no effect after the date of withdrawal, and shall be considered as not having been made, unless a claim for the benefit of a prior filing date under section 365(c) of this part was made in a national application, or an international application designating the United States, filed before the date of such withdrawal. However, such withdrawn international application may serve as the basis for a claim of priority under section 365(a) and (b) of this part, if it designated a country other than the United States.


**Amendment of Section**

Pub. L. 112–211, title I, §§ 102(9), 103, Dec. 18, 2012, 126 Stat. 1532, provided that, effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, this section is amended, in the first sentence, by striking “unless a claim” and all that follows through “withdrawal.” and inserting “unless a claim for benefit of a prior filing date under section 365(c) of this section was made in a national application, or an international application designating the United States, or a claim for benefit under section 386(c) was made in an international design application designating the United States, filed before the date of such withdrawal.” and by striking the second sentence and inserting “However, such withdrawn international application may serve as the basis for a claim of priority under section 365(a) and (b), or under section 386(a) or (b), if it designated a country other than the United States.” See 2012 Amendment note below.

**Amendments**

2012—Pub. L. 112–211 substituted “unless a claim for benefit of a prior filing date under section 365(c) of this section was made in a national application, or an international application designating the United States, or a claim for benefit under section 386(c) was made in an international design application designating the United States, filed before the date of such withdrawal.” for “unless a claim for the benefit of a prior filing date under section 365(c) of this part was made in a national application, or an international application designating the United States, filed before the date of such withdrawal.” and “However, such withdrawn international application may serve as the basis for a claim of priority under section 365(a) and (b), or under section 386(a) or (b), if it designated a country other than the United States.” for “However, such withdrawn international application may serve as the basis for a claim of priority under section 365(a) and (b), or under section 386(a) or (b), if it designated a country other than the United States.”

1984—Pub. L. 98–622 inserted “after the date of withdrawal,” after “effect” and “,” unless a claim for the benefit of a prior filing date under section 365(c) of this part was made in a national application, or an international application designating the United States, filed before the date of such withdrawal” after “having been made” in first sentence, and inserted “withdrawn” after “such” in second sentence.

**Effective Date of 2012 Amendment**

Amendment by Pub. L. 112–211 effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, see section 103 of Pub. L. 112–211, set out as a note under section 100 of this title.

**Effective Date of 1984 Amendment**

Amendment by Pub. L. 98–622 effective six months after Nov. 8, 1984, see section 406(b) of Pub. L. 98–622, set out as a note under section 3 of this title.

§ 367. Actions of other authorities: Review

(a) Where a Receiving Office other than the Patent and Trademark Office has refused to accord an international filing date to an international application designating the United States or where it has held such application to be withdrawn either generally or as to the United States, the applicant may request review of the matter by the Director, on compliance with the requirements and within the time limits specified by the treaty and the Regulations. Such review may result in a determination that such application be considered as pending in the national stage.

(b) The review under subsection (a) of this section, subject to the same requirements and conditions, may also be requested in those instances where an international application designating the United States is considered withdrawn due to a finding by the International Bureau under article 12(3) of the treaty.


**Amendments**

§ 368. Secrecy of certain inventions; filing international applications in foreign countries

(a) International applications filed in the Patent and Trademark Office shall be subject to the provisions of chapter 17.

(b) In accordance with article 27(8) of the treaty, the filing of an international application in a country other than the United States on the invention made in this country shall be considered to constitute the filing of an application in a foreign country within the meaning of chapter 17, whether or not the United States is designated in that international application.

(c) If a license to file in a foreign country is refused or if an international application is ordered to be kept secret and a permit refused, the Patent and Trademark Office when acting as a Receiving Office, International Searching Authority, or International Preliminary Examination Authority, may not disclose the contents of such application to anyone not authorized to receive such disclosure.


AMENDMENTS

2011—Subsecs. (a), (b). Pub. L. 112–29 struck out “of this title” after “IT”.

1986—Subsec. (c). Pub. L. 99–616 substituted a comma for “or” after “Receiving Office” and “International Preliminary Examination Authority” for “both”.


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 proceedings commenced on or after that effective date, see section 29(b) of Pub. L. 112–29, set out as a note under section 2 of this title.

Effective Date of 1986 Amendment

Amendment by Pub. L. 99–616 effective July 1, 1987, and applicable to all international applications pending before or after that date, see section 9 of Pub. L. 99–616, set out as a note under section 351 of this title.

Effective Date of 1984 Amendment


CHAPTER 37—NATIONAL STAGE

Sec. 371. National stage: Commencement.
these requirements are not met by the date of the commencement of the national stage. The requirements of subsection (c)(3) of this section shall be complied with by the date of the commencement of the national stage, and failure to do so shall be regarded as a cancellation of all amendments to the claims, if any, and international search reports submitted in section 41(a) of this title'' for ''prescribed under section 376(a)(4) of this part''.

Subsec. (d). Pub. L. 98–622, §402(a), substituted ''may be'' for ''is'' and struck out ,, except those filed in the Patent Office'' after ''United States'', which amendment was executed by striking out ,, except those filed in the Patent and Trademark Office'' as the probable intent of Congress in view of the amendment by section 403(a) of Pub. L. 98–622. See Effective Date of 1984 Amendment note below.


Subsec. (b). Pub. L. 98–622 struck out ,, at which time the applicant shall have complied with the applicable requirements specified in subsection (c) of this section’’ after ‘‘of the treaty’’.

Subsec. (c). Pub. L. 98–622, §403(a), substituted ‘‘Patent and Trademark Office’’ for ‘‘Patent Office’’ in provisions preceding par. (1) and in par. (3).

Subsec. (c)(2). Pub. L. 98–622, §402(c)(1), (2), substituted ‘‘communicated by’’ for ‘‘received from’’ and struck out ‘‘verified’’ before ‘‘translation’’.

Subsec. (d). Pub. L. 98–622, §402(d), substituted provisions setting forth time periods for compliance with the requirements of subsection (c), payments of surcharges, and the effect of failure to comply for provisions related only to the effect of failure to comply with the requirements of subsection (c).

**EFFECTIVE DATE OF 2012 AMENDMENT**

Amendment by Pub. L. 112–211 effective on the date that is 1 year after Dec. 18, 2012, applicable to patents issued before, on, or after that effective date and patent applications pending on or filed after that effective date, and not effective with respect to patents in litigation commenced before that effective date, see section 203 of Pub. L. 112–211, set out as an Effective Date note under section 27 of this title.

**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 all international applications pending before or after that date, see section 9 of Pub. L. 98–616, set out as a note under section 351 of this title.

**EFFECTIVE DATE OF 1999 AMENDMENT**


**EFFECTIVE DATE OF 1986 AMENDMENT**

Amendment by Pub. L. 99–616 effective July 1, 1987, and applicable to all international applications pending before or after that date, see section 9 of Pub. L. 98–616, set out as a note under section 351 of this title.

**EFFECTIVE DATE OF 1984 AMENDMENT**

Amendment by section 402(a)–(d) of Pub. L. 98–622 effective six months after Nov. 8, 1984, see section 406(b) of Pub. L. 98–622, set out as a note under section 3 of this title.

**EFFECTIVE DATE**

Chapter effective Jan. 24, 1978, and applicable to international and national applications filed, on and after that date, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.
§ 372. National stage: Requirements and procedure

(a) All questions of substance and, within the scope of the requirements of the treaty and Regulations, procedure in an international application designating the United States shall be determined as in the case of national applications regularly filed in the Patent and Trademark Office.

(b) In case of international applications designating but not originating in the United States—

(1) the Director may cause to be reexamined questions relating to form and contents of the application in accordance with the requirements of the treaty and the Regulations;

(2) the Director may cause the question of unity of invention to be reexamined under section 121, within the scope of the requirements of the treaty and the Regulations; and

(3) the Director may require a verification of the translation of the international application or any other document pertaining to the application if the application or other document was filed in a language other than English.


AMENDMENTS


Subsec. (c). Pub. L. 98–622, § 402(f), struck out subsec. (c) which related to cancellation of claims and payment of special fees.

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 proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112–29, set out as a note under section 2 of this title.

EFFECTIVE DATE OF 1999 AMENDMENT


EFFECTIVE DATE OF 1994 AMENDMENT

Amendment by section 402(e), (f) of Pub. L. 98–622 effective six months after Nov. 8, 1984, see section 406(b) of Pub. L. 98–622, set out as a note under section 3 of this title.

Amendment by section 403(a) of Pub. L. 98–622 effective Nov. 8, 1984, see section 406(a) of Pub. L. 98–622, set out as a note under section 351 of this title.


EFFECTIVE DATE OF REPEAL

Repeal effective Jan. 14, 2013, and applicable to proceedings commenced on or after such date, see section 1(i) of Pub. L. 112–274, set out as an Effective Date of 2013 Amendment note under section 5 of this title.

§ 374. Publication of international application

The publication under the treaty defined in section 351(a), of an international application designating the United States shall be deemed a publication under section 122(b), except as provided in section 154(d).


AMENDMENTS

2011—Pub. L. 112–29, § 20(j), struck out “of this title” after “154(a)” and “154(d)”.

Pub. L. 112–29, § 3(g)(4), substituted “section 154(d)” for “sections 152(e) and 154(d)”.

2002—Pub. L. 107–273 amended Pub. L. 106–113, § 1000(a)(9) [title IV, § 4507(10)], see 1999 Amendment note below. Prior to being amended by Pub. L. 107–273, Pub. L. 106–113, § 1000(a)(9) [title IV, § 4507(10)], had amended this section to read as follows: “The publication under the treaty defined in section 351(a) of this title, of an international application designating the United States shall confer the same rights and shall have the same effect under this title as an application for patent published under section 122(b), except as provided in sections 152(e) and 154(d) of this title.”

1999—Pub. L. 106–113, as amended by Pub. L. 107–273, amended section catchline and text generally. Prior to amendment, text read as follows: “The publication under the treaty of an international application shall confer no rights and shall have no effect under this title other than that of a printed publication.”

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 3(g)(4) of Pub. L. 112–29 effective upon the expiration of the 18-month period beginning on Sept. 16, 2011, and applicable to certain applications for patent and any patents issuing thereon, see section 3(a) of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment, Savings Provisions note under section 100 of this title.

Amendment by section 20(j) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112–29, set out as a note under section 2 of this title.

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106–113 effective Nov. 29, 2000, and applicable only to applications (including international applications designating the United States) filed on or after that date, see section 1000(a)(9) [title IV, § 4508] of Pub. L. 106–113, as amended, set out as a note under section 10 of this title.

§ 375. Patent issued on international application: Effect

(a) A patent may be issued by the Director based on an international application designat-
ing the United States, in accordance with the provisions of this title. Such patent shall have the force and effect of a patent issued on a national application filed under the provisions of chapter 11.

(b) Where due to an incorrect translation the scope of a patent granted on an international application designating the United States, which was not originally filed in the English language, exceeds the scope of the international application in its original language, a court of competent jurisdiction may retroactively limit the scope of the patent, by declaring it unenforceable to the extent that it exceeds the scope of the international application in its original language.


AMENDMENTS

2011—Subsec. (a). Pub. L. 112–119, §20(j), struck out “of this title” after “102(e)” and after “11”. Pub. L. 112–29, §3(g)(5), which directed substitution of “Such” for “Subject to section 102(e) of this title, such”, was executed by making the substitution for “Subject to section 102(e), such”, to reflect the probable intent of Congress, because the words “of this title” did not appear after “section 102(e)” subsequent to amendment by Pub. L. 112–29, §20(j). See note above and Effective Date of 2011 Amendment notes below.


EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 3(g)(5) of Pub. L. 112–29 effective upon the expiration of the 18-month period beginning on Sept. 16, 2011, and applicable to certain applications commenced on or after that date.

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106–113 effective 4 months before or after that date, see section 9 of Pub. L. 106–113, set out as a note under section 1 of this title.
PART V—THE HAGUE AGREEMENT CONCERNING INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS

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CHAPTER 38—INTERNATIONAL DESIGN APPLICATIONS

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PRIOR PROVISIONS

A prior chapter 38, as added by Pub. L. 96–517, § 6(a), Dec. 12, 1980, 94 Stat. 3018, was originally editorially inserted after chapter 17 of this title because the probable intent of Congress was to designate the chapter as “18”, in view of the numerical designation of the sections contained in the chapter as sections 200 to 211 and in view of the subject matter of the chapter in relation to the subject matter of Part II of this title. Pub. L. 97–256, title I, § 101(5), Sept. 8, 1982, 96 Stat. 816, redesignated chapter 38 as chapter 18 and transferred chapter 18, as so redesignated, from the end of this part to the end of Part II. See 1982 Amendment note set out under section 100 of this title.

§ 381. Definitions

(a) IN GENERAL.—When used in this part, unless the context otherwise indicates—
(1) the term “treaty” means the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs adopted at Geneva on July 2, 1999;
(2) the term “regulations”—
(A) when capitalized, means the Common Regulations under the treaty; and
(B) when not capitalized, means the regulations established by the Director under this title;
(3) the terms “designation”, “designating”, and “designate” refer to a request that an international registration have effect in a Contracting Party to the treaty;
(4) the term “International Bureau” means the international intergovernmental organization that is recognized as the coordinating body under the treaty and the Regulations;
(5) the term “effective registration date” means the date of international registration determined by the International Bureau under the treaty;
(6) the term “international design application” means an application for international registration; and
(7) the term “international registration” means the international registration of an industrial design filed under the treaty.

(b) RULE OF CONSTRUCTION.—Terms and expressions not defined in this part are to be taken in the sense indicated by the treaty and the Regulations.


EFFECTIVE DATE

Section effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, see section 103 of Pub. L. 112–211, set out as an Effective Date of 2012 Amendment note under section 100 of this title.

§ 382. Filing international design applications

(a) IN GENERAL.—Any person who is a national of the United States, or has a domicile, a habitual residence, or a real and effective industrial or commercial establishment in the United States, may file an international design application by submitting to the Patent and Trademark Office an application in such form, together with such fees, as may be prescribed by the Director.

(b) REQUIRED ACTION.—The Patent and Trademark Office shall perform all acts connected with the discharge of its duties under the treaty, including the collection of international fees and transmittal thereof to the International Bureau. Subject to chapter 17, international design applications shall be forwarded by the Patent and Trademark Office to the International Bureau, upon payment of a transmissible fee.

(c) APPLICABILITY OF CHAPTER 16.—Except as otherwise provided in this chapter, the provisions of chapter 16 shall apply.

(d) APPLICATION FILED IN ANOTHER COUNTRY.—An international design application on an industrial design made in this country shall be considered to constitute the filing of an application in a foreign country within the meaning of chapter 17 if the international design application is filed—
(1) in a country other than the United States;
(2) at the International Bureau; or
(3) with an intergovernmental organization.


EFFECTIVE DATE

Section effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, see section 103 of Pub. L. 112–211, set out as an Effective Date of 2012 Amendment note under section 100 of this title.

§ 383. International design application

In addition to any requirements pursuant to chapter 16, the international design application shall contain—
(1) a request for international registration under the treaty;
(2) an indication of the designated Contracting Parties;
(3) data concerning the applicant as prescribed in the treaty and the Regulations;
(4) copies of a reproduction or, at the choice of the applicant, of several different reproductions.
tions of the industrial design that is the subject of the international design application, presented in the number and manner prescribed in the treaty and the Regulations;

(5) an indication of the product or products that constitute the industrial design or in relation to which the industrial design is to be used, as prescribed in the treaty and the Regulations;

(6) the fees prescribed in the treaty and the Regulations; and

(7) any other particulars prescribed in the Regulations.


**Effective Date**

Section effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, see section 103 of Pub. L. 112–211, set out as an Effective Date of 2012 Amendment note under section 100 of this title.

§ 386. Right of priority

(a) National application.—In accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172, a national application shall be entitled to the right of priority based on a prior international design application that designated at least 1 country other than the United States.

(b) Prior foreign application.—In accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172 and the treaty and the Regulations, an international design application designating the United States shall be entitled to the right of priority based on a prior foreign application, a prior international application as defined in section 351(c) designating at least 1 country other than the United States, or a prior international design application designating at least 1 country other than the United States.

(c) Prior national application.—In accordance with the conditions and requirements of section 120, an international design application designating the United States shall be entitled to the benefit of the filing date of a prior national application, a prior international application as defined in section 351(c) designating the United States, or a prior international design application designating the United States, and a national application shall be entitled to the benefit of the filing date of a prior international design application designating the United States. If any claim for the benefit of an earlier filing date is based on a prior international application as defined in section 351(c) which designated but did not originate in the United States or a prior international design application designating the United States which designated but did not originate in the United States, the Director may require the filing in the Patent and Trademark Office of a certified copy of such application together with a translation thereof into the English language, if it was filed in another language.


**Effective Date**

Section effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, see section 103 of Pub. L. 112–211, set out as an Effective Date of 2012 Amendment note under section 100 of this title.

§ 387. Relief from prescribed time limits

An applicant’s failure to act within prescribed time limits in connection with requirements
pertaining to an international design application may be excused as to the United States upon a showing satisfactory to the Director of unintentional delay and under such conditions, including a requirement for payment of the fee specified in section 41(a)(7), as may be prescribed by the Director.


**Effective Date**

Section effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, see section 103 of Pub. L. 112–211, set out as an Effective Date of 2012 Amendment note under section 100 of this title.

§ 388. Withdrawn or abandoned international design application

Subject to sections 384 and 387, if an international design application designating the United States is withdrawn, renounced or canceled or considered withdrawn or abandoned, either generally or as to the United States, under the conditions of the treaty and the Regulations, the designation of the United States shall have no effect after the date of withdrawal, renunciation, cancellation, or abandonment and shall be considered as not having been made, unless a claim for benefit of a prior filing date under section 365(c) was made in an international application, or an international design application designating the United States, or a claim for benefit under section 365(c) was made in an international application designating the United States, filed before the date of such withdrawal, renunciation, cancellation, or abandonment. However, such withdrawn, renounced, canceled, or abandoned international design application may serve as the basis for a claim of priority under subsections (a) and (b) of section 386, or under subsection (a) or (b) of section 365, if it designated a country other than the United States.


**Effective Date**

Section effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, see section 103 of Pub. L. 112–211, set out as an Effective Date of 2012 Amendment note under section 100 of this title.

§ 389. Examination of international design application

(a) IN GENERAL.—The Director shall cause an examination to be made pursuant to this title of an international design application designating the United States.

(b) APPLICABILITY OF CHAPTER 16.—All questions of substance and, unless otherwise required by the treaty and Regulations, procedures regarding an international design application designating the United States shall be determined as in the case of applications filed under chapter 16.

(c) FEES.—The Director may prescribe fees for filing international design applications, for designating the United States, and for any other processing, services, or materials relating to international design applications, and may provide for later payment of such fees, including surcharges for later submission of fees.

(d) ISSUANCE OF PATENT.—The Director may issue a patent based on an international design application designating the United States, in accordance with the provisions of this title. Such patent shall have the force and effect of a patent issued on an application filed under chapter 16.


**Effective Date**

Section effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, see section 103 of Pub. L. 112–211, set out as an Effective Date of 2012 Amendment note under section 100 of this title.

§ 390. Publication of international design application

The publication under the treaty of an international design application designating the United States shall be deemed a publication under section 122(b).


**Effective Date**

Section effective on the later of the date that is 1 year after Dec. 18, 2012, or the date that the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs enters into force with respect to the United States, and applicable only to certain applications filed on and after that effective date and patents issuing thereon, see section 103 of Pub. L. 112–211, set out as an Effective Date of 2012 Amendment note under section 100 of this title.