

technology transfer organization whose primary purpose is to facilitate the commercialization of technologies developed by one or more such institutions of higher education.

(B) EXCEPTION.—Subparagraph (A) shall not apply if any of the activities required to reduce to practice the subject matter of the claimed invention could not have been undertaken using funds provided by the Federal Government.

(f) UNREASONABLE ASSERTION OF DEFENSE.—If the defense under this section is pleaded by a person who is found to infringe the patent and who subsequently fails to demonstrate a reasonable basis for asserting the defense, the court shall find the case exceptional for the purpose of awarding attorney fees under section 285.

(g) INVALIDITY.—A patent shall not be deemed to be invalid under section 102 or 103 solely because a defense is raised or established under this section.

(Added Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4302(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A–555; amended Pub. L. 112–29, §5(a), Sept. 16, 2011, 125 Stat. 297.)

Editorial Notes

AMENDMENTS

2011—Pub. L. 112–29 amended section generally. Prior to amendment, section related to defense to infringement based on earlier inventor.

Statutory Notes and Related Subsidiaries

EFFECTIVE DATE OF 2011 AMENDMENT

Pub. L. 112–29, §5(c), Sept. 16, 2011, 125 Stat. 299, provided that: “The amendments made by this section [amending this section] shall apply to any patent issued on or after the date of the enactment of this Act [Sept. 16, 2011].”

EFFECTIVE DATE

Pub. L. 106–113, div. B, §1000(a)(9) [title IV, subtitle C, §4303], Nov. 29, 1999, 113 Stat. 1536, 1501A–557, provided that: “This subtitle [enacting this section and provisions set out as a note under section 1 of this title] and the amendments made by this subtitle shall take effect on the date of the enactment of this Act [Nov. 29, 1999], but shall not apply to any action for infringement that is pending on such date of enactment or with respect to any subject matter for which an adjudication of infringement, including a consent judgment, has been made before such date of enactment.”

CHAPTER 29—REMEDIES FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

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Editorial Notes

AMENDMENTS

2011—Pub. L. 112–29, §19(d)(2), Sept. 16, 2011, 125 Stat. 333, added item 299.

Pub. L. 112–29, §17(b), Sept. 16, 2011, 125 Stat. 329, added item 298.

Pub. L. 112–29, §3(h)(2), Sept. 16, 2011, 125 Stat. 289, amended item 291 generally, substituting “Derived patents” for “Interfering patents”.

1999—Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4102(b)], Nov. 29, 1999, 113 Stat. 1536, 1501A–554, added item 297.

1992—Pub. L. 102–560, §2(b), Oct. 28, 1992, 106 Stat. 4230, added item 296.

1988—Pub. L. 100–418, title IX, §§9004(b), 9005(b), Aug. 23, 1988, 102 Stat. 1566, inserted “and other remedies” in item 287 and added item 295.

1982—Pub. L. 97–247, §17(b)(2), Aug. 27, 1982, 96 Stat. 323, added item 294.

§ 281. Remedy for infringement of patent

A patentee shall have remedy by civil action for infringement of his patent.

(July 19, 1952, ch. 950, 66 Stat. 812.)

HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §§67 and 70, part (R.S. 4919; R.S. 4921, amended (1) Mar. 3, 1897, ch. 391, §6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, §8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, §1, 60 Stat. 778).

The corresponding two sections of existing law are divided among sections 281, 283, 284, 285, 286 and 289 with some changes in language. Section 281 serves as an introduction or preamble to the following sections, the modern term civil action is used, there would be, of course, a right to a jury trial when no injunction is sought.

§ 282. Presumption of validity; defenses

(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—

¹ So in original. Does not conform to section catchline.

(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,

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. A due diligence determination under section 156(d)(2) is not subject to review in such an action.

(July 19, 1952, ch. 950, 66 Stat. 812; Pub. L. 89-83, §10, July 24, 1965, 79 Stat. 261; Pub. L. 94-131, §10, Nov. 14, 1975, 89 Stat. 692; Pub. L. 97-164, title I, §161(7), Apr. 2, 1982, 96 Stat. 49; Pub. L. 98-417, title II, §203, Sept. 24, 1984, 98 Stat. 1603; Pub. L. 104-41, §2, Nov. 1, 1995, 109 Stat. 352; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §§4402(b)(1), 4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-560, 1501A-582; Pub. L. 107-273, div. C, title III, §13206(b)(1)(B), (4), Nov. 2, 2002, 116 Stat. 1906; Pub. L. 112-29, §§15(a), 20(g), (j), Sept. 16, 2011, 125 Stat. 328, 334, 335.)

HISTORICAL AND REVISION NOTES

Derived from Title 35, U.S.C., 1946 ed., §69 (R.S. 4920, amended (1) Mar. 3, 1897, ch. 391, §2, 29 Stat. 692, (2) Aug. 5, 1939, ch. 450, §1, 53 Stat. 1212).

The first paragraph declares the existing presumption of validity of patents.

The five defenses named in R.S. 4920 are omitted and replaced by a broader paragraph specifying defenses in general terms.

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.

tively, 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)(1), 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 “II” and substituted “patentability.” for “patentability.”, and in introductory provisions of subsec. (c), struck out “of this title” after “156” and substituted “In an action involving the validity or infringement of a patent” for “In actions 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 “unenforceability.” 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 251.”

for “(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title.”.

2002—Third par. Pub. L. 107-273, §13206(b)(4), made technical correction to directory language of Pub. L. 106-113, §1000(a)(9) [title IV, §4402(b)(1)]. See 1999 Amendment note below.

Pub. L. 107-273, §13206(b)(1)(B), made technical correction to directory language of Pub. L. 106-113, §1000(a)(9) [title IV, §4732(a)(10)(A)]. See 1999 Amendment note below.

1999—Third par. 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 “(2) by the Director,” for “(2) by the Commissioner.”.

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 non-obviousness under section 103(b)(1), the process shall no longer be considered nonobvious solely on the basis of section 103(b)(1).”

1984—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.

1982—Third par. Pub. L. 97-164 substituted “Claims Court” for “Court of Claims”.

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 required each claim of a patent (whether in independent or dependent form) 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.

Editorial Notes

AMENDMENTS

2011—Pub. L. 112-29, §20(g)(1), (2)(A), (C), (3), (j), designated first to third pars. as subsecs. (a) to (c), respec-

Statutory Notes and Related Subsidiaries

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, § 4405(a)] of Pub. L. 106-113, set out as a note under section 154 of this title.

Amendment by section 1000(a)(9) [title IV, § 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 1 of this title.

EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-164 effective Oct. 1, 1982, see section 402 of Pub. L. 97-164, set out as a note under section 171 of Title 28, Judiciary and Judicial Procedure.

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 3 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.

§ 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

Based on Title 35, U.S.C., 1946 ed., § 70, part (R.S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

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 less 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.

(July 19, 1952, ch. 950, 66 Stat. 813; Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4507(9)], Nov. 29, 1999, 113 Stat. 1536, 1501A-566; Pub. L. 112-29, § 20(j), Sept. 16, 2011, 125 Stat. 335.)

HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §§ 67 and 70, part (R.S. 4919; R.S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

This section consolidates the provisions relating to damages in R.S. 4919 and 4921, with some changes in language.

Editorial Notes

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.”

Statutory Notes and Related Subsidiaries

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

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

Based on Title 35, U.S.C., 1946 ed., § 70, part (R.S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

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

Based on Title 35, U.S.C., 1946 ed., § 70, part (R.S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

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 infringe-

ment 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 then 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.

(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.

(July 19, 1952, ch. 950, 66 Stat. 813; Pub. L. 100-418, title IX, §9004(a), Aug. 23, 1988, 102 Stat. 1564; Pub. L. 103-465, title V, §533(b)(5), Dec. 8, 1994, 108 Stat. 4989; Pub. L. 104-208, div. A, title I, §101(a) [title VI, §616], Sept. 30, 1996, 110 Stat. 3009, 3009-67; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4803], Nov. 29, 1999, 113 Stat. 1536, 1501A-589; Pub. L. 112-29, §§3(g)(2), 16(a)(1), 20(i)(4), (j), Sept. 16, 2011, 125 Stat. 288, 328, 335.)

HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §49 (R.S. 4900, amended Feb. 7, 1927, ch. 67, 44 Stat. 1058).

Language is changed. The proviso in the corresponding section of existing statute is omitted as being temporary in character and now obsolete.

Editorial Notes

REFERENCES IN TEXT

Section 9006 of the Process Patent Amendments Act of 1988, referred to in subsec. (b)(1), is section 9006 of title IX of Pub. L. 100-418, which is set out as a note under section 271 of this title.

The effective date of the Process Patent Amendments Act of 1988, referred to in subsec. (b)(4)(C), is the effective date of title IX of Pub. L. 100-418. See section 9006 of Pub. L. 100-418, set out as a note under section 271 of this title.

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 (§201 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. 5, 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, §20(j), struck out “of this title” after “271(g)”.

Subsec. (c)(1). Pub. L. 112-29, §20(j), struck out “of this title” after “271(a) or (b)” and after “285”.

Subsec. (c)(2)(G). Pub. L. 112-29, §20(i)(4), substituted “any State” for “any state”.

Subsec. (c)(4). Pub. L. 112-29, §3(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”.

1996—Subsec. (c). Pub. L. 104-208 added subsec. (c).

1994—Subsec. (a). Pub. L. 103-465, §533(b)(5)(A), substituted “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)(A). Pub. L. 103-465, §533(b)(5)(B)(ii), substituted “sold, offered for sale, or” for “sold or” in introductory provisions.

Subsec. (b)(4)(A)(ii). Pub. L. 103-465, §533(b)(5)(B)(iii), substituted “use, offer for sale, or sale” for “use, or sale”.

Subsec. (b)(4)(C). Pub. L. 103-465, §533(b)(5)(B)(iv), (v), 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”.

1988—Pub. L. 100-418 inserted “and other remedies” in section catchline, designated existing provisions as subsec. (a), and added subsec. (b).

Statutory Notes and Related Subsidiaries

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 20(i)(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 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 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.

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 of the invalid claim has been entered at the Patent and Trademark Office before the commencement of the suit.

(July 19, 1952, ch. 950, 66 Stat. 813; Pub. L. 93-596, §1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 112-29, §20(h), Sept. 16, 2011, 125 Stat. 334.)

HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §71 (R.S. 4922).
The necessity for a disclaimer to recover on valid claims is eliminated. See section 253.
Language is changed.

Editorial Notes

AMENDMENTS

2011—Pub. L. 112-29 struck out “, without deceptive intention,” after “Whenever”.

1975—Pub. L. 93-596 substituted “Patent and Trade-mark Office” for “Patent Office”.

Statutory Notes and Related Subsidiaries

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 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.

§ 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

Based on Title 35, U.S.C., 1946 ed., §§74, 75 (Feb. 4, 1887, ch. 105, §§1, 2, 24 Stat. 387, 388).
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 like 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.

(July 19, 1952, ch. 950, 66 Stat. 814; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536,

1501A-582; Pub. L. 107-273, div. C, title III, §13206(b)(1)(B), Nov. 2, 2002, 116 Stat. 1906.)

HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §70, part (R.S. 4921, amended (1) Mar. 3, 1897, ch. 391, §6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, §8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, §1, 60 Stat. 778).

This is the last sentence of R.S. 4921, third paragraph, with minor changes in language.

Editorial Notes

AMENDMENTS

2002—Pub. L. 107-273 made technical correction to directory language of Pub. L. 106-113. See 1999 Amendment note below.

1999—Pub. L. 106-113, as amended by Pub. L. 107-273, substituted “Director” for “Commissioner” wherever appearing.

Statutory Notes and Related Subsidiaries

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.

§ 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.

(July 19, 1952, ch. 950, 66 Stat. 814; Pub. L. 112-29, §§3(h)(1), 20(j), Sept. 16, 2011, 125 Stat. 288, 335.)

HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §66 (R.S. 4918, amended Mar. 2, 1927, ch. 273, §12, 44 Stat. 1337).
Language is changed.

Editorial Notes

AMENDMENTS

2011—Pub. L. 112-29, §20(j), struck out “of this title” after “146”.

Pub. L. 112-29, §3(h)(1), amended section generally. 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 adjudicate 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.”

Statutory Notes and Related Subsidiaries

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 3(h)(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(f) 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, 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.

§ 292. False marking

(a) Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used, offered for sale, or sold by such person within the United States, or imported by the person into the United States, the name or any imitation of the name of the patentee, the patent number, or the words “patent,” “patentee,” or the like, with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made, offered for sale, sold, or imported into the United States by or with the consent of the patentee; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article, the word “patent” or any word or number importing 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.

(July 19, 1952, ch. 950, 66 Stat. 814; Pub. L. 103-465, title V, §533(b)(6), Dec. 8, 1994, 108 Stat. 4990; Pub. L. 112-29, §16(b)(1)–(3), Sept. 16, 2011, 125 Stat. 329.)

HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §50 (R.S. 4901).

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 which has been interpreted by the courts as a maximum, is replaced by a higher maximum. The informer action is included as additional to an ordinary criminal action.

Editorial Notes

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.”

Subsec. (c). Pub. L. 112-29, §16(b)(3), added subsec. (c). 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”.

Statutory Notes and Related Subsidiaries

EFFECTIVE DATE OF 2011 AMENDMENT

Pub. L. 112-29, §16(b)(4), Sept. 16, 2011, 125 Stat. 329, provided that: “The amendments made by this subsection [amending this section] shall apply to all cases, without exception, that are pending on, or commenced on or after, the date of the enactment of this Act [Sept. 16, 2011].”

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.

§ 293. Nonresident patentee; service and notice

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.

(July 19, 1952, ch. 950, 66 Stat. 814; Pub. L. 93-596, §1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 112-29, §9(a), Sept. 16, 2011, 125 Stat. 316.)

HISTORICAL AND REVISION NOTES

This section provides for service on non-resident patentees.

Editorial Notes

AMENDMENTS

2011—Pub. L. 112-29 substituted “United States District Court for the Eastern District of Virginia” for “United States District Court for the District of Columbia”.

1975—Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

Statutory Notes and Related Subsidiaries**EFFECTIVE 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.

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.

§ 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 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.

(Added Pub. L. 97-247, §17(b)(1), Aug. 27, 1982, 96 Stat. 322; amended Pub. L. 106-113, div. B,

§1000(a)(9) [title IV, §4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-582; Pub. L. 107-273, div. C, title III, §13206(a)(19), (b)(1)(B), Nov. 2, 2002, 116 Stat. 1905, 1906; Pub. L. 112-29, §20(j), Sept. 16, 2011, 125 Stat. 335.)

Editorial Notes**AMENDMENTS**

2011—Subsec. (b). Pub. L. 112-29 struck out “of this title” after “282”.

2002—Subsec. (b). Pub. L. 107-273, §13206(a)(19)(A), struck out “United States Code,” after “title 9.”

Subsec. (c). Pub. L. 107-273, §13206(a)(19)(B), substituted “rendered by a court of” for “rendered by a court to”.

Subsecs. (d), (e). Pub. L. 107-273, §13206(b)(1)(B), made technical correction to directory language of Pub. L. 106-113. See 1999 Amendment note below.

1999—Subsecs. (d), (e). Pub. L. 106-113, as amended by Pub. L. 107-273, §13206(b)(1)(B), substituted “Director” for “Commissioner” wherever appearing.

Statutory Notes and Related Subsidiaries**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

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

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 patent based 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.

(Added Pub. L. 100-418, title IX, §9005(a), Aug. 23, 1988, 102 Stat. 1566; amended Pub. L. 103-465, title V, §533(b)(7), Dec. 8, 1994, 108 Stat. 4990.)

Editorial Notes**AMENDMENTS**

1994—Pub. L. 103-465 substituted “sale, offer for sale, or use” for “sale, or use” in introductory provisions.

Statutory Notes and Related Subsidiaries**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.

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.

(Added Pub. L. 102-560, § 2(a)(2), Oct. 28, 1992, 106 Stat. 4230.)

Editorial Notes**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 Interpretation*, Table of Laws Held Unconstitutional in Whole or in Part by the Supreme Court.

Statutory Notes and Related Subsidiaries**EFFECTIVE DATE**

Section effective with respect to violations that occur on or after Oct. 28, 1992, see section 4 of Pub. L. 102-560, set out as an Effective Date of 1992 Amendment note under section 2541 of Title 7, Agriculture.

§ 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 po-

tential 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.

(Added Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4102(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A–552.)

Editorial Notes

REFERENCES IN TEXT

Section 170(b)(1)(A) of the Internal Revenue Code of 1986, referred to in subsec. (c)(3)(B), is classified to section 170(b)(1)(A) of Title 26, Internal Revenue Code.

Statutory Notes and Related Subsidiaries

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 a note 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.)

Statutory Notes and Related Subsidiaries

EFFECTIVE DATE

Pub. L. 112–274, §1(a), Jan. 14, 2013, 126 Stat. 2456, provided that: “Notwithstanding section 35 of the Leahy-Smith America Invents Act [Pub. L. 112–29] (35 U.S.C. 1 note), section 298 of title 35, United States Code, shall apply to any civil action commenced on or after the date of the enactment of this Act [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 patent issued on or after that effective date, see section 35 of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment note under section 1 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.

(c) WAIVER.—A party that is an accused infringer may waive the limitations set forth in this section with respect to that party.

(Added Pub. L. 112–29, §19(d)(1), Sept. 16, 2011, 125 Stat. 332; amended Pub. L. 112–274, §1(c), Jan. 14, 2013, 126 Stat. 2456.)

Editorial Notes

AMENDMENTS

2013—Subsec. (a). Pub. L. 112–274 substituted “only if” for “or counterclaim defendants only if” in introductory provisions.

Statutory Notes and Related Subsidiaries**EFFECTIVE DATE OF 2013 AMENDMENT**

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

EFFECTIVE DATE

Section applicable to any civil action commenced on or after Sept. 16, 2011, see section 19(e) of Pub. L. 112-29, set out as an Effective Date of 2011 Amendment note under section 1295 of Title 28, Judiciary and Judicial Procedure.

CHAPTER 30—PRIOR ART CITATIONS TO OFFICE AND EX PARTE REEXAMINATION OF PATENTS

Sec.

- 301. Citation of prior art and written statements.
- 302. Request for reexamination.
- 303. Determination of issue by Director.
- 304. Reexamination order by Director.
- 305. Conduct of reexamination proceedings.
- 306. Appeal.
- 307. Certificate of patentability, unpatentability, and claim cancellation.

Editorial Notes**AMENDMENTS**

2011—Pub. L. 112-29, §6(g)(2), Sept. 16, 2011, 125 Stat. 312, amended item 301 generally, substituting “Citation of prior art and written statements” for “Citation of prior art”.

2002—Pub. L. 107-273, div. C, title III, §13206(b)(1)(B), Nov. 2, 2002, 116 Stat. 1906, made technical correction to directory language of Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-582. See 1999 Amendment note below.

1999—Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-582, as amended by Pub. L. 107-273, div. C, title III, §13206(b)(1)(B), Nov. 2, 2002, 116 Stat. 1906, substituted “Director” for “Commissioner” in item 304.

Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §§4602, 4732(a)(9)(B)], Nov. 29, 1999, 113 Stat. 1536, 1501A-567, 1501A-582, inserted “EX PARTE” before “REEXAMINATION” in chapter heading and substituted “Director” for “Commissioner” in item 303.

§ 301. Citation of prior art and written statements

(a) **IN GENERAL.**—Any person at any time may cite to the Office in writing—

(1) prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent; or

(2) statements of the patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of a particular patent.

(b) **OFFICIAL FILE.**—If the person citing prior art or written statements pursuant to subsection (a) explains in writing the pertinence and manner of applying the prior art or written statements to at least 1 claim of the patent, the citation of the prior art or written statements and the explanation thereof shall become a part of the official 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.

(Added Pub. L. 96-517, §1, Dec. 12, 1980, 94 Stat. 3015; amended Pub. L. 112-29, §6(g)(1), Sept. 16, 2011, 125 Stat. 311.)

Editorial Notes**AMENDMENTS**

2011—Pub. L. 112-29 amended section generally. Prior to amendment, text read as follows: “Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential.”

Statutory Notes and Related Subsidiaries**EFFECTIVE DATE OF 2011 AMENDMENT**

Pub. L. 112-29, §6(g)(3), Sept. 16, 2011, 125 Stat. 312, provided that: “The amendments made by this subsection [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 issued before, on, or after that effective date.”

EFFECTIVE DATE

Section effective July 1, 1981, and applicable to patents in force as of July 1, 1981, or issued thereafter, see section 8(b) of Pub. L. 96-517, set out as an Effective Date of 1980 Amendment note under section 41 of this title.

§ 302. Request for reexamination

Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301. The request must be in writing and must be accompanied by payment of a reexamination fee established by the Director pursuant to the provisions of section 41. The request must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested. Unless the requesting person is the owner of the patent, the Director promptly will send a copy of the request to the owner of record of the patent.