

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.

(Added Pub. L. 96–517, §1, Dec. 12, 1980, 94 Stat. 3015; amended Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4732(a)(8), (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; Pub. L. 112–29, §20(j), Sept. 16, 2011, 125 Stat. 335.)

Editorial Notes

AMENDMENTS

2011—Pub. L. 112–29 struck out “of this title” after “301” and after “41”.

2002—Pub. L. 107–273 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—Pub. L. 106–113, §1000(a)(9) [title IV, §4732(a)(10)(A)], as amended by Pub. L. 107–273, substituted “Director promptly” for “Commissioner promptly”.

Pub. L. 106–113, §1000(a)(9) [title IV, §4732(a)(8)], substituted “Director pursuant” for “Commissioner of Patents pursuant”.

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

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.

§ 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.

(Added Pub. L. 96–517, §1, Dec. 12, 1980, 94 Stat. 3015; amended Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4732(a)(9)(A), (10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A–582; Pub. L. 107–273, div. C, title III, §§13105(a), 13206(b)(1), Nov. 2, 2002, 116 Stat. 1900, 1905, 1906; Pub. L. 112–29, §§6(h)(1)(A), 20(j), Sept. 16, 2011, 125 Stat. 312, 335.)

Editorial Notes

AMENDMENTS

2011—Subsec. (a). Pub. L. 112–29, §20(j), struck out “of this title” after “section 302”.

Pub. L. 112–29, §6(h)(1)(A), substituted “section 301 or 302” for “section 301 of this title”.

Subsec. (c). Pub. L. 112–29, §20(j), struck out “of this title” after “section 302”.

2002—Subsec. (a). 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.

Pub. L. 107–273, §13105(a), inserted at end “The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.”

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

Subsec. (c). 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—Pub. L. 106–113, §1000(a)(9) [title IV, §4732(a)(9)(A)(i)], substituted “Director” for “Commissioner” in section catchline.

Subsec. (a). 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” in two places.

Subsec. (b). Pub. L. 106–113, §1000(a)(9) [title IV, §4732(a)(9)(A)(ii)], as amended by Pub. L. 107–273, §13206(b)(1)(A), substituted “Director’s” for “Commissioner’s”.

Subsec. (c). 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” in two places.

Statutory Notes and Related Subsidiaries

EFFECTIVE DATE OF 2011 AMENDMENT

Pub. L. 112–29, §6(h)(1)(B), Sept. 16, 2011, 125 Stat. 312, provided that: “The amendment made by this paragraph [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.”

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 2002 AMENDMENT

Pub. L. 107–273, div. C, title III, §13105(b), Nov. 2, 2002, 116 Stat. 1900, provided that: “The amendments made by this section [amending this section and section 312 of this title] shall apply with respect to any determination of the Director of the United States Patent and Trademark Office that is made under section 303(a) or [former section] 312(a) [see section 314(a)] of title 35, United States Code, on or after the date of enactment of this Act [Nov. 2, 2002].”

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

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.

§ 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 a copy of the determination is given or mailed to him, within which he may 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.

(Added Pub. L. 96-517, §1, Dec. 12, 1980, 94 Stat. 3016; 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(b)(1)(B), Nov. 2, 2002, 116 Stat. 1906; Pub. L. 112-29, §20(j), Sept. 16, 2011, 125 Stat. 335.)

Editorial Notes

AMENDMENTS

2011—Pub. L. 112-29 struck out “of this title” after “303(a)” and after “302”.

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” in section catchline and text.

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

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.

§ 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.

(Added Pub. L. 96-517, §1, Dec. 12, 1980, 94 Stat. 3016; amended Pub. L. 98-622, title II, §204(c), Nov. 8, 1984, 98 Stat. 3388; Pub. L. 112-29, §§3(j)(1), 20(j), Sept. 16, 2011, 125 Stat. 290, 335.)

Editorial Notes

AMENDMENTS

2011—Pub. L. 112-29, §20(j), struck out “of this title” after “304”, after “133”, and after “301”.

Pub. L. 112-29, §3(j)(1), substituted “Patent Trial and Appeal Board” for “Board of Patent Appeals and Interferences”.

1984—Pub. L. 98-622, §204(c), substituted “Patent Appeals and Interferences” for “Appeals”.

Statutory Notes and Related Subsidiaries

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 3(j)(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 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.

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.

§ 306. Appeal

The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134, and may seek court

review under the provisions of sections 141 to 144, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent.

(Added Pub. L. 96-517, §1, Dec. 12, 1980, 94 Stat. 3016; amended Pub. L. 112-29, §§6(h)(2)(A), 20(j), Sept. 16, 2011, 125 Stat. 312, 335.)

Editorial Notes

AMENDMENTS

2011—Pub. L. 112-29, §20(j), struck out “of this title” after “134” and after “144”.

Pub. L. 112-29, §6(h)(2)(A), substituted “144” for “145”.

Statutory Notes and Related Subsidiaries

EFFECTIVE DATE OF 2011 AMENDMENT

Pub. L. 112-29, §6(h)(2)(B), Sept. 16, 2011, 125 Stat. 312, provided that: “The amendment made by this paragraph [amending this section] shall take effect on the date of the enactment of this Act [Sept. 16, 2011] and shall apply to any appeal of a reexamination before the Board of Patent Appeals and Interferences or the Patent Trial and Appeal Board that is pending on, or brought on or after, the date of the enactment of this Act.”

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

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.

§ 307. Certificate of patentability, unpatentability, and claim cancellation

(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 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.

(Added Pub. L. 96-517, §1, Dec. 12, 1980, 94 Stat. 3016; amended Pub. L. 103-465, title V, §533(b)(8), Dec. 8, 1994, 108 Stat. 4990; 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; 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 “252”.

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

1999—Subsec. (a). Pub. L. 106-113, as amended by Pub. L. 107-273, substituted “Director” for “Commissioner”.

1994—Subsec. (b). Pub. L. 103-465 substituted “used within the United States, or imported into the United States, anything” for “used anything”.

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 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 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.

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.

Editorial Notes

AMENDMENTS

2011—Pub. L. 112-29, §6(a), Sept. 16, 2011, 125 Stat. 299, substituted “INTER PARTES REVIEW” for “OPTIONAL INTER PARTES REEXAMINATION PROCEDURES” in chapter heading and amended analysis generally, adding items 311 to 319, and striking out former items 311 “Request for inter partes reexamination”, 312 “Determination of issue by Director”, 313 “Inter partes reexamination order by Director”, 314 “Conduct of inter partes reexamination proceedings”, 315 “Appeal”, 316 “Certificate of patentability, unpatentability, and claim cancellation”, 317 “Inter partes reexamination prohibited”, and 318 “Stay of litigation”.

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

§ 311. Inter partes review

(a) IN GENERAL.—Subject to the provisions of this chapter, a person who is not the owner of a