

98–620, title IV, § 414(a), Nov. 8, 1984, 98 Stat. 3363; Pub. L. 106–113, div. B, § 1000(a)(9) [title IV, §§ 4605(d), 4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A–571, 1501A–582; Pub. L. 107–273, div. C, title III, §§ 13202(b)(2), 13206(b)(1)(B), Nov. 2, 2002, 116 Stat. 1901, 1906; Pub. L. 112–29, §§ 7(c)(3), 20(j), Sept. 16, 2011, 125 Stat. 314, 335.)

HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., § 61 (R.S. 4913, amended Mar. 2, 1927, ch. 273, § 10, 44 Stat. 1336).

Language is changed. The requirement that the Commissioner notify the parties is omitted and a requirement that the court notify the parties is added. The statement relating to filing the papers and testimony is made more explicit.

Editorial Notes

AMENDMENTS

2011—Pub. L. 112–29, § 20(j), struck out “of this title” after “142”.

Pub. L. 112–29, § 7(c)(3), substituted “In an ex parte case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all of the issues raised in the appeal. The Director shall have the right to intervene in an appeal from a decision entered by the Patent Trial and Appeal Board in a derivation proceeding under section 135 or in an inter partes or post-grant review under chapter 31 or 32.” for “In an ex parte case or any reexamination case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal.” and struck out second occurrence of “The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.” at the end.

2002—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, § 13202(b)(2), amended third sentence generally and added fourth sentence identical to existing fourth (now fifth) sentence. Prior to amendment, third sentence read as follows: “In any reexamination case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal.”

1999—Pub. L. 106–113, § 1000(a)(9) [title IV, § 4732(a)(10)(A)], as amended by Pub. L. 107–273, § 13206(b)(1)(B), substituted “Director” for “Commissioner” the first, second, and fourth places appearing.

Pub. L. 106–113, § 1000(a)(9) [title IV, § 4605(d)], amended third sentence generally. Prior to amendment, third sentence read as follows: “In an ex parte case, the Commissioner shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal.”

1984—Pub. L. 98–620 substituted provisions requiring the Commissioner to transmit to the court a certified list of the documents comprising the record in the Patent and Trademark Office, with respect to an appeal described in section 142 of this title, for provision which required the Commissioner to transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant and the appellee, and inserted provision that the court may request that the Commissioner forward the original or certified copies of such documents during the pendency of the appeal.

1982—Pub. L. 97–164 substituted “Court of Appeals for the Federal Circuit” for “Court of Customs and Patent Appeals”.

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 section 7(c)(3) 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, with certain exceptions, see section 7(e) of Pub. L. 112–29, set out as a note under section 6 of this title.

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

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by section 1000(a)(9) [title IV, § 4605(d)] of Pub. L. 106–113 effective Nov. 29, 1999, and applicable to any patent issuing from an original application filed in the United States on or after that date, see section 1000(a)(9) [title IV, § 4608(a)] of Pub. L. 106–113, set out as a note under section 41 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 1984 AMENDMENT

Amendment by Pub. L. 98–620 applicable to proceedings pending in the Patent and Trademark Office on Nov. 8, 1984, and to appeals pending in the United States Court of Appeals for the Federal Circuit on such date, see section 414(c) of Pub. L. 98–620, set out as a note under section 142 of this title.

EFFECTIVE DATE OF 1982 AMENDMENT

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. 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.

§ 144. Decision on appeal

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

(July 19, 1952, ch. 950, 66 Stat. 802; Pub. L. 93–596, § 1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 97–164, title I, § 163(a)(7), Apr. 2, 1982, 96 Stat. 49; Pub. L. 98–620, title IV, § 414(a), Nov. 8, 1984, 98 Stat. 3363; 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., § 62 (R.S. 4914).

Language is changed and the last sentence of the corresponding section of existing statute omitted as superfluous; such a sentence does not appear in the present civil action section, 35 U.S.C. 63 and in either case the validity of the patent may be questioned.

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”.

1984—Pub. L. 98-620 substituted provisions requiring the court to review the decision on the record before the Patent and Trademark Office and upon reaching a determination to issue its mandate and opinion to the Commissioner for provisions which required the court, on petition, to hear and determine the appeal on the evidence produced before the Patent and Trademark Office (with the decision to be confined to the points set forth in the reasons of appeal) and, upon its determination, to return to the Commissioner a certificate of its proceedings and decision.

1982—Pub. L. 97-164 substituted “Court of Appeals for the Federal Circuit” for “Court of Customs and Patent Appeals”.

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

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.

EFFECTIVE DATE OF 1984 AMENDMENT

Amendment by Pub. L. 98-620 applicable to proceedings pending in the Patent and Trademark Office on Nov. 8, 1984, and to appeals pending in the United States Court of Appeals for the Federal Circuit on such date, see section 414(c) of Pub. L. 98-620, set out as a note under section 142 of this title.

EFFECTIVE DATE OF 1982 AMENDMENT

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. 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.

§ 145. Civil action to obtain patent

An applicant dissatisfied with the decision of the Patent Trial and Appeal Board in an appeal under section 134(a) may, unless appeal has been taken to the United States Court of Appeals for the Federal Circuit, have remedy by civil action against the Director in the United States District Court for the Eastern District of Virginia if commenced within such time after such decision, not less than sixty days, as the Director appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Patent Trial and Appeal Board, as the facts in the case may appear and such adjudication shall authorize the Director to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

(July 19, 1952, ch. 950, 66 Stat. 803; Pub. L. 97-164, title I, §163(a)(7), Apr. 2, 1982, 96 Stat. 49; Pub. L. 98-622, title II, §203(b), Nov. 8, 1984, 98 Stat. 3387;

Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §§4605(e), 4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-571, 1501A-582; Pub. L. 107-273, div. C, title III, §13206(b)(1)(B), Nov. 2, 2002, 116 Stat. 1906; Pub. L. 112-29, §§3(j)(1), 9(a), 20(j), Sept. 16, 2011, 125 Stat. 290, 316, 335.)

HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §63 (R.S. 4915, amended (1) Mar. 2, 1927, ch. 273, §11, 44 Stat. 1336, (2) Mar. 2, 1929, ch. 488, §2(b), 45 Stat. 1476, (3) Aug. 5, 1939, ch. 451, §4, 53 Stat. 1212).

Bill in equity is changed to civil action and the section is restricted to exclude interferences which are covered by the next section. The time for filing the action is changed to the same as the time for appeal. The requirement for the applicant to file a copy of the decision in the Patent Office is omitted.

Language is changed.

Editorial Notes

AMENDMENTS

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

Pub. L. 112-29, §9(a), substituted “United States District Court for the Eastern District of Virginia” for “United States District Court for the District of Columbia”.

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

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” for “Commissioner” wherever appearing.

Pub. L. 106-113, §1000(a)(9) [title IV, §4605(e)], inserted “(a)” after “section 134”.

1984—Pub. L. 98-622 substituted “Patent Appeals and Interferences in an appeal under section 134 of this title may,” for “Appeals may” in first sentence and “Patent Appeals and Interferences” for “Appeals” in second sentence.

1982—Pub. L. 97-164 substituted “Court of Appeals for the Federal Circuit” for “Court of Customs and Patent 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 9(a) of Pub. L. 112-29 effective Sept. 16, 2011, and applicable to any civil action commenced on or after that date, see section 9(b) of Pub. L. 112-29, set out as a note under section 1071 of Title 15, Commerce and Trade.

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

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by section 1000(a)(9) [title IV, §4605(e)] of Pub. L. 106-113 applicable to any reexamination filed in the United States Patent and Trademark Office on or after Nov. 2, 2002, see section 13202(d) of Pub. L. 107-273, set out as a note under section 134 of this title.

Amendment by section 1000(a)(9) [title IV, §4605(e)] of Pub. L. 106-113 effective Nov. 29, 1999, and applicable to