

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—

(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.

#### 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), respectively, inserted headings, in subsec. (a), struck out third sentence which read “Notwithstanding the preceding sentence, if a claim to a composition of matter is held invalid and that claim was the basis of a determination of nonobviousness under section 103(b)(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 “unforceability.” in par. (1) of former second par. which was designated subsec. (b), was executed by making the substitution for “unenforceability.”, to reflect the probable intent of Congress.

Pub. L. 112-29, §15(a), amended second par. by substituting “(3) Invalidity of the patent or any claim in suit for failure to comply with—

“(A) any requirement of section 112, except that the failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable; or

“(B) any requirement of section 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.”.