

the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office to submit to Congress a report on possible inequities of certain inter partes reexamination proceedings no later than 5 years after Nov. 29, 1999.

§ 312. Petitions

(a) REQUIREMENTS OF PETITION.—A petition filed under section 311 may be considered only if—

(1) the petition is accompanied by payment of the fee established by the Director under section 311;

(2) the petition identifies all real parties in interest;

(3) the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim, including—

(A) copies of patents and printed publications that the petitioner relies upon in support of the petition; and

(B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on expert opinions;

(4) the petition provides such other information as the Director may require by regulation; and

(5) the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner.

(b) PUBLIC AVAILABILITY.—As soon as practicable after the receipt of a petition under section 311, the Director shall make the petition available to the public.

(Added Pub. L. 106–113, div. B, § 1000(a)(9) [title IV, § 4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A–568; amended Pub. L. 107–273, div. C, title III, §§ 13105(a), 13202(a)(2), (c)(1), Nov. 2, 2002, 116 Stat. 1900–1902; Pub. L. 112–29, § 6(a), (c)(3)(A)(i), Sept. 16, 2011, 125 Stat. 300, 305.)

Editorial Notes

AMENDMENTS

2011—Pub. L. 112–29, § 6(a), amended section generally. Prior to amendment, section related to determination of issue by Director.

Subsec. (a). Pub. L. 112–29, § 6(c)(3)(A)(i)(I), substituted “the information presented in the request shows that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request,” for “a substantial new question of patentability affecting any claim of the patent concerned is raised by the request,” and “A showing that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request” for “The existence of a substantial new question of patentability”.

Subsec. (c). Pub. L. 112–29, § 6(c)(3)(A)(i)(II), substituted “the showing required by subsection (a) has not been made,” for “no substantial new question of patentability has been raised.”

2002—Pub. L. 107–273, § 13202(c)(1), made technical correction to directory language of Pub. L. 106–113, which enacted this section.

Subsec. (a). Pub. L. 107–273, § 13202(a)(2)(A), struck out second sentence which read as follows: “On the Direc-

tor’s initiative, and at any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications.”

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, § 13202(a)(2)(B), struck out “; if any” after “third-party requester”.

Statutory Notes and Related Subsidiaries

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 6(a) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112–29, set out as a note under section 311 of this title.

Pub. L. 112–29, § 6(c)(3)(B), (C), Sept. 16, 2011, 125 Stat. 305, provided that:

“(B) APPLICATION.—The amendments made by this paragraph [amending this section and section 313 of this title]—

“(i) shall take effect on the date of the enactment of this Act [Sept. 16, 2011]; and

“(ii) shall apply to requests for inter partes reexamination that are filed on or after such date of enactment, but before the effective date set forth in paragraph (2)(A) of this subsection [set out as a note under section 311 of this title].

“(C) CONTINUED APPLICABILITY OF PRIOR PROVISIONS.—The provisions of chapter 31 of title 35, United States Code, as amended by this paragraph [amending this section and section 313 of this title], shall continue to apply to requests for inter partes reexamination that are filed before the effective date set forth in paragraph (2)(A) as if subsection (a) [enacting section 319 of this title and amending this section and sections 312 to 318 of this title] had not been enacted.”

EFFECTIVE DATE OF 2002 AMENDMENT

Amendment by section 13105(a) of Pub. L. 107–273 applicable with respect to any determination of the Director of the United States Patent and Trademark Office that is made on or after Nov. 2, 2002, see section 13105(b) of Pub. L. 107–273, set out as a note under section 303 of this title.

EFFECTIVE DATE

Section 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 an Effective Date of 1999 Amendment note under section 41 of this title.

§ 313. Preliminary response to petition

If an inter partes review petition is filed under section 311, the patent owner shall have the right to file a preliminary response to the petition, within a time period set by the Director, that sets forth reasons why no inter partes review should be instituted based upon the failure of the petition to meet any requirement of this chapter.

(Added Pub. L. 106–113, div. B, § 1000(a)(9) [title IV, § 4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A–568; amended Pub. L. 107–273, div. C, title III, § 13202(c)(1), Nov. 2, 2002, 116 Stat. 1902; Pub. L. 112–29, § 6(a), (c)(3)(A)(ii), Sept. 16, 2011, 125 Stat. 300, 305.)

Editorial Notes

AMENDMENTS

2011—Pub. L. 112-29, §6(c)(3)(A)(ii), which directed substitution of “it has been shown that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request” for “a substantial new question of patentability affecting a claim of the patent is raised”, was executed by making the substitution for “a substantial new question of patentability affecting a claim of a patent is raised”, to reflect the probable intent of Congress.

Pub. L. 112-29, §6(a), amended section generally. Prior to amendment, text read as follows: “If, in a determination made under section 312(a), the Director finds that it has been shown that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request, the determination shall include an order for inter partes reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the inter partes reexamination conducted in accordance with section 314.”

2002—Pub. L. 107-273 made technical correction to directory language of Pub. L. 106-113, which enacted this section.

Statutory Notes and Related Subsidiaries

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 6(a) of Pub. L. 112-29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112-29, set out as a note under section 311 of this title.

Amendment by section 6(c)(3)(A)(ii) of Pub. L. 112-29 effective Sept. 16, 2011, and applicable to requests for inter partes reexamination filed on or after Sept. 16, 2011, but before the effective date set forth in section 6(c)(2)(A) of Pub. L. 112-29, with continued applicability of prior provisions, see section 6(c)(3)(B), (C) of Pub. L. 112-29, set out as a note under section 312 of this title.

EFFECTIVE DATE

Section 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 an Effective Date of 1999 Amendment note under section 41 of this title.

§ 314. Institution of inter partes review

(a) **THRESHOLD.**—The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

(b) **TIMING.**—The Director shall determine whether to institute an inter partes review under this chapter pursuant to a petition filed under section 311 within 3 months after—

- (1) receiving a preliminary response to the petition under section 313; or
- (2) if no such preliminary response is filed, the last date on which such response may be filed.

(c) **NOTICE.**—The Director shall notify the petitioner and patent owner, in writing, of the Director’s determination under subsection (a), and

shall make such notice available to the public as soon as is practicable. Such notice shall include the date on which the review shall commence.

(d) **NO APPEAL.**—The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.

(Added Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-568; amended Pub. L. 107-273, div. C, title III, §13202(a)(3), (c)(1), Nov. 2, 2002, 116 Stat. 1901, 1902; Pub. L. 112-29, §6(a), Sept. 16, 2011, 125 Stat. 300.)

Editorial Notes

AMENDMENTS

2011—Pub. L. 112-29 amended section generally. Prior to amendment, section related to conduct of inter partes reexamination proceedings.

2002—Pub. L. 107-273, §13202(c)(1), made technical correction to directory language of Pub. L. 106-113, which enacted this section.

Subsec. (b). Pub. L. 107-273, §13202(a)(3), redesignated par. (2) as (1), substituted “the Office shall send to the third-party requester a copy” for “the third-party requester shall receive a copy”, redesignated par. (3) as (2), and struck out former par. (1) which read as follows: “This subsection shall apply to any inter partes reexamination proceeding in which the order for inter partes reexamination is based upon a request by a third-party requester.”

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 any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112-29, set out as a note under section 311 of this title.

EFFECTIVE DATE

Section 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 an Effective Date of 1999 Amendment note under section 41 of this title.

§ 315. Relation to other proceedings or actions

(a) **INFRINGEMENT’S CIVIL ACTION.**—

(1) **INTER PARTES REVIEW BARRED BY CIVIL ACTION.**—An inter partes review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.

(2) **STAY OF CIVIL ACTION.**—If the petitioner or real party in interest files a civil action challenging the validity of a claim of the patent on or after the date on which the petitioner files a petition for inter partes review of the patent, that civil action shall be automatically stayed until either—

(A) the patent owner moves the court to lift the stay;

(B) the patent owner files a civil action or counterclaim alleging that the petitioner or real party in interest has infringed the patent; or