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§ 321. Post-grant review

(a) IN GENERAL.—Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute a post-grant review of the patent. The Director shall establish, by regulation, fees to be paid by the person requesting the review, in such amounts as the Director determines to be reasonable, considering the aggregate costs of the post-grant review.

(b) SCOPE.—A petitioner in a post-grant review may request to cancel as unpatentable 1 or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of section 282(b) (relating to invalidity of the patent or any claim).

(c) FILING DEADLINE.—A petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a re-issuance patent (as the case may be).

(Added Pub. L. 112–29, §6(d), Sept. 16, 2011, 125 Stat. 306.)

Statutory Notes and Related Subsidiaries

EFFECTIVE DATE

Pub. L. 112–29, §6(f)(2), (3), Sept. 16, 2011, 125 Stat. 311, provided that:

“(2) APPLICABILITY.—

“(A) IN GENERAL.—The amendments made by subsection (d) [enacting this chapter] 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, except as provided in section 18 [set out as a note below] and in paragraph (3), shall apply only to patents described in section 3(n)(1) [set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title].

“(B) LIMITATION.—The Director [Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] may impose a limit on the number of post-grant reviews that may be instituted under chapter 32 of title 35, United States Code, during each of the first 4 1-year periods in which the amendments made by subsection (d) are in effect.

“(3) PENDING INTERFERENCES.—

“(A) PROCEDURES IN GENERAL.—The Director shall determine, and include in the regulations issued under paragraph (1) [set out as a note below], the procedures under which an interference commenced before the effective date set forth in paragraph (2)(A) is to proceed, including whether such interference—

“(i) is to be dismissed without prejudice to the filing of a petition for a post-grant review under chapter 32 of title 35, United States Code; or

“(ii) is to proceed as if this Act [see Short Title of 2011 Amendment note set out under section 1 of this title] had not been enacted.

“(B) PROCEEDINGS BY PATENT TRIAL AND APPEAL BOARD.—For purposes of an interference that is commenced before the effective date set forth in paragraph (2)(A), the Director may deem the Patent Trial and Appeal Board to be the Board of Patent Appeals and Interferences, and may allow the Patent Trial

and Appeal Board to conduct any further proceedings in that interference.

“(C) APPEALS.—The authorization to appeal or have remedy from derivation proceedings in sections 141(d) and 146 of title 35, United States Code, as amended by this Act, and the jurisdiction to entertain appeals from derivation proceedings in section 1295(a)(4)(A) of title 28, United States Code, as amended by this Act, shall be deemed to extend to any final decision in an interference that is commenced before the effective date set forth in paragraph (2)(A) of this subsection and that is not dismissed pursuant to this paragraph.”

REGULATIONS

Pub. L. 112–29, §6(f)(1), Sept. 16, 2011, 125 Stat. 311, provided that: “The Director [Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] shall, not later than the date that is 1 year after the date of the enactment of this Act [Sept. 16, 2011], issue regulations to carry out chapter 32 of title 35, United States Code, as added by subsection (d) of this section.”

TRANSITIONAL PROGRAM FOR COVERED BUSINESS METHOD PATENTS

Pub. L. 112–29, §18, Sept. 16, 2011, 125 Stat. 329, as amended by Pub. L. 112–274, §1(b), Jan. 14, 2013, 126 Stat. 2456, provided that:

“(a) TRANSITIONAL PROGRAM.—

“(1) ESTABLISHMENT.—Not later than the date that is 1 year after the date of the enactment of this Act [Sept. 16, 2011], the Director [Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] shall issue regulations establishing and implementing a transitional post-grant review proceeding for review of the validity of covered business method patents. The transitional proceeding implemented pursuant to this subsection shall be regarded as, and shall employ the standards and procedures of, a post-grant review under chapter 32 of title 35, United States Code, subject to the following:

“(A) Section 321(c) of title 35, United States Code, and subsections (b), (e)(2), and (f) of section 325 of such title shall not apply to a transitional proceeding.

“(B) A person may not file a petition for a transitional proceeding with respect to a covered business method patent unless the person or the person’s real party in interest or privy has been sued for infringement of the patent or has been charged with infringement under that patent.

“(C) A petitioner in a transitional proceeding who challenges the validity of 1 or more claims in a covered business method patent on a ground raised under section 102 or 103 of title 35, United States Code, as in effect on the day before the effective date set forth in section 3(n)(1) [set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title], may support such ground only on the basis of—

“(i) prior art that is described by section 102(a) of such title (as in effect on the day before such effective date); or

“(ii) prior art that—

“(I) discloses the invention more than 1 year before the date of the application for patent in the United States; and

“(II) would be described by section 102(a) of such title (as in effect on the day before the effective date set forth in section 3(n)(1)) if the disclosure had been made by another before the invention thereof by the applicant for patent.

“(D) The petitioner in a transitional proceeding that results in a final written decision under section 328(a) of title 35, United States Code, with respect to a claim in a covered business method patent, or the petitioner’s real party in interest, may

not assert, either in a civil action arising in whole or in part under section 1338 of title 28, United States Code, or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 (19 U.S.C. 1337), that the claim is invalid on any ground that the petitioner raised during that transitional proceeding.

“(E) The Director may institute a transitional proceeding only for a patent that is a covered business method patent.

“(2) EFFECTIVE DATE.—The regulations issued under paragraph (1) 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 covered business method patent issued before, on, or after that effective date, except that the regulations shall not apply to a patent described in section 6(f)(2)(A) of this Act [set out as a note above] during the period in which a petition for post-grant review of that patent would satisfy the requirements of section 321(c) of title 35, United States Code.

“(3) SUNSET.—

“(A) IN GENERAL.—This subsection, and the regulations issued under this subsection, are repealed effective upon the expiration of the 8-year period beginning on the date that the regulations issued under to [sic] paragraph (1) take effect [Regulations effective Sept. 16, 2012, see 77 F.R. 48680.].

“(B) APPLICABILITY.—Notwithstanding subparagraph (A), this subsection and the regulations issued under this subsection shall continue to apply, after the date of the repeal under subparagraph (A), to any petition for a transitional proceeding that is filed before the date of such repeal.

“(b) REQUEST FOR STAY.—

“(1) IN GENERAL.—If a party seeks a stay of a civil action alleging infringement of a patent under section 281 of title 35, United States Code, relating to a transitional proceeding for that patent, the court shall decide whether to enter a stay based on—

“(A) whether a stay, or the denial thereof, will simplify the issues in question and streamline the trial;

“(B) whether discovery is complete and whether a trial date has been set;

“(C) whether a stay, or the denial thereof, would unduly prejudice the nonmoving party or present a clear tactical advantage for the moving party; and

“(D) whether a stay, or the denial thereof, will reduce the burden of litigation on the parties and on the court.

“(2) REVIEW.—A party may take an immediate interlocutory appeal from a district court’s decision under paragraph (1). The United States Court of Appeals for the Federal Circuit shall review the district court’s decision to ensure consistent application of established precedent, and such review may be de novo.

“(c) ATM EXEMPTION FOR VENUE PURPOSES.—In an action for infringement under section 281 of title 35, United States Code, of a covered business method patent, an automated teller machine shall not be deemed to be a regular and established place of business for purposes of section 1400(b) of title 28, United States Code.

“(d) DEFINITION.—

“(1) IN GENERAL.—For purposes of this section, the term ‘covered business method patent’ means a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.

“(2) REGULATIONS.—To assist in implementing the transitional proceeding authorized by this section, the Director shall issue regulations for determining whether a patent is for a technological invention.

“(e) RULE OF CONSTRUCTION.—Nothing in this section shall be construed as amending or interpreting categories of patent-eligible subject matter set forth under section 101 of title 35, United States Code.”

§ 322. Petitions

(a) REQUIREMENTS OF PETITION.—A petition filed under section 321 may be considered only if—

(1) the petition is accompanied by payment of the fee established by the Director under section 321;

(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 other factual evidence or 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 321, the Director shall make the petition available to the public.

(Added Pub. L. 112–29, §6(d), Sept. 16, 2011, 125 Stat. 306.)

Statutory Notes and Related Subsidiaries

EFFECTIVE DATE

Section effective upon the expiration of the 1-year period beginning Sept. 16, 2011, and applicable only to patents described in section 3(n)(1) of Pub. L. 112–29 (35 U.S.C. 100 note), with certain exceptions and limitations, see section 6(f)(2), (3) of Pub. L. 112–29, set out as a note under section 321 of this title.

§ 323. Preliminary response to petition

If a post-grant review petition is filed under section 321, 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 post-grant review should be instituted based upon the failure of the petition to meet any requirement of this chapter.

(Added Pub. L. 112–29, §6(d), Sept. 16, 2011, 125 Stat. 306.)

Statutory Notes and Related Subsidiaries

EFFECTIVE DATE

Section effective upon the expiration of the 1-year period beginning Sept. 16, 2011, and applicable only to patents described in section 3(n)(1) of Pub. L. 112–29 (35 U.S.C. 100 note), with certain exceptions and limitations, see section 6(f)(2), (3) of Pub. L. 112–29, set out as a note under section 321 of this title.

§ 324. Institution of post-grant review

(a) THRESHOLD.—The Director may not authorize a post-grant review to be instituted unless