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# CONSOLIDATED PATENT LAWS

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## United States Code Title 35 - Patents

**Editor's Note (January 2007):** The Patent Laws reproduced below supersede those reproduced in the last revision of the Manual of Patent Examining Procedure (MPEP) dated August 2006. The Public Laws are the authoritative source and should be consulted if a need arises to verify the authenticity of the language reproduced below.

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## PART I — UNITED STATES PATENT AND TRADEMARK OFFICE

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with foreign countries.
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libraries.
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### 35 U.S.C. 1 Establishment.

(a) ESTABLISHMENT.— The United States Patent and Trademark Office is established as an agency of the United States, within the Department of Commerce. In carrying out its functions, the United States Patent and Trademark Office shall be subject to the policy direction of the Secretary of Commerce, but otherwise shall retain responsibility for decisions regarding the management and administration of its operations and shall exercise independent control of its budget allocations and expenditures, personnel decisions and processes, procurements, and other administrative and management functions in accordance with this title and applicable provisions of law. Those operations designed to grant and issue patents and those operations which are designed to facilitate the registration of trademarks shall be treated as separate operating units within the Office.

(b) OFFICES.— The United States Patent and Trademark Office shall maintain its principal office in the metropolitan Washington, D.C., area, for the service of process and papers and for the purpose of carrying out its functions. The United States Patent and Trademark Office shall be deemed, for purposes of venue in civil actions, to be a resident of the district in which its principal office is located, except where jurisdiction is otherwise provided by law. The United States Patent and Trademark Office may establish satellite offices in such other places in the United States as it considers necessary and appropriate in the conduct of its business.

(c) REFERENCE.— For purposes of this title, the United States Patent and Trademark Office shall

also be referred to as the “Office” and the “Patent and Trademark Office”.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-572 (S. 1948 sec. 4711).)

### 35 U.S.C. 2 Powers and duties.

(a) IN GENERAL.— The United States Patent and Trademark Office, subject to the policy direction of the Secretary of Commerce—

(1) shall be responsible for the granting and issuing of patents and the registration of trademarks; and

(2) shall be responsible for disseminating to the public information with respect to patents and trademarks.

(b) SPECIFIC POWERS.— The Office—

(1) shall adopt and use a seal of the Office, which shall be judicially noticed and with which letters patent, certificates of trademark registrations, and papers issued by the Office shall be authenticated;

(2) may establish regulations, not inconsistent with law, which—

(A) shall govern the conduct of proceedings in the Office;

(B) shall be made in accordance with section 553 of title 5;

(C) shall facilitate and expedite the processing of patent applications, particularly those which can be filed, stored, processed, searched, and retrieved electronically, subject to the provisions of section 122 relating to the confidential status of applications;

(D) may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office;

(E) shall recognize the public interest in continuing to safeguard broad access to the United States patent system through the reduced fee structure for small entities under section 41(h)(1) of this title; and

(F) provide for the development of a performance-based process that includes quantitative and qualitative measures and standards for evaluating cost-effectiveness and is consistent with the principles of impartiality and competitiveness;

(3) may acquire, construct, purchase, lease, hold, manage, operate, improve, alter, and renovate any real, personal, or mixed property, or any interest therein, as it considers necessary to carry out its functions;

(4)(A) may make such purchases, contracts for the construction, or management and operation of facilities, and contracts for supplies or services, without regard to the provisions of subtitle I and chapter 33 of title 40, title III of the Federal Property and Administrative Services Act of 1949 (41 U.S.C. 251 et seq.), and the McKinney-Vento Homeless Assistance Act (42 U.S.C. 11301 et seq.);

(B) may enter into and perform such purchases and contracts for printing services, including the process of composition, platemaking, presswork, silk screen processes, binding, microform, and the products of such processes, as it considers necessary to carry out the functions of the Office, without regard to sections 501 through 517 and 1101 through 1123 of title 44;

(5) may use, with their consent, services, equipment, personnel, and facilities of other departments, agencies, and instrumentalities of the Federal Government, on a reimbursable basis, and cooperate with such other departments, agencies, and instrumentalities in the establishment and use of services, equipment, and facilities of the Office;

(6) may, when the Director determines that it is practicable, efficient, and cost-effective to do so, use, with the consent of the United States and the agency, instrumentality, Patent and Trademark Office, or international organization concerned, the services, records, facilities, or personnel of any State or local government agency or instrumentality or foreign patent and trademark office or international organization to perform functions on its behalf;

(7) may retain and use all of its revenues and receipts, including revenues from the sale, lease, or disposal of any real, personal, or mixed property, or any interest therein, of the Office;

(8) shall advise the President, through the Secretary of Commerce, on national and certain international intellectual property policy issues;

(9) shall advise Federal departments and agencies on matters of intellectual property policy in the United States and intellectual property protection in other countries;

(10) shall provide guidance, as appropriate, with respect to proposals by agencies to assist foreign governments and international intergovernmental organizations on matters of intellectual property protection;

(11) may conduct programs, studies, or exchanges of items or services regarding domestic and international intellectual property law and the effectiveness of intellectual property protection domestically and throughout the world;

(12)(A) shall advise the Secretary of Commerce on programs and studies relating to intellectual property policy that are conducted, or authorized to be conducted, cooperatively with foreign intellectual property offices and international intergovernmental organizations; and

(B) may conduct programs and studies described in subparagraph (A); and

(13)(A) in coordination with the Department of State, may conduct programs and studies cooperatively with foreign intellectual property offices and international intergovernmental organizations; and

(B) with the concurrence of the Secretary of State, may authorize the transfer of not to exceed \$100,000 in any year to the Department of State for the purpose of making special payments to international intergovernmental organizations for studies and programs for advancing international cooperation concerning patents, trademarks, and other matters.

(c) CLARIFICATION OF SPECIFIC POWERS.—

(1) The special payments under subsection (b)(13)(B) shall be in addition to any other payments or contributions to international organizations described in subsection (b)(13)(B) and shall not be subject to any limitations imposed by law on the amounts of such other payments or contributions by the United States Government.

(2) Nothing in subsection (b) shall derogate from the duties of the Secretary of State or from the duties of the United States Trade Representative as set forth in section 141 of the Trade Act of 1974 (19 U.S.C. 2171).

(3) Nothing in subsection (b) shall derogate from the duties and functions of the Register of Copyrights or otherwise alter current authorities relating to copyright matters.

(4) In exercising the Director's powers under paragraphs (3) and (4)(A) of subsection (b), the Director shall consult with the Administrator of General Services.

(5) In exercising the Director's powers and duties under this section, the Director shall consult with the Register of Copyrights on all copyright and related matters.

(d) CONSTRUCTION.— Nothing in this section shall be construed to nullify, void, cancel, or interrupt any pending request-for-proposal let or contract issued by the General Services Administration for the specific purpose of relocating or leasing space to the United States Patent and Trademark Office.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-572 (S. 1948 sec. 4712); subsection (b)(4)(A) amended Oct. 30, 2000, Public Law 106-400, sec. 2, 114 Stat. 1675; subsections (b)(2)(B) and (b)(4)(B) amended Nov. 2, 2002, Public Law 107-273, sec. 13206, 116 Stat. 1904; subsection (b)(4)(A) amended Dec. 15, 2003, Public Law 108-178, sec. 4(g), 117 Stat. 2641.)

### **35 U.S.C. 3 Officers and employees.**

(a) UNDER SECRETARY AND DIRECTOR.—

(1) IN GENERAL.— The powers and duties of the United States Patent and Trademark Office shall be vested in an Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (in this title referred to as the "Director"), who shall be a citizen of the United States and who shall be appointed by the President, by and with the advice and consent of the Senate. The Director shall be a person who has a professional background and experience in patent or trademark law.

(2) DUTIES.—

(A) IN GENERAL.— The Director shall be responsible for providing policy direction and

management supervision for the Office and for the issuance of patents and the registration of trademarks. The Director shall perform these duties in a fair, impartial, and equitable manner.

(B) CONSULTING WITH THE PUBLIC ADVISORY COMMITTEES.— The Director shall consult with the Patent Public Advisory Committee established in section 5 on a regular basis on matters relating to the patent operations of the Office, shall consult with the Trademark Public Advisory Committee established in section 5 on a regular basis on matters relating to the trademark operations of the Office, and shall consult with the respective Public Advisory Committee before submitting budgetary proposals to the Office of Management and Budget or changing or proposing to change patent or trademark user fees or patent or trademark regulations which are subject to the requirement to provide notice and opportunity for public comment under section 553 of title 5, as the case may be.

(3) OATH.— The Director shall, before taking office, take an oath to discharge faithfully the duties of the Office.

(4) REMOVAL.— The Director may be removed from office by the President. The President shall provide notification of any such removal to both Houses of Congress.

(b) OFFICERS AND EMPLOYEES OF THE OFFICE.—

(1) DEPUTY UNDER SECRETARY AND DEPUTY DIRECTOR.— The Secretary of Commerce, upon nomination by the Director, shall appoint a Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office who shall be vested with the authority to act in the capacity of the Director in the event of the absence or incapacity of the Director. The Deputy Director shall be a citizen of the United States who has a professional background and experience in patent or trademark law.

(2) COMMISSIONERS.—

(A) APPOINTMENT AND DUTIES.— The Secretary of Commerce shall appoint a Commissioner for Patents and a Commissioner for Trademarks, without regard to chapter 33, 51, or 53 of title 5. The Commissioner for Patents shall be a citizen of the United States with demonstrated management ability and professional background and experience in

patent law and serve for a term of 5 years. The Commissioner for Trademarks shall be a citizen of the United States with demonstrated management ability and professional background and experience in trademark law and serve for a term of 5 years. The Commissioner for Patents and the Commissioner for Trademarks shall serve as the chief operating officers for the operations of the Office relating to patents and trademarks, respectively, and shall be responsible for the management and direction of all aspects of the activities of the Office that affect the administration of patent and trademark operations, respectively. The Secretary may reappoint a Commissioner to subsequent terms of 5 years as long as the performance of the Commissioner as set forth in the performance agreement in subparagraph (B) is satisfactory.

(B) SALARY AND PERFORMANCE AGREEMENT.— The Commissioners shall be paid an annual rate of basic pay not to exceed the maximum rate of basic pay for the Senior Executive Service established under section 5382 of title 5, including any applicable locality-based comparability payment that may be authorized under section 5304(h)(2)(C) of title 5. The compensation of the Commissioners shall be considered, for purposes of section 207(c)(2)(A) of title 18, to be the equivalent of that described under clause (ii) of section 207(c)(2)(A) of title 18. In addition, the Commissioners may receive a bonus in an amount of up to, but not in excess of, 50 percent of the Commissioners' annual rate of basic pay, based upon an evaluation by the Secretary of Commerce, acting through the Director, of the Commissioners' performance as defined in an annual performance agreement between the Commissioners and the Secretary. The annual performance agreements shall incorporate measurable organization and individual goals in key operational areas as delineated in an annual performance plan agreed to by the Commissioners and the Secretary. Payment of a bonus under this subparagraph may be made to the Commissioners only to the extent that such payment does not cause the Commissioners' total aggregate compensation in a calendar year to equal or exceed the amount of the salary of the Vice President under section 104 of title 3.

(C) REMOVAL.— The Commissioners may be removed from office by the Secretary for misconduct or nonsatisfactory performance under the per-

formance agreement described in subparagraph (B), without regard to the provisions of title 5. The Secretary shall provide notification of any such removal to both Houses of Congress.

(3) OTHER OFFICERS AND EMPLOYEES.— The Director shall—

(A) appoint such officers, employees (including attorneys), and agents of the Office as the Director considers necessary to carry out the functions of the Office; and

(B) define the title, authority, and duties of such officers and employees and delegate to them such of the powers vested in the Office as the Director may determine.

The Office shall not be subject to any administratively or statutorily imposed limitation on positions or personnel, and no positions or personnel of the Office shall be taken into account for purposes of applying any such limitation

(4) TRAINING OF EXAMINERS.— The Office shall submit to the Congress a proposal to provide an incentive program to retain as employees patent and trademark examiners of the primary examiner grade or higher who are eligible for retirement, for the sole purpose of training patent and trademark examiners.

(5) NATIONAL SECURITY POSITIONS.— The Director, in consultation with the Director of the Office of Personnel Management, shall maintain a program for identifying national security positions and providing for appropriate security clearances, in order to maintain the secrecy of certain inventions, as described in section 181, and to prevent disclosure of sensitive and strategic information in the interest of national security.

(c) CONTINUED APPLICABILITY OF TITLE 5. — Officers and employees of the Office shall be subject to the provisions of title 5, relating to Federal employees.

(d) ADOPTION OF EXISTING LABOR AGREEMENTS.— The Office shall adopt all labor agreements which are in effect, as of the day before the effective date of the Patent and Trademark Office Efficiency Act, with respect to such Office (as then in effect).

(e) CARRYOVER OF PERSONNEL.—

(1) FROM PTO.— Effective as of the effective date of the Patent and Trademark Office Effi-

ciency Act, all officers and employees of the Patent and Trademark Office on the day before such effective date shall become officers and employees of the Office, without a break in service.

(2) **OTHER PERSONNEL.**— Any individual who, on the day before the effective date of the Patent and Trademark Office Efficiency Act, is an officer or employee of the Department of Commerce (other than an officer or employee under paragraph (1)) shall be transferred to the Office, as necessary to carry out the purposes of this Act, if—

(A) such individual serves in a position for which a major function is the performance of work reimbursed by the Patent and Trademark Office, as determined by the Secretary of Commerce;

(B) such individual serves in a position that performed work in support of the Patent and Trademark Office during at least half of the incumbent's work time, as determined by the Secretary of Commerce; or

(C) such transfer would be in the interest of the Office, as determined by the Secretary of Commerce in consultation with the Director.

Any transfer under this paragraph shall be effective as of the same effective date as referred to in paragraph (1), and shall be made without a break in service.

(f) **TRANSITION PROVISIONS.**—

(1) **INTERIM APPOINTMENT OF DIRECTOR.**— On or after the effective date of the Patent and Trademark Office Efficiency Act, the President shall appoint an individual to serve as the Director until the date on which a Director qualifies under subsection (a). The President shall not make more than one such appointment under this subsection.

(2) **CONTINUATION IN OFFICE OF CERTAIN OFFICERS.**—

(A) The individual serving as the Assistant Commissioner for Patents on the day before the effective date of the Patent and Trademark Office Efficiency Act may serve as the Commissioner for Patents until the date on which a Commissioner for Patents is appointed under subsection (b).

(B) The individual serving as the Assistant Commissioner for Trademarks on the day before the effective date of the Patent and Trademark Office Efficiency Act may serve as the Commissioner for

Trademarks until the date on which a Commissioner for Trademarks is appointed under subsection (b).

(Amended Sept. 6, 1958, Public Law 85-933, sec. 1, 72 Stat. 1793; Sept. 23, 1959, Public Law 86-370, sec. 1(a), 73 Stat. 650; Aug. 14, 1964, Public Law 88-426, sec. 305(26), 78 Stat. 425; Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Jan. 2, 1975, Public Law 93-601, sec. 1, 88 Stat. 1956; Aug. 27, 1982, Public Law 97-247, sec. 4, 96 Stat. 319; Oct. 25, 1982, Public Law 97-366, sec. 4, 96 Stat. 1760; Nov. 8, 1984, Public Law 98-622, sec. 405, 98 Stat. 3392; Oct. 28, 1998, Public Law 105-304, sec. 401(a)(1), 112 Stat. 2887; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-575 (S. 1948 sec. 4713); subsections (a)(2)(B), (b)(2), and (c) amended Nov. 2, 2002, Public Law 107-273, sec. 13206, 116 Stat. 1904.)

### **35 U.S.C. 4 Restrictions on officers and employees as to interest in patents.**

Officers and employees of the Patent and Trademark Office shall be incapable, during the period of their appointments and for one year thereafter, of applying for a patent and of acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in any patent, issued or to be issued by the Office. In patents applied for thereafter they shall not be entitled to any priority date earlier than one year after the termination of their appointment.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

### **35 U.S.C. 5 Patent and Trademark Office Public Advisory Committees.**

(a) **ESTABLISHMENT OF PUBLIC ADVISORY COMMITTEES.**—

(1) **APPOINTMENT.**— The United States Patent and Trademark Office shall have a Patent Public Advisory Committee and a Trademark Public Advisory Committee, each of which shall have nine voting members who shall be appointed by the Secretary of Commerce and serve at the pleasure of the Secretary of Commerce. Members of each Public Advisory Committee shall be appointed for a term of 3 years, except that of the members first appointed, three shall be appointed for a term of 1 year, and three shall be appointed for a term of 2 years. In making appointments to each Committee, the Secretary of Commerce shall consider the risk of loss of competitive advantage in international commerce or other

harm to United States companies as a result of such appointments.

(2) CHAIR.— The Secretary shall designate a chair of each Advisory Committee, whose term as chair shall be for 3 years.

(3) TIMING OF APPOINTMENTS.— Initial appointments to each Advisory Committee shall be made within 3 months after the effective date of the Patent and Trademark Office Efficiency Act. Vacancies shall be filled within 3 months after they occur.

(b) BASIS FOR APPOINTMENTS.— Members of each Advisory Committee—

(1) shall be citizens of the United States who shall be chosen so as to represent the interests of diverse users of the United States Patent and Trademark Office with respect to patents, in the case of the Patent Public Advisory Committee, and with respect to trademarks, in the case of the Trademark Public Advisory Committee;

(2) shall include members who represent small and large entity applicants located in the United States in proportion to the number of applications filed by such applicants, but in no case shall members who represent small entity patent applicants, including small business concerns, independent inventors, and nonprofit organizations, constitute less than 25 percent of the members of the Patent Public Advisory Committee, and such members shall include at least one independent inventor; and

(3) shall include individuals with substantial background and achievement in finance, management, labor relations, science, technology, and office automation. In addition to the voting members, each Advisory Committee shall include a representative of each labor organization recognized by the United States Patent and Trademark Office. Such representatives shall be nonvoting members of the Advisory Committee to which they are appointed.

(c) MEETINGS.— Each Advisory Committee shall meet at the call of the chair to consider an agenda set by the chair.

(d) DUTIES.— Each Advisory Committee shall—

(1) review the policies, goals, performance, budget, and user fees of the United States Patent and Trademark Office with respect to patents, in the case of the Patent Public Advisory Committee, and with respect to Trademarks, in the case of the Trademark

Public Advisory Committee, and advise the Director on these matters;

(2) within 60 days after the end of each fiscal year—

(A) prepare an annual report on the matters referred to in paragraph (1);

(B) transmit the report to the Secretary of Commerce, the President, and the Committees on the Judiciary of the Senate and the House of Representatives; and

(C) publish the report in the Official Gazette of the United States Patent and Trademark Office.

(e) COMPENSATION.— Each member of each Advisory Committee shall be compensated for each day (including travel time) during which such member is attending meetings or conferences of that Advisory Committee or otherwise engaged in the business of that Advisory Committee, at the rate which is the daily equivalent of the annual rate of basic pay in effect for level III of the Executive Schedule under section 5314 of title 5. While away from such member's home or regular place of business such member shall be allowed travel expenses, including per diem in lieu of subsistence, as authorized by section 5703 of title 5.

(f) ACCESS TO INFORMATION.— Members of each Advisory Committee shall be provided access to records and information in the United States Patent and Trademark Office, except for personnel or other privileged information and information concerning patent applications required to be kept in confidence by section 122.

(g) APPLICABILITY OF CERTAIN ETHICS LAWS.— Members of each Advisory Committee shall be special Government employees within the meaning of section 202 of title 18.

(h) INAPPLICABILITY OF FEDERAL ADVISORY COMMITTEE ACT.— The Federal Advisory Committee Act (5 U.S.C. App.) shall not apply to each Advisory Committee.

(i) OPEN MEETINGS.— The meetings of each Advisory Committee shall be open to the public, except that each Advisory Committee may by majority vote meet in executive session when considering personnel, privileged, or other confidential information.

(j) **INAPPLICABILITY OF PATENT PROHIBITION.**— Section 4 shall not apply to voting members of the Advisory Committees.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-578 (S. 1948 sec. 4714); subsections (e) and (g) amended Nov. 2, 2002, Public Law 107-273, sec. 13206, 116 Stat. 1904; subsection (i) amended and subsection (j) added Nov. 2, 2002, Public Law 107-273, sec. 13203, 116 Stat. 1902.)

### **35 U.S.C. 6 Board of Patent Appeals and Interferences.**

(a) **ESTABLISHMENT AND COMPOSITION.**— There shall be in the United States Patent and Trademark Office a Board of Patent Appeals and Interferences. The Director, the Deputy Commissioner, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Board. The administrative patent judges shall be persons of competent legal knowledge and scientific ability who are appointed by the Director.

(b) **DUTIES.**— The Board of Patent Appeals and Interferences shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents and shall determine priority and patentability of invention in interferences declared under section 135(a). Each appeal and interference shall be heard by at least three members of the Board, who shall be designated by the Director. Only the Board of Patent Appeals and Interferences may grant rehearings.

(Repealed by Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4715(a)).

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4717(2)).)

(Subsection (a) amended Nov. 2, 2002, Public Law 107-273, sec. 13203, 116 Stat. 1902.)

### **35 U.S.C. 7 Library.**

The Director shall maintain a library of scientific and other works and periodicals, both foreign and domestic, in the Patent and Trademark Office to aid the officers in the discharge of their duties.

(Repealed Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4717(1)).)

(Transferred from 35 U.S.C. 8 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S.

1948 sec. 4717(1)); amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

### **35 U.S.C. 8 Classification of patents.**

The Director may revise and maintain the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patent are filed.

(Transferred to 35 U.S.C. 7 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4717(1)).)

(Transferred from 35 U.S.C. 9 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4717(1)).)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

### **35 U.S.C. 9 Certified copies of records.**

The Director may furnish certified copies of specifications and drawings of patents issued by the Patent and Trademark Office, and of other records available either to the public or to the person applying therefor.

(Transferred to 35 U.S.C. 8 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4717(1)).)

(Transferred from 35 U.S.C. 10 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4717(1)); amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

### **35 U.S.C. 10 Publications.**

(a) The Director may publish in printed, type-written, or electronic form, the following:

(1) Patents and published applications for patents, including specifications and drawings, together with copies of the same. The Patent and Trademark Office may print the headings of the drawings for patents for the purpose of photolithography.

(2) Certificates of trademark registrations, including statements and drawings, together with copies of the same.

(3) The Official Gazette of the United States Patent and Trademark Office.

(4) Annual indexes of patents and patentees, and of trademarks and registrants.

(5) Annual volumes of decisions in patent and trademark cases.

(6) Pamphlet copies of the patent laws and rules of practice, laws and rules relating to trademarks, and circulars or other publications relating to the business of the Office.

(b) The Director may exchange any of the publications specified in items 3, 4, 5, and 6 of subsection (a) of this section for publications desirable for the use of the Patent and Trademark Office.

(Transferred to 35 U.S.C. 9 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4717(1)).)

(Transferred from 35 U.S.C. 11 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S 1948 sec. 4717(1)); amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-589 (S. 1948 sec. 4804(b)).)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-565, 582 (S. 1948 secs. 4507(1) and 4732(a)(10)(A)).)

**35 U.S.C. 11 Exchange of copies of patents and applications with foreign countries.**

The Director may exchange copies of specifications and drawings of United States patents and published applications for patents for those of foreign countries.

The Director shall not enter into an agreement to provide such copies of specifications and drawings of United States patents and applications to a foreign country, other than a NAFTA country or a WTO member country, without the express authorization of the Secretary of Commerce. For purposes of this section, the terms “NAFTA country” and “WTO member country” have the meanings given those terms in section 104(b).

(Transferred to 35 U.S.C. 10 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S 1948 sec. 4717(1)).)

(Transferred from 35 U.S.C. 12 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S 1948 sec. 4717(1)); amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-591 (S. 1948 sec. 4808).)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-565, 582 (S. 1948 secs. 4507(2)(A), 4507(2)(B), and 4732(a)(10)(A)).)

**35 U.S.C. 12 Copies of patents and applications for public libraries.**

The Director may supply copies of specifications and drawings of patents and published applications for patents in printed or electronic form to public libraries in the United States which shall maintain such copies for the use of the public, at the rate for each year’s issue established for this purpose in section 41(d) of this title.

(Transferred to 35 U.S.C. 11 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4717(1)).)

(Transferred from 35 U.S.C. 13 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S 1948 sec. 4717(1)); amended Aug. 27, 1982, Public Law 97-247, sec. 15, 96 Stat. 321; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-589 (S. 1948 sec. 4804(c)).)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-565, 566, 582 (S. 1948 secs. 4507(3)(A), 4507(3)(B), 4507(4), and 4732(a)(10)(A)).)

**35 U.S.C. 13 Annual report to Congress.**

The Director shall report to the Congress, not later than 180 days after the end of each fiscal year, the moneys received and expended by the Office, the purposes for which the moneys were spent, the quality and quantity of the work of the Office, the nature of training provided to examiners, the evaluation of the Commissioner of Patents and the Commissioner of Trademarks by the Secretary of Commerce, the compensation of the Commissioners, and other information relating to the Office.

(Transferred to 35 U.S.C. 12 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S 1948 sec. 4717(1)).)

(Transferred from 35 U.S.C. 14 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S 1948 sec. 4717(1)).)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-565, 581 (S. 1948 secs. 4507(2), 4718).)

## CHAPTER 2 — PROCEEDINGS IN THE PATENT AND TRADEMARK OFFICE

Sec.

- 21 Filing date and day for taking action.
- 22 Printing of papers filed.
- 23 Testimony in Patent and Trademark Office cases.
- 24 Subpoenas, witnesses.
- 25 Declaration in lieu of oath.
- 26 Effect of defective execution.

### **35 U.S.C. 21 Filing date and day for taking action.**

(a) The Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Director.

(b) When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken, or fee paid, on the next succeeding secular or business day.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Aug. 27, 1982, Public Law 97-247, sec. 12, 96 Stat. 321; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

### **35 U.S.C. 22 Printing of papers filed.**

The Director may require papers filed in the Patent and Trademark Office to be printed, typewritten, or on an electronic medium.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582, 589 (S. 1948 secs. 4732(a)(10)(A), 4804(a)).)

### **35 U.S.C. 23 Testimony in Patent and Trademark Office cases.**

The Director may establish rules for taking affidavits and depositions required in cases in the Patent

and Trademark Office. Any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where he resides, may take such affidavits and depositions.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

### **35 U.S.C. 24 Subpoenas, witnesses.**

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent and Trademark Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office.

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

### **35 U.S.C. 25 Declaration in lieu of oath.**

(a) The Director may by rule prescribe that any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration in such form as the Director may prescribe, such declaration to be in lieu of the oath otherwise required.

(b) Whenever such written declaration is used, the document must warn the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001).

(Added Mar. 26, 1964, Public Law 88-292, sec. 1, 78 Stat. 171; amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

**35 U.S.C. 26 Effect of defective execution.**

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be executed in a specified manner may be provisionally accepted by the Director despite a defective execution, provided a properly executed document is submitted within such time as may be prescribed.

(Added Mar. 26, 1964, Public Law 88-292, sec. 1, 78 Stat. 171; amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

CHAPTER 3 — PRACTICE BEFORE PATENT AND TRADEMARK OFFICE

Sec.

- 31 [Repealed]
- 32 Suspension or exclusion from practice.
- 33 Unauthorized representation as practitioner.

**35 U.S.C. 31 [Repealed].**

(Repealed Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4715(b)).)

**35 U.S.C. 32 Suspension or exclusion from practice.**

The Director may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent and Trademark Office, any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 2(b)(2)(D) of this title, or who shall, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons

for any such suspension or exclusion shall be duly recorded. The Director shall have the discretion to designate any attorney who is an officer or employee of the United States Patent and Trademark Office to conduct the hearing required by this section. The United States District Court for the District of Columbia, under such conditions and upon such proceedings as it by its rules determines, may review the action of the Director upon the petition of the person so refused recognition or so suspended or excluded.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580, 581, 582 (S. 1948 secs. 4715(c), 4719, 4732(a)(10)(A)).)

**35 U.S.C. 33 Unauthorized representation as practitioner.**

Whoever, not being recognized to practice before the Patent and Trademark Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent, shall be fined not more than \$1,000 for each offense.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

CHAPTER 4 — PATENT FEES; FUNDING; SEARCH SYSTEMS

Sec.

- 41 Patent fees; patent and trademark search systems.
- 42 Patent and Trademark Office funding.

**35 U.S.C. 41 Patent fees; patent and trademark search systems.**

**\*Editor’s Note: During fiscal years 2005 and 2006, subsections (a) and (b) of section 41 of title 35, United States Code, shall be administered as though subsections (a) and (b) read as follows:**

(a) GENERAL FEES. — The Director shall charge the following fees:

(1) FILING AND BASIC NATIONAL FEES. —

(A) On filing each application for an original patent, except for design, plant, or provisional applications, \$300.

(B) On filing each application for an original design patent, \$200.

(C) On filing each application for an original plant patent, \$200.

(D) On filing each provisional application for an original patent, \$200.

(E) On filing each application for the reissue of a patent, \$300.

(F) The basic national fee for each international application filed under the treaty defined in section 351(a) of this title entering the national stage under section 371 of this title, \$300.

(G) In addition, excluding any sequence listing or computer program listing filed in electronic medium as prescribed by the Director, for any application the specification and drawings of which exceed 100 sheets of paper (or equivalent as prescribed by the Director if filed in an electronic medium), \$250 for each additional 50 sheets of paper (or equivalent as prescribed by the Director if filed in an electronic medium) or fraction thereof.

(2) EXCESS CLAIMS FEES. — In addition to the fee specified in paragraph (1) —

(A) on filing or on presentation at any other time, \$200 for each claim in independent form in excess of 3;

(B) on filing or on presentation at any other time, \$50 for each claim (whether dependent or independent) in excess of 20; and

(C) for each application containing a multiple dependent claim, \$360.

For the purpose of computing fees under this paragraph, a multiple dependent claim referred to in section 112 of this title or any claim depending therefrom shall be considered as separate dependent claims in accordance with the number of claims to which reference is made. The Director may by regulation provide for a refund of any part of the fee specified in this paragraph for any claim that is canceled before an examination on the merits, as prescribed by the Director, has been made of the application under section 131 of this title. Errors in payment of the additional fees under this paragraph may be rectified in accordance with regulations prescribed by the Director.

(3) EXAMINATION FEES. —

(A) For examination of each application for an original patent, except for design, plant, provisional, or international applications, \$200.

(B) For examination of each application for an original design patent, \$130.

(C) For examination of each application for an original plant patent, \$160.

(D) For examination of the national stage of each international application, \$200.

(E) For examination of each application for the reissue of a patent, \$600.

The provisions of section 111(a) of this title relating to the payment of the fee for filing the application shall apply to the payment of the fee specified in this paragraph with respect to an application filed under section 111(a) of this title. The provisions of section 371(d) of this title relating to the payment of the national fee shall apply to the payment of the fee specified in this paragraph with respect to an international application.

(4) ISSUE FEES. —

(A) For issuing each original patent, except for design or plant patents, \$1,400.

(B) For issuing each original design patent, \$800.

(C) For issuing each original plant patent, \$1,100.

(D) For issuing each reissue patent, \$1,400.

(5) DISCLAIMER FEE. — On filing each disclaimer, \$130.

(6) APPEAL FEES. —

(A) On filing an appeal from the examiner to the Board of Patent Appeals and Interferences, \$500.

(B) In addition, on filing a brief in support of the appeal, \$500, and on requesting an oral hearing in the appeal before the Board of Patent Appeals and Interferences, \$1,000.

(7) REVIVAL FEES. — On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, \$1,500, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$500.

(8) EXTENSION FEES. — For petitions for 1-month extensions of time to take actions required by the Director in an application —

(A) on filing a first petition, \$120;

(B) on filing a second petition, \$330; and

(C) on filing a third or subsequent petition, \$570.

(b) MAINTENANCE FEES. — The Director shall charge the following fees for maintaining in force all patents based on applications filed on or after December 12, 1980:

- (1) 3 years and 6 months after grant, \$900.
- (2) 7 years and 6 months after grant, \$2,300.
- (3) 11 years and 6 months after grant, \$3,800.

Unless payment of the applicable maintenance fee is received in the United States Patent and Trademark Office on or before the date the fee is due or within a grace period of 6 months thereafter, the patent will expire as of the end of such grace period. The Director may require the payment of a surcharge as a condition of accepting within such 6-month grace period the payment of an applicable maintenance fee. No fee may be established for maintaining a design or plant patent in force.

(Dec. 8, 2004, Public Law 108-447, sec. 801, 118 Stat. 2809.)

**The bracketed text below is the unamended text of 35 U.S.C. 41(a) and (b), which may continue to have effect following fiscal year 2006:**

[(a) The Director shall charge the following fees:

(1)(A) On filing each application for an original patent, except in design or plant cases, \$690.

(B) In addition, on filing or on presentation at any other time, \$78 for each claim in independent form which is in excess of 3, \$18 for each claim (whether independent or dependent) which is in excess of 20, and \$260 for each application containing a multiple dependent claim.

(C) On filing each provisional application for an original patent, \$150.

(2) For issuing each original or reissue patent, except in design or plant cases, \$1,210.

- (3) In design and plant cases-
  - (A) on filing each design application, \$310;
  - (B) on filing each plant application, \$480;
  - (C) on issuing each design patent, \$430;

and

(D) on issuing each plant patent, \$580.

(4)(A) On filing each application for the reissue of a patent, \$690.

(B) In addition, on filing or on presentation at any other time, \$78 for each claim in independent form which is in excess of the number of independent claims of the original patent, and \$18 for each claim

(whether independent or dependent) which is in excess of 20 and also in excess of the number of claims of the original patent.

(5) On filing each disclaimer, \$110.

(6)(A) On filing an appeal from the examiner to the Board of Patent Appeals and Interferences, \$300.

(B) In addition, on filing a brief in support of the appeal, \$300, and on requesting an oral hearing in the appeal before the Board of Patent Appeals and Interferences, \$260.

(7) On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, \$1,210, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$110.

(8) For petitions for 1-month extensions of time to take actions required by the Director in an application-

- (A) on filing a first petition, \$110;
- (B) on filing a second petition, \$270; and
- (C) on filing a third or subsequent petition, \$490.

(9) Basic national fee for an international application where the Patent and Trademark Office was the International Preliminary Examining Authority and the International Searching Authority, \$670.

(10) Basic national fee for an international application where the Patent and Trademark Office was the International Searching Authority but not the International Preliminary Examining Authority, \$690.

(11) Basic national fee for an international application where the Patent and Trademark Office was neither the International Searching Authority nor the International Preliminary Examining Authority, \$970.

(12) Basic national fee for an international application where the international preliminary examination has been paid to the Patent and Trademark Office, and the international preliminary examination report states that the provisions of Article 33 (2), (3), and (4) of the Patent Cooperation Treaty have been satisfied for all claims in the application entering the national stage, \$96.

(13) For filing or later presentation of each independent claim in the national stage of an international application in excess of 3, \$78.

(14) For filing or later presentation of each claim (whether independent or dependent) in a national stage of an international application in excess of 20, \$18.

(15) For each national stage of an international application containing a multiple dependent claim, \$260.

For the purpose of computing fees, a multiple dependent claim as referred to in section 112 of this title or any claim depending therefrom shall be considered as separate dependent claims in accordance with the number of claims to which reference is made. Errors in payment of the additional fees may be rectified in accordance with regulations of the Director.

(b) The Director shall charge the following fees for maintaining in force all patents based on applications filed on or after December 12, 1980:

- (1) 3 years and 6 months after grant, \$830.
- (2) 7 years and 6 months after grant, \$1,900.
- (3) 11 years and 6 months after grant, \$2,910.

Unless payment of the applicable maintenance fee is received in the Patent and Trademark Office on or before the date the fee is due or within a grace period of six months thereafter, the patent will expire as of the end of such grace period. The Director may require the payment of a surcharge as a condition of accepting within such 6-month grace period the payment of an applicable maintenance fee. No fee may be established for maintaining a design or plant patent in force.]

(c)(1) The Director may accept the payment of any maintenance fee required by subsection (b) of this section which is made within twenty-four months after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable. The Director may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-month grace period. If the Director accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.

(2) A patent, the term of which has been maintained as a result of the acceptance of a payment of a maintenance fee under this subsection, shall not abridge or affect the right of any person or that person's successors in business who made, purchased, offered to sell, or used anything protected by the patent within the United States, or imported anything protected by the patent into the United States after the 6-month grace period but prior to the acceptance of a maintenance fee under this subsection, to continue the use of, to offer for sale, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported. The court before which such matter is in question may provide for the continued manufacture, use, offer for sale, or sale of the thing made, purchased, offered for sale, or used within the United States, or imported into the United States, as specified, or for the manufacture, use, offer for sale, or sale in the United States of which substantial preparation was made after the 6-month grace period but before the acceptance of a maintenance fee under this subsection, and the court may also provide for the continued practice of any process that is practiced, or for the practice of which substantial preparation was made, after the 6-month grace period but before the acceptance of a maintenance fee under this subsection, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced after the 6-month grace period but before the acceptance of a maintenance fee under this subsection.

**\*Editor's Note: During fiscal years 2005 and 2006, subsection (d) of section 41 of title 35, United States Code, shall be administered as though subsection (d) reads as follows:**

(d) PATENT SEARCH AND OTHER FEES. —

(1) PATENT SEARCH FEES. —

(A) The Director shall charge a fee for the search of each application for a patent, except for provisional applications. The Director shall establish the fees charged under this paragraph to recover an amount not to exceed the estimated average cost to the Office of searching applications for patent either by acquiring a search report from a qualified search authority, or by causing a search by Office personnel to be made, of each application for patent. For the 3-year period beginning on the date of enactment of this

Act, the fee for a search by a qualified search authority of a patent application described in clause (i), (iv), or (v) of subparagraph (B) may not exceed \$500, of a patent application described in clause (ii) of subparagraph (B) may not exceed \$100, and of a patent application described in clause (iii) of subparagraph (B) may not exceed \$300. The Director may not increase any such fee by more than 20 percent in each of the next three 1-year periods, and the Director may not increase any such fee thereafter.

(B) For purposes of determining the fees to be established under this paragraph, the cost to the Office of causing a search of an application to be made by Office personnel shall be deemed to be —

- (i) \$500 for each application for an original patent, except for design, plant, provisional, or international applications;
- (ii) \$100 for each application for an original design patent;
- (iii) \$300 for each application for an original plant patent;
- (iv) \$500 for the national stage of each international application; and
- (v) \$500 for each application for the reissue of a patent.

(C) The provisions of section 111 (a)(3) of this title relating to the payment of the fee for filing the application shall apply to the payment of the fee specified in this paragraph with respect to an application filed under section 111(a) of this title. The provisions of section 371(d) of this title relating to the payment of the national fee shall apply to the payment of the fee specified in this paragraph with respect to an international application.

(D) The Director may by regulation provide for a refund of any part of the fee specified in this paragraph for any applicant who files a written declaration of express abandonment as prescribed by the Director before an examination has been made of the application under section 131 of this title, and for any applicant who provides a search report that meets the conditions prescribed by the Director.

(E) For purposes of subparagraph (A), a “qualified search authority” may not include a commercial entity unless —

- (i) the Director conducts a pilot program of limited scope, conducted over a period of not more than 18 months, which demonstrates that

searches by commercial entities of the available prior art relating to the subject matter of inventions claimed in patent applications —

- (I) are accurate; and
- (II) meet or exceed the standards of searches conducted by and used by the Patent and Trademark Office during the patent examination process;
- (ii) the Director submits a report on the results of the pilot program to Congress and the Patent Public Advisory Committee that includes —
  - (I) a description of the scope and duration of the pilot program;
  - (II) the identity of each commercial entity participating in the pilot program;
  - (III) an explanation of the methodology used to evaluate the accuracy and quality of the search reports; and
  - (IV) an assessment of the effects that the pilot program, as compared to searches conducted by the Patent and Trademark Office, had and will have on —
    - (aa) patentability determinations;
    - (bb) productivity of the Patent and Trademark Office;
    - (cc) costs to the Patent and Trademark Office;
    - (dd) costs to patent applicants; and
    - (ee) other relevant factors;
  - (iii) the Patent Public Advisory Committee reviews and analyzes the Director’s report under clause (ii) and the results of the pilot program and submits a separate report on its analysis to the Director and the Congress that includes —
    - (I) an independent evaluation of the effects that the pilot program, as compared to searches conducted by the Patent and Trademark Office, had and will have on the factors set forth in clause (ii)(IV); and
    - (II) an analysis of the reasonableness, appropriateness, and effectiveness of the methods used in the pilot program to make the evaluations required under clause (ii)(IV); and
    - (iv) Congress does not, during the 1-year period beginning on the date on which the Patent Public Advisory Committee submits its report to the Congress under clause (iii), enact a law prohibiting searches by commercial entities of the available prior

art relating to the subject matter of inventions claimed in patent applications.

(F) The Director shall require that any search by a qualified search authority that is a commercial entity is conducted in the United States by persons that —

(i) if individuals, are United States citizens; and

(ii) if business concerns, are organized under the laws of the United States or any State and employ United States citizens to perform the searches.

(G) A search of an application that is the subject of a secrecy order under section 181 or otherwise involves classified information may only be conducted by Office personnel.

(H) A qualified search authority that is a commercial entity may not conduct a search of a patent application if the entity has any direct or indirect financial interest in any patent or in any pending or imminent application for patent filed or to be filed in the Patent and Trademark Office.

(2) OTHER FEES. — The Director shall establish fees for all other processing, services, or materials relating to patents not specified in this section to recover the estimated average cost to the Office of such processing, services; or materials, except that the Director shall charge the following fees for the following services:

(A) For recording a document affecting title, \$40 per property.

(B) For each photocopy, \$.25 per page.

(C) For each black and white copy of a patent, \$3. The yearly fee for providing a library specified in section 12 of this title with uncertified printed copies of the specifications and drawings for all patents in that year shall be \$50.

(Dec. 8, 2004, Public Law 108-447, sec. 801, 118 Stat. 2809.)

**The bracketed text below is the unamended text of 35 U.S.C. 41(d), which may continue to have effect following fiscal year 2006:**

[(d) The Director shall establish fees for all other processing, services, or materials relating to patents not specified in this section to recover the estimated average cost to the Office of such processing, services, or materials, except that the Director shall charge the following fees for the following services:

(1) For recording a document affecting title, \$40 per property.

(2) For each photocopy, \$.25 per page.

(3) For each black and white copy of a patent, \$3.

The yearly fee for providing a library specified in section 13 of this title with uncertified printed copies of the specifications and drawings for all patents issued in that year shall be \$50.]

(e) The Director may waive the payment of any fee for any service or material related to patents in connection with an occasional or incidental request made by a department or agency of the Government, or any officer thereof. The Director may provide any applicant issued a notice under section 132 of this title with a copy of the specifications and drawings for all patents referred to in that notice without charge.

(f) The fees established in subsections (a) and (b) of this section may be adjusted by the Director on October 1, 1992, and every year thereafter, to reflect any fluctuations occurring during the previous 12 months in the Consumer Price Index, as determined by the Secretary of Labor. Changes of less than 1 per centum may be ignored.

**\*Editor's Note: During fiscal years 2005 and 2006, subsection (f) of section 41 of title 35, United States Code applies to the fees established under section 801 of Public Law 108-447. (Dec. 8, 2004, Public Law 108-447, sec. 801, 118 Stat. 2809.)**

(g) No fee established by the Director under this section shall take effect until at least 30 days after notice of the fee has been published in the Federal Register and in the *Official Gazette* of the Patent and Trademark Office.

**\*Editor's Note: During fiscal years 2005 and 2006, subsection (h) of section 41 of title 35, United States Code, shall be administered as though subsection (h) reads as follows:**

(h)(1) Subject to paragraph (3), fees charged under subsections (a), (b) and (d)(1) shall be reduced by 50 percent with respect to their application to any small business concern as defined under section 3 of the Small Business Act, and to any independent inventor or nonprofit organization as defined in regulations issued by the Director.

(2) With respect to its application to any entity described in paragraph (1), any surcharge or fee charged under subsection (c) or (d) shall not be higher

than the surcharge or fee required of any other entity under the same or substantially similar circumstances.

(3) The fee charged under subsection (a)(1)(A) shall be reduced by 75 percent with respect to its application to any entity to which paragraph (1) applies, if the application is filed by electronic means as prescribed by the Director.

(Dec. 8, 2004, Public Law 108-447, sec. 801, 118 Stat. 2809.)

**The bracketed text below is the unamended text of 35 U.S.C. 41(h), which may continue to have effect following fiscal year 2006:**

[(h)(1) Fees charged under subsection (a) or (b) shall be reduced by 50 percent with respect to their application to any small business concern as defined under section 3 of the Small Business Act, and to any independent inventor or nonprofit organization as defined in regulations issued by the Director.

(2) With respect to its application to any entity described in paragraph (1), any surcharge or fee charged under subsection (c) or (d) shall not be higher than the surcharge or fee required of any other entity under the same or substantially similar circumstances.]

(i)(1) The Director shall maintain, for use by the public, paper, microform or electronic collections of United States patents, foreign patent documents, and United States trademark registrations arranged to permit search for and retrieval of information. The Director may not impose fees directly for the use of such collections, or for the use of the public patent and trademark search rooms or libraries.

(2) The Director shall provide for the full deployment of the automated search systems of the Patent and Trademark Office so that such systems are available for use by the public, and shall assure full access by the public to, and dissemination of, patent and trademark information, using a variety of automated methods, including electronic bulletin boards and remote access by users to mass storage and retrieval systems.

(3) The Director may establish reasonable fees for access by the public to the automated search systems of the Patent and Trademark Office. If such fees are established, a limited amount of free access shall be made available to users of the systems for purposes of education and training. The Director may waive the payment by an individual of fees authorized

by this subsection upon a showing of need or hardship, and if such waiver is in the public interest.

(4) The Director shall submit to the Congress an annual report on the automated search systems of the Patent and Trademark Office and the access by the public to such systems. The Director shall also publish such report in the Federal Register. The Director shall provide an opportunity for the submission of comments by interested persons on each such report.

(Amended July 24, 1965, Public Law 89-83, sec. 1, 2, 79 Stat. 259; Jan. 2, 1975, Public Law 93-596, sec. 1, Jan. 2, 1975, 88 Stat. 1949; Nov. 14, 1975, Public Law 94-131, sec. 3, 89 Stat. 690.)

(Subsection (g) amended Dec. 12, 1980, Public Law 96-517, sec. 2, 94 Stat. 3017; Aug. 27, 1982, Public Law 97-247, sec. 3(a)-(e), 96 Stat. 317.)

(Subsections (a)-(d) amended Sept. 8, 1982, Public Law 97-256, sec. 101, 96 Stat. 816.)

(Subsection (a)(6) amended Nov. 8, 1984, Public Law 98-622, sec. 204(a), 98 Stat. 3388.)

(Subsection (h) added Nov. 6, 1986, Public Law 99-607, sec. 1(b)(2), 100 Stat. 3470.)

(Subsections (a), (b), (d), (f), and (g) amended Dec. 10, 1991, Public Law 102-204, sec. 5, 105 Stat. 1637.)

(Subsections (a)(9) - (15) and (i) added Dec. 10, 1991, Public Law 102-204, sec. 5, 105 Stat. 1637.)

(Subsection (c)(1) amended Oct. 23, 1992, Public Law 102-444, sec. 1, 106 Stat. 2245.)

(Subsection (a)(1)(C) added Dec. 8, 1994, Public Law 103-465, sec. 532(b)(2), 108 Stat. 4986.)

(Subsection (c)(2) amended, Dec. 8, 1994, Public Law 103-465, sec. 533(b)(1), 108 Stat. 4988.)

(Subsections (a)-(b) revised Nov. 10, 1998, Public Law 105-358, sec. 3, 112 Stat. 3272.)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-554, 570, 582, 589 (S. 1948 secs. 4202, 4605(a), 4732(a)(5), 4732(a)(10)(A)) and 4804(d).)

**35 U.S.C. 42 Patent and Trademark Office funding.**

(a) All fees for services performed by or materials furnished by the Patent and Trademark Office will be payable to the Director.

(b) All fees paid to the Director and all appropriations for defraying the costs of the activities of the

Patent and Trademark Office will be credited to the Patent and Trademark Office Appropriation Account in the Treasury of the United States.

(c) To the extent and in the amounts provided in advance in appropriations Acts, fees authorized in this title or any other Act to be charged or established by the Director shall be collected by and shall be available to the Director to carry out the activities of the Patent and Trademark Office. All fees available to the Director under section 31 of the Trademark Act of 1946 shall be used only for the processing of trademark registrations and for other activities, services and materials relating to trademarks and to cover a proportionate share of the administrative costs of the Patent and Trademark Office.

(d) The Director may refund any fee paid by mistake or any amount paid in excess of that required.

(e) The Secretary of Commerce shall, on the day each year on which the President submits the annual budget to the Congress, provide to the Committees on the Judiciary of the Senate and the House of Representatives:

(1) a list of patent and trademark fee collections by the Patent and Trademark Office during the preceding fiscal year;

(2) a list of activities of the Patent and Trademark Office during the preceding fiscal year which were supported by patent fee expenditures, trademark fee expenditures, and appropriations;

(3) budget plans for significant programs, projects, and activities of the Office, including out-year funding estimates;

(4) any proposed disposition of surplus fees by the Office; and

(5) such other information as the committees consider necessary.

(Amended Nov. 14, 1975, Public Law 94-131, sec. 4, 89 Stat. 690; Dec. 12, 1980, Public Law 96-517, sec. 3, 94 Stat. 3018; Aug. 27, 1982, Public Law 97-247, sec. 3(g), 96 Stat. 319; Sept. 13, 1982, Public Law 97-258, sec. 3(i), 96 Stat. 1065.)

(Subsection (c) amended Dec. 10, 1991, Public Law 102-204, sec. 5(e), 105 Stat. 1640.)

(Subsection (e) added Dec. 10, 1991, Public Law 102-204, sec. 4, 105 Stat. 1637.)

(Subsection (c) revised Nov. 10, 1998, Public Law 105-358, sec. 4, 112 Stat. 3274.)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-555, 582 (S. 1948 secs. 4205 and 4732(a)(10)(A)).)

## PART II — PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

### CHAPTER 10 — PATENTABILITY OF INVENTIONS

- Sec.
- 100 Definitions.
- 101 Inventions patentable.
- 102 Conditions for patentability; novelty and loss of right to patent.
- 103 Conditions for patentability; non-obvious subject matter.
- 104 Invention made abroad.
- 105 Inventions in outer space.

#### **35 U.S.C. 100 Definitions.**

When used in this title unless the context otherwise indicates -

(a) The term “invention” means invention or discovery.

(b) The term “process” means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(c) The terms “United States” and “this country” mean the United States of America, its territories and possessions.

(d) The word “patentee” includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

(e) The term “third-party requester” means a person requesting ex parte reexamination under section 302 or inter partes reexamination under section 311 who is not the patent owner.

(Subsection (e) added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-567 (S. 1948 sec. 4603).)

#### **35 U.S.C. 101 Inventions patentable.**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.**

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or

(f) he did not himself invent the subject matter sought to be patented, or

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to prac-

tice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

(Amended July 28, 1972, Public Law 92-358, sec. 2, 86 Stat. 501; Nov. 14, 1975, Public Law 94-131, sec. 5, 89 Stat. 691.)

(Subsection (e) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-565 (S. 1948 sec. 4505).)

(Subsection (g) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-590 (S. 1948 sec. 4806).)

(Subsection (e) amended Nov. 2, 2002, Public Law 107-273, sec. 13205, 116 Stat. 1903.)

**35 U.S.C. 103 Conditions for patentability; non-obvious subject matter.**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b)(1) Notwithstanding subsection (a), and upon timely election by the applicant for patent to proceed under this subsection, a biotechnological process using or resulting in a composition of matter that is novel under section 102 and nonobvious under subsection (a) of this section shall be considered nonobvious if-

(A) claims to the process and the composition of matter are contained in either the same application for patent or in separate applications having the same effective filing date; and

(B) the composition of matter, and the process at the time it was invented, were owned by the same person or subject to an obligation of assignment to the same person.

(2) A patent issued on a process under paragraph (1)-

(A) shall also contain the claims to the composition of matter used in or made by that process, or

(B) shall, if such composition of matter is claimed in another patent, be set to expire on the same date as such other patent, notwithstanding section 154.

(3) For purposes of paragraph (1), the term “biotechnological process” means-

(A) a process of genetically altering or otherwise inducing a single- or multi-celled organism to-

(i) express an exogenous nucleotide sequence,

(ii) inhibit, eliminate, augment, or alter expression of an endogenous nucleotide sequence, or

(iii) express a specific physiological characteristic not naturally associated with said organism;

(B) cell fusion procedures yielding a cell line that expresses a specific protein, such as a monoclonal antibody; and

(C) a method of using a product produced by a process defined by subparagraph (A) or (B), or a combination of subparagraphs (A) and (B).

(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if —

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(3) For purposes of paragraph (2), the term “joint research agreement” means a written contract, grant, or cooperative agreement entered into by two or

more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

(Amended Nov. 8, 1984, Public Law 98-622, sec. 103, 98 Stat. 3384; Nov. 1, 1995, Public Law 104-41, sec.1, 109 Stat. 3511.)

(Subsection (c) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-591 (S. 1948 sec. 4807).)

(Subsection (c) amended Dec. 10, 2004, Public Law 108-453 , sec. 2, 118 Stat. 3596.)

### **35 U.S.C. 104 Invention made abroad.**

(a) IN GENERAL.—

(1) PROCEEDINGS.—In proceedings in the Patent and Trademark Office, in the courts, and before any other competent authority, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country other than a NAFTA country or a WTO member country, except as provided in sections 119 and 365 of this title.

(2) RIGHTS.—If an invention was made by a person, civil or military—

(A) while domiciled in the United States, and serving in any other country in connection with operations by or on behalf of the United States,

(B) while domiciled in a NAFTA country and serving in another country in connection with operations by or on behalf of that NAFTA country, or

(C) while domiciled in a WTO member country and serving in another country in connection with operations by or on behalf of that WTO member country, that person shall be entitled to the same rights of priority in the United States with respect to such invention as if such invention had been made in the United States, that NAFTA country, or that WTO member country, as the case may be.

(3) USE OF INFORMATION.—To the extent that any information in a NAFTA country or a WTO member country concerning knowledge, use, or other activity relevant to proving or disproving a date of invention has not been made available for use in a proceeding in the Patent and Trademark Office, a court, or any other competent authority to the same extent as such information could be made available in the United States, the Director, court, or such other

authority shall draw appropriate inferences, or take other action permitted by statute, rule, or regulation, in favor of the party that requested the information in the proceeding.

(b) DEFINITIONS.—As used in this section—

(1) The term “NAFTA country” has the meaning given that term in section 2(4) of the North American Free Trade Agreement Implementation Act; and

(2) The term “WTO member country” has the meaning given that term in section 2(10) of the Uruguay Round Agreements Act.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 14, 1975, Public Law 94-131, sec. 6, 89 Stat. 691; Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392; Dec. 8, 1993, Public Law 103-182, sec. 331, 107 Stat. 2113; Dec. 8, 1994, Public Law 103-465, sec. 531(a), 108 Stat. 4982; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

**35 U.S.C. 105 Inventions in outer space.**

(a) Any invention made, used, or sold in outer space on a space object or component thereof under the jurisdiction or control of the United States shall be considered to be made, used or sold within the United States for the purposes of this title, except with respect to any space object or component thereof that is specifically identified and otherwise provided for by an international agreement to which the United States is a party, or with respect to any space object or component thereof that is carried on the registry of a foreign state in accordance with the Convention on Registration of Objects Launched into Outer Space.

(b) Any invention made, used, or sold in outer space on a space object or component thereof that is carried on the registry of a foreign state in accordance with the Convention on Registration of Objects Launched into Outer Space, shall be considered to be made, used, or sold within the United States for the purposes of this title if specifically so agreed in an international agreement between the United States and the state of registry.

(Added Nov. 15, 1990, Public Law 101-580, sec. 1(a), 104 Stat. 2863.)

CHAPTER 11 — APPLICATION FOR PATENT

Sec.

- 111 Application.
- 112 Specification.
- 113 Drawings.
- 114 Models, specimens.
- 115 Oath of applicant.
- 116 Inventors.
- 117 Death or incapacity of inventor.
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- 119 Benefit of earlier filing date; right of priority.
- 120 Benefit of earlier filing date in the United States.
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- 122 Confidential status of applications; publication of patent applications.

**35 U.S.C. 111 Application.**

(a) IN GENERAL.—

(1) WRITTEN APPLICATION.—An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.

(2) CONTENTS.—Such application shall include—

(A) a specification as prescribed by section 112 of this title;

(B) a drawing as prescribed by section 113 of this title; and

(C) an oath by the applicant as prescribed by section 115 of this title.

(3) FEE AND OATH.—The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(4) FAILURE TO SUBMIT.—Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath was unavoidable or unintentional. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

**(b) PROVISIONAL APPLICATION.—**

(1) **AUTHORIZATION.**—A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Director. Such application shall include—

(A) a specification as prescribed by the first paragraph of section 112 of this title; and

(B) a drawing as prescribed by section 113 of this title.

(2) **CLAIM.**—A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.

**(3) FEE.—**

(A) The application must be accompanied by the fee required by law.

(B) The fee may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(C) Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee was unavoidable or unintentional.

(4) **FILING DATE.**—The filing date of a provisional application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

(5) **ABANDONMENT.**—Notwithstanding the absence of a claim, upon timely request and as prescribed by the Director, a provisional application may be treated as an application filed under subsection (a). Subject to section 119(e)(3) of this title, if no such request is made, the provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival after such 12-month period.

(6) **OTHER BASIS FOR PROVISIONAL APPLICATION.**—Subject to all the conditions in this subsection and section 119(e) of this title, and as prescribed by the Director, an application for patent filed under subsection (a) may be treated as a provisional application for patent.

(7) **NO RIGHT OF PRIORITY OR BENEFIT OF EARLIEST FILING DATE.**—A provisional application shall not be entitled to the right of priority

of any other application under section 119 or 365(a) of this title or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c) of this title.

(8) **APPLICABLE PROVISIONS.**—The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 115, 131, 135, and 157 of this title.

(Amended Aug. 27, 1982, Public Law 97-247, sec. 5, 96 Stat. 319; Dec. 8, 1994, Public Law 103-465, sec. 532(b)(3), 108 Stat. 4986; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582, 588 (S. 1948 secs. 4732(a)(10)(A), 4801(a)).)

**35 U.S.C. 112 Specification.**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

(Amended July 24, 1965, Public Law 89-83, sec. 9, 79 Stat. 261; Nov. 14, 1975, Public Law 94-131, sec. 7, 89 Stat. 691.)

### **35 U.S.C. 113 Drawings.**

The applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented. When the nature of such subject matter admits of illustration by a drawing and the applicant has not furnished such a drawing, the Director may require its submission within a time period of not less than two months from the sending of a notice thereof. Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.

(Amended Nov. 14, 1975, Public Law 94-131, sec. 8, 89 Stat. 691; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

### **35 U.S.C. 114 Models, specimens.**

The Director may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Director may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

### **35 U.S.C. 115 Oath of applicant.**

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such

oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority is proved by certificate of a diplomatic or consular officer of the United States, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States. Such oath is valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him. For purposes of this section, a consular officer shall include any United States citizen serving overseas, authorized to perform notarial functions pursuant to section 1750 of the Revised Statutes, as amended (22 U.S.C. 4221).

(Amended Aug. 27, 1982, Public Law 97-247, sec. 14(a), 96 Stat. 321; Oct. 21, 1998, Pub. L. 105-277, sec. 2222(d), 112 Stat. 2681-818.)

### **35 U.S.C. 116 Inventors.**

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Director, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever through error a person is named in an application for patent as the inventor, or through an error an inventor is not named in an application, and

such error arose without any deceptive intention on his part, the Director may permit the application to be amended accordingly, under such terms as he prescribes.

(Amended Aug. 27, 1982, Public Law 97-247, sec. 6(a), 96 Stat. 320; Nov. 8, 1984, Public Law 98-622, sec. 104(a), 98 Stat. 3384; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

### **35 U.S.C. 117 Death or incapacity of inventor.**

Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

### **35 U.S.C. 118 Filing by other than inventor.**

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Director may grant a patent to such inventor upon such notice to him as the Director deems sufficient, and on compliance with such regulations as he prescribes.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

### **35 U.S.C. 119 Benefit of earlier filing date; right of priority.**

(a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed

within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

(b)(1) No application for patent shall be entitled to this right of priority unless a claim is filed in the Patent and Trademark Office, identifying the foreign application by specifying the application number on that foreign application, the intellectual property authority or country in or for which the application was filed, and the date of filing the application, at such time during the pendency of the application as required by the Director.

(2) The Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed claim under this section.

(3) The Director may require a certified copy of the original foreign application, specification, and drawings upon which it is based, a translation if not in the English language, and such other information as the Director considers necessary. Any such certification shall be made by the foreign intellectual property authority in which the foreign application was filed and show the date of the application and of the filing of the specification and other papers.

(c) In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in the same foreign country instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

(d) Applications for inventors' certificates filed in a foreign country in which applicants have a right to apply, at their discretion, either for a patent or for an inventor's certificate shall be treated in this country in the same manner and have the same effect for pur-

pose of the right of priority under this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents, provided such applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of such filing.

(e)(1) An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application

(2) A provisional application filed under section 111(b) of this title may not be relied upon in any proceeding in the Patent and Trademark Office unless the fee set forth in subparagraph (A) or (C) of section 41(a)(1) of this title has been paid.

(3) If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

(f) Applications for plant breeder's rights filed in a WTO member country (or in a foreign UPOV Contracting Party) shall have the same effect for the purpose of the right of priority under subsections (a)

through (c) of this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents.

(g) As used in this section—

(1) the term “WTO member country” has the same meaning as the term is defined in section 104(b)(2) of this title; and

(2) the term “UPOV Contracting Party” means a member of the International Convention for the Protection of New Varieties of Plants.

(Amended Oct. 3, 1961, Public Law 87-333, sec. 1, 75 Stat. 748; July 28, 1972, Public Law 92-358, sec. 1, 86 Stat. 501; Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Dec. 8, 1994, Public Law 103-465, sec. 532(b)(1), 108 Stat. 4985.)

(Subsection (b) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-563 (S. 1948 sec.4503(a)).)

(Subsection (e) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-564, 588, 589 (S. 1948 secs. 4503(b)(2), 4801 and 4802).)

(Subsections (f) and (g) added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-589 (S. 1948 sec. 4802).)

**35 U.S.C. 120 Benefit of earlier filing date in the United States.**

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Direc-

tor may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

(Amended Nov. 14, 1975, Public Law 94-131, sec. 9, 89 Stat. 691; Nov. 8, 1984, Public Law 98-622, sec. 104(b), 98 Stat. 3385; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-563 (S. 1948 sec. 4503(b)(1)).)

### 35 U.S.C. 121 Divisional applications.

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Director may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

### 35 U.S.C. 122 Confidential status of applications; publication of patent applications.

(a) CONFIDENTIALITY.— Except as provided in subsection (b), applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of an Act of Congress or in such special circumstances as may be determined by the Director.

(b) PUBLICATION.—

(1) IN GENERAL.—

(A) Subject to paragraph (2), each application for a patent shall be published, in accordance with procedures determined by the Director, promptly after the expiration of a period of 18 months from the earliest filing date for which a benefit is sought under this title. At the request of the applicant, an application may be published earlier than the end of such 18-month period.

(B) No information concerning published patent applications shall be made available to the public except as the Director determines.

(C) Notwithstanding any other provision of law, a determination by the Director to release or not to release information concerning a published patent application shall be final and nonreviewable.

(2) EXCEPTIONS.—

(A) An application shall not be published if that application is—

- (i) no longer pending;
- (ii) subject to a secrecy order under section 181 of this title;
- (iii) a provisional application filed under section 111(b) of this title; or
- (iv) an application for a design patent filed under chapter 16 of this title.

(B)(i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

(ii) An applicant may rescind a request made under clause (i) at any time.

(iii) An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is

shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

(iv) If an applicant rescinds a request made under clause (i) or notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).

(v) If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign filed applications corresponding to an application filed in the Patent and Trademark Office or the description of the invention in such foreign filed applications is less extensive than the application or description of the invention in the application filed in the Patent and Trademark Office, the applicant may submit a redacted copy of the application filed in the Patent and Trademark Office eliminating any part or description of the invention in such application that is not also contained in any of the corresponding applications filed in a foreign country. The Director may only publish the redacted copy of the application unless the redacted copy of the application is not received within 16 months after the earliest effective filing date for which a benefit is sought under this title. The provisions of section 154(d) shall not apply to a claim if the description of the invention published in the redacted application filed under this clause with respect to the claim does not enable a person skilled in the art to make and use the subject matter of the claim.

(c) **PROTEST AND PRE-ISSUANCE OPPOSITION.**— The Director shall establish appropriate procedures to ensure that no protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant.

(d) **NATIONAL SECURITY.**— No application for patent shall be published under subsection (b)(1) if the publication or disclosure of such invention would be detrimental to the national security. The Director shall establish appropriate procedures to ensure that such applications are promptly identified and the secrecy of such inventions is maintained in accordance with chapter 17 of this title.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-563 (S. 1948 sec. 4503(b)(1)).)

CHAPTER 12 — EXAMINATION OF APPLICATION

Sec.

- 131 Examination of application.
- 132 Notice of rejection; reexamination.
- 133 Time for prosecuting application.
- 134 Appeal to the Board of Patent Appeals and Interferences.
- 135 Interferences.

**35 U.S.C. 131 Examination of application.**

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

**35 U.S.C. 132 Notice of rejection; reexamination.**

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

(b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-560, 582 (S. 1948 secs. 4403 and 4732(a)(10)(A)).)

**35 U.S.C. 133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

**35 U.S.C. 134 Appeal to the Board of Patent Appeals and Interferences.**

(a) **PATENT APPLICANT.**— An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

(b) **PATENT OWNER.**— A patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

(c) **THIRD-PARTY.**— A third-party requester in an inter partes proceeding may appeal to the Board of Patent Appeals and Interferences from the final decision of the primary examiner favorable to the patentability of any original or proposed amended or new claim of a patent, having once paid the fee for such appeal.

(Amended Nov. 8, 1984, Public Law 98-622, sec. 204(b)(1), 98 Stat. 3388; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4605(b)); subsections (a)-(c) amended Nov. 2, 2002, Public Law 107-273, secs. 13106 and 13202, 116 Stat. 1901.)

**35 U.S.C. 135 Interferences.**

(a) Whenever an application is made for a patent which, in the opinion of the Director, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the Director shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability. Any final decision, if adverse to the claim of an

applicant, shall constitute the final refusal by the Patent and Trademark Office of the claims involved, and the Director may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved in the patent, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation by the Patent and Trademark Office.

(b)(1) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

(2) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an application published under section 122(b) of this title may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published.

(c) Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent and Trademark Office before the termination of the interference as between the said parties to the agreement or understanding. If any party filing the same so requests, the copy shall be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person on a showing of good cause. Failure to file the copy of such agreement or understanding shall render permanently unenforceable such agreement or understanding and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved. The Director may, however, on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six-month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

The Director shall give notice to the parties or their attorneys of record, a reasonable time prior to

said termination, of the filing requirement of this section. If the Director gives such notice at a later time, irrespective of the right to file such agreement or understanding within the six-month period on a showing of good cause, the parties may file such agreement or understanding within sixty days of the receipt of such notice.

Any discretionary action of the Director under this subsection shall be reviewable under section 10 of the Administrative Procedure Act.

(d) Parties to a patent interference, within such time as may be specified by the Director by regulation, may determine such contest or any aspect thereof by arbitration. Such arbitration shall be governed by the provisions of title 9 to the extent such title is not inconsistent with this section. The parties shall give notice of any arbitration award to the Director, and such award shall, as between the parties to the arbitration, be dispositive of the issues to which it relates. The arbitration award shall be unenforceable until such notice is given. Nothing in this subsection shall preclude the Director from determining patentability of the invention involved in the interference.

(Subsection (c) added Oct. 15, 1962, Public Law 87-831, 76 Stat. 958.)

(Subsections (a) and (c) amended, Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

(Subsection (a) amended Nov. 8, 1984, Public Law 98-622, sec. 202, 98 Stat. 3386.)

(Subsection (d) added Nov. 8, 1984, Public Law 98-622, sec. 105, 98 Stat. 3385.)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-566, 582 (S. 1948 secs. 4507(11) and 4732(a)(10)(A)).)

CHAPTER 13 — REVIEW OF PATENT AND  
TRADEMARK OFFICE DECISION

Sec.

- 141 Appeal to Court of Appeals for the Federal Circuit.
- 142 Notice of appeal.
- 143 Proceedings on appeal.
- 144 Decision on appeal.
- 145 Civil action to obtain patent.
- 146 Civil action in case of interference.

**35 U.S.C. 141 Appeal to the Court of Appeals for the Federal Circuit.**

An applicant dissatisfied with the decision in an appeal to the Board of Patent Appeals and Interferences under section 134 of this title may appeal the decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal the applicant waives his or her right to proceed under section 145 of this title. A patent owner, or a third-party requester in an inter partes reexamination proceeding, who is in any reexamination proceeding dissatisfied with the final decision in an appeal to the Board of Patent Appeals and Interferences under section 134 may appeal the decision only to the United States Court of Appeals for the Federal Circuit. A party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences on the interference may appeal the decision to the United States Court of Appeals for the Federal Circuit, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal in accordance with section 142 of this title, files notice with the Director that the party elects to have all further proceedings conducted as provided in section 146 of this title. If the appellant does not, within thirty days after filing of such notice by the adverse party, file a civil action under section 146, the decision appealed from shall govern the further proceedings in the case.

(Amended Apr. 2, 1982, Public Law 97-164, sec. 163(a)(7), (b)(2), 96 Stat. 49, 50; Nov. 8, 1984, Public Law 98-622, sec. 203(a), 98 Stat. 3387; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-571, 582 (S. 1948 secs. 4605(c) and 4732(a)(10)(A)); Nov. 2, 2002, Public Law 107-273, sec. 13106, 116 Stat. 1901.)

**35 U.S.C. 142 Notice of appeal.**

When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Apr. 2, 1982, Public Law 97-164, sec. 163(a)(7), 96 Stat. 49; Nov. 8, 1984, Public Law 98-620, sec. 414(a), 98 Stat. 3363; Nov. 29, 1999, Public Law 106-

113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

### **35 U.S.C. 143 Proceedings on appeal.**

With respect to an appeal described in section 142 of this title, the Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the Director forward the original or certified copies of such documents during the pendency of the appeal. 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. 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.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Apr. 2, 1982, Public Law 97-164, sec. 163(a)(7), 96 Stat. 49; Nov. 8, 1984, Public Law 98-620, sec. 414(a), 98 Stat. 3363; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-571, 582 (S. 1948 secs. 4605(d) and 4732(a)(10)(A)); Nov. 2, 2002, Public Law 107-273, sec. 13202, 116 Stat. 1901.)

### **35 U.S.C. 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.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Apr. 2, 1982, Public Law 97-164, sec. 163(a)(7), 96 Stat. 49; Nov. 8, 1984, Public Law 98-620, sec. 414(a), 98 Stat. 3363; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

### **35 U.S.C. 145 Civil action to obtain patent.**

An applicant dissatisfied with the decision of the Board of Patent Appeals and Interferences in an appeal under section 134(a) of this title 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 District of Columbia 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 Board of Patent Appeals and Interferences, 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.

(Amended Apr. 2, 1982, Public Law 97-164, sec. 163(a)(7), 96 Stat. 49; Nov. 8, 1984, Public Law 98-622, sec. 203(b), 98 Stat. 3387; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-571, 582 (S. 1948 secs. 4605(e) and 4732(a)(10)(A)).)

### **35 U.S.C. 146 Civil action in case of interference.**

Any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Director appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Appeals for the Federal Circuit, and such appeal is pending or has been decided. In such suits the record in the Patent and Trademark Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Director shall not be a necessary party but he shall be notified of the filing of















































































































