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Patent Bootcamp

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PATENT BOOT CAMP 2019

Training Packet

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[Editor Note: Current as of March 31, 2019. This document has been updated to reflect the proper content of 35 U.S.C. 115(f) effected by Public Law 112-274 on January 14, 2013. 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

CHAPTER 1 — ESTABLISHMENT, OFFICERS AND EMPLOYEES, FUNCTIONS

Sec.

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);

(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; and

(G) may, subject to any conditions prescribed by the Director and at the request of the patent applicant, provide for prioritization of examination of applications for products, processes, or technologies that are important to the national economy or national competitiveness without recovering the aggregate extra cost of providing such prioritization, notwithstanding section 41 or any other provision of law;

(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, division C (except sections 3302, 3501(b), 3509, 3906, 4710, and 4711) of subtitle I of title 41, 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, and the Office is authorized to expend funds to cover the subsistence expenses and travel-related expenses, including per diem, lodging costs, and transportation costs, of persons attending such programs who are not Federal employees;

(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; subsection (b)(4)(A) amended January 4, 2011, Public Law 111-350, sec. 5(i)(1), 124 Stat. 3849; subsection (b)(2)(G) added and subsections (b)(2)(E) and (b)(11) amended Sept. 16, 2011, Public Law 112-29, secs. 20(j), 21(a), and 25 (effective Sept. 16, 2012), 125 Stat. 284.)

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 performance 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.

(6) ADMINISTRATIVE PATENT JUDGES AND ADMINISTRATIVE TRADEMARK JUDGES.—The Director may fix the rate of basic pay for the administrative patent judges appointed pursuant to section 6 and the administrative trademark judges appointed pursuant to section 17 of the Trademark Act of 1946 (15 U.S.C. 1067) at not greater than the rate of basic pay payable for level III of the Executive Schedule under section 5314 of title 5. The payment of a rate of basic pay under this paragraph shall not be subject to the pay limitation under section 5306(e) or 5373 of title 5.

(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 Efficiency 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 that 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; subsection (b)(6) added and (e)(2) amended Sept. 16, 2011, Public Law 112-29, secs. 20(i) and 21(b) (effective Sept. 16, 2012), 125 Stat. 284.)

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. In each year, 3 members shall be appointed to each Advisory Committee for 3-year terms that shall begin on December 1 of that year. Any vacancy on an Advisory Committee shall be filled within 90 days after it occurs. A new member who is appointed to fill a vacancy shall be appointed to serve for the remainder of the predecessor's term.

(2) CHAIR.— The Secretary of Commerce, in consultation with the Director, shall designate a Chair and Vice Chair of each Advisory Committee from among the members appointed under paragraph (1). If the Chair resigns before the completion of his or her term, or is otherwise unable to exercise the functions of the Chair, the Vice Chair shall exercise the functions of the Chair.

(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 (c) 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; subsection (a) amended Jan. 14, 2013, Public Law 112-274, sec. 1(l), 126 Stat. 2456.)

35 U.S.C. 6 Patent Trial and Appeal Board.

[Editor Note: Applicable to proceedings commenced on or after September 16, 2012. See 35 U.S.C. 6 (pre-AIA) for the law otherwise applicable.]*

(a) IN GENERAL.—There shall be in the Office a Patent Trial and Appeal Board. The Director, the Deputy Director, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Patent Trial and Appeal Board. The administrative patent judges shall be persons of competent legal knowledge and scientific ability who are appointed by the Secretary, in consultation with the Director. Any reference in any Federal law, Executive order, rule, regulation, or delegation of authority, or any document of or pertaining to the Board of Patent Appeals and Interferences is deemed to refer to the Patent Trial and Appeal Board.

(b) DUTIES.—The Patent Trial and Appeal Board shall—

(1) on written appeal of an applicant, review adverse decisions of examiners upon applications for patents pursuant to section 134(a);

(2) review appeals of reexaminations pursuant to section 134(b);

(3) conduct derivation proceedings pursuant to section 135; and

(4) conduct inter partes reviews and post-grant reviews pursuant to chapters 31 and 32.

(c) 3-MEMBER PANELS.—Each appeal, derivation proceeding, post-grant review, and inter partes review shall be heard by at least 3 members of the Patent Trial and Appeal Board, who shall be designated by the Director. Only the Patent Trial and Appeal Board may grant rehearings.

(d) TREATMENT OF PRIOR APPOINTMENTS.—The Secretary of Commerce may, in the Secretary's discretion, deem the appointment of an administrative patent judge who, before the date of the enactment of this subsection, held office pursuant to an appointment by the Director to take effect on the date on which the Director initially appointed the administrative patent judge. It shall be a defense to a challenge to the appointment of an administrative patent judge on the basis of the judge's having been originally appointed by the Director that the administrative patent judge so appointed was acting as a de facto officer.

(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; subsection(a) amended and subsections (c) and (d) added Aug. 12, 2008, Public Law 110-313, sec. 1(a)(1), 122 Stat. 3014; amended Sept. 16, 2011, Public Law 112-29, sec. 7(a) (effective Sept. 16, 2012), 125 Stat. 284.*)

***NOTE:** The provisions of this section as in effect on Sept. 15, 2012 (35 U.S.C. 6 (pre-AIA)) apply to interference proceedings that are declared after September 15, 2012 under 35 U.S.C. 135 (pre-AIA). See Public Law 112-274, sec. 1(k)(3), 126 Stat. 2456 (Jan. 14, 2013).

35 U.S.C. 6 (pre-AIA) Board of Patent Appeals and Interferences.

[Editor Note: Not applicable to proceedings commenced on or after September 16, 2012. See 35 U.S.C. 6 for the law otherwise applicable.]*

(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 Director, 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 Secretary of Commerce, in consultation with 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.

(c) AUTHORITY OF THE SECRETARY.— The Secretary of Commerce may, in his or her discretion, deem the appointment of an administrative patent judge who, before the date of the enactment of this subsection, held office pursuant to an appointment by the Director to take effect on the date on which the Director initially appointed the administrative patent judge.

(d) DEFENSE TO CHALLENGE OF APPOINTMENT.— It shall be a defense to a challenge to the appointment of an administrative patent judge on the basis of the judge's having been originally appointed by the Director that the administrative patent judge so appointed was acting as a de facto officer.

(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; subsection(a) amended and subsections (c) and (d) added Aug. 12, 2008, Public Law 110-313, sec. 1(a)(1), 122 Stat. 3014.)

***NOTE:** The provisions of this section as in effect on Sept. 15, 2012 apply to interference proceedings that are declared after September 15, 2012 under 35 U.S.C. 135 (pre-AIA). See Public Law 112-274, sec. 1(k)(3), 126 Stat. 2456 (Jan. 14, 2013).

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.

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)); subsection (c) amended Sept. 16, 2011, Public Law 112-29, sec. 22, 125 Stat. 284, effective Oct. 1, 2011; subsection (c)(3) amended Jan. 14, 2013, Public Law 112-274, sec. 1(j), 126 Stat. 2456.)

PART II — PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

CHAPTER 10 — PATENTABILITY OF INVENTIONS

Sec.

35 U.S.C. 100 (note) AIA First inventor to file provisions.

The first inventor to file provisions of the Leahy-Smith America Invents Act (AIA) apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time—

(A) a claim to a claimed invention that has an effective filing date on or after March 16, 2013 wherein the effective filing date is:

(i) if subparagraph (ii) does not apply, the actual filing date of the patent or the application for the patent containing a claim to the invention; or

(ii) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b) or to the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c); or

(B) a specific reference under section 120, 121, 365(c), or 386(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

(Sept. 16, 2011, Public Law 112-29, sec. 3(n)(1) (effective March 16, 2013), 125 Stat. 284; references to 35 U.S.C. 386 added Dec. 18, 2012, Public Law 112-211, sec. 102(1) (effective May 13, 2015), 126 Stat. 1531.)

35 U.S.C. 100 Definitions.

[Editor Note: 35 U.S.C. 100(e)-(j) as set forth below are only applicable to patent applications and patents subject to the first inventor to file provisions of the AIA (35 U.S.C. 100 (note)). See 35 U.S.C. 100(e) (pre-AIA) for subsection (e) as otherwise applicable.]

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 who is not the patent owner.

(f) The term "inventor" means the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.

(g) The terms "joint inventor" and "coinventor" mean any 1 of the individuals who invented or discovered the subject matter of a joint invention.

(h) The term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by 2 or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

(i)(1) The term "effective filing date" for a claimed invention in a patent or application for patent means—

(A) if subparagraph (B) does not apply, the actual filing date of the patent or the application for the patent containing a claim to the invention; or

(B) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b) or to the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c).

(2) The effective filing date for a claimed invention in an application for reissue or reissued patent shall be determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought.

(j) The term "claimed invention" means the subject matter defined by a claim in a patent or an application for a patent.

(Subsection (e) added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-567 (S. 1948 sec. 4603); subsection (e) amended and subsections (f) - (j) added Sept. 16, 2011, Public Law 112-29, sec. 3(a) (effective March 16, 2013), 125 Stat. 284.); subsection (i)(1)(B) amended Dec. 18, 2012, Public Law 112-211, sec. 102(1) (effective May 13, 2015), 126 Stat. 1531.)

35 U.S.C. 100 (pre-AIA) Definitions.

*[Editor Note: pre-AIA 35 U.S.C. 100(e) as set forth below is **not applicable** to any patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 100(e)-(j) for the law otherwise applicable.]*

When used in this title unless the context otherwise indicates -

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(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.

(Public Law 112-29, sec. 33, 125 Stat. 284 (Sept. 16, 2011) provided a limitation on the issuance of patents (see AIA § 33).)

35 U.S.C. 102 Conditions for patentability; novelty.

[Editor Note: Applicable to any patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 102 (pre-AIA) for the law otherwise applicable.]

(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) EXCEPTIONS.—

(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

(c) COMMON OWNERSHIP UNDER JOINT RESEARCH AGREEMENTS.—Subject matter disclosed 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 in applying the provisions of subsection (b)(2)(C) if—

(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;

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

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

(d) PATENTS AND PUBLISHED APPLICATIONS EFFECTIVE AS PRIOR ART.—For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application—

(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or

(2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b), or to claim the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c) based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

(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; amended Sept. 16, 2011, Public Law 112-29, sec. 3(b), 125 Stat. 284, effective March 16, 2013.*; subsection (d)(2) amended Dec. 18, 2012, Public Law 112-211, sec. 102(2) (effective May 13, 2015), 126 Stat. 1531.))

(Public Law 112-29, sec. 14, 125 Stat. 284 (Sept. 16, 2011) provided that tax strategies are deemed to be within the prior art (see AIA § 14).)

*NOTE: The provisions of 35 U.S.C. 102(g), as in effect on ***March 15, 2013,*** shall also apply to each claim of an application for patent, and any patent issued thereon, for which the first inventor to file provisions of the AIA apply (see 35 U.S.C. 100 (note)), if such application or patent contains or contained at any time a claim to a claimed invention to which is ***not*** subject to the first inventor to file provisions of the AIA.]

35 U.S.C. 102 (pre-AIA) Conditions for patentability; novelty and loss of right to patent.

[Editor Note: With the exception of subsection (g)), **not applicable** to any patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 102 for the law otherwise applicable.]*

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 practice 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.)

(Public Law 112-29, sec. 14, 125 Stat. 284 (Sept. 16, 2011) provided that tax strategies are deemed to be within the prior art (see AIA § 14).)

*NOTE: The provisions of 35 U.S.C. 102(g), as in effect on ***March 15, 2013,*** shall apply to each claim of an application for patent, and any patent issued thereon, for which the first inventor to file provisions of the AIA apply (see 35 U.S.C. 100 (note), if such application or patent contains or contained at any time—

(A) a claim to an invention having an effective filing date as defined in section 100(i) of title 35, United States Code, that occurs before March 16, 2013; or

(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

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

[Editor Note: Applicable to any patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 103 (pre-AIA) for the law otherwise applicable.]

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.

Patentability shall not be negated by the manner in which the invention was made.

(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; amended Sept. 16, 2011, Public Law 112-29, secs. 20(j) (effective Sept. 16, 2012) and 3(c) (effective March 16, 2013), 125 Stat. 284.)

(Public Law 112-29, sec. 14, 125 Stat. 284 (Sept. 16, 2011) provided that tax strategies are deemed to be within the prior art (see AIA § 14).)

35 U.S.C. 103 (pre-AIA) Conditions for patentability; non-obvious subject matter.

*[Editor Note: **Not applicable** to any patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 103 for the law otherwise applicable.]*

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102, 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 negatived 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, 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; amended Sept. 16, 2011, Public Law 112-29, sec. 20(j) (effective Sept. 16, 2012), 125 Stat. 284.)

(Public Law 112-29, sec. 14, 125 Stat. 284 (Sept. 16, 2011) provided that tax strategies are deemed to be within the prior art (see AIA § 14).)

35 U.S.C. 104 [Repealed.]

(Repealed Sept. 16, 2011, Public Law 112-29, sec. 3(d) (effective March 16, 2013), 125 Stat. 284.)

35 U.S.C. 104 (pre-AIA) Invention made abroad.

*[Editor Note: **Not applicable** to any patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). 35 U.S.C. 104 repealed with regard to such applications).]*

(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.

(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)); amended Sept. 16, 2011, Public Law 112-29, sec. 20(j) (effective Sept. 16, 2012), 125 Stat. 284.

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.

35 U.S.C. 111 Application.

[Editor Note: Applicable to any patent application filed on or after December 18, 2013. See 35 U.S.C. 111 (pre-PLT (AIA)) or 35 U.S.C. 111 (pre-AIA) for the law otherwise applicable.]

(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;

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

(C) an oath or declaration as prescribed by section 115.

(3) FEE, OATH OR DECLARATION, AND CLAIMS.—The application shall be accompanied by the fee required by law. The fee, oath or declaration, and 1 or more claims may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the fee, oath or declaration, and 1 or more claims within such prescribed period, the application shall be regarded as abandoned.

(4) FILING DATE.—The filing date of an application shall be the date on which a specification, with or without claims, is received in the United States 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 section 112(a); and

(B) a drawing as prescribed by section 113.

(2) CLAIM.—A claim, as required by subsections (b) through (e) of section 112, shall not be required in a provisional application.

(3) FEE.—The application shall be accompanied by the fee required by law. The fee may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned.

(4) FILING DATE.—The filing date of a provisional application shall be the date on which a specification, with or without claims, is received in the United States 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), 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), 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, 365(a), or 386(a) or to the benefit of an earlier filing date in the United States under section 120, 121, 365(c), or 386(c).

(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 131 and 135.

(c) PRIOR FILED APPLICATION.—Notwithstanding the provisions of subsection (a), the Director may prescribe the conditions, including the payment of a surcharge, under which a reference made upon the filing of an application under subsection (a) to a previously filed application, specifying the previously filed application by application number and the intellectual property authority or country in which the application was filed, shall constitute the specification and any drawings of the subsequent application for purposes of a filing date. A copy of the specification and any drawings of the previously filed application shall be submitted within such period and under such conditions as may be prescribed by the Director. A failure to submit the copy of the specification and any drawings of the previously filed application within the prescribed period shall result in the application being regarded as abandoned. Such application shall be treated as having never been filed, unless—

(1) the application is revived under section 27; and

(2) a copy of the specification and any drawings of the previously filed application are submitted to the Director.

(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); Sept. 16, 2011, Public Law 112-29, secs. 4 and 20(j) (effective Sept. 16, 2012) and sec. 3(e) (effective March 16, 2013), 125 Stat. 284; Dec. 18, 2012, Public Law 112-211, sec. 201(a)(1), 126 Stat. 1531; subsection (b)(7) amended Dec. 18, 2012, Public Law 112-211, sec. 102(3) (effective May 13, 2015), 126 Stat 1531.)

35 U.S.C. 111 (pre-PLT (AIA)) Application.

[Editor Note: Applicable to any patent application filed on or after September 16, 2012, and before December 18, 2013. See 35 U.S.C. 111 or 35 U.S.C. 111 (pre-AIA) for the law otherwise applicable.]

(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;

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

(C) an oath or declaration as prescribed by section 115.

(3) FEE AND OATH OR DECLARATION.—The application must be accompanied by the fee required by law. The fee and oath or declaration 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 or declaration 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 or declaration 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 section 112(a); and

(B) a drawing as prescribed by section 113.

(2) CLAIM.—A claim, as required by subsections (b) through (e) 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), 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), 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) or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c).

(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 131 and 135.

(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); Sept. 16, 2011, Public Law 112-29, secs. 4 and 20(j) (effective Sept. 16, 2012) and sec. 3(e) (effective March 16, 2013), 125 Stat. 284.)

35 U.S.C. 111 (pre-AIA) Application.

*[Editor Note: **Not applicable** to any patent application filed on or after September 16, 2012. See 35 U.S.C. 111 or 35 U.S.C. 111 (pre-PLT (AIA)) for the law otherwise applicable.]*

(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.

[Editor Note: Applicable to any patent application filed on or after September 16, 2012. See 35 U.S.C. 112 (pre-AIA) for the law otherwise applicable.]

(a) IN GENERAL.—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 or joint inventor of carrying out the invention.

(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

(c) FORM.—A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

(d) REFERENCE IN DEPENDENT FORMS.—Subject to subsection (e), 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.

(e) REFERENCE IN MULTIPLE DEPENDENT FORM.—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.

(f) ELEMENT IN CLAIM FOR A COMBINATION.—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; amended Sept. 16, 2011, Public Law 112-29, sec. 4(c), 125 Stat. 284, effective Sept. 16, 2012.)

35 U.S.C. 112 (pre-AIA) Specification.

*[Editor Note: **Not applicable** to any patent application filed on or after September 16, 2012. See 35 U.S.C. 112 for the law otherwise applicable.]*

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 Inventor's oath or declaration.

[Editor Note: Applicable to any patent application filed on or after September 16, 2012. See 35 U.S.C. 115 (pre-AIA) for the law otherwise applicable.]

(a) NAMING THE INVENTOR; INVENTOR'S OATH OR DECLARATION.—An application for patent that is filed under section 111(a) or commences the national stage under section 371 shall include, or be amended to include, the name of the inventor for any invention claimed in the application. Except as otherwise provided in this section, each individual who is the inventor or a joint inventor of a claimed invention in an application for patent shall execute an oath or declaration in connection with the application.

(b) REQUIRED STATEMENTS.—An oath or declaration under subsection (a) shall contain statements that—

(1) the application was made or was authorized to be made by the affiant or declarant; and

(2) such individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.

(c) ADDITIONAL REQUIREMENTS.—The Director may specify additional information relating to the inventor and the invention that is required to be included in an oath or declaration under subsection (a).

(d) SUBSTITUTE STATEMENT.—

(1) IN GENERAL.—In lieu of executing an oath or declaration under subsection (a), the applicant for patent may provide a substitute statement under the circumstances described in paragraph (2) and such additional circumstances that the Director may specify by regulation.

(2) PERMITTED CIRCUMSTANCES.—A substitute statement under paragraph (1) is permitted with respect to any individual who—

(A) is unable to file the oath or declaration under subsection (a) because the individual—

(i) is deceased;

(ii) is under legal incapacity; or

(iii) cannot be found or reached after diligent effort; or

(B) is under an obligation to assign the invention but has refused to make the oath or declaration required under subsection (a).

(3) CONTENTS.—A substitute statement under this subsection shall—

(A) identify the individual with respect to whom the statement applies;

(B) set forth the circumstances representing the permitted basis for the filing of the substitute statement in lieu of the oath or declaration under subsection (a); and

(C) contain any additional information, including any showing, required by the Director.

(e) MAKING REQUIRED STATEMENTS IN ASSIGNMENT OF RECORD.—An individual who is under an obligation of assignment of an application for patent may include the required statements under subsections (b) and (c) in the assignment executed by the individual, in lieu of filing such statements separately.

(f) TIME FOR FILING.—The applicant for patent shall provide each required oath or declaration under subsection (a), substitute statement under subsection (d), or recorded assignment meeting the requirements of subsection (e) no later than the date on which the issue fee for the patent is paid.

(g) EARLIER-FILED APPLICATION CONTAINING REQUIRED STATEMENTS OR SUBSTITUTE STATEMENT.—

(1) EXCEPTION.—The requirements under this section shall not apply to an individual with respect to an application for patent in which the individual is named as the inventor or a joint inventor and that claims the benefit under section 120, 121, 365(c), or 386(c) of the filing of an earlier-filed application, if—

(A) an oath or declaration meeting the requirements of subsection (a) was executed by the individual and was filed in connection with the earlier-filed application;

(B) a substitute statement meeting the requirements of subsection (d) was filed in connection with the earlier filed application with respect to the individual; or

(C) an assignment meeting the requirements of subsection (e) was executed with respect to the earlier-filed application by the individual and was recorded in connection with the earlier-filed application.

(2) COPIES OF OATHS, DECLARATIONS, STATEMENTS, OR ASSIGNMENTS.—Notwithstanding paragraph (1), the Director may require that a copy of the executed oath or declaration, the substitute statement, or the assignment filed in connection with the earlier-filed application be included in the later-filed application.

(h) SUPPLEMENTAL AND CORRECTED STATEMENTS; FILING ADDITIONAL STATEMENTS.—

(1) IN GENERAL.—Any person making a statement required under this section may withdraw, replace, or otherwise correct the statement at any time. If a change is made in the naming of the inventor requiring the filing of 1 or more additional statements under this section, the Director shall establish regulations under which such additional statements may be filed.

(2) SUPPLEMENTAL STATEMENTS NOT REQUIRED.—If an individual has executed an oath or declaration meeting the requirements of subsection (a) or an assignment meeting the requirements of subsection (e) with respect to an application for patent, the Director may not thereafter require that individual to make any additional oath, declaration, or other statement equivalent to those required by this section in connection with the application for patent or any patent issuing thereon.

(3) SAVINGS CLAUSE.—A patent shall not be invalid or unenforceable based upon the failure to comply with a requirement under this section if the failure is remedied as provided under paragraph (1).

(i) ACKNOWLEDGMENT OF PENALTIES.—Any declaration or statement filed pursuant to this section shall contain an acknowledgment that any willful false statement made in such declaration or statement is punishable under section 1001 of title 18 by fine or imprisonment of not more than 5 years, or both.

(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; amended Sept. 16, 2011, Public Law 112-29, sec. 4(a) (effective Sept. 16, 2012), 125 Stat. 284; subsections (f) and (g)(1) amended Jan. 14, 2013, Public Law 112-274, sec. 1(f), 126 Stat. 2456; subsection (g)(1) amended Dec. 18, 2012, Public Law 112-211, sec. 102(4) (effective May 13, 2015), 126 Stat. 1531.)

35 U.S.C. 115 (pre-AIA) Oath of applicant.

*[Editor Note: **Not applicable** to any patent application filed on or after September 16, 2012. See 35 U.S.C. 115 for the law otherwise applicable.]*

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.

[Editor Note: Applicable to proceedings commenced on or after Sept. 16, 2012. See 35 U.S.C. 116 (pre-AIA) for the law otherwise applicable.]

(a) JOINT INVENTIONS.—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.

(b) OMITTED INVENTOR.—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.

(c) CORRECTION OF ERRORS IN 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, 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)); amended Sept. 16, 2011, Public Law 112-29, sec. 20(a), 125 Stat. 284, effective Sept. 16, 2012.)

35 U.S.C. 116 (pre-AIA) Inventors.

*[Editor Note: **Not applicable** to proceedings commenced on or after September 16, 2012. See 35 U.S.C. 116 for the law otherwise applicable.]*

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.

[Editor Note: Applicable to any patent application filed on or after September 16, 2012. See 35 U.S.C. 118 (pre-AIA) for the law otherwise applicable.]

A person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent. A person who otherwise shows sufficient proprietary interest in the matter may make an 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 appropriate to preserve the rights of the parties. If the Director grants a patent on an application filed under this section by a person other than the inventor, the patent shall be granted to the real party in interest and upon such notice to the inventor as the Director considers to be sufficient.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)); amended Sept. 16, 2011, Public Law 112-29, sec. 4(b), 125 Stat. 284, effective Sept. 16, 2012.)

35 U.S.C. 118 (pre-AIA) Filing by other than inventor.

*[Editor Note: **Not applicable** to any patent application filed on or after September 16, 2012. See 35 U.S.C. 118 for the law otherwise applicable.]*

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.

[Editor Note: 35 U.S.C. 119(a) as set forth below is only applicable to patent applications subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 119(a) (pre-AIA) for the law otherwise applicable.]

(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 12 months from the earliest date on which such foreign application was filed. The Director may prescribe regulations, including the requirement for payment of the fee specified in section 41(a)(7), pursuant to which the 12-month period set forth in this subsection may be extended by an additional 2 months if the delay in filing the application in this country within the 12-month period was unintentional.

(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 requirement for payment of the fee specified in section 41(a)(7), 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 purpose 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 for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in a provisional application filed under section 111(b), 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), if the application for patent filed under section 111(a) or section 363 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. The Director may prescribe regulations, including the requirement for payment of the fee specified in section 41(a)(7), pursuant to which the 12-month period set forth in this subsection may be extended by an additional 2 months if the delay in filing the application under section 111(a) or section 363 within the 12-month period was unintentional. 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 the fee specified in section 41(a)(7), to accept an unintentionally delayed submission of an amendment under this subsection.

(2) A provisional application filed under section 111(b) 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) 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. For an application for patent filed under section 363 in a Receiving Office other than the Patent and Trademark Office, the 12-month and additional 2-month period set forth in this subsection shall be extended as provided under the treaty and Regulations as defined in section 351.

(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); 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); subsections (e), (g) amended Sept. 16, 2011, Public Law 112-29, secs. 15(b) (effective Sept. 16, 2011) and 20(j) (effective Sept. 16, 2012), 125 Stat. 284; subsection (a) amended Sept. 16, 2011, Public Law 112-29, sec. 3(g) (effective March 16, 2013), 125 Stat. 284; subsections (a) and (e), Dec. 18, 2012, Public Law 112-211, sec. 201(c)(1)(A), 126 Stat. 1527; subsection (b)(2), Dec. 18, 2012, Public Law 112-211, sec. 202(b)(2), 126 Stat. 1536.)

35 U.S.C. 119 (pre-AIA) Benefit of earlier filing date; right of priority.

[Editor Note: pre-AIA 35 U.S.C. 119(a) as set forth below is applicable to patent applications not subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 119(a) for the law otherwise applicable.]

(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.

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(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); subsections (e), (g) amended Sept. 16, 2011, Public Law 112-29, secs. 15(b) (effective Sept. 16, 2011) and 20(j) (effective Sept. 16, 2012), 125 Stat. 284.)

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

[Editor Note: Applicable to a patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 120 (pre-AIA) for the law otherwise applicable.]

An application for patent for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in an application previously filed in the United States, or as provided by section 363 or 385 which names an inventor or joint inventor 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 Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), 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)); amended Sept. 16, 2011, Public Law 112-29, secs. 15(b) (effective Sept. 16, 2012), 20(j) (effective Sept. 16, 2012) and 3(f) (effective March 16, 2013), 125 Stat. 284; Dec. 18, 2012, Public Law 112-211, sec. 202(b)(3), 126 Stat. 1536; amended Dec. 18, 2012, Public Law 112-211, sec. 102(5) (effective May 13, 2015), 126 Stat. 1531.)

35 U.S.C. 120 (pre-AIA) Benefit of earlier filing date in the United States.

[Editor Note: Not applicable to patent applications subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 120 for the law otherwise applicable.]

An application for patent for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in an application previously filed in the United States, or as provided by section 363, 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 Director 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)); amended Sept. 16, 2011, Public Law 112-29, secs. 15(b) (effective Sept. 16, 2011) and 20(j) (effective Sept. 16, 2012), 125 Stat. 284.)

35 U.S.C. 121 Divisional applications.

[Editor Note: Applicable to any patent application filed on or after September 16, 2012. See 35 U.S.C. 121 (pre-AIA) for the law otherwise applicable.]

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 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. 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)); amended Sept. 16, 2011, Public Law 112-29, secs. 4(a) and 20(j) (effective Sept. 16, 2012), 125 Stat. 284.)

35 U.S.C. 121 (pre-AIA) Divisional applications.

*[Editor Note: **Not applicable** to any patent application filed on or after September 16, 2012. See 35 U.S.C. 121 for the law otherwise applicable.]*

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;

(iii) a provisional application filed under section 111(b); or

(iv) an application for a design patent filed under chapter 16.

(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.

(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.

(e) PREISSUANCE SUBMISSIONS BY THIRD PARTIES.—

(1) IN GENERAL.—Any third party may submit for consideration and inclusion in the record of a patent application, any patent, published patent application, or other printed publication of potential relevance to the examination of the application, if such submission is made in writing before the earlier of—

(A) the date a notice of allowance under section 151 is given or mailed in the application for patent; or

(B) the later of—

(i) 6 months after the date on which the application for patent is first published under section 122 by the Office, or

(ii) the date of the first rejection under section 132 of any claim by the examiner during the examination of the application for patent.

(2) OTHER REQUIREMENTS.—Any submission under paragraph (1) shall—

(A) set forth a concise description of the asserted relevance of each submitted document;

(B) be accompanied by such fee as the Director may prescribe; and

(C) include a statement by the person making such submission affirming that the submission was made in compliance with this section.

(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)); amended and subsection (e) added Sept. 16, 2011, Public Law 112-29, secs. 8 and 20(j) (effective Sept. 16, 2012), 125 Stat. 284; subsection (b)(2)(B)(iii), Dec. 18, 2012, Public Law 112-211, sec. 202(b)(4), 126 Stat. 1536.)

35 U.S.C. 123 Micro entity defined.

(a) IN GENERAL.—For purposes of this title, the term "micro entity" means an applicant who makes a certification that the applicant—

(1) qualifies as a small entity, as defined in regulations issued by the Director;

(2) has not been named as an inventor on more than 4 previously filed patent applications, other than applications filed in another country, provisional applications under section 111(b), or international applications filed under the treaty defined in section 351(a) for which the basic national fee under section 41(a) was not paid;

(3) did not, in the calendar year preceding the calendar year in which the applicable fee is being paid, have a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding 3 times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census; and

(4) has not assigned, granted, or conveyed, and is not under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a

gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding 3 times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

(b) APPLICATIONS RESULTING FROM PRIOR EMPLOYMENT.—An applicant is not considered to be named on a previously filed application for purposes of subsection (a)(2) if the applicant has assigned, or is under an obligation by contract or law to assign, all ownership rights in the application as the result of the applicant's previous employment.

(c) FOREIGN CURRENCY EXCHANGE RATE.—If an applicant's or entity's gross income in the preceding calendar year is not in United States dollars, the average currency exchange rate, as reported by the Internal Revenue Service, during that calendar year shall be used to determine whether the applicant's or entity's gross income exceeds the threshold specified in paragraphs (3) or (4) of subsection (a).

(d) INSTITUTIONS OF HIGHER EDUCATION.—For purposes of this section, a micro entity shall include an applicant who certifies that—

(1) the applicant's employer, from which the applicant obtains the majority of the applicant's income, is an institution of higher education as defined in section 101(a) of the Higher Education Act of 1965 (20 U.S.C. 1001(a)); or

(2) the applicant has assigned, granted, conveyed, or is under an obligation by contract or law, to assign, grant, or convey, a license or other ownership interest in the particular applications to such an institution of higher education.

(e) DIRECTOR'S AUTHORITY.—In addition to the limits imposed by this section, the Director may, in the Director's discretion, impose income limits, annual filing limits, or other limits on who may qualify as a micro entity pursuant to this section if the Director determines that such additional limits are reasonably necessary to avoid an undue impact on other patent applicants or owners or are otherwise reasonably necessary and appropriate. At least 3 months before any limits proposed to be imposed pursuant to this subsection take effect, the Director shall inform the Committee on the Judiciary of the House of Representatives and the Committee on the Judiciary of the Senate of any such proposed limits.

(Added Sept. 16, 2011, Public Law 112-29, sec. 10(g), 125 Stat. 284; amended Public Law 112-29, sec. 20(j), 125 Stat. 284 and corrected Jan. 14, 2013, Public Law 112-274, sec. 1(m), 126 Stat. 2456.)

CHAPTER 12 — EXAMINATION OF APPLICATION

Sec.

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).

(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)); amended Sept. 16, 2011, Public Law 112-29, sec. 20(j) (effective Sept. 16, 2012), 125 Stat. 284.)

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.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)); Dec. 18, 2012, Public Law 12-211, sec. 202(b)(5), 126 Stat. 1536.)

35 U.S.C. 134 Appeal to the Patent Trial and Appeal Board.

[Editor Note: Applicable to proceedings commenced on or after September 16, 2012 and applicable to any patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 134 (transitional) for the law applicable to proceedings commenced on or after

*September 16, 2012 but **not applicable** to any patent application subject to the first inventor to file provisions of the AIA. See 35 U.S.C. 134 (pre-AIA) for the law applicable to proceedings commenced before September 16, 2012.]*

(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 Patent Trial and Appeal Board, having once paid the fee for such appeal.

(b) PATENT OWNER.— A patent owner in a reexamination may appeal from the final rejection of any claim by the primary examiner to the Patent Trial and Appeal Board, 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; amended Sept. 16, 2011, Public Law 112-29, secs. 7(b) (effective Sept. 16, 2012) and 3(j) (effective March 16, 2013), 125 Stat. 284.)

35 U.S.C. 134 (transitional) Appeal to the Board of Patent Appeals and Interferences.

*[Editor Note: Applicable to proceedings commenced on or after September 16, 2012, but **not applicable** to any patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 134 for the law applicable to patent applications subject to the first inventor to file provisions of the AIA.] See 35 U.S.C. 134 (pre-AIA) for the law applicable to proceedings commenced before September 16, 2012.]*

(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 a reexamination 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.

(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; amended Sept. 16, 2011, Public Law 112-29, sec. 7(b) (effective Sept. 16, 2012), 125 Stat. 284.)

35 U.S.C. 134 (pre-AIA) Appeal to the Board of Patent Appeals and Interferences.

*[Editor Note: **Not applicable** to proceedings commenced on or after September 16, 2012. See 35 U.S.C. 134 or 35 U.S.C. 134 (transitional) for the law otherwise applicable.]*

(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 Derivation proceedings.

[Editor Note: Applicable to any patent application subject to the AIA first inventor to file provisions (see 35 U.S.C. 100 (note)). See 35 U.S.C. 135 (pre-AIA) for the law otherwise applicable.]*

(a) INSTITUTION OF PROCEEDING.—

(1) IN GENERAL.— An applicant for patent may file a petition with respect to an invention to institute a derivation proceeding in the Office. The petition shall set forth with particularity the basis for finding that an individual named in an earlier application as the inventor or a joint inventor derived such invention from an individual named in the petitioner's application as the inventor or a joint inventor and, without authorization, the earlier application claiming such invention was filed. Whenever the Director determines that a petition filed under this subsection demonstrates that the standards for instituting a derivation proceeding are met, the Director may institute a derivation proceeding.

(2) TIME FOR FILING.—A petition under this section with respect to an invention that is the same or substantially the same invention as a claim contained in a patent issued on an earlier application, or contained in an earlier application when published or deemed published under section 122(b), may not be filed unless such petition is filed during the 1-year period following the date on which the patent containing such claim was granted or the earlier application containing such claim was published, whichever is earlier.

(3) EARLIER APPLICATION.—For purposes of this section, an application shall not be deemed to be an earlier application with respect to an invention, relative to another application, unless a claim to the invention was or could have been made in such application having an effective filing date that is earlier than the effective filing date of any claim to the invention that was or could have been made in such other application.

(4) NO APPEAL.—A determination by the Director whether to institute a derivation proceeding under paragraph (1) shall be final and not appealable.

(b) DETERMINATION BY PATENT TRIAL AND APPEAL BOARD.— In a derivation proceeding instituted under subsection (a), the Patent Trial and Appeal Board shall determine whether an inventor named in the earlier application derived the claimed invention from an inventor named in the petitioner's application and, without authorization, the earlier application claiming such invention was filed. In appropriate circumstances, the Patent Trial and Appeal Board may correct the naming of the inventor in any application or patent at issue. The Director shall prescribe regulations setting forth standards for the conduct of derivation proceedings, including requiring parties to provide sufficient evidence to prove and rebut a claim of derivation.

(c) DEFERRAL OF DECISION.—The Patent Trial and Appeal Board may defer action on a petition for a derivation proceeding until the expiration of the 3-month period beginning on the date on which the Director issues a patent that includes the claimed invention that is the subject of the petition. The Patent Trial and Appeal Board also may defer action on a petition for a derivation proceeding, or stay the proceeding after it has been instituted, until the termination of a proceeding under chapter 30, 31, or 32 involving the patent of the earlier applicant.

(d) EFFECT OF FINAL DECISION.—The final decision of the Patent Trial and Appeal Board, if adverse to claims in an application for patent, shall constitute the final refusal by the Office on those claims. The final decision of the Patent Trial and Appeal Board, if adverse to claims in a patent, shall, if no appeal or other review of the decision has been or can be taken or had, constitute cancellation of those claims, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation.

(e) SETTLEMENT.—Parties to a proceeding instituted under subsection (a) may terminate the proceeding by filing a written statement reflecting the agreement of the parties as to the correct inventor of the claimed invention in dispute. Unless the Patent Trial and Appeal Board finds the agreement to be inconsistent with the evidence of record, if any, it shall take action consistent with the agreement. Any written settlement or understanding of the parties shall be filed with the Director. At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents or applications, and shall be made available only to Government agencies on written request, or to any person on a showing of good cause.

(f) ARBITRATION.—Parties to a proceeding instituted under subsection (a) may, within such time as may be specified by the Director by regulation, 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 the patentability of the claimed inventions involved in the proceeding.

(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)); amended Sept. 16, 2011, Public Law 112-29, secs. 20(j) (effective Sept. 16, 2012) and (3)(i)(effective March 16, 2013)*, 125 Stat. 284; subsections (a) and (e) amended Jan. 14, 2013, Public Law 112-274, secs. 1(e) and (k), 126 Stat. 2456, effective March 16, 2013.*)

NOTE:** The provisions of 35 U.S.C. 135 (pre-AIA), as in effect on ***March 15, 2013, shall apply to each claim of an application for patent, and any patent issued thereon, for which the first inventor to file provisions of the AIA also apply (see35 U.S.C. 100 (note)), if such application or patent contains or contained at any time—

(A) a claim to an invention having an effective filing date as defined in section 100(i), that occurs before March 16, 2013; or

(B) a specific reference under section 120 , 121, or 365(c) to any patent or application that contains or contained at any time such a claim.

35 U.S.C. 135 (pre-AIA) Interferences.

*[Editor Note: Except as noted below, **not applicable to any patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 135 for the law otherwise applicable.]*

(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) 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)); amended Sept. 16, 2011, Public Law 112-29, sec. 20(j) (effective Sept. 16, 2012), 125 Stat. 284 .

NOTE:** The provisions of 35 U.S.C. 135 (pre-AIA), as in effect on ***March 15, 2013, shall apply to each claim of an application for patent, and any patent issued thereon, for which the first inventor to file provisions of the AIA also apply (see 35 U.S.C. 100 (note)), if such application or patent contains or contained at any time—

(A) a claim to an invention having an effective filing date as defined in section 100(i), that occurs before March 16, 2013; or

(B) a specific reference under section 120 , 121, or 365(c) to any patent or application that contains or contained at any time such a claim.

CHAPTER 13 — REVIEW OF PATENT AND TRADEMARK OFFICE DECISION

Sec.

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

[Editor Note: Applicable to proceedings commenced on or after September 16, 2012. See 35 U.S.C. 141 (pre-AIA) for the law otherwise applicable.]*

(a) EXAMINATIONS.—An applicant who is dissatisfied with the final decision in an appeal to the Patent Trial and Appeal Board under section 134(a) may appeal the Board's 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 .

(b) REEXAMINATIONS.—A patent owner who is dissatisfied with the final decision in an appeal of a reexamination to the Patent Trial and Appeal Board under section 134(a) may appeal the Board's decision only to the United States Court of Appeals for the Federal Circuit.

(c) POST-GRANT AND INTER PARTES REVIEWS.—A party to an inter partes review or a post-grant review who is dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) or 328(a) (as the case may be) may appeal the Board's decision only to the United States Court of Appeals for the Federal Circuit.

(d) DERIVATION PROCEEDINGS.—A party to a derivation proceeding who is dissatisfied with the final decision of the Patent Trial and Appeal Board in the proceeding 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 derivation proceeding, within 20 days after the appellant has filed notice of appeal in accordance with section 142, files notice with the Director that the party elects to have all further proceedings conducted as provided in section 146. If the appellant does not, within 30 days after the filing of such notice by the adverse party, file a civil action under section 146, the Board's decision 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; amended Sept. 16, 2011, Public Law 112-29, sec. 7(c) (effective Sept. 16, 2012), 125 Stat. 284.)

***NOTE:** The provisions of this section as in effect on Sept. 15, 2012 (35 U.S.C. 141 (pre-AIA)) apply to interference proceedings that are declared after September 15, 2012 under 35 U.S.C. 135 (pre-AIA). See Public Law 112-274, sec. 1(k)(3), 126 Stat. 2456 (Jan. 14, 2013).

35 U.S.C. 141 (pre-AIA) Appeal to the Court of Appeals for the Federal Circuit.

*[Editor Note: **Not applicable** to proceedings commenced on or after September 16, 2012.* See 35 U.S.C. 141 for the law otherwise applicable.]*

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.)

***NOTE:** The provisions of 35 U.S.C. 141 (pre-AIA) as in effect on Sept. 15, 2012 apply to interference proceedings that are declared after September 15, 2012 under 35 U.S.C. 135 (pre-AIA). See Public Law 112-274, sec. 1(k)(3), 126 Stat. 2456 (Jan. 14, 2013).

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.

[Editor Note: Applicable to proceedings commenced on or after Sept. 16, 2012. See 35 U.S.C. 143 (pre-AIA) for the law otherwise applicable.]

With respect to an appeal described in section 142, 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, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all of the issues raised in the appeal. The Director shall have the right to intervene in an appeal from a decision entered by the Patent Trial and Appeal Board in a derivation proceeding under section 135 or in an inter partes or post-grant review under chapter 31 or 32.

(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; amended Sept. 16, 2011, Public Law 112-29, secs. 7(c) and 20(j) (effective Sept. 16, 2012), 125 Stat. 284.)

35 U.S.C. 143 (pre-AIA) Proceedings on appeal.

*[Editor Note: **Not applicable** to proceedings commenced on or after September 16, 2012. See 35 U.S.C. 143 for the law otherwise applicable.]*

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.

[Editor Note: Applicable to any patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 145 (pre-AIA) for the law otherwise applicable.]

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

(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)); amended Sept. 16, 2011, Public Law 112-29, secs. 9 (effective Sept. 16, 2011), 20(j) (effective Sept. 16, 2012), and 3(j) (effective March 16, 2013), 125 Stat. 284.)

35 U.S.C. 145 (pre-AIA) Civil action to obtain patent.

[Editor Note: Not applicable to any patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 145 for the law otherwise applicable.]

An applicant dissatisfied with the decision of the Board of Patent Appeals and Interferences in an appeal under section 134(a) may, unless appeal has been taken to the United States Court of Appeals for the Federal Circuit, have remedy by civil action against the Director in the United States District Court for the Eastern District of Virginia if commenced within such time after such decision, not less than sixty days, as the Director appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the 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)); amended Sept. 16, 2011, Public Law 112-29, secs. 9 (effective Sept. 16, 2011) and 20(j) (effective Sept. 16, 2012), 125 Stat. 284.)

35 U.S.C. 146 Civil action in case of derivation proceeding.

[Editor Note: Applicable to any patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 146 (pre-AIA) for the law otherwise applicable.]

Any party to a derivation proceeding dissatisfied with the decision of the Patent Trial and Appeal Board on the derivation proceeding, 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, 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 Eastern District of Virginia 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 the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Director to issue such patent on the filing in the Patent and Trademark Office of a certified copy of the judgment and on compliance with the requirements of law.

(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 98-622, sec. 203(c), 98 Stat. 3387; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)); amended Sept. 16, 2011, Public Law 112-29, secs. 9 (effective Sept. 16, 2011), sec. 20(j) (effective Sept. 16, 2012) and 3(j) (effective March 16, 2013), 125 Stat. 284.)

35 U.S.C. 146 (pre-AIA) Civil action in case of interference.

*[Editor Note: **Not applicable** to any patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 146 for the law otherwise applicable.]*

Any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences on the interference, 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, 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 Eastern District of Virginia 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 the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Director to issue such patent on the filing in the Patent and Trademark Office of a certified copy of the judgment and on compliance with the requirements of law.

(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 98-622, sec. 203(c), 98 Stat. 3387; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)); amended Sept. 16, 2011, Public Law 112-29, secs. 9 (effective Sept. 16, 2011) and 20(j) (effective Sept. 16, 2012), 125 Stat. 284.)

CHAPTER 14 — ISSUE OF PATENT

35 U.S.C. 151 Issue of patent.

(a) IN GENERAL.—If it appears that an applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee and any required publication fee, which shall be paid within 3 months thereafter.

(b) EFFECT OF PAYMENT.—Upon payment of this sum the patent may issue, but if payment is not timely made, the application shall be regarded as abandoned.

(Amended July 24, 1965, Public Law 89-83, sec. 4, 79 Stat. 260; Jan. 2, 1975, Public Law 93-601, sec. 3, 88 Stat. 1956; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)); Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)); Dec. 18, 2012, Public Law 112-211, sec. 202(b)(6), 126 Stat. 1536.)

35 U.S.C. 152 Issue of patent to assignee.

Patents may be granted to the assignee of the inventor of record in the Patent and Trademark Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.

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

35 U.S.C. 153 How issued.

Patents shall be issued in the name of the United States of America, under the seal of the Patent and Trademark Office,

and shall be signed by the Director or have his signature placed thereon and shall be recorded in the Patent and Trademark Office.

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

35 U.S.C. 154 Contents and term of patent; provisional rights.

[Editor Note: 35 U.S.C. 154(b)(1) as set forth below is only applicable to patent applications subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 154(b)(1) (pre-AIA) for the law otherwise applicable.]

(a) IN GENERAL.—

(1) CONTENTS.—Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, of the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States, and, if the invention is a process, of the right to exclude others from using, offering for sale or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof.

(2) TERM.—Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, 365(c), or 386(c) from the date on which the earliest such application was filed.

(3) PRIORITY.—Priority under section 119, 365(a), 365(b), 386(a), or 386(b) shall not be taken into account in determining the term of a patent.

(4) SPECIFICATION AND DRAWING.—A copy of the specification and drawing shall be annexed to the patent and be a part of such patent.

(b) ADJUSTMENT OF PATENT TERM.—

(1) PATENT TERM GUARANTEES.—

(A) GUARANTEE OF PROMPT PATENT AND TRADEMARK OFFICE RESPONSES.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

(i) provide at least one of the notifications under section 132 or a notice of allowance under section 151 not later than 14 months after—

(I) the date on which an application was filed under section 111(a); or

(II) the date of commencement of the national stage under section 371 in an international application;

(ii) respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken;

(iii) act on an application within 4 months after the date of a decision by the Patent Trial and Appeal Board under section 134 or 135 or a decision by a Federal court under section 141, 145, or 146 in a case in which allowable claims remain in the application; or

(iv) issue a patent within 4 months after the date on which the issue fee was paid under section 151 and all outstanding requirements were satisfied,

the term of the patent shall be extended 1 day for each day after the end of the period specified in clause (i), (ii), (iii), or (iv), as the case may be, until the action described in such clause is taken.

(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application under section 111(a) in the United States or, in the case of an international application, the date of commencement of the national stage under section 371 in the international application not including—

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

(ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Patent Trial and Appeal Board or by a Federal court; or

(iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C),

the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

(C) GUARANTEE OR ADJUSTMENTS FOR DELAYS DUE TO DERIVATION PROCEEDINGS, SECRECY ORDERS, AND APPEALS.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to—

(i) a proceeding under section 135(a);

(ii) the imposition of an order under section 181; or

(iii) appellate review by the Patent Trial and Appeal Board or by a Federal court in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability,

the term of the patent shall be extended 1 day for each day of the pendency of the proceeding, order, or review, as the case may be.

(2) LIMITATIONS.—

(A) IN GENERAL.— To the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

(B) DISCLAIMED TERM.— No patent the term of which has been disclaimed beyond a specified date may be adjusted under this section beyond the expiration date specified in the disclaimer.

(C) REDUCTION OF PERIOD OF ADJUSTMENT.—

(i) The period of adjustment of the term of a patent under paragraph (1) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application.

(ii) With respect to adjustments to patent term made under the authority of paragraph (1)(B), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of 3 months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, measuring such 3-month period from the date the notice was given or mailed to the applicant.

(iii) The Director shall prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

(3) PROCEDURES FOR PATENT TERM ADJUSTMENT DETERMINATION.—

(A) The Director shall prescribe regulations establishing procedures for the application for and determination of patent term adjustments under this subsection.

(B) Under the procedures established under subparagraph (A), the Director shall—

(i) make a determination of the period of any patent term adjustment under this subsection, and shall transmit a notice of that determination no later than the date of issuance of the patent; and

(ii) provide the applicant one opportunity to request reconsideration of any patent term adjustment determination made by the Director.

(C) The Director shall reinstate all or part of the cumulative period of time of an adjustment under paragraph (2)(C) if the applicant, prior to the issuance of the patent, makes a showing that, in spite of all due care, the applicant was unable to respond within the 3-month period, but in no case shall more than three additional months for each such response beyond the original 3-month period be reinstated.

(D) The Director shall proceed to grant the patent after completion of the Director's determination of a patent term adjustment under the procedures established under this subsection, notwithstanding any appeal taken by the applicant of such determination.

(4) APPEAL OF PATENT TERM ADJUSTMENT DETERMINATION.—

(A) An applicant dissatisfied with the Director's decision on the applicant's request for reconsideration under paragraph (3)(B)(ii) shall have exclusive remedy by a civil action against the Director filed in the United States District Court for the Eastern District of Virginia within 180 days after the date of the Director's decision on the applicant's request for reconsideration. Chapter 7 of title 5 shall apply to such action. Any final judgment resulting in a change to the period of adjustment of the patent term shall be served on the Director, and the Director shall thereafter alter the term of the patent to reflect such change.

(B) The determination of a patent term adjustment under this subsection shall not be subject to appeal or challenge by a third party prior to the grant of the patent.

(c) CONTINUATION.—

(1) DETERMINATION.—The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers.

(2) REMEDIES.—The remedies of sections 283, 284, and 285 shall not apply to acts which —

(A) were commenced or for which substantial investment was made before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act; and

(B) became infringing by reason of paragraph (1).

(3) REMUNERATION.—The acts referred to in paragraph (2) may be continued only upon the payment of an equitable remuneration to the patentee that is determined in an action brought under chapter 28 and chapter 29 (other than those provisions excluded by paragraph (2)).

(d) PROVISIONAL RIGHTS.—

(1) IN GENERAL.— In addition to other rights provided by this section, a patent shall include the right to obtain a reasonable royalty from any person who, during the period beginning on the date of publication of the application for such patent under section 122(b), or in the case of an international application filed under the treaty defined in section 351(a) designating the United States under Article 21(2)(a) of such treaty, or an international design application filed under the treaty defined in section 381(a)(1) designating the United States under Article 5 of such treaty, the date of publication of the application, and ending on the date the patent is issued—

(A) (i) makes, uses, offers for sale, or sells in the United States the invention as claimed in the published patent application or imports such an invention into the United States; or

(ii) if the invention as claimed in the published patent application is a process, uses, offers for sale, or sells in the United States or imports into the United States products made by that process as claimed in the published patent application; and

(B) had actual notice of the published patent application and, in a case in which the right arising under this paragraph is based upon an international application designating the United States that is published in a language other than English, had a translation of the international application into the English language.

(2) RIGHT BASED ON SUBSTANTIALLY IDENTICAL INVENTIONS.— The right under paragraph (1) to obtain a reasonable royalty shall not be available under this subsection unless the invention as claimed in the patent is substantially identical to the invention as claimed in the published patent application.

(3) TIME LIMITATION ON OBTAINING A REASONABLE ROYALTY.— The right under paragraph (1) to obtain a reasonable royalty shall be available only in an action brought not later than 6 years after the patent is issued. The right under paragraph (1) to obtain a reasonable royalty shall not be affected by the duration of the period described in paragraph (1).

(4) REQUIREMENTS FOR INTERNATIONAL APPLICATIONS—

(A) EFFECTIVE DATE.— The right under paragraph (1) to obtain a reasonable royalty based upon the publication under the treaty defined in section 351(a) of an international application designating the United States shall commence on the date of publication under the treaty of the international application, or, if the publication under the treaty of the international application is in a language other than English, on the date on which the Patent and Trademark Office receives a translation of the publication in the English language.

(B) COPIES.— The Director may require the applicant to provide a copy of the international application and a translation thereof.

(Amended July 24, 1965, Public Law 89-83, sec. 5, 79 Stat. 261; Dec. 12, 1980, Public Law 96-517, sec. 4, 94 Stat. 3018; Aug. 23, 1988, Public Law 100-418, sec. 9002, 102 Stat. 1563; Dec. 8, 1994, Public Law 103-465, sec. 532 (a)(1), 108 Stat. 4983; Oct. 11, 1996, Public Law 104-295, sec. 20(e)(1), 110 Stat. 3529; subsection (b) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-557 (S. 1948 sec. 4402(a)); subsection (d) added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-564 (S. 1948 sec. 4504); subsection (b)(4) amended Nov. 2, 2002, Public Law 107-273, sec. 13206, 116 Stat. 1904; subsection (d)(4)(A) amended Nov. 2, 2002, Public Law 107-273, sec. 13204, 116 Stat. 1902; subsection (b)(4)(A) amended Sept. 16, 2011, Public Law 112-29, secs. 9 (effective Sept. 16, 2011), 20(j) (effective Sept. 16, 2012), and 3(j) (effective March 16, 2013), 125 Stat. 284; subsection (b) amended Jan. 14, 2013, Public Law 112-274, sec. 1(h), 126 Stat. 2456; subsections (a) and (d)(1) amended Dec. 18, 2012, Public Law 112-211, sec. 102(6) (effective May 13, 2015), 126 Stat. 1531.)

35 U.S.C. 154 (pre-AIA) Contents and term of patent; provisional rights.

[Editor Note: 35 U.S.C. 154(b)(1)(pre-AIA) as set forth below is not applicable to any patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 154(b)(1) for the law otherwise applicable.]

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(b) ADJUSTMENT OF PATENT TERM.—

(1) PATENT TERM GUARANTEES.—

(A) GUARANTEE OF PROMPT PATENT AND TRADEMARK OFFICE RESPONSES.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

(i) provide at least one of the notifications under section 132 or a notice of allowance under section 151 not later than 14 months after—

(I) the date on which an application was filed under section 111(a); or

(II) the date of commencement of the national stage under section 371 in an international application;

(ii) respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken;

(iii) act on an application within 4 months after the date of a decision by the Board of Patent Appeals and Interferences under section 134 or 135 or a decision by a Federal court under section 141, 145, or 146 in a case in which allowable claims remain in the application; or

(iv) issue a patent within 4 months after the date on which the issue fee was paid under section 151 and all outstanding requirements were satisfied,

the term of the patent shall be extended 1 day for each day after the end of the period specified in clause (i), (ii), (iii), or (iv), as the case may be, until the action described in such clause is taken.

(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application under section 111(a) in the United States or, in the case of an international application, the date of commencement of the national stage under section 371 in the international application not including—

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

(ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or

(iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C),

the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

(C) GUARANTEE OR ADJUSTMENTS FOR DELAYS DUE TO INTERFERENCES, SECRECY ORDERS, AND APPEALS.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to—

(i) a proceeding under section 135(a);

(ii) the imposition of an order under section 181; or

(iii) appellate review by the Board of Patent Appeals and Interferences or by a Federal court in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability,

the term of the patent shall be extended 1 day for each day of the pendency of the proceeding, order, or review, as the case may be.

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(Amended July 24, 1965, Public Law 89-83, sec. 5, 79 Stat. 261; Dec. 12, 1980, Public Law 96-517, sec. 4, 94 Stat. 3018; Aug. 23, 1988, Public Law 100-418, sec. 9002, 102 Stat. 1563; Dec. 8, 1994, Public Law 103-465, sec. 532 (a)(1), 108 Stat. 4983; Oct. 11, 1996, Public Law 104-295, sec. 20(e)(1), 110 Stat. 3529; subsection (b) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-557 (S. 1948 sec. 4402(a)); subsection (d) added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-564 (S. 1948 sec. 4504); subsection (b)(4) amended Nov. 2, 2002, Public Law 107-273, sec. 13206, 116 Stat. 1904; subsection (d)(4)(A) amended Nov. 2, 2002, Public Law 107-273, sec. 13204, 116 Stat. 1902; subsection (b)(4)(A) amended Sept. 16, 2011, Public Law 112-29, secs. 9 (effective Sept. 16, 2011) and 20(j) (effective Sept. 16, 2012), 125 Stat. 284.)

35 U.S.C. 155 [Repealed.]

(Repealed Sept. 16, 2011, Public Law 112-29, sec. 20(k) (effective Sept. 16, 2012), 125 Stat. 284.)

35 U.S.C. 155A [Repealed.]

(Repealed Sept. 16, 2011, Public Law 112-29, sec. 20(k) (effective Sept. 16, 2012), 125 Stat. 284.)

35 U.S.C. 156 Extension of patent term.

(a) The term of a patent which claims a product, a method of using a product, or a method of manufacturing a product shall be extended in accordance with this section from the original expiration date of the patent, which shall include any patent term adjustment granted under section 154(b) if —

(1) the term of the patent has not expired before an application is submitted under subsection (d)(1) for its extension;

(2) the term of the patent has never been extended under subsection (e)(1) of this section;

(3) an application for extension is submitted by the owner of record of the patent or its agent and in accordance with the requirements of paragraphs (1) through (4) of subsection (d);

(4) the product has been subject to a regulatory review period before its commercial marketing or use;

(5)(A) except as provided in subparagraph (B) or (C), the permission for the commercial marketing or use of the product after such regulatory review period is the first permitted commercial marketing or use of the product under the provision of law under which such regulatory review period occurred;

(B) in the case of a patent which claims a method of manufacturing the product which primarily uses recombinant DNA technology in the manufacture of the product, the permission for the commercial marketing or use of the product after such regulatory review period is the first permitted commercial marketing or use of a product manufactured under the process claimed in the patent; or

(C) for purposes of subparagraph (A), in the case of a patent which —

(i) claims a new animal drug or a veterinary biological product which (I) is not covered by the claims in any other patent which has been extended, and (II) has received permission for the commercial marketing or use in non-food-producing animals and in food-producing animals, and

(ii) was not extended on the basis of the regulatory review period for use in non-food-producing animals,

the permission for the commercial marketing or use of the drug or product after the regulatory review period for use in food-producing animals is the first permitted commercial marketing or use of the drug or product for administration to a food-producing animal.

The product referred to in paragraphs (4) and (5) is hereinafter in this section referred to as the "approved product."

(b) Except as provided in subsection (d)(5)(F), the rights derived from any patent the term of which is extended under this section shall during the period during which the term of the patent is extended —

(1) in the case of a patent which claims a product, be limited to any use approved for the product —

(A) before the expiration of the term of the patent —

(i) under the provision of law under which the applicable regulatory review occurred, or

(ii) under the provision of law under which any regulatory review described in paragraph (1), (4), or (5) of subsection (g) occurred, and

(B) on or after the expiration of the regulatory review period upon which the extension of the patent was based;

(2) in the case of a patent which claims a method of using a product, be limited to any use claimed by the patent and approved for the product —

(A) before the expiration of the term of the patent —

(i) under any provision of law under which an applicable regulatory review occurred, and

(ii) under the provision of law under which any regulatory review described in paragraph (1), (4), or (5) of subsection (g) occurred, and

(B) on or after the expiration of the regulatory review period upon which the extension of the patent was based; and

(3) in the case of a patent which claims a method of manufacturing a product, be limited to the method of manufacturing as used to make —

(A) the approved product, or

(B) the product if it has been subject to a regulatory review period described in paragraph (1), (4), or (5) of subsection (g).

As used in this subsection, the term "product" includes an approved product.

(c) The term of a patent eligible for extension under subsection (a) shall be extended by the time equal to the regulatory review period for the approved product which period occurs after the date the patent is issued, except that—

(1) each period of the regulatory review period shall be reduced by any period determined under subsection (d)(2)(B) during which the applicant for the patent extension did not act with due diligence during such period of the regulatory review period;

(2) after any reduction required by paragraph (1), the period of extension shall include only one-half of the time remaining in the periods described in paragraphs (1)(B)(i), (2)(B)(i), (3)(B)(i), (4)(B)(i), and (5)(B)(i) of subsection (g);

(3) if the period remaining in the term of a patent after the date of the approval of the approved product under the provision of law under which such regulatory review occurred when added to the regulatory review period as revised under paragraphs (1) and (2) exceeds fourteen years, the period of extension shall be reduced so that the total of both such periods does not exceed fourteen years, and

(4) in no event shall more than one patent be extended under subsection (e)(1) for the same regulatory review period for any product.

(d)(1) To obtain an extension of the term of a patent under this section, the owner of record of the patent or its agent shall submit an application to the Director. Except as provided in paragraph (5), such an application may only be submitted within the sixty-day period beginning on the date the product received permission under the provision of law under which the applicable regulatory review period occurred for commercial marketing or use, or in the case of a drug product described in subsection (i), within the sixty-day period beginning on the covered date (as defined in subsection (i)). The application shall contain—

(A) the identity of the approved product and the Federal statute under which regulatory review occurred;

(B) the identity of the patent for which an extension is being sought and the identity of each claim of such patent which claims the approved product or a method of using or manufacturing the approved product;

(C) information to enable the Director to determine under subsections (a) and (b) the eligibility of a patent for extension and the rights that will be derived from the extension and information to enable the Director and the Secretary of Health and Human Services or the Secretary of Agriculture to determine the period of the extension under subsection (g);

(D) a brief description of the activities undertaken by the applicant during the applicable regulatory review period with respect to the approved product and the significant dates applicable to such activities; and

(E) such patent or other information as the Director may require.

For purposes of determining the date on which a product receives permission under the second sentence of this paragraph, if such permission is transmitted after 4:30 P.M., Eastern Time, on a business day, or is transmitted on a day that is not a business day, the product shall be deemed to receive such permission on the next business day. For purposes of the preceding sentence, the term "business day" means any Monday, Tuesday, Wednesday, Thursday, or Friday, excluding any legal holiday under section 6103 of title 5.

(2)(A) Within 60 days of the submittal of an application for extension of the term of a patent under paragraph (1), the Director shall notify —

(i) the Secretary of Agriculture if the patent claims a drug product or a method of using or manufacturing a drug product and the drug product is subject to the Virus-Serum-Toxin Act, and

(ii) the Secretary of Health and Human Services if the patent claims any other drug product, a medical device, or a food additive or color additive or a method of using or manufacturing such a product, device, or additive and if the product, device, and additive are subject to the Federal Food, Drug and Cosmetic Act, of the extension application and shall submit to the Secretary who is so notified a copy of the application. Not later than 30 days after the receipt of an application from the Director, the Secretary receiving the application shall review the dates contained in the application pursuant to paragraph (1)(C) and determine the applicable regulatory review period, shall notify the Director of the determination, and shall publish in the Federal Register a notice of such determination.

(B)(i) If a petition is submitted to the Secretary making the determination under subparagraph (A), not later than 180 days after the publication of the determination under subparagraph (A), upon which it may reasonably be determined that the applicant did not act with due diligence during the applicable regulatory review period, the Secretary making the determination shall, in accordance with regulations promulgated by such Secretary, determine if the applicant acted with due diligence during the applicable regulatory review period. The Secretary making the determination shall make such determination not later than 90 days after the receipt of such a

petition. For a drug product, device, or additive subject to the Federal Food, Drug, and Cosmetic Act or the Public Health Service Act, the Secretary may not delegate the authority to make the determination prescribed by this clause to an office below the Office of the Director* of Food and Drugs. For a product subject to the Virus-Serum-Toxin Act, the Secretary of Agriculture may not delegate the authority to make the determination prescribed by this clause to an office below the Office of the Assistant Secretary for Marketing and Inspection Services.

(ii) The Secretary making a determination under clause (i) shall notify the Director of the determination and shall publish in the Federal Register a notice of such determination together with the factual and legal basis for such determination. Any interested person may request, within the 60-day period beginning on the publication of a determination, the Secretary making the determination to hold an informal hearing on the determination. If such a request is made within such period, such Secretary shall hold such hearing not later than 30 days after the date of the request, or at the request of the person making the request, not later than 60 days after such date. The Secretary who is holding the hearing shall provide notice of the hearing to the owner of the patent involved and to any interested person and provide the owner and any interested person an opportunity to participate in the hearing. Within 30 days after the completion of the hearing, such Secretary shall affirm or revise the determination which was the subject of the hearing and shall notify the Director of any revision of the determination and shall publish any such revision in the Federal Register.

(3) For the purposes of paragraph (2)(B), the term "due diligence" means that degree of attention, continuous directed effort, and timeliness as may reasonably be expected from, and are ordinarily exercised by, a person during a regulatory review period.

(4) An application for the extension of the term of a patent is subject to the disclosure requirements prescribed by the Director.

(5)(A) If the owner of record of the patent or its agent reasonably expects that the applicable regulatory review period described in paragraph (1)(B)(ii), (2)(B)(ii), (3)(B)(ii), (4)(B)(ii), or (5)(B)(ii) of subsection (g) that began for a product that is the subject of such patent may extend beyond the expiration of the patent term in effect, the owner or its agent may submit an application to the Director for an interim extension during the period beginning 6 months, and ending 15 days before such term is due to expire. The application shall contain—

(i) the identity of the product subject to regulatory review and the Federal statute under which such review is occurring;

(ii) the identity of the patent for which interim extension is being sought and the identity of each claim of such patent which claims the product under regulatory review or a method of using or manufacturing the product;

(iii) information to enable the Director to determine under subsection (a)(1), (2), and (3) the eligibility of a patent for extension;

(iv) a brief description of the activities undertaken by the applicant during the applicable regulatory review period to date with respect to the product under review and the significant dates applicable to such activities; and

(v) such patent or other information as the Director may require.

(B) If the Director determines that, except for permission to market or use the product commercially, the patent would be eligible for an extension of the patent term under this section, the Director shall publish in the Federal Register a notice of such determination, including the identity of the product under regulatory review, and shall issue to the applicant a certificate of interim extension for a period of not more than 1 year.

(C) The owner of record of a patent, or its agent, for which an interim extension has been granted under subparagraph (B), may apply for not more than 4 subsequent interim extensions under this paragraph, except that, in the case of a patent subject to subsection (g)(6)(C), the owner of record of the patent, or its agent, may apply for only 1 subsequent interim extension under this paragraph. Each such subsequent application shall be made during the period beginning 60 days before, and ending 30 days before, the expiration of the preceding interim extension.

(D) Each certificate of interim extension under this paragraph shall be recorded in the official file of the patent and shall be considered part of the original patent.

(E) Any interim extension granted under this paragraph shall terminate at the end of the 60-day period beginning on the date on which the product involved receives permission for commercial marketing or use, except that, if within that 60-day period, the applicant notifies the Director of such permission and submits any additional information under paragraph (1) of this subsection not previously contained in the application for interim extension, the patent shall be further extended, in accordance with the provisions of this section—

(i) for not to exceed 5 years from the date of expiration of the original patent term; or

(ii) if the patent is subject to subsection (g)(6)(C), from the date on which the product involved receives approval for commercial marketing or use.

(F) The rights derived from any patent the term of which is extended under this paragraph shall, during the period of interim extension—

(i) in the case of a patent which claims a product, be limited to any use then under regulatory review;

(ii) in the case of a patent which claims a method of using a product, be limited to any use claimed by the patent then under regulatory review; and

(iii) in the case of a patent which claims a method of manufacturing a product, be limited to the method of manufacturing as used to make the product then under regulatory review.

(e)(1) A determination that a patent is eligible for extension may be made by the Director solely on the basis of the representations contained in the application for the extension.

If the Director determines that a patent is eligible for extension under subsection (a) and that the requirements of paragraphs (1) through (4) of subsection (d) have been complied with, the Director shall issue to the applicant for the extension of the term of the patent a certificate of extension, under seal, for the period prescribed by subsection (c). Such certificate shall be recorded in the official file of the patent and shall be considered as part of the original patent.

(2) If the term of a patent for which an application has been submitted under subsection (d)(1) would expire before a certificate of extension is issued or denied under paragraph (1) respecting the application, the Director shall extend, until such determination is made, the term of the patent for periods of up to one year if he determines that the patent is eligible for extension.

(f) For purposes of this section:

(1) The term "product" means:

(A) A drug product.

(B) Any medical device, food additive, or color additive subject to regulation under the Federal Food, Drug, and Cosmetic Act.

(2) The term "drug product" means the active ingredient of—

(A) a new drug, antibiotic drug, or human biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Public Health Service Act), or

(B) a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Virus-Serum-Toxin Act) which is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques
including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient.

(3) The term "major health or environmental effects test" means a test which is reasonably related to the evaluation of the health or environmental effects of a product, which requires at least six months to conduct, and the data from which is submitted to receive permission for commercial marketing or use. Periods of analysis or evaluation of test results are not to be included in determining if the conduct of a test required at least six months.

(4)(A) Any reference to section 351 is a reference to section 351 of the Public Health Service Act.

(B) Any reference to section 503, 505, 512, or 515 is a reference to section 503, 505, 512, or 515 of the Federal Food, Drug and Cosmetic Act.

(C) Any reference to the Virus-Serum-Toxin Act is a reference to the Act of March 4, 1913 (21 U.S.C. 151 - 158).

(5) The term "informal hearing" has the meaning prescribed for such term by section 201(y) of the Federal Food, Drug and Cosmetic Act.

(6) The term "patent" means a patent issued by the United States Patent and Trademark Office.

(7) The term "date of enactment" as used in this section means September 24, 1984, for human drug product, a medical device, food additive, or color additive.

(8) The term "date of enactment" as used in this section means the date of enactment of the Generic Animal Drug and Patent Term Restoration Act for an animal drug or a veterinary biological product.

(g) For purposes of this section, the term "regulatory review period" has the following meanings:

(1)(A) In the case of a product which is a new drug, antibiotic drug, or human biological product, the term means the period described in subparagraph (B) to which the limitation described in paragraph (6) applies.

(B) The regulatory review period for a new drug, antibiotic drug, or human biological product is the sum of —

(i) the period beginning on the date an exemption under subsection (i) of section 505 or subsection (d) of section 507 became effective for the approved product and ending on the date an application was initially submitted for such drug product under section 351, 505, or 507, and

(ii) the period beginning on the date the application was initially submitted for the approved product under section 351, subsection (b) of section 505, or section 507 and ending on the date such application was approved under such section.

(2)(A) In the case of a product which is a food additive or color additive, the term means the period described in subparagraph (B) to which the limitation described in paragraph (6) applies.

(B) The regulatory review period for a food or color additive is the sum of —

(i) the period beginning on the date a major health or environmental effects test on the additive was initiated and ending on the date a petition was initially submitted with respect to the product under the Federal Food, Drug, and Cosmetic Act requesting the issuance of a regulation for use of the product, and

(ii) the period beginning on the date a petition was initially submitted with respect to the product under the Federal Food, Drug, and Cosmetic Act requesting the issuance of a regulation for use of the product, and ending on the date such regulation became effective or, if objections were filed to such regulation, ending on the date such objections were resolved and commercial marketing was permitted or, if commercial marketing was permitted and later revoked pending further proceedings as a result of such objections, ending on the date such proceedings were finally resolved and commercial marketing was permitted.

(3)(A) In the case of a product which is a medical device, the term means the period described in subparagraph (B) to which the limitation described in paragraph (6) applies.

(B) The regulatory review period for a medical device is the sum of —

(i) the period beginning on the date a clinical investigation on humans involving the device was begun and

ending on the date an application was initially submitted with respect to the device under section 515, and

(ii) the period beginning on the date an application was initially submitted with respect to the device under section 515 and ending on the date such application was approved under such Act or the period beginning on the date a notice of completion of a product development protocol was initially submitted under section 515(f)(5) and ending on the date the protocol was declared completed under section 515(f)(6).

(4)(A) In the case of a product which is a new animal drug, the term means the period described in subparagraph (B) to which the limitation described in paragraph (6) applies.

(B) The regulatory review period for a new animal drug product is the sum of —

(i) the period beginning on the earlier of the date a major health or environmental effects test on the drug was initiated or the date an exemption under subsection (j) of section 512 became effective for the approved new animal drug product and ending on the date an application was initially submitted for such animal drug product under section 512, and

(ii) the period beginning on the date the application was initially submitted for the approved animal drug product under subsection (b) of section 512 and ending on the date such application was approved under such section.

(5)(A) In the case of a product which is a veterinary biological product, the term means the period described in subparagraph (B) to which the limitation described in paragraph (6) applies.

(B) The regulatory period for a veterinary biological product is the sum of —

(i) the period beginning on the date the authority to prepare an experimental biological product under the Virus- Serum-Toxin Act became effective and ending on the date an application for a license was submitted under the Virus-Serum-Toxin Act, and

(ii) the period beginning on the date an application for a license was initially submitted for approval under the Virus-Serum-Toxin Act and ending on the date such license was issued.

(6) A period determined under any of the preceding paragraphs is subject to the following limitations:

(A) If the patent involved was issued after the date of the enactment of this section, the period of extension determined on the basis of the regulatory review period determined under any such paragraph may not exceed five years.

(B) If the patent involved was issued before the date of the enactment of this section and —

(i) no request for an exemption described in paragraph (1)(B) or (4)(B) was submitted and no request for the authority described in paragraph (5)(B) was submitted,

(ii) no major health or environmental effects test described in paragraph (2)(B) or (4)(B) was initiated and no petition for a regulation or application for registration described in such paragraph was submitted, or

(iii) no clinical investigation described in paragraph (3) was begun or product development protocol described in such paragraph was submitted, before such date for the approved product the period of extension determined on the basis of the regulatory review period determined under any such paragraph may not exceed five years.

(C) If the patent involved was issued before the date of the enactment of this section and if an action described in subparagraph (B) was taken before the date of the enactment of this section with respect to the approved product and the commercial marketing or use of the product has not been approved before such date, the period of extension determined on the basis of the regulatory review period determined under such paragraph may not exceed two years or in the case of an approved product which is a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act or the Virus-Serum-Toxin Act), three years.

(h) The Director may establish such fees as the Director determines appropriate to cover the costs to the Office of receiving and acting upon applications under this section.

(i)(1) For purposes of this section, if the Secretary of Health and Human Services provides notice to the sponsor of an application or request for approval, conditional approval, or indexing of a drug product for which the Secretary intends to recommend controls under the Controlled Substances Act, beginning on the covered date, the drug product shall be considered to—

(A) have been approved or indexed under the relevant provision of the Public Health Service Act or Federal Food, Drug, and Cosmetic Act; and

(B) have permission for commercial marketing or use.

(2) In this subsection, the term "covered date" means the later of—

(A) the date an application is approved—

(i) under section 351(a)(2)(C) of the Public Health Service Act; or

(ii) under section 505(b) or 512(c) of the Federal Food, Drug, and Cosmetic Act;

(B) the date an application is conditionally approved under section 571(b) of the Federal Food, Drug, and Cosmetic Act;

(C) the date a request for indexing is granted under section 572(d) of the Federal Food, Drug, and Cosmetic Act; or

(D) the date of issuance of the interim final rule controlling the drug under section 201(j) of the Controlled Substances Act.

(Added Sept. 24, 1984, Public Law 98-417, sec. 201(a), 98 Stat. 1598; amended Nov. 16, 1988, Public Law 100-670, sec. 201(a)-(h), 102 Stat. 3984; Dec. 3, 1993, Public Law 103-179, secs. 5, 6, 107 Stat. 2040, 2042; Dec. 8, 1994, Public Law

Appendix R

Appendix R Consolidated Patent Rules - August 2019 Update

Title 37 - Code of Federal Regulations
Patents, Trademarks, and Copyrights

[Editor Note: Current as of August 3, 2019. The Federal Register is the authoritative source and should be consulted if a need arises to verify the authenticity of the language reproduced below. This Consolidated Rules document incorporates the following rule revisions that became effective subsequent to the publication of MPEP Revision 08.2017 (which was updated as of August 2017):
(1) Rule on Attorney-Client Privilege for Trials Before the Patent Trial and Appeal Board, 82 FR 51570 (November 7, 2017);
(2) Setting and Adjusting Patent Fees During Fiscal Year 2017, 82 FR 52780 (November 14, 2017);
(3) Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 FR 51340 (October 11, 2018); and
(4) Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants, 84 FR 31498 (July 2, 2019).]

CHAPTER I — UNITED STATES PATENT AND TRADEMARK OFFICE, DEPARTMENT OF COMMERCE

SUBCHAPTER A — GENERAL

PATENTS

PART 1 — RULES OF PRACTICE IN PATENT CASES

General Provisions

GENERAL INFORMATION AND CORRESPONDENCE

Biotechnology Invention Disclosures

DEPOSIT OF BIOLOGICAL MATERIAL

APPLICATION DISCLOSURES CONTAINING NUCLEOTIDE AND/OR AMINO ACID SEQUENCES

Inter Partes Reexamination of Patents That Issued From an Original Application Filed in the United States on or After November 29, 1999

PRIOR ART CITATIONS

REQUIREMENTS FOR INTER PARTES REEXAMINATION PROCEEDINGS

INTER PARTES REEXAMINATION OF PATENTS

INFORMATION DISCLOSURE IN INTER PARTES REEXAMINATION

OFFICE ACTIONS AND RESPONSES (BEFORE THE EXAMINER) IN INTER PARTES REEXAMINATION

Subpart A — General Provisions

GENERAL INFORMATION AND CORRESPONDENCE

§ 1.1 Addresses for non-trademark correspondence with the United States Patent and Trademark Office.

(a) *In general.* Except as provided in paragraphs (a)(3)(i), (a)(3)(ii), and (d)(1) of this section, all correspondence intended for the United States Patent and Trademark Office must be addressed to either "Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450" or to specific areas within the Office as set out in paragraphs (a)(1), and (a)(3)(iii) of this section. When appropriate, correspondence should also be marked for the attention of a particular office or individual.

(1) *Patent correspondence.*

(i) *In general.* All correspondence concerning patent matters processed by organizations reporting to the Commissioner for Patents should be addressed to: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.

(ii) *Patent Trial and Appeal Board.* See § 41.10 or § 42.6 of this title. Notices of appeal, appeal briefs, reply briefs, requests for oral hearing, as well as all other correspondence in an application or a patent involved in an appeal to the Board for which an address is not otherwise specified, should be addressed as set out in paragraph (a)(1)(i) of this section.

(2) [Reserved]

(3) *Office of General Counsel correspondence.*—

(i) *Litigation and service.* Correspondence relating to pending litigation or

Success Act of 2018

Public Law 115–273
115th Congress

An Act

To direct the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, in consultation with the Administrator of the Small Business Administration, to study and provide recommendations to promote the participation of women, minorities, and veterans in entrepreneurship activities and the patent system, to extend by 8 years the Patent and Trademark Office's authority to set the amounts for the fees it charges, and for other purposes.

Oct. 31, 2018
[H.R. 6758]

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,

Study of Underrepresented Classes Chasing Engineering and Science Success Act of 2018.
15 USC 1 note.

SECTION 1. SHORT TITLE.

This Act may be cited as the "Study of Underrepresented Classes Chasing Engineering and Science Success Act of 2018" or the "SUCCESS Act".

SEC. 2. FINDINGS; SENSE OF CONGRESS.

(a) FINDINGS.—Congress finds the following:

(1) Patents and other forms of intellectual property are important engines of innovation, invention, and economic growth.

(2) Many innovative small businesses, which create over 20 percent of the total number of new jobs created in the United States each year, depend on patent protections to commercialize new technologies.

(3) Universities and their industry partners also rely on patent protections to transfer innovative new technologies from the laboratory or classroom to commercial use.

(4) Recent studies have shown that there is a significant gap in the number of patents applied for and obtained by women and minorities.

(b) SENSE OF CONGRESS.—It is the sense of Congress that the United States has the responsibility to work with the private sector to close the gap in the number of patents applied for and obtained by women and minorities to harness the maximum innovative potential and continue to promote United States leadership in the global economy.

SEC. 3. REPORT.

(a) STUDY.—The Director, in consultation with the Administrator and any other head of an appropriate agency, shall conduct a study that—

(1) identifies publicly available data on the number of patents annually applied for and obtained by, and the benefits of increasing the number of patents applied for and obtained

by women, minorities, and veterans and small businesses owned by women, minorities, and veterans; and

(2) provides legislative recommendations for how to—

(A) promote the participation of women, minorities, and veterans in entrepreneurship activities; and

(B) increase the number of women, minorities, and veterans who apply for and obtain patents.

(b) REPORT.—Not later than 1 year after the date of the enactment of this Act, the Director shall submit to the Committees on the Judiciary and Small Business of the House of Representatives and the Committees on the Judiciary and Small Business and Entrepreneurship of the Senate a report on the results of the study conducted under subsection (a).

SEC. 4. EXTENSION OF FEE-SETTING AUTHORITY.

Section 10(i)(2) of the Leahy-Smith America Invents Act (Public Law 112–29; 125 Stat. 319; 35 U.S.C. 41 note) is amended by striking "7-year" and inserting "15-year".

SEC. 5. DEFINITIONS.

In this Act:

(1) ADMINISTRATOR.—The term "Administrator" means the Administrator of the Small Business Administration.

(2) AGENCY.—The term "agency" means a department, agency, or instrumentality of the United States Government.

(3) DIRECTOR.—The term "Director" means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

Approved October 31, 2018.

LEGISLATIVE HISTORY—H.R. 6758:

HOUSE REPORTS: No. 115–966 (Comm. on the Judiciary).
CONGRESSIONAL RECORD, Vol. 164 (2018):
Sept. 25, considered and passed House.
Oct. 11, considered and passed Senate.
DAILY COMPILATION OF PRESIDENTIAL DOCUMENTS (2018):
Oct. 31, Presidential statement.

United States Patent And Trade Mark Office (USPTO) Resources

(/)

MENU LINKS SEARCH

Laws, regulations, policies, procedures, guidance and training

The following laws, regulations, policies, procedures, guidance and training apply to the patent process.

- Patent Rules, Consolidated (/web/offices/pac/mpep/consolidated_rules.pdf) [PDF]
- Patent Laws, Consolidated (/web/offices/pac/mpep/consolidated_laws.pdf) [PDF]
- Manual of Patent Examining Procedure (MPEP), Patent Procedures & related guides (/web/offices/pac/mpep/index.htm)
- Patent-Related Notices (/patent/laws-and-regulations/patent-related-notices/patent-related-notices-2016)
- Leahy-Smith America Invents Act Implementation (/patent/laws-and-regulations/leahy-smith-america-invents-act-implementation)
- Examination Guidance and Training Materials (/patent/laws-and-regulations/examination-policy/examination-guidance-and-training-materials)
  Materials related to 35 U.S.C. 101/112/103, America Invents Act, Patent Trial & Appeal Board, and Best Practices in Examination

Archival Materials:

- American Inventors Protection Act of 1999 (/patent/laws-and-regulations/american-inventors-protection-act-1999) (AIPA)
- Patent Business Goals - Final Rule (/patent/laws-and-regulations/patent-business-goals-final-rule-home-page) (PBG)(2000)
- 1997 Changes to Patent Practice and Procedure (/patents/law/exam/changes/1997/index.jsp)

NOTE: The information contained in Archival Materials was correct at the time of original publication. Some information may no longer be applicable. For example, amendments may have been made to the rules of practice since the original date of a publication, there may have been a change in any fees indicated, and certain references to publications may no longer be valid. Wherever there is a reference to a statute or rule, please check carefully whether the statute or rule in force at the date of publication of the advice has since been amended.

- Also see: How to Find Laws and Regulations (/patent/laws-and-regulations/how-find-laws-and-regulations).
- Learn more about Examination Policy (/patent/laws-and-regulations/patent-examination-policy).

Some contents linked to on this page require a plug-in for PDF (/using-usptogov/browser-plugins/plugins-pdf) and DOC (/using-usptogov/browser-plugins/plugins-word-processing-spreadsheets-and-presentations) files

Patents FAQs

(/)

MENU LINKS SEARCH

Patent FAQs

Search FAQs

Go

- General information concerning patents (/patents-getting-started/general-information-concerning-patents)
- Contact Patents (/patent/contact-patents)

Show all FAQs

Categories

Patent Help - Getting Started - Other

- How do I know if my invention is patentable?
- How do I apply for a patent?
- What is a patent?
- Who can apply for a patent?
- What can and cannot be patented?
- What is a patent?
- Will Licensing and Review assist me in determining whether or not a license is required in my specific instance?
-

I noticed that my application has been "REFERRED BY L&R FOR THIRD-LEVEL SECURITY REVIEW". What does that mean?

- How long should the THIRD-LEVEL SECURITY REVIEW take?
- Can applicant file a paper on an application under secrecy order if the paper does not disclose the subject invention, such as a change of correspondence address?
- I filed a petition for an expedited license under 37 CFR 5.13 for material not disclosed in any U.S. patent application and received the license. The document I filed was assigned a "P" control number. I subsequently filed a U.S. patent application disclo
- If a petition for expedited license is filed without a corresponding U.S. application, how much information should be submitted in the copy of the material required by 37 CFR 5.13? Will an invention summary suffice?
- When I receive a license, what does it cover?
- Can applicant file papers on an application under secrecy order via EFS-Web?
- Must an application for an invention made at least partially in the U.S. be filed in the U.S. prior to filing abroad?
- Does a foreign filing license from the USPTO apply to any country?
- Does a foreign filing license from the USPTO permit an applicant to send information abroad for the preparation of a patent application to be filed first in the US?
- I filed a provisional application and did not receive a foreign filing license. Six months have passed and having received no secrecy order, I foreign filed the application. I later filed the nonprovisional application and again did not receive a foreign
- Can a petition for an expedited license be filed via EFS-Web?

- What are the various options for filing a petition for expedited foreign filing license?
- How quickly can Licensing and Review process a petition for expedited license?
- Does an applicant have to file a petition for a license with a new patent application to obtain a foreign filing license?
- What is the role of Licensing and Review?
- What is a patent?

General - Patent Help - Getting Started - Other

- Do I have to come to Alexandria, Virginia to do a patent search?
- How do I conduct a patent assignment search?
- How do I obtain a complete file history of a patent?
- How do I check on the status of my pending patent application?

Fees & Payments - Fees – General Information - Patent Help - Getting Started - Other - Other

- How much does it cost to get a patent?

Patent Help - Popular Patent Application (EBC) Customer Questions - Other

- How do Misindexed Documents Get Corrected that Have Been Submitted through EFS-Web?
- How can the list of Attorney/ Agent listed for an application as having Power of Attorney be updated?
- How can the Digital Certificate (EPF) file be located on your system?
- How can duplicate/unwanted documents from my application be removed?

- How can Customer Number data be corrected?
- How can Applications be associated with a Customer Number?
- How can a Non-embedded Font error be fixed?
- How can a File Naming Convention Error be fixed?
- How can a Digital Certificate be created for new users?
- Where can Patent forms be located?
- When a document is indexed in EFS-Web what are the differences between Category and Document descriptions?
- What if the IFW tab is not available for application in PAIR?
- What if my Digital Certificate stops working?
- What if a Customer Number cannot be viewed in Private PAIR?
- How are Self Recovery Codes established for my Digital Certificate?
- What can be done if an Acknowledgement Receipt is not received?
- How does a customer become a registered e-filer and gain access to Private PAIR?
- How do you Pay Patent Application Fees?
- How do you manage a Digital Certificate (EPF) file on multiple computers or in multiple locations on the same computer?

Patent Help - Patent Business Goals - Other

- If an application is filed prior to September 8, 2000 with the small entity basic filing fee and an assertion that the applicant is a small

entity, but no small entity statement in compliance with former 37 CFR 1.27: (1) what must the applicant do to esta

- If an applicant elects to utilize optional paragraph numbering as per § 1.52(b)(6), would amendments to the specification (under §1.121) which add new paragraphs require a renumbering of all the paragraphs?

- If amendment by paragraph replacement is now required by the Office for amendments submitted during prosecution, how should I amend the specification in a reissue application at the time of filing?

- If a reissue application is filed which broadens the claims of the invention of the original patent as well as adds claims to a different invention, will the broadened claims of the original invention still be considered to be constructively elected under

- I tried to access the PTO form site to download a small entity form for a small business and have found out that the Office is no longer making any of the four small entity forms available. Must I apply for small entity status only by payment of the small

- I still have some questions regarding claiming small entity status. Who can I talk to?

- I noticed that the recently modified declaration forms (PTO/SB/01, PTO/SB/03 and PTO/SB/04) no longer have language to appoint an attorney or authorize an agent. How do I appoint a power of attorney or authorize an agent when filing my application?

- I noticed that the new declaration forms no longer have a box to claim domestic priority under 35 U.S.C. 119(e) and 120. Why was this deleted from the forms?

- How would the Office treat an amendment that is not in compliance with 37 CFR 1.121?

- How should I respond to the Notice to File Missing Parts of Application stating that I owe a large entity filing fee and a large entity surcharge when I submitted an unsigned small entity statement with no authorization to charge fees prior to the effecti

- How long may the abstract be?
- How do I amend claims which were previously amended prior to the change to 37 CFR 1.121?
- How can Microsoft Word® software be used in preparing "clean" and "marked-up" versions of an amendment in order to comply with revised 37 CFR 1.121?
- Can I merely make a request for transfer of drawings (from the patent file to the reissue application) to satisfy the drawing requirements for a reissue application?
- If an attorney represents an assignee of an invention of a patent application, what is the preferred way for that attorney to obtain his/her power of attorney and become of record as applicant's attorney to prosecute the case?
- If multiple reissue applications are filed, into which application should the original patent claims be placed, and how should the claims be numbered in each of the applications?
- Can an amendment after final that was not in compliance with 37 CFR 1.121 be a proper submission for a RCE that was filed with a fee?
- Is there a fee for submission of information by a third party?
- Is there a provision for entry of section headings (e.g., "SUMMARY OF THE INVENTION") under the revised § 1.121 practice?
- Under what conditions may the Commissioner issue a certificate of correction to correct a mistake in a patent incurred through the fault of the Office?
- What if I fail to amend my specification/claims according to the revised rule after March 1, 2001?
- What is the effective date for implementing the requirements for amendments by replacement paragraph/claims?

- Are there software products currently on the market which will automatically number paragraphs?

- What will happen if an application is filed with an abstract that has more than 150 words?

- An application was filed before September 8, 2000, which did not comply with former 1.27, but which does comply with amended 37 CFR 1.27. The small entity filing fee was paid on filing and the Office processed the application as a small entity after Septe

- Where the Office discovers a mistake or receives a submission of information or request for a certificate of correction from a third party, will the patentee be notified prior to the issuance of any certificate of correction?

- Where third parties submit information or a request for a certification of correction, will the Office correspond with the third parties about their submission or request?

- Why are all applications with drawings reviewed in the Office of Initial Patent Examination? Can applications which are not going to be published as part of the pre-grant publication process be reviewed later?

- Why were the small entity forms (PTO/SB/9-12) deleted from the website and how do I now claim small entity status?

- An application is filed before September 8, 2000, which did not comply with former rule 1.27, but which does comply with amended 37 CFR 1.27. The application contained a general authorization to charge fees. The large entity fees were charged by the Offic

- Will all mistakes incurred by the Office and identified by the patentee, the patentee's assignee, the Office, or a third party be corrected?

- Will papers containing a submission of information or request for a certificate of correction submitted by a third party be made record of and kept in the patent file?

- Although the Office no longer makes available the four small entity forms, can I still use them (as I have a blank electronic or paper copy) if I desire to do so?

- Would the Office treat an amendment with a certificate of mailing dated before 3/1/01 (the effective date of revised rule 37 CFR 1.121) as non-compliant if the amendment was submitted without meeting the requirements of revised § 1.121?

- 37 CFR 1.27(a)(2)(i) and (ii) set forth two requirements for qualifying for small entity status as a small business. The first relates to the lack of transfer of rights to a large entity, and the second relates to qualification as to the standards set for

Patent Help - Ombudsman Program - Basics

- Why should I contact the examiner and the SPE first?

- Will the Ombudsman keep my complaints confidential?

Patent Help - Peer review prior art pilot - Other

- How do I opt out - exit from the pilot program after I join in (both before and after prosecution begins)?

- Does the Peer-to-Patent organization or Applicant file the submission with the USPTO?

- I want to participate in the pilot. How do I file a request for early Pre-Grant Publication for an application previously filed or filed during the pilot period?

- Should foreign references be accompanied with full English translation?

- Do I have to send the USPTO an email notification of the filing of the consent?

- Will my application be advanced out of turn?

- How long after Pre-Grant Publication does the Peer-to-Patent website have to file a submission?

- Does the submission have to be served upon applicant as in a Rule 1.99 submission?

- What if an application is accepted in the program and a submission comes in from someone other than the Peer-to-Patent organization?

- What happens after the submission of the prior art to the USPTO?

- What effect/impact will the pilot program have on applications/applicants that chose not to participate in the pilot program?

- How are reviewers/members of the public chosen to participate in the pilot program (requirements, pre-requisites, etc.)?

Patent Help - Certificate of Correction - Other

- How can I get erroneous assignee information appearing on my printed patent corrected?

- I filed a Certificate of Correction, but my correspondence address and/or Power of Attorney has changed since the request. What should I do?

- I have a trademark, how do I file a Certificate of Correction?

- Who should I speak to about requesting a Certificate of Correction form?

- A Certificate of Correction issued to correct an error in my patent. However, the correction has not been made to the patent appearing on the USPTO Web site. Who should I contact to correct an error appearing in a patent on the USPTO Website?

- How do I get my request for a Certificate of Correction expedited?

- My issue notification is incorrect (e.g., an inventor's name, address, title of invention), what should I do

- What do I need to file to request an error appearing in printed patent be corrected?
- Who do I contact regarding the status of my request for a Certificate of Correction?
- What should I do if I disagree or have a question in regards to the notification letter (or denial letter) that I received from the Certificates of Correction Branch

Patent Help - eOffice Action - Other

- How do I gain access to Private PAIR?
- How do I associate my existing patent applications to my Customer Number?
- If I am participating in the initial Pilot Program for e-Office Action, will I need to sign up again when the program is made available to everyone?
- If I utilize an e-mail spam filter, what configuration setting must be performed to allow the e-mail notification?
- Which business units in the USPTO do not participate in the e-Office Action program?
- Can I view an e-mail history of e-mail notifications?
- What should I do if I do not get notified or get notified late via an e-Office Action e-mail notification?
- What happens if I forget to view my Office communication?
- How many e-mail addresses can I associate to e-Office Action?
- Which USPTO business units participate in the e-Office Action program?
-

General Information Concerning Patents

General information concerning patents

UNITED STATES PATENT AND TRADEMARK OFFICE

October 2015

ALEXANDRIA, VIRGINIA

- Patent Marking and Patent Pending
- Design Patents
- Plant Patents
- Treaties and Foreign Patents
- Foreign Applicants for U.S. Patents

Functions of the United States Patent and Trademark Office

The United States Patent and Trademark Office (USPTO or Office) is an agency of the U.S. Department of Commerce. The role of the USPTO is to grant patents for the protection of inventions and to register trademarks. It serves the interests of inventors and businesses with respect to their inventions and corporate products, and service identifications. It also advises and assists the President of the United States, the Secretary of Commerce, the bureaus and offices of the Department of Commerce, and other agencies of the government in matters involving all domestic and global aspects of "intellectual property." Through the preservation, classification, and dissemination of patent information, the Office promotes the industrial and technological progress of the nation and strengthens the economy.

In discharging its patent related duties, the USPTO examines applications and grants patents on inventions when applicants are entitled to them; it publishes and disseminates patent information, records assignments of patents, maintains search files of U.S. and foreign patents, and maintains a search room for public use in examining issued patents and records. The Office supplies copies of patents and official records to the public. It provides training to practitioners as to requirements of the patent statutes and regulations, and it publishes the Manual of Patent Examining Procedure to elucidate these. Similar functions are performed relating to trademarks. By protecting intellectual endeavors and encouraging technological progress, the USPTO seeks to preserve the United States' technological edge, which is key to our current and future competitiveness. The USPTO also disseminates patent and trademark information that promotes an understanding of intellectual property protection and facilitates the development and sharing of new technologies worldwide.

What Are Patents, Trademarks, Servicemarks, and Copyrights?

Some people confuse patents, copyrights, and trademarks. Although there may be some similarities among these kinds of intellectual property protection, they are different and serve different purposes.

What is a Patent?

A patent for an invention is the grant of a property right to the inventor, issued by the United States Patent and Trademark Office. Generally, the term of a new patent is 20 years from the date on which the application for the patent was filed in the United States or, in special cases, from the date an earlier related application was filed, subject to the payment of maintenance fees. U.S. patent grants are effective only within the United States, U.S. territories, and U.S. possessions. Under certain circumstances, patent term extensions or adjustments may be available.

The right conferred by the patent grant is, in the language of the statute and of the grant itself, "the right to exclude others from making, using, offering for sale, or selling" the invention in the United States or "importing" the invention into the United States. What is granted is not the right to make, use, offer for sale, sell or import, but the right to exclude others from making, using, offering for sale, selling or importing the invention. Once a patent is issued, the patentee must enforce the patent without aid of the USPTO.

There are three types of patents:

1) **Utility patents** may be granted to anyone who invents or discovers any new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof;
2) **Design patents** may be granted to anyone who invents a new, original, and ornamental design for an article of manufacture; and
3) **Plant patents** may be granted to anyone who invents or discovers and asexually reproduces any distinct and new variety of plant.

What Is a Trademark or Servicemark?

A trademark is a word, name, symbol, or device that is used in trade with goods to indicate the source of the goods and to distinguish them from the goods of others. A servicemark is the same as a trademark except that it identifies and distinguishes the source of a service rather than a product. The terms "trademark" and "mark" are commonly used to refer to both trademarks and servicemarks.

Trademark rights may be used to prevent others from using a confusingly similar mark, but not to prevent others from making the same goods or from selling the same goods or services under a clearly different mark. Trademarks that are used in interstate or foreign commerce may be registered with the USPTO. The registration procedure for trademarks and general information concerning trademarks can be found in the separate book entitled "Basic Facts about Trademarks." (http://www.uspto.gov/trademarks/basics/Basic_Facts_Trademarks.jsp (http://www.uspto.gov/trademarks/basics/Basic_Facts_Trademarks.jsp)).

What is a Copyright?

Copyright is a form of protection provided to the authors of "original works of authorship" including literary, dramatic, musical, artistic, and certain other intellectual works, both published and unpublished. The 1976 Copyright Act generally gives the owner of copyright the exclusive right to reproduce the copyrighted work, to prepare derivative works, to distribute copies or phonorecords of the copyrighted work, to perform the copyrighted work publicly, or to display the copyrighted work publicly.

The copyright protects the form of expression rather than the subject matter of the writing. For example, a description of a machine could be copyrighted, but this would only prevent others from copying the description; it would not prevent others from writing a description of their own or from making and using the machine. Copyrights are registered by the Copyright Office of the Library of Congress.

Patent Laws

The Constitution of the United States gives Congress the power to enact laws relating to patents, in Article I, section 8, which reads "Congress shall have power . . . to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." Under this power Congress has from time to time enacted various laws relating to patents. The first patent law was enacted in 1790. The patent laws underwent a general revision which was enacted July 19, 1952, and which came into effect January 1, 1953. It is codified in Title 35, United States Code. Additionally, on November 29, 1999, Congress enacted the American Inventors Protection Act of 1999 (AIPA), which further revised the patent laws. See Public Law 106-113, 113 Stat. 1501 (1999).

The patent law specifies the subject matter for which a patent may be obtained and the conditions for patentability. The law establishes the United States Patent and Trademark Office to administer the law relating to the granting of patents and contains various other provisions relating to patents.

What Can Be Patented

The patent law specifies the general field of subject matter that can be patented and the conditions under which a patent may be obtained.

In the language of the statute, any person who "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," subject to the conditions and requirements of the law. The word "process" is defined by law as a process, act, or method, and primarily includes industrial or technical processes. The term "machine" used in the statute needs no explanation. The term "manufacture" refers to articles that are made, and includes all manufactured articles. The term "composition of matter" relates to chemical compositions and may include mixtures of ingredients as well as new chemical compounds. These classes of subject matter taken together include practically everything that is made by man and the processes for making the products.

The Atomic Energy Act of 1954 excludes the patenting of inventions useful solely in the utilization of special nuclear material or atomic energy in an atomic weapon. See 42 U.S.C. 2181(a).

The patent law specifies that the subject matter must be "useful." The term "useful" in this connection refers to the condition that the subject matter has a useful purpose and also includes operativeness, that is, a machine which will not operate to perform the intended purpose would not be called useful, and therefore would not be granted a patent.

Interpretations of the statute by the courts have defined the limits of the field of subject matter that can be patented, thus it has been held that the laws of nature, physical phenomena, and abstract ideas are not patentable subject matter.

A patent cannot be obtained upon a mere idea or suggestion. The patent is granted upon the new machine, manufacture, etc., as has been said, and not upon the idea or suggestion of the new machine. A complete description of the actual machine or other subject matter for which a patent is sought is required.

Novelty And Non-Obviousness, Conditions For Obtaining A Patent

In order for an invention to be patentable it must be new as defined in the patent law, which provides that an invention cannot be patented if:

> "(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention" or
>
> "(2) the claimed invention was described in a patent issued [by the U.S.] or in an application for patent published or deemed published [by the U.S.], in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention."

There are certain limited patent law exceptions to patent prohibitions (1) and (2) above. Notably, an exception may apply to a "disclosure made 1 year or less before the effective filing date of the claimed invention," but only if "the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed... from the inventor or a joint inventor."

In patent prohibition (1), the term "otherwise available to the public" refers to other types of disclosures of the claimed invention such as, for example, an oral presentation at a scientific meeting, a demonstration at a trade show, a lecture or speech, a statement made on a radio talk show, a YouTube™ video, or a website or other on-line material.

Effective filing date of the claimed invention: This term appears in patent prohibitions (1) and (2). For a U.S. nonprovisional patent application that is the first application containing the claimed subject matter, the term "effective filing date of the claimed invention" means the actual filing date of the U.S. nonprovisional patent application. For a U.S. nonprovisional application that claims the benefit of a corresponding prior-filed U.S. provisional application, "effective filing date of the claimed invention" can be the filing date of the prior-filed provisional application provided the provisional application sufficiently describes the claimed invention. Similarly, for a U.S. nonprovisional application that is a continuation or division of a prior-filed U.S. nonprovisional application, "effective filing date of the claimed invention" can be the filing date of the prior filed nonprovisional application that sufficiently describes the claimed invention. Finally, "effective filing date of the claimed invention" may be the filing date of a prior-filed foreign patent application to which foreign priority is claimed provided the foreign patent application sufficiently describes the claimed invention.

Even if the subject matter sought to be patented is not exactly shown by the prior art, and involves one or more differences over the most nearly similar thing already known, a patent may still be refused if the differences would be obvious. The subject matter sought to be patented must be sufficiently different from what has been used or described before that it may be said to be non-obvious to a person having ordinary skill in the area of technology related to the invention. For example, the substitution of one color for another, or changes in size, are ordinarily not patentable.

The United States Patent and Trademark Office

Congress established the United States Patent and Trademark Office to issue patents on behalf of the government. The Patent Office as a distinct bureau dates from the year 1802 when a separate official in the Department of State, who became known as "Superintendent of Patents," was placed in charge of patents. The revision of the patent laws enacted in 1836 reorganized the Patent Office and designated the official in charge as Commissioner of Patents. The Patent Office remained in the Department of State until 1849 when it was transferred to the Department of Interior. In 1925 it was transferred to the Department of Commerce where it is today. The name of the Patent Office was changed to the Patent and Trademark Office in 1975 and changed to the United States Patent and Trademark Office in 2000.

The USPTO administers the patent laws as they relate to the granting of patents for inventions, and performs other duties relating to patents. Applications for patents are examined to determine if the applicants are entitled to patents under the law and patents are granted when applicants are so entitled. The USPTO publishes issued patents and most patent applications 18 months from the earliest effective application filing date, and makes various other publications concerning patents. The USPTO also records assignments of patents, maintains a search room for the use of the public to examine issued patents and records, and supplies copies of records and other papers, and the like. Similar functions are performed with respect to the registration of trademarks. The USPTO has no jurisdiction over questions of infringement and the enforcement of patents.

The head of the Office is the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (Director). The Director's staff includes the Deputy Under Secretary of Commerce and Deputy Director of the USPTO, the Commissioner for Patents, the Commissioner for Trademarks, and other officials. As head of the Office, the Director superintends or performs all duties respecting the granting and issuing of patents and the registration of trademarks; exercises general supervision over the entire work of the USPTO; prescribes the rules, subject to the approval of the Secretary of Commerce, for the conduct of proceedings in the USPTO, and for recognition of attorneys and agents; decides various questions brought before the Office by petition as prescribed by the rules; and performs other duties necessary and required for the administration of the United States Patent and Trademark Office.

The work of examining applications for patents is divided among a number of examining technology centers (TCs), each TC having jurisdiction over certain assigned fields of technology. Each TC is headed by group directors and staffed by examiners and support staff. The examiners review applications for patents and determine whether patents can be granted. An appeal can be taken to the Patent Trial and Appeal Board from their decisions refusing to grant a patent, and a review by the Director of the USPTO may be had on other matters by petition. In addition to the examining TCs, other offices perform various services, such as receiving and distributing mail, receiving new applications, handling sales of printed copies of patents, making copies of records, inspecting drawings, and recording assignments.

At present, the USPTO has over 11,000 employees, of whom about three quarters are examiners and others with technical and legal training. Patent applications are received at the rate of over 500,000 per year.

Effective November 15, 2011, any regular nonprovisional utility application filed by mail or hand-delivery will require payment of an additional $400 fee called the "non-electronic filing fee," which is reduced by 50 percent (to $200) for applicants that qualify for small entity status under 37 CFR 1.27(a). The 75 percent micro entity discount does not apply to the non-electronic filing fee and consequently the non-electronic filing fee is also $200 for applicants that qualify for micro entity status under 37 CFR 1.29(a) or (d). This fee is required by Section 10(h) of the Leahy-Smith America Invents Act, Public Law 112-29 (Sept. 16, 2011; 125 Stat. 284). The only way to avoid having to pay the additional $400 non-electronic filing fee is to file the regular nonprovisional utility patent application via EFS-Web.Design, plant, and provisional applications are not subject to the additional non-electronic filing fee and may continue to be filed by mail or hand-delivery without additional charge. See the information available at www.uspto.gov/patents/process/file/efs/index/jsp (http://www.uspto.gov/patents/process/file/efs/index/jsp). Any questions regarding filing applications via EFS-Web should be directed to the **Electronic Business Center at 866-217-9197**.

General Information and Correspondence

All business with the United States Patent and Trademark Office should be transacted in writing. Regular nonprovisional utility applications must be filed via EFS-Web in order to avoid the additional $400 non-electronic filing fee.

Other patent correspondence, including design, plant, and provisional application filings, as well as correspondence filed in a nonprovisional application after the application filing date (known as "follow-on" correspondence), can still be filed by mail or hand-delivery without incurring the $400 non-electronic filing fee.

Such other correspondence relating to patent matters should be addressed to

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

when sent by mail via the United States Postal Service. If a mail stop is appropriate, the mail stop should also be used.

Mail addressed to different mail stops should be mailed separately to ensure proper routing. For example, after final correspondence should be mailed to

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

and assignments should be mailed to

Mail Stop Assignment Recordation Services
Director of the U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Correspondents should be sure to include their full return addresses, including zip codes. The principal location of the USPTO is 600 Dulany Street, Alexandria, Virginia. The personal presence of applicants at the USPTO is unnecessary.

You do not have to be a Registered eFiler to file a patent application via EFS-Web. However, unless you are a Registered eFiler, you must not attempt to file follow-on correspondence via EFS-Web, because Unregistered eFilers are not permitted to file follow-on correspondence via EFS-Web. Follow-on correspondence filed by anyone other than an EFS-Web Registered eFiler must be sent by mail or hand-delivered to the address specified in the paragraph above.

Applicants and attorneys are required to conduct their business with decorum and courtesy. Papers presented in violation of this requirement will be returned.

Separate letters (but not necessarily in separate envelopes) should be written for each distinct subject of inquiry, such as assignments, payments, orders for printed copies of patents, orders for copies of records, and requests for other services. None of these inquiries should be included with letters responding to Office actions in applications.

When a letter concerns a patent application, the correspondent must include the application number (consisting of the series code and the serial number, e.g., 12/123,456) or the serial number and filing date assigned to that application by the Office, or the international application number of the international application number of the international application. When a letter concerns a patent (other than for purposes of payment of a maintenance fee), it should include the name of the patentee, the title of the invention, the patent number, and the date of issue.

An order for a copy of an assignment should identify the reel and frame number where the assignment document is recorded; otherwise, an additional charge is made for the time consumed in making the search for the assignment.

Applications for patents, which are not published or issued as patents, are not generally open to the public, and no information concerning them is released except on written authority of the applicant, his or her assignee, or his or her attorney, or when necessary to the conduct of the business of the USPTO. Patent application publications and patents and related records, including records of any decisions, the records of assignments other than those relating to assignments of unpublished patent applications, patent applications that are relied upon for priority in a patent application publication or patent, books, and other records and papers in the Office are open to the public. They may be inspected in the USPTO Search Room, or copies may be ordered.

The Office cannot respond to inquiries concerning the novelty and patentability of an invention prior to the filing of an application; give advice as to possible infringement of a patent; advise of the propriety of filing an application; respond to inquiries as to whether, or to whom, any alleged invention has been patented; act as an expounder of the patent law or as counselor for individuals, except in deciding questions arising before it in regularly filed cases. Information of a general nature may be furnished either directly or by supplying or calling attention to an appropriate publication.

Scientific and Technical Information Center, Public Search Facility, and Patent and Trademark Resource Centers

The Scientific and Technical Information Center of the United States Patent and Trademark Office located at 1D58 Remsen, 400 Dulany Street, Alexandria, Va., has available for public use over 120,000 volumes of scientific and technical books in various languages, about 90,000 bound volumes of periodicals devoted to science and technology, the official journals of 77 foreign patent organizations, and over 40 million foreign patents on paper, microfilm, microfiche, and CD-ROM.

The Scientific and Technical Information Center is open to the public from 8 a.m. to 5 p.m., Monday through Friday except federal holidays.

The Public Search Facility located at Madison East, First Floor, 600 Dulany Street, Alexandria, Va., is where the public may search and examine U.S. patents granted since 1790 using state of the art computer workstations. A numerical sequence patent backfile from 1790 to 2000 is available on microfilm. Patents from 2000 forward may be found using a variety of the patent database available on workstations. Official Gazettes, Annual Indexes (of inventors), the Manual of Classification and its subject matter index, and other search aids are available in various formats. Patent assignment records of transactions affecting the ownership of patents, microfilmed deeds, and indexes are also available.

The Public Search Facility is open from 8 a.m. to 8 p.m. Monday through Friday except on federal holidays. Research assistance is offered between the hours of 8 a.m. and 5 p.m. Monday through Friday. Self-service access is permitted between 5 p.m. and 8 p.m.

Many inventors attempt to make their own search of the prior patents and publications before applying for a patent. This may be done in the Public Search Facility of the USPTO, and in libraries located throughout the United States that have been designated as Patent and Trademark Resource Centers (PTRCs). An inventor may make a preliminary search through the U.S. patents and publications to discover if the particular invention or one similar to it has been shown in the prior patent. An inventor may also employ patent attorneys or agents to

perform the preliminary search. This search may not be as complete as that made by the USPTO during the examination of an application, but only serves, as its name indicates, a preliminary purpose. For this reason, the patent examiner may, and often does, reject claims in an application on the basis of prior patents or publications not found in the preliminary search.

Those who cannot come to the Public Search Facility may order from the USPTO copies of lists of original patents or of cross-referenced patents contained in the subclasses comprising the field of search, or may inspect and obtain copies of the patents at a Patent and Trademark Resource Center. The PTRCs receive current issues of U.S. patents and maintain collections of earlier issued patent and trademark information. The scope of these collections varies from library to library, ranging from patents of only recent years to all or most of the patents issued since 1790.

These patent collections are open to public use. Each of the PTRCs, in addition, offers the publications of the U.S. Patent Classification System (e.g., Manual of Classification, Index to the U.S. Patent Classification System, Classification Definitions, etc.) and other patent documents and forms, and provides technical staff assistance in their use to aid the public in gaining effective access to information contained in patents. The collections are organized in patent number sequence.

Available in all PTRCs is the Cassis CD-ROM system. With various files, it permits the effective identification of appropriate classifications to search, provides numbers of patents assigned to a classification to facilitate finding the patents in a numerical file of patents, provides the current classification(s) of all patents, permits word searching on classification titles, and on abstracts, and provides certain bibliographic information on more recently issued patents. These libraries also provide access to the USPTO website.

Facilities for making paper copies from microfilm, the paper bound volumes or CD-ROM are generally provided for a fee.

Due to variations in the scope of patent collections among the PTRCs and in their hours of service to the public, anyone contemplating the use of the patents at a particular library is advised to contact that library, in advance, about its collection, services, and hours, so as to avert possible inconvenience. For a complete list of PTRCs, refer to the USPTO website at www.uspto.gov/products/library/ptdl/index.jsp (http://www.uspto.gov/products/library/ptdl/index.jsp).

Attorneys and Agents

The preparation of an application for patent and the conducting of the proceedings in the United States Patent and Trademark Office to obtain the patent is an undertaking requiring the knowledge of patent law and rules and Office practice and procedures, as well as knowledge of the scientific or technical matters involved in the particular invention.

Inventors may prepare their own applications and file them in the USPTO and conduct the proceedings themselves, but unless they are familiar with these matters or study them in detail, they may get into considerable difficulty. While a patent may be obtained in many cases by persons not skilled in this work, there would be no assurance that the patent obtained would adequately protect the particular invention.

Most inventors employ the services of registered patent attorneys or patent agents. The law gives the USPTO the power to make rules and regulations governing conduct and the recognition of patent attorneys and agents to practice before the USPTO. Persons who are not recognized by the USPTO for this practice are not permitted

by law to represent inventors before the USPTO. The USPTO maintains a register of attorneys and agents. To be admitted to this register, a person must comply with the regulations prescribed by the Office, which require a showing that the person is of good moral character and of good repute and that he or she has the legal, scientific, and technical qualifications necessary to render applicants for patents a valuable service. Certain of these qualifications must be demonstrated by the passing of an examination. Those admitted to the examination must have a college degree in engineering or physical science or the equivalent of such a degree.

The USPTO registers both attorneys at law and persons who are not attorneys at law. The former persons are now referred to as "patent attorneys," and the latter persons are referred to as "patent agents." Both patent attorneys and patent agents are permitted to prepare an application for a patent and conduct the prosecution in the USPTO. Patent agents, however, cannot conduct patent litigation in the courts or perform various services that the local jurisdiction considers as practicing law. For example, a patent agent could not draw up a contract relating to a patent, such as an assignment or a license, if the state in which he or she resides considers drafting contracts as practicing law.

Some individuals and organizations that are not registered advertise their services in the fields of patent searching and invention marketing and development. Such individuals and organizations cannot represent inventors before the USPTO. They are not subject to USPTO discipline, but the USPTO does provide a public forum (www.uspto.gov/web/offices/com/iip/complaints.htm (http://www.uspto.gov/inventors/scam_prevention/complaints/index.jsp)) where complaints and responses concerning invention promoters/promotion firms are published.

The USPTO cannot recommend any particular attorney or agent, or aid in the selection of an attorney or agent, as by stating, in response to inquiry that a named patent attorney, agent, or firm, is "reliable" or "capable." The USPTO maintains a directory of registered patent attorneys and agents at **https://oedci.uspto.gov/OEDCI/** (https://oedci.uspto.gov/OEDCI/).

The telephone directories of most large cities have, in the classified section, a heading for patent attorneys under which those in that area are listed. Many large cities have associations of patent attorneys.

In employing a patent attorney or agent, the inventor executes a power of attorney, which is filed in the USPTO and made of record in the application file. When a registered attorney or agent has been appointed, the Office does not communicate with the inventor directly but conducts the correspondence with the attorney or agent since he or she is acting for the inventor thereafter although the inventor is free to contact the USPTO concerning the status of his or her application. The inventor may remove the attorney or agent by revoking the power of attorney.

The USPTO has the power to disbar, or suspend from practicing before it, persons guilty of gross misconduct, etc., but this can only be done after a full hearing with the presentation of clear and convincing evidence concerning the misconduct. The USPTO will receive and, in appropriate cases, act upon complaints against attorneys and agents. The fees charged to inventors by patent attorneys and agents for their professional services are not subject to regulation by the USPTO. Definite evidence of overcharging may afford basis for USPTO action, but the Office rarely intervenes in disputes concerning fees.

Who May Apply For A Patent

According to the law, the inventor, or a person to whom the inventor has assigned or is under an obligation to assign the invention, may apply for a patent, with certain exceptions. If the inventor is deceased, the application may be made by legal representatives, that is, the administrator or executor of the estate. If the inventor is legally incapacitated, the application for patent may be made by a legal representative (e.g., guardian). If an inventor refuses to apply for a patent or cannot be found, a joint inventor may apply on behalf of the non-signing inventor.

If two or more persons make an invention jointly, they apply for a patent as joint inventors. A person who makes only a financial contribution is not a joint inventor and cannot be joined in the application as an inventor. It is possible to correct an innocent mistake in erroneously omitting an inventor or in erroneously naming a person as an inventor.

Officers and employees of the United States Patent and Trademark Office are prohibited by law from applying for a patent or acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in any patent.

Independent Inventor Resources

A section of the USPTO's website, found at www.uspto.gov/inventors (http://www.uspto.gov/inventors), is devoted to independent inventors (the site is titled "Inventors Resources") and offers a broad range of material covering most aspects of the patent and trademark process. The website also endeavors to educate independent inventors about fraudulent invention development and marketing firms and the scams that may affect these inventors and offers tips and warning signs on avoiding these scams. The site also publishes complaints against these firms and any responses received from them. The site further provides links to other USPTO sites, as well as links to other federal agencies.

> Mail for the Inventor's Assistance Program, including complaints about invention promoters, should be addressed to:
>
> **Mail Stop 24**
> **Director of the U.S. Patent and Trademark Office**
> **PO Box 1450**
> **Alexandria, VA 22313- 1450**
> **Email:** independentinventor@uspto.gov (http://mailto:independentinventor@uspto.gov)

The Inventors Assistance Center (IAC) provides the primary point of contact to the independent inventor community and the general public for general information about filing a provisional patent application, or a regular, nonprovisional patent application.

For additional information on the patent process, telephone the Inventors Assistance Center at:

> **Telephone 1-800-PTO-9199**
> **TTY: 571-272-9950**
> **USPTO's home page is** www.uspto.gov (http://www.uspto.gov)

Inventors also have the option of filing a Provisional Application for Patent. Provisional applications are described in more detail below. To receive more information on provisional applications, please visit the USPTO website or request a print brochure by calling 800-786-9199 or 571-272-1000.

Application For Patent

Nonprovisional Application for a Patent

A nonprovisional application for a patent is made to the Director of the United States Patent and Trademark Office and includes:

(1) A written document which comprises a specification (description and claims);

(2) Drawings (when necessary);

(3) An oath or declaration; and

(4) Filing, search, and examination fees. Fees for filing, searching, examining, issuing, appealing, and maintaining patent applications and patents are reduced by 50 percent for any small entity that qualifies for reduced fees under 37 CFR 1.27(a), and are reduced by 75 percent for any micro entity that files a certification that the requirements under 37 CFR 1.29(a) or (d) are met.

- Small Entity Status: Applicant must determine that small entity status under 37 CFR 1.27(a) is appropriate before making an assertion of entitlement to small entity status and paying a fee at the 50 percent small entity discount. Fees change each October. Note that by filing electronically via EFS-Web, the filing fee for an applicant qualifying for small entity status is further reduced.
- Micro Entity Status: Applicant must determine that micro entity status under 37 CFR 1.29(a) or (d) is appropriate before filing the required certification of micro entity status and paying a fee at the 75 percent micro entity discount. The patent forms Web page is indexed under the section titled Forms, Patents on the USPTO website at www.uspto.gov (http://www.uspto.gov). There are two micro entity certification forms – namely form PTO/SB/15A for certifying micro entity status on the "gross income basis" under 37 CFR 1.29(a), and form PTO/SB/15B for certifying micro entity status on the "institution of higher education basis" under 37 CFR 1.29(d). Effective November 15, 2011, any regular nonprovisional utility application filed by mail or hand-delivery will require payment of an additional $400 fee called the "non-electronic filing fee," which is reduced by 50 percent (to $200) for applicants that qualify for small entity status under 37 CFR 1.27(a) or micro entity status under 37 CFR 1.29(a) or (d). The only way to avoid having to pay the additional $400 non-electronic filing fee is by filing the regular nonprovisional utility application via EFS-Web.

Other patent correspondence, including design, plant, and provisional application filings, as well as correspondence filed in a nonprovisional application after the application filing date (known as "follow-on" correspondence), can still be filed by mail or hand-delivery without incurring the $400 non-electronic filing fee. You do not have to be a Registered eFiler to file a patent application via EFS-Web. However, unless you are a Registered eFiler, you must not attempt to file follow-on correspondence via EFS-Web, because Unregistered eFilers are not permitted to file follow-on correspondence via EFS-Web. Follow-on correspondence filed by anyone other than an EFS-Web Registered eFiler must be sent by mail or be hand-delivered. (See the "General Information and Correspondence" section of this brochure.) In the event you receive from the USPTO a "Notice of Incomplete Application" in response to your EFS-Web filing stating that an application number has been assigned but no filing date has been granted, you must become a Registered eFiler and file your reply to the "Notice of Incomplete Application" via EFS-Web in order to avoid the $400 non-electronic filing fee. To become a Registered eFiler and have the ability to file follow-on correspondence, please consult the information at

www.uspto.gov/patents/process/file/efs/guidance/register.jsp (http://www.uspto.gov/patents/process/file/efs/guidance/register.jsp), or call the Electronic Business Center at 866-217-9197.

The specification (description and claims) can be created using a word processing program such as Microsoft® Word or Corel® WordPerfect. The document containing the specification can normally be converted into PDF format by the word processing program itself so that it can be included as an attachment when filing the application via EFS-Web. Other application documents, such as drawings and a hand-signed declaration, may have to be scanned as a PDF file for filing via EFS-Web. See the information available at www.uspto.gov/patents/process/file/efs/index.jsp (http://www.uspto.gov/patents/process/file/efs/index.jsp). Any questions regarding filing applications via EFS-Web should be directed to the Electronic Business Center at 866-217-9197.

All application documents must be in the English language or a translation into the English language will be required along with the required fee set forth in 37 CFR 1.17(i).

Each document (which should be filed via EFS-Web in PDF format) must have a top margin of at least 2 cm (3/4 inch), a left side margin of at least 2.5 cm (1 inch), a right side margin of at least 2 cm (3/4 inch) and a bottom margin of at least 2 cm (3/4 inch) with no holes made in the submitted papers. It is also required that the spacing on all papers be 1.5 or double-spaced and the application papers must be numbered consecutively (centrally located above or below the text) starting with page one.

The specification must have text written in a nonscript font (e.g., Arial, Times Roman, or Courier, preferably a font size of 12pt) lettering style having capital letters that should be at least 0.3175 cm (0.125 inch) high, but may be no smaller than 0.21 cm (0.08 inch) high (e.g., a font size of 6). The specification must have only a single column of text.

The specification must conclude with a claim or claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as the invention. The portion of the application in which the applicant sets forth the claim or claims is an important part of the application, as it is the claims that define the scope of the protection afforded by the patent. The claims must commence on a separate sheet.

More than one claim may be presented provided they differ from each other. Claims may be presented in independent form (e.g. the claim stands by itself) or in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim that refers back to more than one other claim is considered a "multiple dependent claim."

The application for patent is not forwarded for examination until all required parts, complying with the rules related thereto, are received. If any application is filed without all the required parts for obtaining a filing date (incomplete or defective), the applicant will be notified of the deficiencies and given a time period to complete the application filing (a surcharge may be required)—at which time a filing date as of the date of such a completed submission will be obtained by the applicant. If the omission is not corrected within a specified time period, the application will be returned or otherwise disposed of; the filing fee if submitted will be refunded less a handling fee as set forth in the fee schedule.

The filing fee and declaration or oath need not be submitted with the parts requiring a filing date. It is, however, desirable that all parts of the complete application be deposited in the Office together; otherwise, each part must be signed and a letter must accompany each part, accurately and clearly connecting it with the other parts

of the application. If an application that has been accorded a filing date does not include the filing fee or the oath or declaration, applicant will be notified and given a time period to pay the filing fee, file an oath or declaration and pay a surcharge.

All applications received in the USPTO are numbered in sequential order, and the applicant will be informed of the application number and filing date by a filing receipt.

The filing date of an application for patent is the date on which a specification (including at least one claim) and any drawings necessary to understand the subject matter sought to be patented are received in the USPTO; or the date on which the last part completing the application is received in the case of a previously incomplete or defective application.

Provisional Application for a Patent

Since June 8, 1995, the USPTO has offered inventors the option of filing a provisional application for patent, which was designed to provide a lower-cost first patent filing in the United States and to give U.S. applicants parity with foreign applicants. Claims and oath or declaration are NOT required for a provisional application. A provisional application provides the means to establish an early effective filing date in a patent application and permits the term "Patent Pending" to be applied in connection with the invention. Provisional applications may not be filed for design inventions.

The filing date of a provisional application is the date on which a written description of the invention, and drawings if necessary, are received in the USPTO. To be complete, a provisional application must also include the filing fee, and a cover sheet specifying that the application is a provisional application for patent. The applicant would then have up to 12 months to file a nonprovisional application for patent as described above. The claimed subject matter in the later filed nonprovisional application is entitled to the benefit of the filing date of the provisional application if it has support in the provisional application.

If a provisional application is not filed in English, and a nonprovisional application is filed claiming benefit to the provisional application, a translation of the provisional application will be required. See title 37, Code of Federal Regulations, Section 1.78(a)(5).

Provisional applications are NOT examined on their merits. A provisional application will become abandoned by the operation of law 12 months from its filing date. The 12-month pendency for a provisional application is not counted toward the 20-year term of a patent granted on a subsequently filed nonprovisional application that claims benefit of the filing date of the provisional application.

A surcharge is required for filing the basic filing fee or the cover sheet on a date later than the filing of the provisional application. Unlike nonprovisional utility applications, design, plant, and provisional applications can still be filed by mail or hand-delivery without having to pay the additional $400 non-electronic filing fee. Design and provisional applications can also be filed via EFS-Web. Plant applications, however, are not permitted to be filed via EFS-Web.

Publication of Patent Applications

Publication of patent applications is required by the American Inventors Protection Act of 1999 for most plant and utility patent applications filed on or after November 29, 2000. On filing of a plant or utility application on or after November 29, 2000, an applicant may request that the application not be published, but only if the invention has not been and will not be the subject of an application filed in a foreign country that requires publication 18 months after filing (or earlier claimed priority date) or under the Patent Cooperation Treaty.

Publication occurs after the expiration of an 18-month period following the earliest effective filing date or priority date claimed by an application. Following publication, the application for patent is no longer held in confidence by the Office and any member of the public may request access to the entire file history of the application.

As a result of publication, an applicant may assert provisional rights. These rights provide a patentee with the opportunity to obtain a reasonable royalty from a third party that infringes a published application claim provided actual notice is given to the third party by applicant, and patent issues from the application with a substantially identical claim. Thus, damages for pre-patent grant infringement by another are now available.

File Your Application Electronically Using EFS-Web

Effective November 15, 2011, any regular nonprovisional utility application filed by mail or hand-delivery will require payment of an additional $400 fee called the "non-electronic filing fee," which is reduced by 50 percent (to $200) for applicants that qualify for small entity status under 37 CFR 1.27(a) or micro entity status under 37 CFR 1.29(a) or (d). **The only way to avoid having to pay the additional $400 non-electronic filing fee is by filing your nonprovisional utility application via EFS-Web.** A small entity applicant who files electronically not only avoids the additional non-electronic filing ($200 for small entity and micro entity applicants); the small entity applicant who files electronically also receives a bigger discount on the regular filing fee. Any questions regarding filing applications via EFS-Web should be directed to the Electronic Business Center at 866-217-9197.

Other patent correspondence, including design, plant, and provisional application filings, as well as correspondence filed in a nonprovisional application after the application filing date (known as "follow-on" correspondence), can still be filed by mail or hand-delivery without incurring the $400 non-electronic filing fee. You do not have to be a Registered eFiler to file a patent application via EFS-Web. However, unless you are a Registered eFiler, you must not attempt to file follow-on correspondence via EFS-Web, because Unregistered eFilers are not permitted to file follow-on correspondence via EFS-Web. Follow-on correspondence filed by anyone other than an EFS-Web Registered eFiler must be sent by mail or be hand-delivered. (See the "General Information and Correspondence" section of this brochure.) In the event you receive from the USPTO a "Notice of Incomplete Application" in response to your EFS-Web filing stating that an application number has been assigned but no filing date has been granted, you must become a Registered eFiler and file your reply to the "Notice of Incomplete Application" via EFS-Web in order to avoid the $400 non-electronic filing fee. To become a Registered eFiler and have the ability to file follow-on correspondence, please consult the information at www.uspto.gov/patents/process/file/efs/guidance/register.jsp (http://www.uspto.gov/patents/process/file/efs/guidance/register.jsp), or call the Electronic Business Center at 866-217-9197.

EFS-Web allows customers to electronically file patent application documents securely via the Internet via a Web page. EFS-Web is a system for submitting new applications and documents related to previously-filed patent applications. Customers prepare documents in Portable Document Format (PDF), attach the documents, validate that the PDF documents will be compatible with USPTO internal automated information systems, submit the documents, and pay fees with real-time payment processing. Some forms are available as fillable EFS-Web forms. When these fillable EFS-Web forms are used, the data entered into the forms is automatically loaded into USPTO information systems.

EFS-Web can be used to submit:

(A) New utility patent applications and fees

(B) New design patent applications and fees

(C) Provisional patent applications and fees

(D) Requests to enter the national stage under 35 U.S.C. 371 and fees

(E) Most follow-on documents and fees for a previously filed patent application

Further information on EFS-Web is available at www.uspto.gov/patents/process/file/efs/guidance (http://www.uspto.gov/patents/process/file/efs/guidance).

See the "Legal Framework" document on that Web page for a list of correspondence that may not be filed via EFS-Web and answers to frequently asked questions.

Oath or Declaration, Signature

An oath or declaration is a formal statement that must be made by the inventor in a nonprovisional application. Each inventor must sign an oath or declaration that includes certain statements required by law and the USPTO rules, including the statement that he or she believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application and the statement that the application was made or authorized to be made by him or her. See 35 U.S.C 115 and 37 CFR 1.63. An oath must be sworn to by the inventor before a notary public. A declaration may be submitted in lieu of an oath. A declaration does not need to be notarized. Oaths or declarations are required for design, plant, utility, and reissue applications. In addition to the required statements, the oath or declaration must set forth the legal name of the inventor, and, if not provided in an application data sheet, the inventor's mailing address and residence. In lieu of an oath or declaration, a substitute statement may be signed by the applicant with respect to an inventor who is deceased, legally incapacitated, cannot be found or reached after diligent effort, or has refused to execute the oath or declaration. When filing a continuing application, a copy of the oath or declaration filed in the earlier application may be used provided that it complies with the rules in effect for the continuing application (i.e., the rules that apply to applications filed on or after September 16, 2012).

Forms for declarations are available by calling the USPTO General Information Services at 800-786-9199 or 571-272-1000 or by accessing USPTO website at www.uspto.gov (http://www.uspto.gov/), indexed under the section titled "Forms, Patents." Most of the forms on the USPTO website are electronically fillable and can be included in the application filed via EFS-Web without having to print the form out in order to scan it for inclusion as a PDF attachment to the application.

Filing, Search, and Examination Fees

A patent application is subject to the payment of a basic fee and additional fees that include a search fee, an examination fee, and issue fee. Consult the USPTO website at www.uspto.gov (http://www.uspto.gov)for the current fees (http://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule). Total claims that exceed 20, and independent claims that exceed three are considered "excess claims" for which additional fees are due. For example, if applicant filed a total of 25 claims, including four independent claims, applicant would be required to pay excess claims fees for five total claims exceeding 20, and one independent

claim exceeding three. If the same applicant later filed an amendment increasing the total number of claims to 29, and the number of independent claims to six, applicant would be required to pay more excess claims fees for the four additional total claims and the two additional independent claims.

In calculating fees, a claim is singularly dependent if it incorporates by reference a single preceding claim that may be an independent or dependent claim. A multiple dependent claim or any claim depending therefrom shall be considered as separate dependent claims in accordance with the number of claims to which reference is made. In addition, if the application contains multiple dependent claims, an additional fee is required for each multiple dependent claim.

If the owner of the invention is a small entity, (an independent inventor, a small business concern or a nonprofit organization), most fees are reduced by half if small entity status is claimed. If small entity status is desired and appropriate, applicants should pay the small entity filing fee. Applicants claiming small entity status should make an investigation as to whether small entity status is appropriate before claiming such status.

Most of the fees are subject to change in October of each year.

Specification [Description and Claims]

The following order of arrangement should be observed in framing the application:

(a) Application transmittal form

(b) Fee transmittal form

(c) Application Data Sheet

(d) Specification

(e) Drawings

(f) Executed Oath or declaration

The specification should have the following sections, in order:

(1) Title of the Invention

(2) Cross Reference to related applications (if any). (Related applications may be listed on an application data sheet, either instead of or together with being listed in the specification.)

(3) Statement of federally sponsored research or development (if any)

(4) The names of the parties to a joint research agreement if the claimed invention was made as a result of activities within the scope of a joint research agreement

(5) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on a compact disc and an incorporation by reference of the material on the compact disc. The total number of compact disc including duplicates and the files on each compact disc shall be specified.

(6) Background of the Invention

(7) Brief Summary of the Invention

(8) Brief description of the several views of the drawing (if any)

(9) Detailed Description of the Invention

(10) A claim or claims

(11) Abstract of the disclosure

(12) Sequence listing (if any)

The specification must include a written description of the invention and of the manner and process of making and using it, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the technological area to which the invention pertains, or with which it is most nearly connected, to make and use the same.

The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter, or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor for carrying out the invention must be set forth.

In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The title of the invention, which should be as short and specific as possible (no more than 500 characters), should appear as a heading on the first page of the specification if it does not otherwise appear at the beginning of the application. A brief abstract of the technical disclosure in the specification, including that which is new in the art to which the invention pertains, must be set forth on a separate page preferably following the claims. The abstract should be in the form of a single paragraph of 150 words or less, under the heading "Abstract of the Disclosure."

A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. The summary should be commensurate with the invention as claimed, and any object recited should be that of the invention as claimed.

When there are drawings, there shall be a brief description of the several views of the drawings, and the detailed description of the invention shall refer to the different views by specifying the numbers of the figures, and to the different parts by use of reference numerals.

The specification must conclude with a claim or claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as the invention. The portion of the application in which the applicant sets forth the claim or claims is an important part of the application, as it is the claims that define the scope of the protection afforded by the patent and which questions of infringement are judged by the courts.

More than one claim may be presented, provided they differ substantially from each other and are not unduly multiplied. One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim that refers back to more than one other claim is considered a "multiple dependent claim."

Multiple dependent claims shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. Claims in dependent form shall be construed to include all of the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate all the limitations of each of the particular claims in relation to which it is being considered.

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

Drawing

The applicant for a patent will be required by law to furnish a drawing of the invention whenever the nature of the case requires a drawing to understand the invention. However, the Director may require a drawing where the nature of the subject matter admits of it; this drawing must be filed with the application. This includes practically all inventions except compositions of matter or processes, but a drawing may also be useful in the case of many processes.

The drawing must show every feature of the invention specified in the claims, and is required by the Office rules to be in a particular form. The Office specifies the size of the sheet on which the drawing is made, the type of paper, the margins, and other details relating to the making of the drawing. The reason for specifying the standards in detail is that the drawings are printed and published in a uniform style when the patent issues, and the drawings must also be such that they can be readily understood by persons using the patent descriptions.

The sheets of drawings should be numbered in consecutive Arabic numerals, starting with 1, within the sight (the usable surface). For regular nonprovisional utility applications, these "sheets" should be contained in an electronic document in PDF format filed with the other application documents via EFS-Web. These numbers, if present, must be placed in the middle of the top of the sheet, but not in the margin. The numbers can be placed on the right-hand side if the drawing extends too close to the middle of the top edge of the usable surface. The drawing sheet numbering must be clear and larger than the numbers used as reference characters to avoid confusion. The number of each sheet should be shown by two Arabic numerals placed on either side of an oblique line, with the first being the sheet number and the second being the total number of sheets of drawings, with no other marking.

Identifying indicia, if provided, should include the title of the invention, the inventor's name, the application number (if known), and docket number (if any). This information should be placed on the top margin of each sheet of drawings. No names or other identification will be permitted within the "sight" of the drawing. The name and telephone number of a person to call if the USPTO is unable to match the drawings to the proper application may also be provided.

Standards for Drawings

Patent Pro Bono Program

Patent Pro Bono Program for independent inventors and small businesses

Inventors and small businesses that meet certain financial thresholds and other criteria may be eligible for free legal assistance in preparing and filing a patent application. The Patent Pro Bono Program is a nationwide network of independently operated regional programs that match volunteer patent professionals with financially under-resourced inventors and small businesses for the purpose of securing patent protection. Each regional program provides services for residents of one or more states. Please watch this short series of videos (/learning-and-resources/uspto-videos/intro-uspto-pro-bono-program) to learn more.

Requirements

Each of the regional programs may have different requirements for admission. In general, the requirements for admission are:

Income
Your gross household income should be less than three times the federal poverty level guidelines (https://aspe.hhs.gov/poverty-guidelines) though some regional programs may have different criteria.

Knowledge
You must demonstrate knowledge of the patent system in one of two ways:

- Having a provisional application already on file with the USPTO, or
- Successful completion of the certificate training course (https://www.uspto.gov/video/cbt/certpck/index.htm) (certificado de formación en español (https://www.uspto.gov/video/cbt/spanish-trngcrtcrse/)).

Invention
You must be able to describe the particular features of the invention and how it works.

Because the specific requirements of income, knowledge, and invention vary by program, you should contact your regional program for specific information. Learn more by selecting your regional program on the **Patent Pro Bono Coverage Map** below.

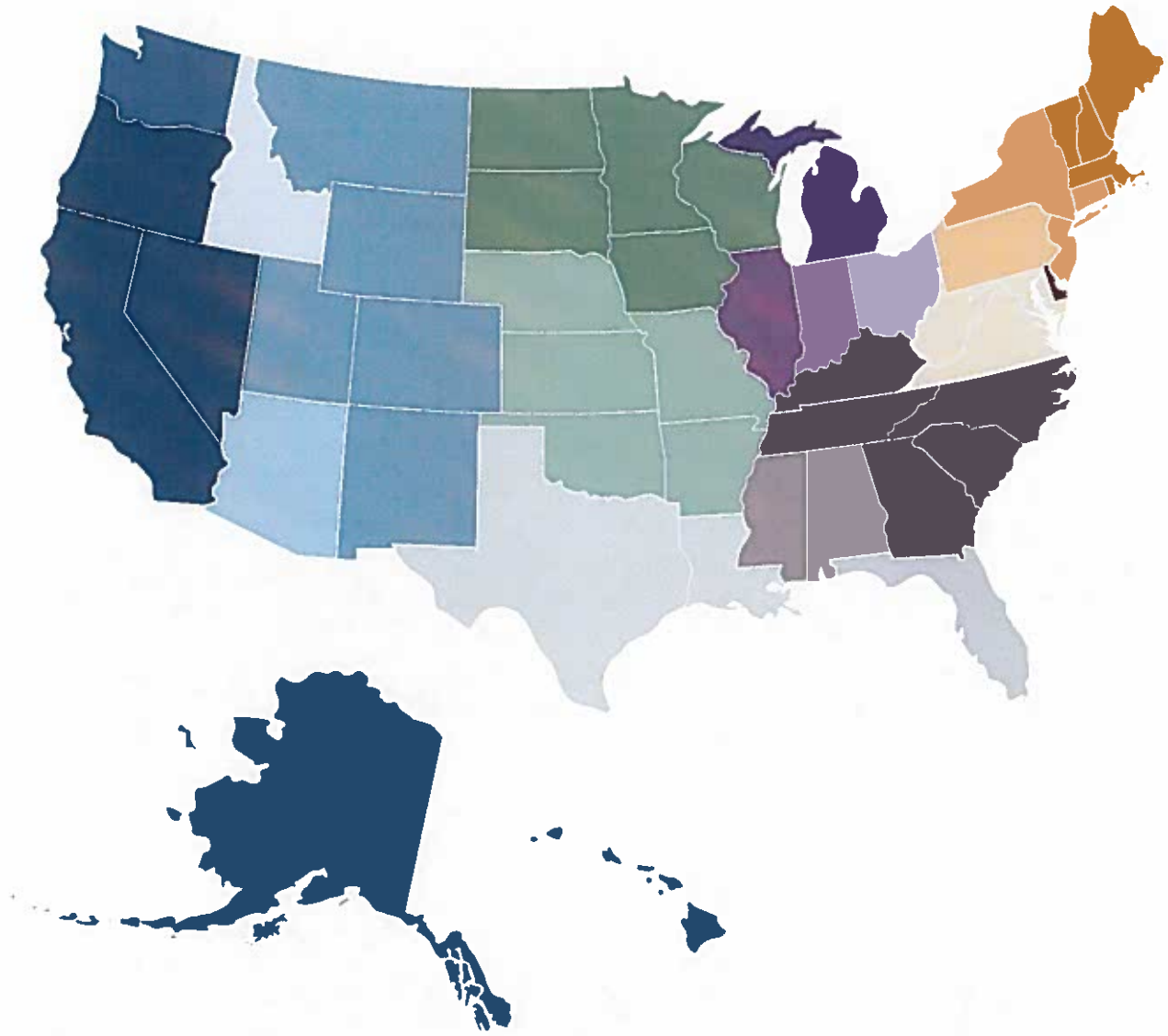
How to Apply for Patent Pro Bono Assistance

Use the map below, to locate your regional program. Most regional programs provide online application forms. Keep in mind that your state may be covered by a regional program that is located in another state. Alternatively, you may complete a National Clearinghouse Applications Submission form provided by the Federal Circuit's National Clearinghouse (https://fedcirbar.org/Pro-Bono-Scholarships/PTO-Pro-Bono/National-Clearinghouse-Application-Submission).

How to Volunteer

Registered patent practitioners are critical to the success of the Patent Pro Bono Program. If you are a patent practitioner interested in volunteering your legal services, click on your state in the **Patent Pro Bono Coverage Map** and fill out an online volunteer application form found on the program's website.

Coverage of Patent Pro Bono Program



- Washington Pro Bono Patent Network
- Idaho Patent Pro Bono
- CLA
- ProBoPat
- Arizona Public Patent Program
- LegalCorps (MN)
- Pro Bono Patent Project (MI)
- Gateway Venture Mentoring Service
- TALA
- Chicago-Kent Patent Hub
- PatentConnect for Hoosiers (IN KY)
- Ohio Invents
- BBVLP Patent Program (MS AL)
- New England Program
- New York Tri State Program
- Delaware Program
- FCBA (Mid-Atlantic)
- PA Patent
- NC Leap
- Georgia Patents
- Patent Pro Bono FL

Patent Pro Bono Informational Videos

Please watch this short series of videos (/learning-and-resources/uspto-videos/intro-uspto-pro-bono-program) to learn more about the Patent Pro Bono Program.

Law School Clinic Certification Program

Law School Clinic Certification Program

What It Is

The Law School Clinic Certification program allows law students enrolled in a participating law school's clinic program to practice Intellectual Property Law before the USPTO under the strict guidance of a Law School Faculty Clinic Supervisor. The program currently consists of students practicing in both patent and trademark law before the USPTO. The program is administered by the Office of Enrollment and Discipline. The Director of the Office of Enrollment and Discipline grants the law students limited recognition to practice before the Office.

Students gain experience drafting and filing either patent applications or trademark applications for clients of the law school clinic. Further, as they are authorized to practice before the USPTO, they gain experience answering Office Actions and communicating with either patent examiners or trademark examining attorneys for the applications they have filed.

Participating Law Schools

The law schools listed below participate in the USPTO Law School Clinic Certification Program. **Please contact the school at the listed e-mail address if you wish to make general inquiries or request legal services.**

****ACCEPTANCE AS A CLIENT IS SUBJECT TO THE LAW SCHOOL'S REQUIREMENTS AND DISCRETION**

Participating Law Schools	E-mail Address	IP Practice Area	Geographic Area** (from which the law school may accept clients)
American University, Washington College of Law	ipclinic@wcl.american.edu (mailto:ipclinic@wcl.american.edu)	Patents and Trademarks	District of Columbia, Maryland and Virginia Only
Arizona State University Sandra Day O'Conner College of Law	patent_clinic@asu.edu (mailto:patent_clinic@asu.edu) (patents) Trademark_clinic@asu.edu (mailto:Trademark_clinic@asu.edu) (trademarks)	Patents and Trademarks	All United States

Baylor Law School	iplawclinic@baylor.edu (mailto:iplawclinic@baylor.edu)	Patents and Trademarks	Texas Only
Brooklyn Law School	BLIP@brooklaw.edu (mailto:BLIP@brooklaw.edu)	Patents	All United States
California Western School of Law	TrademarkClinic@cwsl.edu (mailto:TrademarkClinic@cwsl.edu)	Trademarks	All United States
Case Western Reserve University School of Law	lawclinic@case.edu (mailto:lawclinic@case.edu)	Patents	Northern Ohio Only
Florida International University College of Law	clinics@fiu.edu (mailto:clinics@fiu.edu)	Patents	Florida Only
Fordham University School of Law	IPILClinic@lsls.fordham.edu (mailto:IPILClinic@lsls.fordham.edu)	Patents and Trademarks	Northeastern United States Only
Howard University School of Law	clinics.husl@gmail.com (mailto:clinics.husl@gmail.com) (Trademarks) howardpatentipclinic@gmail.com (mailto:howardpatentipclinic@gmail.com) (Patents)	Trademarks Patents (commencing participation January 1, 2019)	District of Columbia, Maryland and Virginia Only
Indiana University Maurer School of Law	ipclinic@indiana.edu (mailto:ipclinic@indiana.edu)	Patents and Trademarks	Indiana Only
Indiana University McKinney School of Law	iuindip@iupui.edu (mailto:iuindip@iupui.edu)	Patents and Trademarks	Midwestern States Only

Lewis & Clark Law School	sblc@lclark.edu (mailto:sblc@lclark.edu)	Patents and Trademarks	Oregon Only
Liberty University School of Law	ipclinic@liberty.edu (mailto:ipclinic@liberty.edu)	Trademarks	All United States (preference to central and southern Virginia)
Lincoln Law School of San Jose	ipclinic@lincolnlawsj.edu (mailto:ipclinic@lincolnlawsj.edu)	Patents and Trademarks	All United States
Mitchell Hamline School of Law	jean.backes@mitchellhamline.edu (mailto:jean.backes@mitchellhamline.edu)	Patents and Trademarks	Upper Midwestern United States Only
New York Law School	ptoclinic@nyls.edu (mailto:ptoclinic@nyls.edu) (patents) trademarkclinic@nyls.edu (mailto:trademarkclinic@nyls.edu) (trademarks)	Patents and Trademarks	All United States
North Carolina Central University School of Law	ipclinic@nccu.edu (mailto:ipclinic@nccu.edu) (link sends email)	Patent and Trademarks	Patents: North Carolina, South Carolina, Tennessee and Georgia Trademarks: North Carolina and South Carolina
Northeastern University School of Law	ipcolab@northeastern.edu (mailto:ipcolab@northeastern.edu)	Trademarks	Massachusetts
Northwestern Pritzker School of Law	elc@law.northwestern.edu (mailto:elc@law.northwestern.edu)	Trademarks	Illinois Only (preference to Chicago, Illinois Area)
Roger Williams University School of Law	bsuc@rwu.edu (mailto:bsuc@rwu.edu)	Trademarks	Rhode Island and surrounding States Only

Rutgers Law School	jkettle@kinoy.rutgers.edu (mailto:jkettle@kinoy.rutgers.edu)	Trademarks	All United States
Seattle University School of Law	TMclinic@seattleu.edu (mailto:TMclinic@seattleu.edu)	Trademarks	Washington, Alaska, Montana, Nevada, Utah and Wyoming
South Texas College Of Law Houston	patent@stcl.edu (mailto:patent@stcl.edu) (patents) trademark@stcl.edu (mailto:trademark@stcl.edu) (trademarks)	Patents and Trademarks	Texas and Louisiana Only (Patents) All United States (Trademarks)
Southern Methodist University Dedman School of Law	patentclinic@smu.edu (mailto:patentclinic@smu.edu) (patents) trademarkclinic@smu.edu (mailto:trademarkclinic@smu.edu) (trademarks)	Patents and Trademarks	Dallas-Forth Worth, Texas and Northern Texas on a limited basis
Southern University Law Center	sulctechclinic@gmail.com (mailto:sulctechclinic@gmail.com)	Patents and Trademarks	Louisiana Only
Suffolk University Law School	clinical@suffolk.edu (mailto:clinical@suffolk.edu)	Patents and Trademarks	Connecticut, Massachusetts, New Hampshire and Rhode Island
Syracuse University College of Law	trademarks-cdlc@syr.edu (mailto:trademarks-cdlc@syr.edu)	Trademarks	Upstate New York Only
Texas A&M University School of Law	patc-info@law.tamu.edu (mailto:patc-info@law.tamu.edu) (patents) tmc-info@law.tamu.edu (mailto:tmc-info@law.tamu.edu) (trademarks)	Patents and Trademarks	Texas Only
The George Washington University School of Law	sbced_uspto_intake@law.gwu.edu (mailto:sbced_uspto_intake@law.gwu.edu)	Trademarks	District of Columbia Only

Thomas Jefferson School of Law	PatentClinic@tjsl.edu (mailto:PatentClinic@tjsl.edu) (patents) TrademarkClinic@tjsl.edu (mailto:TrademarkClinic@tjsl.edu) (trademarks)	Patents and Trademarks	San Diego, Imperial and Riverside Counties, California (Patents) San Diego County, California (Trademarks)
Tulane University Law School	TLSIPLab@tulane.edu (mailto:TLSIPLab@tulane.edu)	Patents and Trademarks	Louisiana Only
UIC John Marshall Law School	patentclinic@jmls.edu (mailto:patentclinic@jmls.edu) (patents) trademarkclinic@jmls.edu (mailto:trademarkclinic@jmls.edu) (trademarks)	Patents and Trademarks	All United States (preference to Illinois and Midwest States) (Patents) All United States (Trademarks)
University of Akron School of Law	trademarkclinic@uakron.edu (mailto:trademarkclinic@uakron.edu)	Trademarks	All United States
University of Arizona, James E. Rogers College of Law	Law-IPClinic@list.arizona.edu (mailto:Law-IPClinic@list.arizona.edu)	Patents and Trademarks	Arizona Only
University of California, Irvine School of Law	IPATintake@law.uci.edu (mailto:IPATintake@law.uci.edu)	Trademarks	California Only (preference to Orange, Los Angeles, San Bernardino, and Riverside Counties)
University of California, Los Angeles School of Law	uspto@law.ucla.edu (mailto:uspto@law.ucla.edu)	Patents	All United States (preference to Southern California)
University of Colorado Law School	elawclin@colorado.edu (mailto:elawclin@colorado.edu)	Patents	Colorado Only

University of Connecticut School of Law	iplawclinic@uconn.edu (mailto:iplawclinic@uconn.edu)	Patents and Trademarks	Connecticut Only
University of Detroit Mercy School of Law	IPClinic@udmercy.edu (mailto:IPClinic@udmercy.edu)	Patents Trademarks (commencing participation August 1, 2018)	All United States (preference to Michigan and Ohio) and Ontario, Canada
University of Idaho College of Law	trademarks@uidaho.edu (mailto:trademarks@uidaho.edu)	Trademarks	Idaho Only
University of Maryland School of Law	miplrc@law.umaryland.edu (mailto:miplrc@law.umaryland.edu)	Patents and Trademarks	Maryland and District of Columbia Metro Area Only
University of Miami School of Law	dravicher@law.miami.edu (mailto:dravicher@law.miami.edu)	Patents and Trademarks	All United States
University of Nebraska College of Law	eclinic@unl.edu (mailto:eclinic@unl.edu)	Trademarks	Nebraska Only
University of New Hampshire School of Law	ipclinic@law.unh.edu (mailto:ipclinic@law.unh.edu)	Trademarks	All United States
University of North Carolina at Chapel Hill School of Law	whitede@email.unc.edu (mailto:whitede@email.unc.edu)	Trademarks	All United States
University of Notre Dame Law School	ipclinic@nd.edu (mailto:ipclinic@nd.edu)	Patents and Trademarks	Midwestern United States Only

University of Pennsylvania Law School	DetkinIPTC@law.upenn.edu (mailto:DetkinIPTC@law.upenn.edu)	Trademarks	Pennsylvania Only
University of Puerto Rico School of Law	Eugenio.torres@upr.edu (mailto:Eugenio.torres@upr.edu)	Patents and Trademarks	Puerto Rico Only
University of Richmond School of Law	ipclinic@richmond.edu (mailto:ipclinic@richmond.edu)	Trademarks	Virginia and District of Columbia
University of San Diego School of Law	eclinic@sandiego.edu (mailto:eclinic@sandiego.edu)	Patents and Trademarks	Southern California Only
University of San Francisco School of Law	lawclinic@usfca.edu (mailto:lawclinic@usfca.edu)	Trademarks	All United States
University of St. Thomas School of Law	IPCtrademark@stthomas.edu (mailto:IPCtrademark@stthomas.edu)	Trademarks	Minnesota Only
University of Tennessee College of Law	bkrumm@utk.edu (mailto:bkrumm@utk.edu) Clinicdocs@utk.edu (mailto:Clinicdocs@utk.edu)	Trademarks	All United States
University of Washington School of Law	elcinfo@uw.edu (mailto:elcinfo@uw.edu)	Patents and Trademarks	Washington Only
Vanderbilt Law School	legal.clinic@vanderbilt.edu (mailto:legal.clinic@vanderbilt.edu)	Trademarks	All United States
Washington University in St. Louis School of Law	EIPAssistance@wulaw.wustl.edu (mailto:EIPAssistance@wulaw.wustl.edu)	Patents	Missouri and Illinois

USPTO Fee Schedule

USPTO Fee Schedule

Effective January 16, 2018 (Last Revised on March 1, 2019)

The fee schedule provides information and fee rates for USPTO's products and services. All payments must be paid in U.S. dollars for the full amount of the fee required. View the **Accepted payment methods** page or call the USPTO Contact Center at 571-272-1000 or 800-786-9199 for assistance.

Warning about non-USPTO solicitations requesting payments that are sent by numerous companies unaffiliated with the USPTO.

Patent Fees

The fees subject to reduction upon establishment of small entity status (37 CFR 1.27) or micro entity status (37 CFR 1.29) are shown in separate columns. Except for provisional applications, each application for a patent requires the appropriate search fee and examination fee in addition to the appropriate fee(s) in the "Patent Application Filing Fees" section below. This means each fee listed as a "Basic filing fee" in the "Patent Application Filing Fees" section should be accompanied by the appropriate search fee listed in the "Patent Search Fees" section as well as the appropriate examination fee listed in the "Patent Examination Fees" section. The $400/$200 non-electronic filing fee (fee codes 1090/2090/3090 or 1690/2690/3690) must be paid in addition to the filing, search and examination fees, in each original nonprovisional utility application filed in paper with the USPTO. The only way to avoid payment of the non-electronic filing fee is by filing your nonprovisional utility application via EFS-Web. The non-electronic filing fee does not apply to reissue, design, plant, or provisional applications.

Patent Application Filing Fees

Fee Code	37 CFR	Description	Fee	Small Entity Fee	Micro Entity Fee
1011/2011/3011	1.16(a)	Basic filing fee - Utility (paper filing also requires non-electronic filing fee under 1.16(t))	300.00	150.00	75.00
4011†	1.16(a)	Basic filing fee - Utility (electronic filing for small entities)	n/a	75.00	n/a
1012/2012/3012	1.16(b)	Basic filing fee - Design	200.00	100.00	50.00
1017/2017/3017	1.16(b)	Basic filing fee - Design CPA	200.00	100.00	50.00
1013/2013/3013	1.16(c)	Basic filing fee - Plant	200.00	100.00	50.00
1005/2005/3005	1.16(d)	Provisional application filing fee	280.00	140.00	70.00
1014/2014/3014	1.16(e)	Basic filing fee - Reissue	300.00	150.00	75.00
1019/2019/3019	1.16(e)	Basic filing fee - Reissue (Design CPA)	300.00	150.00	75.00
1051/2051/3051	1.16(f)	Surcharge - Late filing fee, search fee, examination fee, inventor's oath or declaration, or application filed without at least one claim or by reference	160.00	80.00	40.00
1052/2052/3052	1.16(g)	Surcharge - Late provisional filing fee or cover sheet	60.00	30.00	15.00
1201/2201/3201	1.16(h)	Each independent claim in excess of three	460.00	230.00	115.00
1204/2204/3204	1.16(h)	Each reissue independent claim in excess of three	460.00	230.00	115.00
1202/2202/3202	1.16(i)	Each claim in excess of 20	100.00	50.00	25.00
1205/2205/3205	1.16(i)	Each reissue claim in excess of 20	100.00	50.00	25.00
1203/2203/3203	1.16(j)	Multiple dependent claim	820.00	410.00	205.00

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1081/2081/3081	1.16(s)	Utility Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	400.00	200.00	100.00
1082/2082/3082	1.16(s)	Design Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	400.00	200.00	100.00
1083/2083/3083	1.16(s)	Plant Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	400.00	200.00	100.00
1084/2084/3084	1.16(s)	Reissue Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	400.00	200.00	100.00
1085/2085/3085	1.16(s)	Provisional Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	400.00	200.00	100.00
1090/2090/3090	1.16(t)	Non-electronic filing fee — Utility (additional fee for applications filed in paper)	400.00	200.00	200.00
1053/2053/3053	1.17(i)(1)	Non-English translation	140.00	70.00	35.00
1091/2091/3091	1.21(o)(1)	Submission of sequence listings of 300MB to 800MB	1,000.00	500.00	250.00
1092/2092/3092	1.21(o)(2)	Submission of sequence listings of more than 800MB	10,000.00	5,000.00	2,500.00
† The 4000 series fee code may be used via EFS-Web					
Patent Search Fees					
Fee Code	**37 CFR**	**Description**	**Fee**	**Small Entity Fee**	**Micro Entity Fee**
1111/2111/3111	1.16(k)	Utility Search Fee	660.00	330.00	165.00
1112/2112/3112	1.16(l)	Design Search Fee or Design CPA Search Fee	160.00	80.00	40.00
1113/2113/3113	1.16(m)	Plant Search Fee	420.00	210.00	105.00
1114/2114/3114	1.16(n)	Reissue Search Fee or Reissue (Design CPA) Search Fee	660.00	330.00	165.00
Patent Examination Fees					
Fee Code	**37 CFR**	**Description**	**Fee**	**Small Entity Fee**	**Micro Entity Fee**
1311/2311/3311	1.16(o)	Utility Examination Fee	760.00	380.00	190.00
1312/2312/3312	1.16(p)	Design Examination Fee or Design CPA Examination Fee	600.00	300.00	150.00
1313/2313/3313	1.16(q)	Plant Examination Fee	620.00	310.00	155.00
1314/2314/3314	1.16(r)	Reissue Examination Fee or Reissue (Design CPA) Examination Fee	2,200.00	1,100.00	550.00
Patent Post-Allowance Fees					
Fee Code	**37 CFR**	**Description**	**Fee**	**Small Entity Fee**	**Micro Entity Fee**
1501/2501/3501	1.18(a)(1)	Utility issue fee	1,000.00	500.00	250.00
1511/2511/3511	1.18(a)(1)	Reissue issue fee	1,000.00	500.00	250.00
1502/2502/3502	1.18(b)(1)	Design issue fee	700.00	350.00	175.00
1503/2503/3503	1.18(c)(1)	Plant issue fee	800.00	400.00	200.00
n/a	1.18(d)(1)	Publication fee for early, voluntary, or normal publication	0.00	0.00	0.00
1505/2505/3505	1.18(d)(3)	Publication fee for republication	300.00	300.00	300.00*
* Third-party filers are not eligible for the micro entity fee.					

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Patent Extension of Time Fees					
Fee Code	**37 CFR**	**Description**	**Fee**	**Small Entity Fee**	**Micro Entity Fee**
1251/2251/3251	1.17(a)(1)	Extension for response within first month	200.00	100.00	50.00
1252/2252/3252	1.17(a)(2)	Extension for response within second month	600.00	300.00	150.00
1253/2253/3253	1.17(a)(3)	Extension for response within third month	1,400.00	700.00	350.00
1254/2254/3254	1.17(a)(4)	Extension for response within fourth month	2,200.00	1,100.00	550.00
1255/2255/3255	1.17(a)(5)	Extension for response within fifth month	3,000.00	1,500.00	750.00
Patent Maintenance Fees					
Fee Code	**37 CFR**	**Description**	**Fee**	**Small Entity Fee**	**Micro Entity Fee**
1551/2551/3551	1.20(e)	For maintaining an original or any reissue patent, due at 3.5 years	1,600.00	800.00	400.00
1552/2552/3552	1.20(f)	For maintaining an original or any reissue patent, due at 7.5 years	3,600.00	1,800.00	900.00
1553/2553/3553	1.20(g)	For maintaining an original or any reissue patent, due at 11.5 years	7,400.00	3,700.00	1,850.00
1554/2554/3554	1.20(h)	Surcharge - 3.5 year - Late payment within 6 months	160.00	80.00	40.00
1555/2555/3555	1.20(h)	Surcharge - 7.5 year - Late payment within 6 months	160.00	80.00	40.00
1556/2556/3556	1.20(h)	Surcharge - 11.5 year - Late payment within 6 months	160.00	80.00	40.00
1558/2558/3558	1.17(m)	Petition for the delayed payment of the fee for maintaining a patent in force	2,000.00	1,000.00	500.00
Miscellaneous Patent Fees					
Fee Code	**37 CFR**	**Description**	**Fee**	**Small Entity Fee**	**Micro Entity Fee**
1817/2817/3817	1.17(c)	Request for prioritized examination	4,000.00	2,000.00	1,000.00
1819/2819/3819	1.17(d)	Correction of inventorship after first action on merits	600.00	300.00	150.00
1801/2801/3801	1.17(e)(1)	Request for continued examination (RCE) - 1st request (see 37 CFR 1.114)	1,300.00	650.00	325.00
1820/2820/3820	1.17(e)(2)	Request for continued examination (RCE) - 2nd and subsequent request (see 37 CFR 1.114)	1,900.00	950.00	475.00
1830/2830/3830	1.17(i)(1)	Processing fee, except in provisional applications	140.00	70.00	35.00
1808/2808/3808	1.17(i)(2)	Other publication processing fee	130.00	130.00	130.00
1803/2803/3803	1.17(i)(2)	Request for voluntary publication or republication	130.00	130.00	130.00*
1802/2802/3802	1.17(k)	Request for expedited examination of a design application	900.00	450.00	225.00
1818/2818	1.17(o)	Document fee for third-party submissions (see 37 CFR 1.290(f))	180.00	90.00	n/a*
1806/2806/3806	1.17(p)	Submission of an Information Disclosure Statement	240.00	120.00	60.00
1807/2807/3807	1.17(q)	Processing fee for provisional applications	50.00	50.00	50.00

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1809/2809/3809	1.17(r)	Filing a submission after final rejection (see 37 CFR 1.129(a))	840.00	420.00	210.00
1810/2810/3810	1.17(s)	For each additional invention to be examined (see 37 CFR 1.129(b))	840.00	420.00	210.00
* Third-party filers are not eligible for the micro entity fee.					

Post Issuance Fees

Fee Code	37 CFR	Description	Fee	Small Entity Fee	Micro Entity Fee
1811/2811/3811	1.20(a)	Certificate of correction	150.00	150.00	150.00
1816/2816/3816	1.20(b)	Processing fee for correcting inventorship in a patent	150.00	150.00	150.00
1831/2831/3831	1.20(c)(1)	Ex parte reexamination (§ 1.510(a)) Streamlined	6,000.00	3,000.00	1,500.00*
1812/2812/3812	1.20(c)(2)	Ex parte reexamination (§ 1.510(a)) Non-streamlined	12,000.00	6,000.00	3,000.00*
1821/2821/3821	1.20(c)(3)	Each reexamination independent claim in excess of three and also in excess of the number of such claims in the patent under reexamination	460.00	230.00	115.00
1822/2822/3822	1.20(c)(4)	Each reexamination claim in excess of 20 and also in excess of the number of claims in the patent under reexamination	100.00	50.00	25.00
1814/2814/3814	1.20(d)	Statutory disclaimer, including terminal disclaimer	160.00	160.00	160.00
1826/2826/3826	1.20(k)(1)	Request for supplemental examination	4,400.00	2,200.00	1,100.00
1827/2827/3827	1.20(k)(2)	Reexamination ordered as a result of supplemental examination	12,100.00	6,050.00	3,025.00
1828/2828/3828	1.20(k)(3)(i)	Supplemental Examination Document Size Fee - for nonpatent document having between 21 and 50 sheets	180.00	90.00	45.00
1829/2829/3829	1.20(k)(3)(ii)	Supplemental Examination Document Size Fee - for each additional 50 sheets or a fraction thereof in a nonpatent document	280.00	140.00	70.00
* Third-party filers are not eligible for the micro entity fee.					

Patent Trial and Appeal Fees

Fee Code	37 CFR	Description	Fee	Small Entity Fee	Micro Entity Fee
1405/2405/3405	41.20(a)	Petitions to the Chief Administrative Patent Judge under 37 CFR 41.3	400.00	400.00	400.00
1401/2401/3401	41.20(b)(1)	Notice of appeal	800.00	400.00	200.00*
n/a	41.20(b)(2)(i)	Filing a brief in support of an appeal	0.00	0.00	0.00
1404/2404/3404	41.20(b)(2)(ii)	Filing a brief in support of an appeal in an inter partes reexamination proceeding	2,000.00	1,000.00	500.00*
1403/2403/3403	41.20(b)(3)	Request for oral hearing	1,300.00	650.00	325.00*
1413/2413/3413	41.20(b)(4)	Forwarding an appeal in an application or ex parte reexamination proceeding to the Board	2,240.00	1,120.00	560.00*
1406/2406/3406	42.15(a)(1)	Inter partes review request fee - Up to 20 claims	15,500.00	15,500.00	15,500.00

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1414/2414/3414	42.15(a)(2)	Inter partes review post-institution fee - Up to 15 claims	15,000.00	15,000.00	15,000.00
1407/2407/3407	42.15(a)(3)	Inter partes review request of each claim in excess of 20	300.00	300.00	300.00
1415/2415/3415	42.15(a)(4)	Inter partes post-institution request of each claim in excess of 15	600.00	600.00	600.00
1408/2408/3408	42.15(b)(1)	Post-grant or covered business method review request fee - Up to 20 claims	16,000.00	16,000.00	16,000.00
1416/2416/3416	42.15(b)(2)	Post-grant or covered business method review post-institution fee - Up to 15 claims	22,000.00	22,000.00	22,000.00
1409/2409/3409	42.15(b)(3)	Post-grant or covered business method review request of each claim in excess of 20	375.00	375.00	375.00
1417/2417/3417	42.15(b)(4)	Post-grant or covered business method review post-institution request of each claim in excess of 15	825.00	825.00	825.00
1412/2412/3412	42.15(c)(1)	Petition for a derivation proceeding	400.00	400.00	400.00
1411/2411/3411	42.15(d)	Request to make a settlement agreement available and other requests filed in a patent trial proceeding	400.00	400.00	400.00
* Third-party filers are not eligible for the micro entity fee.					

Patent Petition Fees

Fee Code	37 CFR	Description	Fee	Small Entity Fee	Micro Entity Fee
1462/2462/3462	1.17(f)	Petitions requiring the petition fee set forth in 37 CFR 1.17(f) (Group I)	400.00	200.00	100.00
1463/2463/3463	1.17(g)	Petitions requiring the petition fee set forth in 37 CFR 1.17(g) (Group II)	200.00	100.00	50.00
1464/2464/3464	1.17(h)	Petitions requiring the petition fee set forth in 37 CFR 1.17(h) (Group III)	140.00	70.00	35.00
1453/2453/3453	1.17(m)	Petition for revival of an abandoned application for a patent, for the delayed payment of the fee for issuing each patent, or for the delayed response by the patent owner in any reexamination proceeding	2,000.00	1,000.00	500.00
1454/2454/3454	1.17(m)	Petition for the delayed submission of a priority or benefit claim	2,000.00	1,000.00	500.00
1784/2784/3784	1.17(m)	Petition to excuse applicant's failure to act within prescribed time limits in an international design application	2,000.00	1,000.00	500.00
1783/2783/3783	1.17(t)	Petition to convert an international design application to a design application under 35 U.S.C. chapter 16	180.00	90.00	45.00
1455/2455/3455	1.18(e)	Filing an application for patent term adjustment	200.00	200.00	200.00
1456/2456/3456	1.18(f)	Request for reinstatement of term reduced	400.00	400.00	400.00
1824/2824/3824	1.20(c)(6)	Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d)	1,940.00	970.00	485.00*
1457/2457/3457	1.20(j)(1)	Extension of term of patent	1,120.00	1,120.00	1,120.00

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1458/2458/3458	1.20(j)(2)	Initial application for interim extension (see 37 CFR 1.790)	420.00	420.00	420.00
1459/2459/3459	1.20(j)(3)	Subsequent application for interim extension (see 37 CFR 1.790)	220.00	220.00	220.00
* Third-party filers are not eligible for the micro entity fee.					
PCT Fees - National Stage					
Fee Code	**37 CFR**	**Description**	**Fee**	**Small Entity Fee**	**Micro Entity Fee**
1631/2631/3631	1.492(a)	Basic National Stage Fee	300.00	150.00	75.00
n/a	1.492(b)(1)	National Stage Search Fee - U.S. was the ISA or IPEA and all claims satisfy PCT Article 33(1)-(4)	0.00	0.00	0.00
1641/2641/3641	1.492(b)(2)	National Stage Search Fee - U.S. was the ISA	140.00	70.00	35.00
1642/2642/3642	1.492(b)(3)	National Stage Search Fee - search report prepared and provided to USPTO	520.00	260.00	130.00
1632/2632/3632	1.492(b)(4)	National Stage Search Fee - all other situations	660.00	330.00	165.00
n/a	1.492(c)(1)	National Stage Examination Fee - U.S. was the ISA or IPEA and all claims satisfy PCT Article 33(1)-(4)	0.00	0.00	0.00
1633/2633/3633	1.492(c)(2)	National Stage Examination Fee - all other situations	760.00	380.00	190.00
1614/2614/3614	1.492(d)	Each independent claim in excess of three	460.00	230.00	115.00
1615/2615/3615	1.492(e)	Each claim in excess of 20	100.00	50.00	25.00
1616/2616/3616	1.492(f)	Multiple dependent claim	820.00	410.00	205.00
1617/2617/3617	1.492(h)	Search fee, examination fee or oath or declaration after the date of commencement of the national stage	140.00	70.00	35.00
1618/2618/3618	1.492(i)	English translation after thirty months from priority date	140.00	70.00	35.00
1681/2681/3681	1.492(j)	National Stage Application Size Fee - for each additional 50 sheets that exceeds 100 sheets	400.00	200.00	100.00
PCT Fees - International Stage					
Fee Code	**37 CFR**	**Description**	**Fee**	**Small Entity Fee**	**Micro Entity Fee**
1601/2601/3601	1.445(a)(1)(i)(A)	Transmittal fee	240.00	120.00	60.00
1690/2690/3690	1.445(a)(1)(ii)	Non-electronic filing fee (additional fee for applications filed in paper)	400.00	200.00	200.00
1602/2602/3602	1.445(a)(2)(i)	Search fee - regardless of whether there is a corresponding application (see 35 U.S.C. 361(d) and PCT Rule 16)	2,080.00	1,040.00	520.00
1604/2604/3604	1.445(a)(3)(i)	Supplemental search fee when required, per additional invention	2,080.00	1,040.00	520.00
1621/2621/3621	1.445(a)(4)(i)	Transmitting application to Intl. Bureau to act as receiving office	240.00	120.00	60.00
1605/2605/3605	1.482(a)(1)(i)(A)	Preliminary examination fee - U.S. was the ISA	600.00	300.00	150.00
1606/2606/3606	1.482(a)(1)(ii)(A)	Preliminary examination fee - U.S. was not the ISA	760.00	380.00	190.00

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1607/2607/3607	1.482(a)(2)(i)	Supplemental examination fee per additional invention	600.00	300.00	150.00
1619/2619/3619		Late payment fee	variable	variable	variable
1627/2627/3627	1.445(a)(5) and 1.482(c)	Late furnishing fee for providing a sequence listing in response to an invitation under PCT rule 13*ter*	300.00	150.00	75.00
PCT Fees to Foreign Offices**					
Fee Code	**37 CFR**	**Description**	**Fee**	**Small Entity Fee**	**Micro Entity Fee**
1701		International filing fee (first 30 pages - filed electronically without ePCT or PCT-EASY .zip file)	1,250.00	1,250.00	1,250.00
1710		International filing fee (first 30 pages - filed electronically with ePCT or PCT-EASY .zip file)	1,149.00	1,149.00	1,149.00
1702		International filing fee (first 30 pages)	1,352.00	1,352.00	1,352.00
1703		Supplemental fee (for each page over 30)	15.00	15.00	15.00
1704		International search (EPO)	2,053.00	2,053.00	2,053.00
1715		International search (ILPO)	963.00	963.00	963.00
1712		International search (IPAU)	1,589.00	1,589.00	1,589.00
1717		International search (IPOS)	1,633.00	1,633.00	1,633.00
1716		International search (JPO)	1,369.00	1,369.00	1,369.00
1709		International search (KIPO)	1,169.00	1,169.00	1,169.00
1714		International search (Rospatent)	612.00	612.00	612.00
1705		Handling fee	203.00	203.00	203.00
1706		Handling Fee - 90% reduction, if applicant meets criteria specified at: http://www.wipo.int/pct/en/fees/fee_reduction.pdf	20.30	20.30	20.30
** PCT Fees to Foreign Offices subject to periodic change due to fluctuations in exchange rate.					
Hague - International Design Application Fees					
Fee Code	**37 CFR**	**Description**	**Fee**	**Small Entity Fee**	**Micro Entity Fee**
1781/2781/3781	1.1031(a)	Hague International Design Application - Transmittal fee	120.00	60.00	30.00
1782	1.1031(c)	International design application fees payable to WIPO	variable	variable	variable
Patent Service Fees					
Fee Code	**37 CFR**	**Description**	**Fee**	**Small Entity Fee**	**Micro Entity Fee**
8001	1.19(a)(1)	Printed copy of patent w/o color, delivery by USPS, USPTO Box, or electronic means	3.00	3.00	3.00
8005	1.19(a)(1)	Patent Application Publication (PAP)	3.00	3.00	3.00
8003	1.19(a)(2)	Printed copy of plant patent in color	15.00	15.00	15.00
8004	1.19(a)(3)	Color copy of patent (other than plant patent) containing a color drawing	25.00	25.00	25.00

8007	1.19(b)(1)(i)(A) and (ii)(A)	Copy of patent application as filed	35.00	35.00	35.00
8051	1.19(b)(1)(i)(B)	Copy patent file wrapper, paper medium, any number of sheets	280.00	280.00	280.00
8010	1.19(b)(1)(i)(D)	Individual application documents, other than application as filed, per document	25.00	25.00	25.00
8052	1.19(b)(1)(ii)(B)	Copy patent file wrapper, electronic medium, any size or provided electronically	55.00	55.00	55.00
8013	1.19(b)(3)	Copy of office records, except copies of applications as filed	25.00	25.00	25.00
8014	1.19(b)(4)	For assignment records, abstract of title and certification, per patent	35.00	35.00	35.00
8904	1.19(c)	Library service	50.00	50.00	50.00
8017	1.19(f)	Copy of non-U.S. document	25.00	25.00	25.00
8057	1.19(j)	Copy of Patent Technology Monitoring Team (PTMT) patent bibliographic extract and other DVD (optical disc)	50.00	50.00	50.00
8058	1.19(k)	Copy of U.S. patent custom data extracts	100.00	100.00	100.00
8059	1.19(l)	Copy of selected technology reports, miscellaneous technology areas	30.00	30.00	30.00
8020	1.21(e)	International type search report	40.00	40.00	40.00
n/a	1.21(h)(1)	Recording each patent assignment, agreement or other paper, per property – if submitted electronically	0.00	0.00	0.00
8021	1.21(h)(2)	Recording each patent assignment, agreement or other paper, per property – if not submitted electronically	50.00	50.00	50.00
8022	1.21(i)	Publication in Official Gazette	25.00	25.00	25.00
8026	1.21(n)	Handling fee for incomplete or improper application	130.00	130.00	130.00
8053	1.21(p)	Additional fee for overnight delivery	40.00	40.00	40.00
8054	1.21(q)	Additional fee for expedited service	160.00	160.00	160.00

Patent Enrollment Fees			
Fee Code	**37 CFR**	**Description**	**Fee**
9001	1.21(a)(1)(i)	Application fee (non-refundable)	100.00
9010	1.21(a)(1)(ii)(A)	For test administration by commercial entity	200.00
9011	1.21(a)(1)(ii)(B)	For test administration by the USPTO	450.00
9029	1.21(a)(1)(iii)	For USPTO-administered review of registration examination	450.00
9003	1.21(a)(2)(i)	On registration to practice under §11.6	200.00
9026	1.21(a)(2)(ii)	On grant of limited recognition under §11.9(b)	200.00

9025	1.21(a)(2)(iii)	On change of registration from agent to attorney	100.00
9005	1.21(a)(4)(i)	Certificate of good standing as an attorney or agent, standard	40.00
9006	1.21(a)(4)(ii)	Certificate of good standing as an attorney or agent, suitable for framing	50.00
9012	1.21(a)(5)(i)	Review of decision by the Director of Enrollment and Discipline under §11.2(c)	400.00
9013	1.21(a)(5)(ii)	Review of decision of the Director of Enrollment and Discipline under §11.2(d)	400.00
9027	1.21(a)(6)(i)	For USPTO-assisted recovery of ID or reset of password for the Office of Enrollment and Discipline Information System	70.00
9028	1.21(a)(6)(ii)	For USPTO-assisted change of address within the Office of Enrollment and Discipline Information System	70.00
9020	1.21(a)(9)(i)	Delinquency fee	50.00
9004	1.21(a)(9)(ii)	Administrative reinstatement fee	200.00
9014	1.21(a)(10)	On petition for reinstatement by a person excluded or suspended on ethical grounds, or excluded on consent from practice before the Office	1,600.00
9024	1.21(k)	Unspecified other services, excluding labor	AT COST

Trademark Fees

The 7000 series fee code (e.g., 7001, 7002, etc.) is used for electronic filing via TEAS. The fee required when combining post-registration filings is the sum of the separate fee amounts shown below.

Trademark Processing Fees		Electronically Filed		Paper Filed	
37 CFR	Description	Fee Code	Fee Amount	Fee Code	Fee Amount
2.6(a)(1)(i)	Application for registration, per international class (paper filing)	n/a	n/a	6001	600.00
2.6(a)(1)(ii)	Application for registration, per international class (electronic filing, TEAS Regular application)	7001	400.00	n/a	n/a
2.6(a)(1)(iii)	Application for registration, per international class (electronic filing, TEAS RF application)	7009	275.00	n/a	n/a
2.6(a)(1)(iv)	Application for registration, per international class (electronic filing, TEAS Plus application)	7007	225.00	n/a	n/a
2.6(a)(2)	Filing an amendment to allege use under §1(c), per class	7002	100.00	6002	200.00
2.6(a)(3)	Filing a statement of use under §1(d)(1), per class	7003	100.00	6003	200.00

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2.6(a)(4)	Filing a request for a six-month extension of time for filing a statement of use under §1(d)(1), per class	7004	125.00	6004	225.00
2.6(a)(15)	Petitions to the Director	7005	100.00	6005	200.00
2.6(a)(19)	Dividing an application, per new application (file wrapper) created	7006	100.00	6006	200.00
2.6(a)(1)(v)	Additional fee for application that doesn't meet TEAS Plus or TEAS RF filing requirements, per class	7008	125.00	6008	125.00
2.6(a)(5)	Application for renewal under §9, per class	7201	300.00	6201	500.00
2.6(a)(6)	Additional fee for filing renewal application during grace period, per class	7203	100.00	6203	200.00
2.6(a)(21)	Correcting a deficiency in a renewal application	7204	100.00	6204	200.00
2.6(a)(12)	Filing §8 affidavit, per class	7205	125.00	6205	225.00
2.6(a)(14)	Additional fee for filing §8 affidavit during grace period, per class	7206	100.00	6206	200.00
2.6(a)(20)	Correcting a deficiency in a §8 affidavit	7207	100.00	6207	200.00
2.6(a)(13)	Filing §15 affidavit, per class	7208	200.00	6208	300.00
2.6(a)(7)	Publication of mark under §12(c), per class	7210	100.00	6210	200.00
2.6(a)(8)	Issuing new certificate of registration	7211	100.00	6211	200.00
2.6(a)(9)	Certificate of correction, registrant's error	7212	100.00	6212	200.00
2.6(a)(10)	Filing disclaimer to registration	7213	100.00	6213	200.00
2.6(a)(11)	Filing amendment to registration	7214	100.00	6214	200.00
2.6(a)(16)	Petition for cancellation, per class	7401	400.00	6401	500.00
2.6(a)(17)	Notice of opposition, per class	7402	400.00	6402	500.00
2.6(a)(18)	Ex parte appeal, per class	7403	200.00	6403	300.00
2.6(a)(22)	Filing a request for an extension of time to file a notice of opposition under §2.102(c)(1)(ii) or (c)(2)	7404	100.00	6404	200.00
2.6(a)(23)	Filing a request for an extension of time to file a notice of opposition under §2.102(c)(3)	7405	200.00	6405	300.00
Trademark Madrid Protocol Fees		**Electronically Filed**		**Paper Filed**	
37 CFR	**Description**	**Fee Code**	**Fee Amount**	**Fee Code**	**Fee Amount**
7.6(a)(1)	Certifying an international application based on single application or registration, per class	7901	100.00	6901	200.00
7.6(a)(2)	Certifying an international application based on more than one basic application or registration, per class	7902	150.00	6902	250.00
7.6(a)(4)	Transmitting a request to record an assignment or restriction under §7.23 or §7.24	7903	100.00	6903	200.00
7.6(a)(5)	Filing a notice of replacement under §7.28, per class	7904	100.00	6904	200.00
7.6(a)(6)	Filing an affidavit under §71 of the Act, per class	7905	125.00	6905	225.00
7.6(a)(7)	Surcharge for filing affidavit under §71 of the Act during grace period, per class	7906	100.00	6906	200.00
7.6(a)(3)	Transmitting a subsequent designation under §7.21	7907	100.00	6907	200.00

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7.6(a)(8)	Correcting a deficiency in an affidavit under §71 of the Act	7908	100.00	6908	200.00
Trademark International Application Fees		**Electronically Filed**		**Paper Filed**	
37 CFR	**Description**	**Fee Code**	**Fee Amount**	**Fee Code**	**Fee Amount**
7.7(1)	International application fee	7951	**Reference CFR 7.7 for payment of fees to International Bureau (IB) and the WIPO fee calculator (link is external).**	n/a	**Reference CFR 7.7 for payment of fees to International Bureau (IB) and the WIPO fee calculator (link is external).**
7.14(c)	Correcting irregularities in an International application	7952		n/a	
7.21	Subsequent designation fee	7953		n/a	
7.23	Recording of an assignment of an international registration under 7.23	7954		n/a	
Trademark Service Fees		**Electronically Filed**		**Paper Filed**	
37 CFR	**Description**	**Fee Code**	**Fee Amount**	**Fee Code**	**Fee Amount**
2.6(b)(1)	Printed copy of registered mark, delivery by USPS, USPTO Box, or electronic means	8501	3.00	8501	3.00
2.6(b)(4)(i)	Certified copy of registered mark, with title and/or status, regular service	8503	15.00	8503	15.00
2.6(b)(4)(ii)	Certified copy of registered mark, with title and/or status, expedited local service	8504	30.00	8504	30.00
2.6(b)(2)	Certified copy of trademark application as filed	8507	15.00	8507	15.00
2.6(b)(3)	Certified or uncertified copy of trademark-related file wrapper and contents	8508	50.00	8508	50.00
2.6(b)(5)	Certified or uncertified copy of trademark document, unless otherwise provided	8513	25.00	8513	25.00
2.6(b)(7)	For assignment records, abstracts of title and certification per registration	8514	25.00	8514	25.00
2.6(b)(6)	Recording trademark assignment, agreement or other paper, first mark per document	8521	40.00	8521	40.00
2.6(b)(6)	For second and subsequent marks in the same document	8522	25.00	8522	25.00
2.6(b)(9)	Additional fee for expedited service	8534	160.00	8534	160.00
2.6(b)(8)	Additional fee for overnight delivery	8533	40.00	8533	40.00

USPTO Fee Schedule

Fastener Quality Act Fees		Electronically Filed		Paper Filed	
37 CFR	Description	Fee Code	Fee Amount	Fee Code	Fee Amount
2.7(a)	Recordal application fee	n/a	n/a	6991	20.00
2.7(b)	Renewal application fee	n/a	n/a	6992	20.00
2.7(c)	Late fee for renewal application	n/a	n/a	6993	20.00
2.7(a)	Application fee for reactivation of insignia, per request	n/a	n/a	6994	20.00

General Service Fees

General Service Fees			
Fee Code	37 CFR	Description	Fee Amount
9202	1.21(b)(2), (b)(3) or 2.6(b)(11)	Service charge for below minimum balance	25.00
9101	1.21(m) or 2.6(b)(10)	Processing each payment refused or charged back	50.00

Case Law

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How to Read a Legal Opinion

A Guide for New Law Students

Orin S. Kerr

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How to Read a Legal Opinion

A Guide for New Law Students

Orin S. Kerr

This essay is designed to help new law students prepare for the first few weeks of class. It explains what judicial opinions are, how they are structured, and what law students should look for when reading them.

I. What's in a Legal Opinion?

When two people disagree and that disagreement leads to a lawsuit, the lawsuit will sometimes end with a ruling by a judge in favor of one side. The judge will explain the ruling in a written document referred to as an "opinion." The opinion explains what the case is about, discusses the relevant legal principles, and then applies the law to the facts to reach a ruling in favor of one side and against the other.

Modern judicial opinions reflect hundreds of years of history and practice. They usually follow a simple and predictable formula. This

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Orin Kerr is a professor of law at the George Washington University Law School.

with multiple judges. The name tells you which judge wrote that particular opinion. In older cases, the opinion often simply states a last name followed by the initial "J." No, judges don't all have the first initial "J." The letter stands for "Judge" or "Justice," depending on the court. On occasion, the opinion will use the Latin phrase "per curiam" instead of a judge's name. Per curiam means "by the court." It signals that the opinion reflects a common view among all the judges rather than the writings of a specific judge.

The Facts of the Case

Now let's move on to the opinion itself. The first part of the body of the opinion presents the facts of the case. In other words, what happened? The facts might be that Andy pulled out a gun and shot Bob. Or maybe Fred agreed to give Sally $100 and then changed his mind. Surprisingly, there are no particular rules for what facts a judge must include in the fact section of an opinion. Sometimes the fact sections are long, and sometimes they are short. Sometimes they are clear and accurate, and other times they are vague or incomplete.

Most discussions of the facts also cover the "procedural history" of the case. The procedural history explains how the legal dispute worked its way through the legal system to the court that is issuing the opinion. It will include various motions, hearings, and trials that occurred after the case was initially filed. Your civil procedure class is all about that kind of stuff; you should pay very close attention to the procedural history of cases when you read assignments for your civil procedure class. The procedural history of cases usually will be less important when you read a case for your other classes.

The Law of the Case

After the opinion presents the facts, it will then discuss the law. Many opinions present the law in two stages. The first stage discusses the general principles of law that are relevant to cases such as the one the court is deciding. This section might explore the history of a particular field of law or may include a discussion of past cases (known as "precedents") that are related to the case the court is de-

How to Read a Legal Opinion

Why should you care about this ancient history? The American colonists considered themselves Englishmen, so they used the English legal system and adopted its language. This means that American legal opinions today are littered with weird French terms. Examples include plaintiff, defendant, tort, contract, crime, judge, attorney, counsel, court, verdict, party, appeal, evidence, and jury. These words are the everyday language of the American legal system. And they're all from the French, brought to you by William the Conqueror in 1066.

This means that when you read a legal opinion, you'll come across a lot of foreign-sounding words to describe the court system. You need to learn all of these words eventually; you should read cases with a legal dictionary nearby and should look up every word you don't know. But this section will give you a head start by introducing you to some of the most common words, many of which (but not all) are French in origin.

Types of Disputes and the Names of Participants

There are two basic kinds of legal disputes: civil and criminal. In a civil case, one person files a lawsuit against another asking the court to order the other side to pay him money or to do or stop doing something. An award of money is called "damages" and an order to do something or to refrain from doing something is called an "injunction." The person bringing the lawsuit is known as the "plaintiff" and the person sued is called the "defendant."

In criminal cases, there is no plaintiff and no lawsuit. The role of a plaintiff is occupied by a government prosecutor. Instead of filing a lawsuit (or equivalently, "suing" someone), the prosecutor files criminal "charges." Instead of asking for damages or an injunction, the prosecutor asks the court to punish the individual through either jail time or a fine. The government prosecutor is often referred to as "the state," "the prosecution," or simply "the government." The person charged is called the defendant, just like the person sued in a civil case.

In legal disputes, each party ordinarily is represented by a lawyer. Legal opinions use several different words for lawyers, includ-

in error." Finally, some courts label an appeal as a "petition," and require the losing party to petition the higher court for relief. In these cases, the party that lost before the lower court and is filing the petition for review is called the "petitioner." The party that won before the lower court and is responding to the petition in the higher court is called the "respondent."

Confused yet? You probably are, but don't worry. You'll read so many cases in the next few weeks that you'll get used to all of this very soon.

III. What You Need to Learn from Reading a Case

Okay, so you've just read a case for class. You think you understand it, but you're not sure if you learned what your professor wanted you to learn. Here is what professors want students to know after reading a case assigned for class:

Know the Facts

Law professors love the facts. When they call on students in class, they typically begin by asking students to state the facts of a particular case. Facts are important because law is often highly fact-sensitive, which is a fancy way of saying that the proper legal outcome depends on the exact details of what happened. If you don't know the facts, you can't really understand the case and can't understand the law.

Most law students don't appreciate the importance of the facts when they read a case. Students think, "I'm in law school, not fact school; I want to know what the law is, not just what happened in this one case." But trust me: the facts are really important.[2]

[2] If you don't believe me, you should take a look at a few law school exams. It turns out that the most common form of law school exam question presents a long description of a very particular set of facts. It then asks the student to "spot" and analyze the legal issues presented by those facts. These exam questions are known as "issue-spotters," as they test the student's ability to understand the facts and spot the legal issues they raise. As you might imagine, doing well on an issue-

interpret "statutes," which is a fancy name for written laws passed by legislative bodies such as Congress. Still other cases interpret "the common law," which is a term that usually refers to the body of prior case decisions that derive ultimately from pre-1776 English law that the Colonists brought over from England.[3]

In your first year, the opinions that you read in your Torts, Contracts, and Property classes will mostly interpret the common law. Opinions in Criminal Law mostly interpret either the common law or statutes. Finally, opinions in your Civil Procedure casebook will mostly interpret statutory law or the Constitution. The source of law is very important because American law follows a clear hierarchy. Constitutional rules trump statutory (statute-based) rules, and statutory rules trump common law rules.

After you have identified the source of law, you should next identify the method of reasoning that the court used to justify its decision. When a case is governed by a statute, for example, the court usually will simply follow what the statute says. The court's role is narrow in such settings because the legislature has settled the law. Similarly, when past courts have already answered similar questions before, a court may conclude that it is required to reach a particular result because it is bound by the past precedents. This is an application of the judicial practice of "stare decisis," an abbreviation of a Latin phrase meaning "That which has been already decided should remain settled."

In other settings, courts may justify their decisions on public policy grounds. That is, they may pick the rule that they think is the best rule, and they may explain in the opinion why they think that rule is best. This is particularly likely in common law cases where judges are not bound by a statute or constitutional rule. Other courts will rely on morality, fairness, or notions of justice to justify

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[3] The phrase "common law" started being used about a thousand years ago to refer to laws that were common to all English citizens. Thus, the word "common" in the phrase "common law" means common in the sense of "shared by all," not common in the sense of "not very special." The "common law" was announced in judicial opinions. As a result, you will sometimes hear the phrase "common law" used to refer to areas of judge-made law as opposed to legislatively-made law.

when the law is unclear. Indeed, this skill of identifying when a problem is easy and when it is hard (in the sense of being unsettled or unresolved by the courts) is one of the keys to doing very well in law school. The best law students are the ones who recognize and identify these unsettled issues without pretending that they are easy.

Understand Any Concurring and/or Dissenting Opinions

You probably won't believe me at first, but concurrences and dissents are very important. You need to read them carefully. To understand why, you need to appreciate that law is man-made, and Anglo-American law has often been judge-made. Learning to "think like a lawyer" often means learning to think like a judge, which means learning how to evaluate which rules and explanations are strong and which are weak. Courts occasionally say things that are silly, wrongheaded, or confused, and you need to think independently about what judges say.

Concurring and dissenting opinions often do this work for you. Casebook authors edit out any unimportant concurrences and dissents to keep the opinions short. When concurrences and dissents appear in a casebook, it signals that they offer some valuable insights and raise important arguments. Disagreement between the majority opinion and concurring or dissenting opinions often frames the key issue raised by the case; to understand the case, you need to understand the arguments offered in concurring and dissenting opinions.

IV. Why Do Law Professors Use the Case Method?

I'll conclude by stepping back and explaining why law professors bother with the case method. Every law student quickly realizes that law school classes are very different from college classes. Your college professors probably stood at the podium and droned on while you sat back in your chair, safe in your cocoon. You're now starting law school, and it's very different. You're reading about actual cases, real-life disputes, and you're trying to learn about the law by picking up bits and pieces of it from what the opinions tell

need a vivid imagination; they need to imagine how rules might apply, where they might be unclear, and where they might lead to unexpected outcomes. The case method and the frequent use of hypotheticals will help train your brain to think this way. Learning the law in light of concrete situations will help you deal with particular facts you'll encounter as a practicing lawyer.

Good luck!

Articles

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Trade Secrets, Tech Innovations and the Changing Legal Landscape

FEBRUARY 6, 2018 02:58:00 PM | **Uche Ewelukwa**
Edited by: **Kelly Cullen**

JURIST Guest Columnist **Uché Ewelukwa** of **the University of Arkansas School of Law**, discusses the dynamic landscape of trade secret law in a multi-part series. In part 1, she introduces current legal trends in trade secrets ...

I. Introduction

2018 is already proving to be a busy year for trade secret owners, for attorneys that prosecute trade secrets misappropriation cases and for the judges who have to interpret and apply relevant laws. On January 24, 2018, a Wisconsin court **convicted** Chinese wind turbine maker Sinovel Wind Group Co. (Sinovel) of stealing trade secrets from U.S. company American Superconductor Corp. (AMSC). In a lawsuit filed on January 29, 2018, intelligent

electric car company Faraday Future **claims** its two former executives, CFO Stephan Krause and CTO Ulrich Kranz, stole its trade secrets when they left to form Evelozcity, Inc. Jury selection in the Waymo-Uber trade secret trial **concluded** on January 31, 2018; trial was set to start on February 5. What these three cases have in common are breakthrough technological innovations worth millions of dollars, cutthroat competition for global dominance in new and emerging sectors, and highly ambitious and very mobile tech employees. Against the backdrop of the 21st century's impressive technological revolution and a highly competitive marketplace, trade secrets are increasingly recognized as very important business assets. Reflecting the importance of trade secrets, a growing number of countries are taking unprecedented steps to ramp up their legal and regulatory framework for trade secret protection. Overall, recent studies show that trade secrets are playing a significantly increased role in the brand value and corporate strategies of companies big and small. Business executives that ignore or minimize the role of trade secrets in their corporate strategy do so at their own peril.

II. What is a Trade Secret?

According to the World Intellectual Property Organization, "any confidential business information which provides an enterprise a competitive edge" may qualify as a trade secret. In the U.S., the **Uniform Trade Secret Act** defines a trade secret as information, that "derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable," and "is the subject of efforts that are reasonable under the circumstances to maintain its secrecy." To qualify as trade secrets, three important condition must be met. First, the information must be valuable and must confer a competitive advantage on the owner. Second, the information must not be generally known or readily ascertainable. Third, the owner must take on-going reasonable effort to protect the secrecy. Famous examples of trade secrets include the Coca Cola formula, Google's search algorithm, and Kentucky Fried Chicken's original recipe.

III. Just How Important Are Trade Secrets?

Trade secrets are extremely important to mid-market companies, recent studies suggest. A June 2017 **report** by multinational law firm Baker McKenzie found that 82% of senior executives said their trade secrets are an important, if not essential, part of their businesses. The report also found that one in five companies has suffered trade secret theft and that many companies do not know if they have been the victim of trade secret misappropriation. A July 2017 **report** from the European Union Intellectual Property Office (EUIPO) came to similar conclusions. In the report the EUIPO concludes that while innovating firms often use both patents and trade secrets to protect their innovations, the use of trade secrets to protect innovations was higher than the of use patents by most types of companies, in most economic sectors and in all Member States

IV. What Are the Advantages of Trade Secrets Over Patents?

Trade secrets have some advantages over patents, such as:

- **Broad Subject Matter:** Patent protection is only available for processes, machines, manufactures, or composition of matters. Trade secret protection on the other hand is available over technological innovations, manufacturing processes, marketing plans, compilations, and indeed any information that gives the owner a competitive advantage. On October 6, 2017, a federal jury entered a $2.1 million trade secret verdict in the case of **Bimbo Bakeries USA, Inc. v. Sycamore**, a case that involved the recipe for making bread.
- **No Formal Registration or Examination:** In most jurisdiction, patents are granted by the government after a rigorous examination procedure. No formality or registration is required to enjoy trade secret protection.
- **Potentially Long Life Span:** Patents generally last for twenty years. A trade secret, on the other hand, can last forever provided it remains relatively secret and is the subject to continuing effort to protect secrecy.
- **Absolute Novelty Not Required:** The legal requirements for patentability are much more stringent that those for trade secrets and include the requirements of novelty and non-obviousness.

V. Do Patents Have Any Advantages Over Trade Secrets?

Although trade secrets has any advantages over patents, trade secret protection is not ideal for every type of technology and for every company. Compared to patents, the disadvantages of trade secrets include:

- **Possibility of Reverse Engineering:** In the U.S. and many other jurisdiction, it is lawful to reverse engineer a trade secret. A patent on the other hand cannot be reverse engineered.
- **Ease of loss:** Trade secrets can be lost through theft, industrial espionage, accidental disclosures and willful disclosure in breach of confidential relationships.
- **Independent Creation:** Independent creation is a complete defense to a trade secret misappropriation claim but is not a defense in a patent suit.
- **No Presumption of Validity** In the U.S., a patent is **presumed** valid until invalidated by a court. Trade secrets do not enjoy a similar presumption

VI. A Changing Legal Landscape?

The legal and regulatory landscape for trade secret protection is changing. First, a growing number of countries are passing specific trade secret laws. Second, countries are ramping up the penalties for trade secret theft. Third, some jurisdictions like the European Union (EU) are taking step to harmonize their trade secret laws.

- **European Union:** EU countries have until June 9, 2018 to bring their domestic legislation into compliance with **Directive (EU) 2016/943**, protecting trade secrets against unlawful acquisition, use and disclosure. The Directive was adopted on May 26, 2016, and aims at harmonizing the trade secret laws of EU Member States.
- **China:** The **General Provisions of the Civil Law of the People's Republic of China** was adopted at the 5th Session of the Twelfth National People's Congress of the People's Republic of China on March 15, 2017, and became effective October 1, 2017. Article 123 confirms that trade secrets are recognized and protected as a form of intellectual property in China.
- **United States:** In May 2016, the U.S. Congress passed the **Defend Trade Secrets Act of 2016** ("DTSA"), which creates a brand new federal civil cause of action for trade secret misappropriation. Section 2 of the DTSA states unequivocally that "[a]n owner of a trade secret that is misappropriated may bring a civil action." Before the DTSA, trade secret was primarily protected under state law.
- **Japan: Amendments** to Japan's Unfair Competition Prevention Act became effective on January 1, 2016. Among other things, the amendments expanded the punishment for the theft of trade secrets.
- **Subnational Governments (e.g. the State of Texas):** On 19 May 2017, Texas Governor Greg Abbott signed **House Bill 1995**, which amends several provisions of the Texas Uniform Trade Secrets Act to bring it into conformity with the DTSA.

VII. What Lessons for Businesses?

Long regarded as the stepchild of intellectual property rights, trade secrets are gradually coming into their own and are increasingly at the center of multi-million dollar lawsuits between major tech titans. The good news is that legal protection for trade secret is becoming stronger in a growing number of countries. The bad news is that with increased digitization, globalization, and the growing popularity of electronic communication technologies, trade secrets are extremely vulnerable to theft and unauthorized disclosure especially in sectors with high employee mobility. In Waymo v. Uber, a former Waymo employee allegedly stole 14,000 electronic files shortly before he left Waymo. At the center of **Sinovel's trade secret theft scandal** is Dejan Karabesevic, a former employee of a wholly-owned subsidiary of AMSC. On January 18, 2018, Xu Jiaquiang a former software developer for IBM Corp. was **sentenced** to five years in prison for stealing trade secrets belonging to IBM.

Patent or trade secrets? That is a tough question. The choice of protection strategy will frequently depend on a number of factors including the subject matter of innovation (whether production or process), the nature of the trade secret and the marketplace, the risk of disclosure, as well as business considerations such as the desire to sustain exclusivity for an extended period of time. Overall, evidence suggests that innovating firms

tend to combine patents with secrecy and use both to protect different aspects of their innovation. Companies choosing to rely on trade secrets must ensure the security of their innovations using a mix of physical security measures, legal (contractual) measures, and technological security measures.

Uché Ewelukwa is a professor of law at the University of Arkansas School of Law in Fayetteville, Arkansas, where she teaches in the international law and intellectual property fields and an active member of American Bar Association Section on International Law (ABA-SIL). Professor Ewelukwa has received numerous awards for her work including, Outstanding 2015 Year-in-Review Award from ABA-SIL and the 2009 Human Rights Essay Award from the Academy on Human Rights and Humanitarian Law.

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This article was prepared for publication by **Kelly Cullen**, a JURIST Section Editor. Please direct any questions or comments to him at **commentary@jurist.org**

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Trade Secrets (Part 2): The Defend Trade Secrets Act of 2016

FEBRUARY 8, 2018 07:00:00 PM | **Uche Ewelukwa**
Edited by: **Kelly Cullen**

JURIST Guest Columnist **Uché Ewelukwa** of **the University of Arkansas School of Law**, discusses the dynamic landscape of trade secret law in a multi-part series. In part 2, she discusses the Defend Trade Secrets Act of 2016 ...

I. Introduction

Signed into law on May 11, 2016, the **Defend Trade Secrets Act of 2016** ("DTSA") creates a new federal private right of civil action for trade secrets misappropriation. Section 2 of the DTSA states unequivocally that "[a]n owner of a trade secret that is misappropriated may bring a civil action." One of the most significant provisions of the DTSA is the *ex parte* seizure provision. The *ex parte* seizure provision gives trade secret owners the right, in

extraordinary circumstances, to request the court to order the seizure of property if necessary to prevent the propagation or dissemination of the trade secret that is the subject of an action. Are attorneys requesting *ex parte* seizure orders and are courts granting such requests? The questions are important because oftentimes there is an urgent need for a company to stop a departing employee or a former business partner from taking or disclosing proprietary information. In an explosive new lawsuit filed in January 2018, Faraday Futures **alleges** that a former executive, Bill Strickland, "copied and took potentially thousands of FF's most sensitive electronic documents from his FF computer and FF's servers." Tan Liu, a former employee of Rockwell Automation, Inc., was **charged** (since **acquitted**) with 12 counts of stealing trade secrets from Rockwell. Just before he left Rockwell, Liu allegedly downloaded 2,500 files containing Rockwell's proprietary software and source code.

II. *Ex Parte* Seizure Order Under the DTSA

Under the DTSA, a court may issue an *ex parte* seizure order "only in extraordinary circumstances." Courts appear to be reluctant to grant *ex parte* seizure orders and are granting it only in truly extraordinary circumstances. In **Mission Capital Advisors LLC v. Romaka**, the court awarded the first, and possibly the only, DTSA seizure order in the U.S. to date. In this case, Plaintiff Mission Capital Advisors LLC ("Mission") accused an employee, Romaka, of downloading confidential company files including contact lists. Forensic examination of Romaka's personal desktop had revealed that he had indeed downloaded a multitude of company files. Plaintiff requested a seizure order. When the defendant failed to acknowledge service or to show up for hearing, the court ordered the United States Marshals Service ("U.S. Marshal") to copy onto a storage medium and delete specific files (the Contact Lists of Plaintiff Mission Capital Advisors LLC.) on the Defendant's computer.

A request for an *ex parte* seizure order was denied in **Balearia Caribbean Ltd., Corp., v. Calvo**. Plaintiff Balearia Caribbean Ltd., Corp. ("BCL") alleged that its former Chief Executive Officer, Hernan Calvo, misappropriated its trade secrets. Just before he left BCL, Calvo had his personal laptop computer reconfigured to access Balearia's electronic information systems and secretly inserted an electronic command into his BCL email addresses to ensure that all email communications he received would be surreptitiously forwarded in their entirety to his private G-mail account. Nevertheless, the court denied BCL's request to seize Calvo's personal computer concluding that the applicant failed to demonstrate the "extraordinary circumstances contemplated by the DTSA."

In **OOO Brunswick Rail Management v. Sultanov**, plaintiffs OOO Brunswick Rail Management and Brunswick Rail Group Limited ("Brunswick") alleged that defendants, former employees, Richard Sultanov and Paul Ostling, misappropriated Brunswick's confidential information. Plaintiff filed an *ex parte* application for inter alia a seizure order under the DTSA, a seizure and preservation order under Rule 65, and expedited discovery.

The court granted the request for a seizure and preservation order under **Rule 65** but denied the request for a seizure order pursuant to the DTSA concluding that seizure under the DTSA was unnecessary because an order under Rule 65 was adequate.

Attorneys appear to be using the DTSA's *ex parte* seizure process sparingly and are instead opting for temporary restraining orders (TROs) and orders for expedited discovery. In **Henry Schein, Inc. v. Cook, Henry Schein, Inc.** (HSI) alleged that defendant and former employee Jennifer Cook looted confidential data, failed to return her laptop for two weeks after she stopped working for HSI, unlawfully accessed HSI's computer system after her resignation and attempted to erase the e-mails that she sent from her HSI computer. Granting the plaintiff's request for a TRO, the court ordered the defendant to "immediately preserve all documents, data, tangible things, and other materials relating to th[e] case." The defendant was also enjoined "from altering, destroying, or disposing of any evidence or other materials, in any form, relating to th[e] action," and "from directly or indirectly accessing, using, disclosing, or making available to any person or entity other than Plaintiff, any of HSI's confidential, proprietary, or trade secret documents, data or information."

So what can we learn from the handful of cases that have addressed the DTSA's *ex parte* seizure provisions?

First, courts are reluctant to issue *ex parte* seizure orders. The only *ex parte* seizure order under the Act to date is that issued in Mission Capital Advisors LLC v. Romaka.

Second, courts appear to be more willing to allow more common forms of pre-trial relief, such as expedited discovery and TROs. In **Dazzle Software II v. Kinney**, the court denied plaintiff's request for civil seizure of computers and computer storage devices pursuant to the DTSA but granted in part a motion for expedited discovery that permitted the plaintiff to take the depositions of several key witnesses.

Third, a lot can be achieved with an "ordinary" TRO under Rule 65. In **Earthbound Corporation v. MiTek USA, Inc.**, the TRO required the defendant to inter alia "immediately deliver to a neutral third-party expert ... all flash drives, SD cards, cell phones, and other external drives ... that are in Defendants' possession, custody, or control," for forensic imaging at defendants' expense. In **Panera, LLC v. Nettles**, the court ordered the defendant to provide his personal laptop and any other materials that may have housed plaintiff's information for review and inspection.

Fourth, even if a plaintiff is successful in getting an *ex parte* seizure order, such an order is likely to be limited. The DTSA stipulates that *ex parte* seizure orders shall "provide for the narrowest seizure of property necessary to achieve the purpose of [the statute]." Not surprising, in Mission Capital Advisors LLC v. Romaka, the court only allowed the seizure of a single document, a contact list.

III. Conclusions

The legal and regulatory landscape for trade secret protection is changing in the United States and around the world. The usefulness of some of the recent laws are beginning to be tested in courts. Although an important piece of legislation, reliance the DTSA's *ex parte* seizure provision is still limited but is likely to grow. When it comes to using trade secret to protect innovations, extreme vigilance backed-up by appropriate contractual, technological and physical security measures remains the word. However, where an invention is patentable, the risk of disclosure is high, and reverse engineering is highly possible, a company would be well advised to consider patents over trade secrets.

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Articles: Patent Gaps And Patent Diversity

Diversity Gaps in Innovation and Patenting: A Bibliography

By

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    - https://researchpark.illinois.edu/AWARE

- Empowering Women In Technology Startups (EWITS®)
    - "EWITS® provides educated women with hands-on entrepreneurial training and skills that will empower them for the rest of their lives. Many think of entrepreneurs as business people, but entrepreneurs come from all walks of life. EWITS® leverages women's unique skills and perspectives for new business creation and transforms them from employees to employers."
    - http://ewits.org/

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VI. Addressing Patenting and Innovation Gap Through Mentoring and Scholarships

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    - https://www.aiplef.org/
  - Hispanic National Bar Association/Microsoft Intellectual Property Law Institute (2019)
    - https://hnba.com/2018-hnbamicrosoft-intellectual-property-law-institute-ipli/
- Some law firms are beginning to offer 'diversity scholarships, fellowships or summer opportunities to diverse students in interest in intellectual property; others are creating programs that target women innovators.
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INTELLECTUAL PROPERTY

The Minority Gender Patent Gap

A minority gap in patenting -- just like other gaps -- is detrimental for our innovation system.

By KRISTA L. COX

Aug 2, 2018 at 5:42 PM

I previously wrote about an interesting study finding that women were granted patents at a far lower rate than men. While it is well known that women hold a lower number of patents than men, the study highlighted that inherent biases may play a role in the patent gender gap. For example, where an application listed inventors with obviously female names, they had a lower chance of being approved. Similarly, for female inventors who had patents granted, those with obviously female names were cited 30 percent less frequently than obviously male names, but for less common female names, patent citations actually increased over less common male names.

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women of color, in particular, are less likely to own patents. According to the report, Black and Hispanic women are particularly underrepresented. While this isn't exactly a groundbreaking revelation — we see diversity problems nearly everywhere — it's still important to address these issues. Unlike the study from earlier this year on the gender gap, this one focuses on trends and patent holdings, rather than looking at biases in the application process. Regardless of the *reason* behind the gap, this report should still be taken seriously and the innovation community must determine how to promote greater diversity and equity in the patent world.

Here's why it matters. Society benefits from diversity and we need new innovations from multifaceted perspectives to address existing problems. A problem that is more prevalent in a particular minority community may not be addressed if we do not have inventors from these communities. Even for an issue that applies to society as a whole, an invention created by a white man might only work for that population and leave unaddressed other aspects of concern to women and minorities.

While many have heralded technology as leveling the playing field and providing equal access (theoretically) to social media platforms, numerous systems have inherent biases that shape the way they operate. Last year, for example, Google Translate took heat for translating sentences from Turkish — which uses gender-neutral platforms — to English, in which the algorithms had to make a choice in translating gender. For example, when referencing a doctor in a gender-neutral way in Turkish, Google Translate spit out "He is a doctor." When referring to a teacher, Google Translate determined that the translation was, "She is a teacher." Translating from Turkish to English, Google translated the neutral pronoun to a male pronoun for engineers, soldiers and hardworking, while assuming a female pronoun for nurse, cook and lazy. Let's remember that algorithms are created by people and learn from existing culture and information; biases in the system are clearly problematic and perpetuate existing inequities.

Think Facebook's patent (if granted) for determining socio-economic status won't be filled with biases that disadvantage minority populations? Or take Amazon's facial recognition software, known as Rekognition, which in a test conducted by the ACLU mistakenly matched 28 members of Congress with mugshots, and "[t]he false matches were disproportionately

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in our test were of people of color, even though they make up only 20 percent of Congress." These biases also demonstrate the importance of greater diversity — both in terms of gender and race (as well as other overlooked communities, such as people with disabilities) — in patents and innovation.

As I noted in my post on the gender patent gap, inequities in the patent system can result in perpetuating the existing social, employment, and financial inequities; naturally, these points hold equally (if not more) true for a patent gap for minority women.

> A gender gap in patenting — just like other gaps — is detrimental for our innovation system. New inventions are less likely to adequately address gender-specific issues (or those for minorities, persons with disabilities, etc.). Women may be less likely to secure venture capital for a new business without a patent, making it more difficult to move forward. Inherent biases can perpetuate a multitude of historical problems associated with gender gaps, including financial inequity.

Businesses may find greater success when holding a patent and be more likely to get started or advance. Greater innovation by minority women therefore has the potential for more diverse solutions to existing problems, but also in allowing greater diversity in business.

How do we address this lack of diversity? In addition to various suggestions on creating a more blind review process for patent applications (such as through anonymization), we need to address other barriers to getting a patent in the first place. Those from underrepresented groups may be overwhelmed by the patent application process or lack the funds to pay the required fees. Even if they can come up with the money for PTO's fees, they may lack additional capital for a patent attorney to shepherd them through the process. While a patent attorney isn't necessary, it can certainly be helpful in ensuring a successful outcome.

Our innovation system will benefit in numerous ways from greater diversity, including from minority women and women more broadly. In order to promote such diversity, we need to change the patent application system and remove barriers for underrepresented groups.

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profit organizations and associations. She has expertise in copyright, patent, and intellectual property enforcement law, as well as international trade. She currently works for a non-profit member association advocating for balanced copyright. You can reach her at kristay@gmail.com.

TOPICS

Gender, Gender Gaps, Intellectual Property, Krista L. Cox, Minority Issues, Patents, Women's Issues

Closing the Gender Gap in Patenting, Innovation, and Commercialization

Programs Promoting Equity and Inclusion

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UNIVERSITY OF ARKANSAS | School of Law

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for Women and Minorities in STEM

WOMEN'S GIVING CIRCLE

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