

美國專利法

United States Code Title 35 - Patents

原文及譯文

Appendix L Patent Laws

United States Code Title 35 - Patents

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PART I — UNITED STATES PATENT AND TRADEMARK OFFICE

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35 U.S.C. 1 Establishment.

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

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

(c) **REFERENCE.**— For purposes of this title, the United States Patent and Trademark Office shall also be referred to as the “Office” and the “Patent and Trademark Office”.

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

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

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

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

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

(b) **SPECIFIC POWERS.**— The Office—

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

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

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

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

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

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

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

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

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

(4)(A) may make such purchases, contracts for the construction, or management and operation of facilities, and contracts for supplies or services, without regard to the provisions of subtitle I and chapter 33 of title 40, title III of the Federal Property and

Administrative Services Act of 1949 (41 U.S.C. 251 et seq.), and the McKinney-Vento Homeless Assistance Act (42 U.S.C. 11301 et seq.);

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

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

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

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

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

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

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

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

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

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

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

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

(c) CLARIFICATION OF SPECIFIC POWERS.—

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

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

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

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

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

(d) CONSTRUCTION.— Nothing in this section shall be construed to nullify, void, cancel, or interrupt any pending request-for-proposal let or con-

tract issued by the General Services Administration for the specific purpose of relocating or leasing space to the United States Patent and Trademark Office.

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

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

(a) UNDER SECRETARY AND DIRECTOR.—

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

(2) DUTIES.—

(A) **IN GENERAL.**— The Director shall be responsible for providing policy direction and management supervision for the Office and for the issuance of patents and the registration of trademarks. The Director shall perform these duties in a fair, impartial, and equitable manner.

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

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

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

(b) OFFICERS AND EMPLOYEES OF THE OFFICE.—

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

(2) COMMISSIONERS.—

(A) **APPOINTMENT AND DUTIES.**— The Secretary of Commerce shall appoint a Commissioner for Patents and a Commissioner for Trademarks, without regard to chapter 33, 51, or 53 of title 5. The Commissioner for Patents shall be a citizen of the United States with demonstrated management ability and professional background and experience in patent law and serve for a term of 5 years. The Commissioner for Trademarks shall be a citizen of the United States with demonstrated management ability and professional background and experience in trademark law and serve for a term of 5 years. The Commissioner for Patents and the Commissioner for Trademarks shall serve as the chief operating officers for the operations of the Office relating to patents and trademarks, respectively, and shall be responsible for the management and direction of all aspects of the activities of the Office that affect the administration of patent and trademark operations, respectively. The Secretary may reappoint a Commissioner to subsequent terms of 5 years as long as the performance of the Commissioner as set forth in the performance agreement in subparagraph (B) is satisfactory.

(B) **SALARY AND PERFORMANCE AGREEMENT.**— The Commissioners shall be paid an annual rate of basic pay not to exceed the maximum rate of basic pay for the Senior Executive Ser-

vice 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.

(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 this Act, if—

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

(B) such individual serves in a position that performed work in support of the Patent and Trademark Office during at least half of the incumbent's

work time, as determined by the Secretary of Commerce; or

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

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

(f) **TRANSITION PROVISIONS.—**

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

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

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

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

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

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

Officers and employees of the Patent and Trademark Office shall be incapable, during the period of

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

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

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

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

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

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

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

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

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

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

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

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

(d) DUTIES.— Each Advisory Committee shall—

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

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

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

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

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

(e) COMPENSATION.— Each member of each Advisory Committee shall be compensated for each day (including travel time) during which such member is attending meetings or conferences of that Advisory Committee or otherwise engaged in the business of that Advisory Committee, at the rate

which is the daily equivalent of the annual rate of basic pay in effect for level III of the Executive Schedule under section 5314 of title 5. While away from such member's home or regular place of business such member shall be allowed travel expenses, including per diem in lieu of subsistence, as authorized by section 5703 of title 5.

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

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

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

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

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

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

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

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

knowledge and scientific ability who are appointed by the Director.

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

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

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

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

35 U.S.C. 7 Library.

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

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

(Transferred from 35 U.S.C. 8 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4717(1)); amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

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

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

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

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

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

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

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

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

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

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

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

35 U.S.C. 10 Publications.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

CHAPTER 2 — PROCEEDINGS IN THE PATENT AND TRADEMARK OFFICE

- | | |
|------|---|
| Sec. | |
| 21 | Filing date and day for taking action. |
| 22 | Printing of papers filed. |
| 23 | Testimony in Patent and Trademark Office cases. |
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35 U.S.C. 21 Filing date and day for taking action.

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

deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Director.

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

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

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

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

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

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

The Director may establish rules for taking affidavits and depositions required in cases in the Patent and Trademark Office. Any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where he resides, may take such affidavits and depositions.

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

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

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

shall apply to contested cases in the Patent and Trademark Office.

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

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

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

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

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

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

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

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

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

(Added Mar. 26, 1964, Public Law 88-292, sec. 1, 78 Stat. 171; amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113,

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

CHAPTER 3 — PRACTICE BEFORE PATENT AND TRADEMARK OFFICE

Sec.

31 [Repealed]

32 Suspension or exclusion from practice.

33 Unauthorized representation as practitioner.

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

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

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

The Director may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent and Trademark Office, any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 2(b)(2)(D) of this title, or who shall, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The Director shall have the discretion to designate any attorney who is an officer or employee of the United States Patent and Trademark Office to conduct the hearing required by this section. The United States District Court for the District of Columbia, under such conditions and upon such proceedings as it by its rules determines, may review the action of the Director upon the petition of the person so refused recognition or so suspended or excluded.

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

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

Whoever, not being recognized to practice before the Patent and Trademark Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications

for patent, shall be fined not more than \$1,000 for each offense.

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

CHAPTER 4 — PATENT FEES; FUNDING; SEARCH SYSTEMS

Sec.

41 Patent fees; patent and trademark search systems.

42 Patent and Trademark Office funding.

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

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

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

(1) FILING AND BASIC NATIONAL FEES. —

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

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

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

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

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

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

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

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

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

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

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

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

(3) **EXAMINATION FEES.** —

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

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

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

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

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

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

(4) **ISSUE FEES.** —

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

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

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

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

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

(6) **APPEAL FEES.** —

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

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

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

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

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

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

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

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

(1) 3 years and 6 months after grant, \$900.

(2) 7 years and 6 months after grant, \$2,300.

(3) 11 years and 6 months after grant, \$3,800.

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

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

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

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

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

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

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

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

(3) In design and plant cases-

(A) on filing each design application, \$310;

(B) on filing each plant application, \$480;

(C) on issuing each design patent, \$430;

and

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

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

(B) In addition, on filing or on presentation at any other time, \$78 for each claim in independent form which is in excess of the number of independent claims of the original patent, and \$18 for each claim (whether independent or dependent) which is in excess of 20 and also in excess of the number of claims of the original patent.

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

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

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

(7) On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, \$1,210, unless the petition is filed under

section 133 or 151 of this title, in which case the fee shall be \$110.

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

(A) on filing a first petition, \$110;

(B) on filing a second petition, \$270; and

(C) on filing a third or subsequent petition, \$490.

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

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

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

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

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

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

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

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

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

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

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

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

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

use, offer for sale, or sale in the United States of which substantial preparation was made after the 6-month grace period but before the acceptance of a maintenance fee under this subsection, and the court may also provide for the continued practice of any process that is practiced, or for the practice of which substantial preparation was made, after the 6-month grace period but before the acceptance of a maintenance fee under this subsection, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced after the 6-month grace period but before the acceptance of a maintenance fee under this subsection.

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

(d) PATENT SEARCH AND OTHER FEES. —

(1) PATENT SEARCH FEES. —

(A) The Director shall charge a fee for the search of each application for a patent, except for provisional applications. The Director shall establish the fees charged under this paragraph to recover an amount not to exceed the estimated average cost to the Office of searching applications for patent either by acquiring a search report from a qualified search authority, or by causing a search by Office personnel to be made, of each application for patent. For the 3-year period beginning on the date of enactment of this Act, the fee for a search by a qualified search authority of a patent application described in clause (i), (iv), or (v) of subparagraph (B) may not exceed \$500, of a patent application described in clause (ii) of subparagraph (B) may not exceed \$100, and of a patent application described in clause (iii) of subparagraph (B) may not exceed \$300. The Director may not increase any such fee by more than 20 percent in each of the next three 1-year periods, and the Director may not increase any such fee thereafter.

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

(i) \$500 for each application for an original patent, except for design, plant, provisional, or international applications;

(ii) \$100 for each application for an original design patent;

(iii) \$300 for each application for an original plant patent;

(iv) \$500 for the national stage of each international application; and

(v) \$500 for each application for the reissue of a patent.

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

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

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

(i) the Director conducts a pilot program of limited scope, conducted over a period of not more than 18 months, which demonstrates that searches by commercial entities of the available prior art relating to the subject matter of inventions claimed in patent applications —

(I) are accurate; and

(II) meet or exceed the standards of searches conducted by and used by the Patent and Trademark Office during the patent examination process;

(ii) the Director submits a report on the results of the pilot program to Congress and the Patent Public Advisory Committee that includes —

(I) a description of the scope and duration of the pilot program;

(II) the identity of each commercial entity participating in the pilot program;

(III) an explanation of the methodology used to evaluate the accuracy and quality of the search reports; and

(IV) an assessment of the effects that the pilot program, as compared to searches conducted by the Patent and Trademark Office, had and will have on —

(aa) patentability determinations;

(bb) productivity of the Patent and Trademark Office;

(cc) costs to the Patent and Trademark Office;

(dd) costs to patent applicants; and

(ee) other relevant factors;

(iii) the Patent Public Advisory Committee reviews and analyzes the Director’s report under clause (ii) and the results of the pilot program and submits a separate report on its analysis to the Director and the Congress that includes —

(I) an independent evaluation of the effects that the pilot program, as compared to searches conducted by the Patent and Trademark Office, had and will have on the factors set forth in clause (ii)(IV); and

(II) an analysis of the reasonableness, appropriateness, and effectiveness of the methods used in the pilot program to make the evaluations required under clause (ii)(IV); and

(iv) Congress does not, during the 1-year period beginning on the date on which the Patent Public Advisory Committee submits its report to the Congress under clause (iii), enact a law prohibiting searches by commercial entities of the available prior art relating to the subject matter of inventions claimed in patent applications.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

(e) The Director may waive the payment of any fee for any service or material related to patents in connection with an occasional or incidental request made by a department or agency of the Government, or any officer thereof. The Director may provide any applicant issued a notice under section 132 of this title

with a copy of the specifications and drawings for all patents referred to in that notice without charge.

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

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

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

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

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

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

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

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

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

[(h)(1) Fees charged under subsection (a) or (b) shall be reduced by 50 percent with respect to their application to any small business concern as defined

under section 3 of the Small Business Act, and to any independent inventor or nonprofit organization as defined in regulations issued by the Director.

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

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

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

(3) The Director may establish reasonable fees for access by the public to the automated search systems of the Patent and Trademark Office. If such fees are established, a limited amount of free access shall be made available to users of the systems for purposes of education and training. The Director may waive the payment by an individual of fees authorized by this subsection upon a showing of need or hardship, and if such waiver is in the public interest.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

(b) All fees paid to the Director and all appropriations for defraying the costs of the activities of the Patent and Trademark Office will be credited to the Patent and Trademark Office Appropriation Account in the Treasury of the United States.

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

proportionate share of the administrative costs of the Patent and Trademark Office.

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

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

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

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

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

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

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

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

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

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

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

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

PART II — PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

CHAPTER 10 — PATENTABILITY OF INVENTIONS

Sec.

100 Definitions.

101 Inventions patentable.

102 Conditions for patentability; novelty and loss of right to patent.

103 Conditions for patentability; non-obvious subject matter.

104 Invention made abroad.

105 Inventions in outer space.

35 U.S.C. 100 Definitions.

When used in this title unless the context otherwise indicates -

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

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

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

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

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

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

35 U.S.C. 101 Inventions patentable.

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

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

A person shall be entitled to a patent unless —

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

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

(c) he has abandoned the invention, or

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

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

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

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

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

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

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

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

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

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

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

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

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

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

(i) express an exogenous nucleotide sequence,

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

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

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

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

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

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

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

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

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

(3) For purposes of paragraph (2), the term “joint research agreement” means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

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

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

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

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

(a) IN GENERAL.—

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

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

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

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

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

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

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

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

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

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

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

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

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

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

CHAPTER 11 — APPLICATION FOR PATENT

Sec.

- 111 Application.
- 112 Specification.
- 113 Drawings.
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- 116 Inventors.
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- 119 Benefit of earlier filing date; right of priority.
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35 U.S.C. 111 Application.

(a) IN GENERAL.—

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

(2) CONTENTS.—Such application shall include—

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

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

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

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

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

(b) PROVISIONAL APPLICATION.—

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

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

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

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

(3) FEE.—

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

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

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

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

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

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

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

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

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

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

35 U.S.C. 112 Specification.

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

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

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

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

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

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

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

35 U.S.C. 113 Drawings.

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

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

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

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

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

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

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

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

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

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

35 U.S.C. 116 Inventors.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

(g) As used in this section—

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

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

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

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

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

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

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

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

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

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

35 U.S.C. 121 Divisional applications.

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

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

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

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

(b) PUBLICATION.—

(1) IN GENERAL.—

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

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

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

(2) EXCEPTIONS.—

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

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

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

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

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

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

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

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

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

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

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

CHAPTER 12 — EXAMINATION OF APPLICATION

Sec.

131 Examination of application.

132 Notice of rejection; reexamination.

133 Time for prosecuting application.

134 Appeal to the Board of Patent Appeals and Interferences.

135 Interferences.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

35 U.S.C. 135 Interferences.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

CHAPTER 13 — REVIEW OF PATENT AND TRADEMARK OFFICE DECISION

Sec.

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

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

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

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

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

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

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

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

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

With respect to an appeal described in section 142 of this title, the Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the Director forward the original or certified copies of such documents during the pendency of the appeal. In an ex parte case or any reexamination case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.

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

35 U.S.C. 144 Decision on appeal.

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

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

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

An applicant dissatisfied with the decision of the Board of Patent Appeals and Interferences in an appeal under section 134(a) of this title may, unless appeal has been taken to the United States Court of Appeals for the Federal Circuit, have remedy by civil action against the Director in the United States District Court for the District of Columbia if commenced

within such time after such decision, not less than sixty days, as the Director appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Patent Appeals and Interferences, as the facts in the case may appear, and such adjudication shall authorize the Director to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

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

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

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

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

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)).)

CHAPTER 14 — ISSUE OF PATENT

Sec.

- 151 Issue of patent.
- 152 Issue of patent to assignee.
- 153 How issued.
- 154 Contents and term of patent; provisional rights.
- 155 Patent term extension.
- 155A Patent term restoration.
- 156 Extension of patent term.
- 157 Statutory invention registration.

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

If it appears that 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 or a portion thereof, which shall be paid within three months thereafter.

Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof, and, if not paid, the patent shall lapse at the termination of this three-month period. In calculating the amount of a remaining balance, charges for a page or less may be disregarded.

If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be accepted by the Director as though no abandonment or lapse had ever occurred.

(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)).)

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.

(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, or 365(c) of this title, from the date on which the earliest such application was filed.

(3) **PRIORITY.**—Priority under section 119, 365(a), or 365(b) of this title 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 of this title or a notice of allowance under section 151 of this title not later than 14 months after—

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

(II) the date on which an international application fulfilled the requirements of section 371 of this title;

(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 in the United States, 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.

(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 with the written notice of allowance of the application under section 151; 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 a determination made by the Director under paragraph (3) shall have remedy by a civil action against the Director filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent. 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 of this title 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)) of this title.

(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, 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.)

35 U.S.C. 155 Patent term extension.

Notwithstanding the provisions of section 154, the term of a patent which encompasses within its scope a composition of matter or a process for using such composition shall be extended if such composition or process has been subjected to a regulatory review by the Federal Food and Drug Administration pursuant to the Federal Food, Drug and Cosmetic Act leading to the publication of regulation permitting the interstate distribution and sale of such composition or process and for which there has thereafter been a stay of regulation of approval imposed pursuant to section 409 of the Federal Food, Drug and Cosmetic Act, which stay was in effect on January 1, 1981, by a length of time to be measured from the date such stay of regulation of approval was imposed until such proceedings are finally resolved and commercial marketing permitted. The patentee, his heirs, successors, or assigns shall notify the Director within 90 days of the date of enactment of this section or the date the stay of regulation of approval has been removed, whichever is later, of the number of the patent to be extended and the date the stay was imposed and the date commercial marketing was permitted. On receipt of such notice, the Director shall promptly issue to the owner of record of the patent a certificate of extension, under seal, stating the fact and length of the extension and identifying the composition of matter or process for using such composition to which such extension is

applicable. Such certificate shall be recorded in the official file of each patent extended and such certificate shall be considered as part of the original patent, and an appropriate notice shall be published in the Official Gazette of the Patent and Trademark Office.

(Added Jan. 4, 1983, Public Law 97-414, sec. 11(a), 96 Stat. 2065; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 secs. 4732(a)(6) and 4732(a)(10)(A)).)

35 U.S.C. 155A Patent term restoration.

(a) Notwithstanding section 154 of this title, the term of each of the following patents shall be extended in accordance with this section:

(1) Any patent which encompasses within its scope a composition of matter which is a new drug product, if during the regulatory review of the product by the Federal Food and Drug Administration —

(A) the Federal Food and Drug Administration notified the patentee, by letter dated February 20, 1976, that such product's new drug application was not approvable under section 505(b)(1) of the Federal Food, Drug and Cosmetic Act;

(B) in 1977 the patentee submitted to the Federal Food and Drug Administration the results of a health effects test to evaluate the carcinogenic potential of such product;

(C) the Federal Food and Drug Administration approved, by letter dated December 18, 1979, the new drug application for such application; and

(D) the Federal Food and Drug Administration approved, by letter dated May 26, 1981, a supplementary application covering the facility for the production of such product.

(2) Any patent which encompasses within its scope a process for using the composition described in paragraph (1).

(b) The term of any patent described in subsection (a) shall be extended for a period equal to the period beginning February 20, 1976, and ending May 26, 1981, and such patent shall have the effect as if originally issued with such extended term.

(c) The patentee of any patent described in subsection (a) of this section shall, within ninety days after the date of enactment of this section, notify the Director of the number of any patent so extended. On receipt of such notice, the Director shall confirm such extension by placing a notice thereof in the official file of such patent and publishing an appropriate

notice of such extension in the *Official Gazette* of the Patent and Trademark Office.

(Added Oct. 13, 1983, Public Law 98-127, sec. 4(a), 97 Stat. 832; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 secs. 4732(a)(7) and 4732(a)(10)(A)).)

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 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)(i) 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. 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;

(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.

(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 reviewing 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 the 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 Commissioner 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 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 paragraphs (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 regulating 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 day 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 peri-

ods 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 environment 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 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.

(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 103-465, sec. 532(c)(1), 108 Stat. 4987.)

(Subsection (f) amended Nov. 21, 1997, Public Law 105-115, sec. 125(b)(2)(P), 111 Stat. 2326.)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-560, 582 (S. 1948 secs. 4404 and 4732(a)(10)(A)).)

(Subsections (b)(3)(B), (d)(2)(B)(i), and (g)(6)(B)(iii) amended Nov. 2, 2002, Public Law 107-273, sec. 13206, 116 Stat. 1904.)

35 U.S.C. 157 Statutory invention registration.

(a) Notwithstanding any other provision of this title, the Director is authorized to publish a statutory invention registration containing the specification and drawings of a regularly filed application for a patent without examination if the applicant —

(1) meets the requirements of section 112 of this title;

(2) has complied with the requirements for printing, as set forth in regulations of the Director;

(3) waives the right to receive a patent on the invention within such period as may be prescribed by the Director; and

(4) pays application, publication, and other processing fees established by the Director.

If an interference is declared with respect to such an application, a statutory invention registration may not be published unless the issue of priority of invention is finally determined in favor of the applicant.

(b) The waiver under subsection (a)(3) of this section by an applicant shall take effect upon publication of the statutory invention registration.

(c) A statutory invention registration published pursuant to this section shall have all of the attributes specified for patents in this title except those specified

in section 183 and sections 271 through 289 of this title. A statutory invention registration shall not have any of the attributes specified for patents in any other provision of law other than this title. A statutory invention registration published pursuant to this section shall give appropriate notice to the public, pursuant to regulations which the Director shall issue, of the preceding provisions of this subsection. The invention with respect to which a statutory invention certificate is published is not a patented invention for purposes of section 292 of this title.

(d) The Director shall report to the Congress annually on the use of statutory invention registrations. Such report shall include an assessment of the degree to which agencies of the federal government are making use of the statutory invention registration system, the degree to which it aids the management of federally developed technology, and an assessment of the cost savings to the Federal Government of the uses of such procedures.

(Added Nov. 8, 1984, Public Law 98-622, sec. 102(a), 98 Stat. 3383; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582, 583 (S. 1948 secs. 4732(a)(10)(A) and 4732(a)(11)).)

CHAPTER 15 — PLANT PATENTS

Sec.

161 Patents for plants.

162 Description, claim.

163 Grant.

164 Assistance of the Department of Agriculture.

35 U.S.C. 161 Patents for plants.

Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids, and newly found seedlings, other than a tuber propagated plant or a plant found in an uncultivated state, may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided.

(Amended Sept. 3, 1954, 68 Stat. 1190.)

35 U.S.C. 162 Description, claim.

No plant patent shall be declared invalid for non-compliance with section 112 of this title if the description is as complete as is reasonably possible.

The claim in the specification shall be in formal terms to the plant shown and described.

35 U.S.C. 163 Grant.

In the case of a plant patent, the grant shall include the right to exclude others from asexually reproducing the plant, and from using, offering for sale, or selling the plant so reproduced, or any of its parts, throughout the United States, or from importing the plant so reproduced, or any parts thereof, into the United States.

(Amended Oct. 27, 1998, Public Law 105-289, sec. 3, 112 Stat. 2781.)

35 U.S.C. 164 Assistance of the Department of Agriculture.

The President may by Executive order direct the Secretary of Agriculture, in accordance with the requests of the Director, for the purpose of carrying into effect the provisions of this title with respect to plants (1) to furnish available information of the Department of Agriculture, (2) to conduct through the appropriate bureau or division of the Department research upon special problems, or (3) to detail to the Director officers and employees of the Department.

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

CHAPTER 16 — DESIGNS

Sec.

- 171 Patents for designs.
- 172 Right of priority.
- 173 Term of design patent.

35 U.S.C. 171 Patents for designs.

Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

35 U.S.C. 172 Right of priority.

The right of priority provided for by subsections (a) through (d) of section 119 of this title and the time specified in section 102(d) shall be six months in the

case of designs. The right of priority provided for by section 119(e) of this title shall not apply to designs.

(Amended Dec. 8, 1994, Public Law 103-465, sec. 532(c)(2), 108 Stat. 4987.)

35 U.S.C. 173 Term of design patent.

Patents for designs shall be granted for the term of fourteen years from the date of grant.

(Amended Aug. 27, 1982, Public Law 97-247, sec. 16, 96 Stat. 321; Dec. 8, 1994, Public Law 103-465, sec. 532(c)(3), 108 Stat. 4987.)

CHAPTER 17 — SECRECY OF CERTAIN INVENTIONS AND FILING APPLICATIONS IN FOREIGN COUNTRIES

Sec.

- 181 Secrecy of certain inventions and withholding of patent.
- 182 Abandonment of invention for unauthorized disclosure.
- 183 Right to compensation.
- 184 Filing of application in foreign country.
- 185 Patent barred for filing without license.
- 186 Penalty.
- 187 Nonapplicability to certain persons.
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35 U.S.C. 181 Secrecy of certain inventions and withholding of patent.

Whenever publication or disclosure by the publication of an application or by the grant of a patent on an invention in which the Government has a property interest might, in the opinion of the head of the interested Government agency, be detrimental to the national security, the Commissioner of Patents upon being so notified shall order that the invention be kept secret and shall withhold the publication of an application or the grant of a patent therefor under the conditions set forth hereinafter.

Whenever the publication or disclosure of an invention by the publication of an application or by the granting of a patent, in which the Government does not have a property interest, might, in the opinion of the Commissioner of Patents, be detrimental to the national security, he shall make the application for patent in which such invention is disclosed available for inspection to the Atomic Energy Commission, the Secretary of Defense, and the chief officer of any other department or agency of the Government desig-

nated by the President as a defense agency of the United States.

Each individual to whom the application is disclosed shall sign a dated acknowledgment thereof, which acknowledgment shall be entered in the file of the application. If, in the opinion of the Atomic Energy Commission, the Secretary of a Defense Department, or the chief officer of another department or agency so designated, the publication or disclosure of the invention by the publication of an application or by the granting of a patent therefor would be detrimental to the national security, the Atomic Energy Commission, the Secretary of a Defense Department, or such other chief officer shall notify the Commissioner of Patents and the Commissioner of Patents shall order that the invention be kept secret and shall withhold the publication of the application or the grant of a patent for such period as the national interest requires, and notify the applicant thereof. Upon proper showing by the head of the department or agency who caused the secrecy order to be issued that the examination of the application might jeopardize the national interest, the Commissioner of Patents shall thereupon maintain the application in a sealed condition and notify the applicant thereof. The owner of an application which has been placed under a secrecy order shall have a right to appeal from the order to the Secretary of Commerce under rules prescribed by him.

An invention shall not be ordered kept secret and the publication of an application or the grant of a patent withheld for a period of more than one year. The Commissioner of Patents shall renew the order at the end thereof, or at the end of any renewal period, for additional periods of one year upon notification by the head of the department or the chief officer of the agency who caused the order to be issued that an affirmative determination has been made that the national interest continues to so require. An order in effect, or issued, during a time when the United States is at war, shall remain in effect for the duration of hostilities and one year following cessation of hostilities. An order in effect, or issued, during a national emergency declared by the President shall remain in effect for the duration of the national emergency and six months thereafter. The Commissioner of Patents may rescind any order upon notification by the heads of the departments and the chief officers of the agencies who

caused the order to be issued that the publication or disclosure of the invention is no longer deemed detrimental to the national security.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-566, 582 (S. 1948 secs. 4507(7) and 4732(a)(10)(B)).)

35 U.S.C. 182 Abandonment of invention for unauthorized disclosure.

The invention disclosed in an application for patent subject to an order made pursuant to section 181 of this title may be held abandoned upon its being established by the Commissioner of Patents that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent of the Commissioner of Patents. The abandonment shall be held to have occurred as of the time of violation. The consent of the Commissioner of Patents shall not be given without the concurrence of the heads of the departments and the chief officers of the agencies who caused the order to be issued. A holding of abandonment shall constitute forfeiture by the applicant, his successors, assigns, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention.

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

35 U.S.C. 183 Right to compensation.

An applicant, his successors, assigns, or legal representatives, whose patent is withheld as herein provided, shall have the right, beginning at the date the applicant is notified that, except for such order, his application is otherwise in condition for allowance, or February 1, 1952, whichever is later, and ending six years after a patent is issued thereon, to apply to the head of any department or agency who caused the order to be issued for compensation for the damage caused by the order of secrecy and/or for the use of the invention by the Government, resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. The head of the department or agency is authorized, upon the presentation of a

claim, to enter into an agreement with the applicant, his successors, assigns, or legal representatives, in full settlement for the damage and/or use. This settlement agreement shall be conclusive for all purposes notwithstanding any other provision of law to the contrary. If full settlement of the claim cannot be effected, the head of the department or agency may award and pay to such applicant, his successors, assigns, or legal representatives, a sum not exceeding 75 per centum of the sum which the head of the department or agency considers just compensation for the damage and/or use. A claimant may bring suit against the United States in the United States Court of Federal Claims or in the District Court of the United States for the district in which such claimant is a resident for an amount which when added to the award shall constitute just compensation for the damage and/or use of the invention by the Government. The owner of any patent issued upon an application that was subject to a secrecy order issued pursuant to section 181 of this title, who did not apply for compensation as above provided, shall have the right, after the date of issuance of such patent, to bring suit in the United States Court of Federal Claims for just compensation for the damage caused by reason of the order of secrecy and/or use by the Government of the invention resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. In a suit under the provisions of this section the United States may avail itself of all defenses it may plead in an action under section 1498 of title 28. This section shall not confer a right of action on anyone or his successors, assigns, or legal representatives who, while in the full-time employment or service of the United States, discovered, invented, or developed the invention on which the claim is based.

(Amended Apr. 2, 1982, Public Law 97-164, sec. 160(a)(12), 96 Stat. 48; Oct. 29, 1992, Public Law 102-572, sec. 902 (b)(1), 106 Stat. 4516.)

35 U.S.C. 184 Filing of application in foreign country.

Except when authorized by a license obtained from the Commissioner of Patents a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an

invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner of Patents pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been filed abroad through error and without deceptive intent and the application does not disclose an invention within the scope of section 181 of this title.

The term “application” when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

The scope of a license shall permit subsequent modifications, amendments, and supplements containing additional subject matter if the application upon which the request for the license is based is not, or was not, required to be made available for inspection under section 181 of this title and if such modifications, amendments, and supplements do not change the general nature of the invention in a manner which would require such application to be made available for inspection under such section 181. In any case in which a license is not, or was not, required in order to file an application in any foreign country, such subsequent modifications, amendments, and supplements may be made, without a license, to the application filed in the foreign country if the United States application was not required to be made available for inspection under section 181 and if such modifications, amendments, and supplements do not, or did not, change the general nature of the invention in a manner which would require the United States application to have been made available for inspection under such section 181.

(Amended Aug. 23, 1988, Public Law 100-418, sec. 9101(b)(1), 102 Stat. 1567; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(B)).)

35 U.S.C. 185 Patent barred for filing without license.

Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184 of this title, have

made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid, unless the failure to procure such license was through error and without deceptive intent, and the patent does not disclose subject matter within the scope of section 181 of this title.

(Amended Aug. 23, 1988, Public Law 100-418, sec. 9101(b)(2), 102 Stat. 1568; Nov. 2, 2002, Public Law 107-273, sec. 13206, 116 Stat. 1904.)

35 U.S.C. 186 Penalty.

Whoever, during the period or periods of time an invention has been ordered to be kept secret and the grant of a patent thereon withheld pursuant to section 181 of this title, shall, with knowledge of such order and without due authorization, willfully publish or disclose or authorize or cause to be published or disclosed the invention, or material information with respect thereto, or whoever willfully, in violation of the provisions of section 184 of this title, shall file or cause or authorize to be filed in any foreign country an application for patent or for the registration of a utility model, industrial design, or model in respect of any invention made in the United States, shall, upon conviction, be fined not more than \$10,000 or imprisoned for not more than two years, or both.

(Amended Aug. 23, 1988, Public Law 100-418, sec. 9101(b)(3), 102 Stat. 1568.)

35 U.S.C. 187 Nonapplicability to certain persons.

The prohibitions and penalties of this chapter shall not apply to any officer or agent of the United States acting within the scope of his authority, nor to any person acting upon his written instructions or permission.

35 U.S.C. 188 Rules and regulations, delegation of power.

The Atomic Energy Commission, the Secretary of a defense department, the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States, and the Secretary of Commerce, may separately issue rules and regulations to enable the respec-

tive department or agency to carry out the provisions of this chapter, and may delegate any power conferred by this chapter.

CHAPTER 18 — PATENT RIGHTS IN INVENTIONS MADE WITH FEDERAL ASSISTANCE

Sec.

- 200 Policy and objective.
- 201 Definitions.
- 202 Disposition of rights.
- 203 March-in rights.
- 204 Preference for United States industry.
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35 U.S.C. 200 Policy and objective.

It is the policy and objective of the Congress to use the patent system to promote the utilization of inventions arising from federally supported research or development; to encourage maximum participation of small business firms in federally supported research and development efforts; to promote collaboration between commercial concerns and nonprofit organizations, including universities; to ensure that inventions made by nonprofit organizations and small business firms are used in a manner to promote free competition and enterprise without unduly encumbering future research and discovery; to promote the commercialization and public availability of inventions made in the United States by United States industry and labor; to ensure that the Government obtains sufficient rights in federally supported inventions to meet the needs of the Government and protect the public against nonuse or unreasonable use of inventions; and to minimize the costs of administering policies in this area.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3018; amended Nov. 1, 2000, Public Law 106-404, sec. 5, 114 Stat. 1745.)

35 U.S.C. 201 Definitions.

As used in this chapter —

(a) The term “Federal agency” means any executive agency as defined in section 105 of title 5, and the military departments as defined by section 102 of title 5.

(b) The term “funding agreement” means any contract, grant, or cooperative agreement entered into between any Federal agency, other than the Tennessee Valley Authority, and any contractor for the performance of experimental, developmental, or research work funded in whole or in part by the Federal Government. Such term includes any assignment, substitution of parties, or subcontract of any type entered into for the performance of experimental, developmental, or research work under a funding agreement as herein defined.

(c) The term “contractor” means any person, small business firm, or nonprofit organization that is a party to a funding agreement.

(d) The term “invention” means any invention or discovery which is or may be patentable or otherwise protectable under this title or any novel variety of plant which is or may be protectable under the Plant Variety Protection Act (7 U.S.C. 2321, et seq.).

(e) The term “subject invention” means any invention of the contractor conceived or first actually reduced to practice in the performance of work under a funding agreement: *Provided*, That in the case of a variety of plant, the date of determination (as defined in section 41(d) of the Plant Variety Protection Act (7 U.S.C. 2401(d)) must also occur during the period of contract performance.

(f) The term “practical application” means to manufacture in the case of a composition or product, to practice in the case of a process or method, or to operate in the case of a machine or system; and, in each case, under such conditions as to establish that the invention is being utilized and that its benefits are to the extent permitted by law or Government regulations available to the public on reasonable terms.

(g) The term “made” when used in relation to any invention means the conception or first actual reduction to practice of such invention.

(h) The term “small business firm” means a small business concern as defined at section 2 of Public Law 85-536 (15 U.S.C. 632) and implementing

regulations of the Administrator of the Small Business Administration.

(i) The term “nonprofit organization” means universities and other institutions of higher education or an organization of the type described in section 501(c)(3) of the Internal Revenue Code of 1986 (26 U.S.C. 501(c)) and exempt from taxation under section 501(a) of the Internal Revenue Code (26 U.S.C. 501(a)) or any nonprofit scientific or educational organization qualified under a State nonprofit organization statute.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3019.)

(Subsection (d) amended Nov. 8, 1984, Public Law 98-620, sec. 501(1), 98 Stat. 3364.)

(Subsection (e) amended Nov. 8, 1984, Public Law 98-620, sec. 501(2), 98 Stat. 3364.)

(Subsection (i) amended Oct. 22, 1986, Public Law 99-514, sec. 2, 100 Stat. 2095.)

(Subsection (a) amended Nov. 2, 2002, Public Law 107-273, sec. 13206, 116 Stat. 1904.)

35 U.S.C. 202 Disposition of rights.

(a) Each nonprofit organization or small business firm may, within a reasonable time after disclosure as required by paragraph (c)(1) of this section, elect to retain title to any subject invention: *Provided, however*, That a funding agreement may provide otherwise (i) when the contractor is not located in the United States or does not have a place of business located in the United States or is subject to the control of a foreign government, (ii) in exceptional circumstances when it is determined by the agency that restriction or elimination of the right to retain title to any subject invention will better promote the policy and objectives of this chapter, (iii) when it is determined by a Government authority which is authorized by statute or Executive order to conduct foreign intelligence or counterintelligence activities that the restriction or elimination of the right to retain title to any subject invention is necessary to protect the security of such activities, or (iv) when the funding agreement includes the operation of a Government-owned, contractor-operated facility of the Department of Energy primarily dedicated to that Department’s naval nuclear propulsion or weapons related programs and all funding agreement limitations under this subparagraph on the contractor’s right to elect title to a sub-

ject invention are limited to inventions occurring under the above two programs of the Department of Energy. The rights of the nonprofit organization or small business firm shall be subject to the provisions of paragraph (c) of this section and the other provisions of this chapter.

(b)(1) The rights of the Government under subsection (a) shall not be exercised by a Federal agency unless it first determines that at least one of the conditions identified in clauses (i) through (iii) of subsection (a) exists. Except in the case of subsection (a)(iii), the agency shall file with the Secretary of Commerce, within thirty days after the award of the applicable funding agreement, a copy of such determination. In the case of a determination under subsection (a)(ii), the statement shall include an analysis justifying the determination. In the case of determinations applicable to funding agreements with small business firms, copies shall also be sent to the Chief Counsel for Advocacy of the Small Business Administration. If the Secretary of Commerce believes that any individual determination or pattern of determinations is contrary to the policies and objectives of this chapter or otherwise not in conformance with this chapter, the Secretary shall so advise the head of the agency concerned and the Administrator of the Office of Federal Procurement Policy, and recommend corrective actions.

(2) Whenever the Administrator of the Office of Federal Procurement Policy has determined that one or more Federal agencies are utilizing the authority of clause (i) or (ii) of subsection (a) of this section in a manner that is contrary to the policies and objectives of this chapter the Administrator is authorized to issue regulations describing classes of situations in which agencies may not exercise the authorities of those clauses.

(3) At least once every 5 years, the Comptroller General shall transmit a report to the Committees on the Judiciary of the Senate and House of Representatives on the manner in which this chapter is being implemented by the agencies and on such other aspects of Government patent policies and practices with respect to federally funded inventions as the Comptroller General believes appropriate.

(4) If the contractor believes that a determination is contrary to the policies and objectives of this chapter or constitutes an abuse of discretion by the

agency, the determination shall be subject to the section 203(b).

(c) Each funding agreement with a small business firm or nonprofit organization shall contain appropriate provisions to effectuate the following:

(1) That the contractor disclose each subject invention to the Federal agency within a reasonable time after it becomes known to contractor personnel responsible for the administration of patent matters, and that the Federal Government may receive title to any subject invention not disclosed to it within such time.

(2) That the contractor make a written election within two years after disclosure to the Federal agency (or such additional time as may be approved by the Federal agency) whether the contractor will retain title to a subject invention: *Provided*, That in any case where publication, on sale, or public use, has initiated the one year statutory period in which valid patent protection can still be obtained in the United States, the period for election may be shortened by the Federal agency to a date that is not more than sixty days prior to the end of the statutory period: And *provided further*, That the Federal Government may receive title to any subject invention in which the contractor does not elect to retain rights or fails to elect rights within such times.

(3) That a contractor electing rights in a subject invention agrees to file a patent application prior to any statutory bar date that may occur under this title due to publication, on sale, or public use, and shall thereafter file corresponding patent applications in other countries in which it wishes to retain title within reasonable times, and that the Federal Government may receive title to any subject inventions in the United States or other countries in which the contractor has not filed patent applications on the subject invention within such times.

(4) With respect to any invention in which the contractor elects rights, the Federal agency shall have a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States any subject invention throughout the world: *Provided*, That the funding agreement may provide for such additional rights, including the right to assign or have assigned foreign patent rights in the subject invention, as are determined by the agency as necessary for meeting the

obligations of the United States under any treaty, international agreement, arrangement of cooperation, memorandum of understanding, or similar arrangement, including military agreements relating to weapons development and production.

(5) The right of the Federal agency to require periodic reporting on the utilization or efforts at obtaining utilization that are being made by the contractor or his licensees or assignees: *Provided*, That any such information, as well as any information on utilization or efforts at obtaining utilization obtained as part of a proceeding under section 203 of this chapter shall be treated by the Federal agency as commercial and financial information obtained from a person and privileged and confidential and not subject to disclosure under section 552 of title 5.

(6) An obligation on the part of the contractor, in the event a United States patent application is filed by or on its behalf or by any assignee of the contractor, to include within the specification of such application and any patent issuing thereon, a statement specifying that the invention was made with Government support and that the Government has certain rights in the invention.

(7) In the case of a nonprofit organization, (A) a prohibition upon the assignment of rights to a subject invention in the United States without the approval of the Federal agency, except where such assignment is made to an organization which has as one of its primary functions the management of inventions (provided that such assignee shall be subject to the same provisions as the contractor); (B) a requirement that the contractor share royalties with the inventor; (C) except with respect to a funding agreement for the operation of a Government-owned-contractor-operated facility, a requirement that the balance of any royalties or income earned by the contractor with respect to subject inventions, after payment of expenses (including payments to inventors) incidental to the administration of subject inventions, be utilized for the support of scientific research, or education; (D) a requirement that, except where it proves infeasible after a reasonable inquiry, in the licensing of subject inventions shall be given to small business firms; and (E) with respect to a funding agreement for the operation of a Government-owned-contractor-operator facility, requirements (i) that after payment of patenting costs, licensing costs, payments

to inventors, and other expenses incidental to the administration of subject inventions, 100 percent of the balance of any royalties or income earned and retained by the contractor during any fiscal year, up to an amount equal to 5 percent of the annual budget of the facility, shall be used by the contractor for scientific research, development, and education consistent with the research and development mission and objectives of the facility, including activities that increase the licensing potential of other inventions of the facility provided that if said balance exceeds 5 percent of the annual budget of the facility, that 75 percent of such excess shall be paid to the Treasury of the United States and the remaining 25 percent shall be used for the same purposes as described above in this clause (D); and (ii) that, to the extent it provides the most effective technology transfer, the licensing of subject inventions shall be administered by contractor employees on location at the facility.

(8) The requirements of sections 203 and 204 of this chapter.

(d) If a contractor does not elect to retain title to a subject invention in cases subject to this section, the Federal agency may consider and after consultation with the contractor grant requests for retention of rights by the inventor subject to the provisions of this Act and regulations promulgated hereunder.

(e) In any case when a Federal employee is a coinventor of any invention made with a nonprofit organization, a small business firm, or a non-Federal inventor, the Federal agency employing such coinventor may, for the purpose of consolidating rights in the invention and if it finds that it would expedite the development of the invention—

(1) license or assign whatever rights it may acquire in the subject invention to the nonprofit organization, small business firm, or non-Federal inventor in accordance with the provisions of this chapter; or

(2) acquire any rights in the subject invention from the nonprofit organization, small business firm, or non-Federal inventor, but only to the extent the party from whom the rights are acquired voluntarily enters into the transaction and no other transaction under this chapter is conditioned on such acquisition.

(f)(1) No funding agreement with a small business firm or nonprofit organization shall contain a provision allowing a Federal agency to require the licensing to third parties of inventions owned by the

contractor that are not subject inventions unless such provision has been approved by the head of the agency and a written justification has been signed by the head of the agency. Any such provision shall clearly state whether the licensing may be required in connection with the practice of a subject invention, a specifically identified work object, or both. The head of the agency may not delegate the authority to approve provisions or sign justifications required by this paragraph.

(2) A Federal agency shall not require the licensing of third parties under any such provision unless the head of the agency determines that the use of the invention by others is necessary for the practice of a subject invention or for the use of a work object of the funding agreement and that such action is necessary to achieve the practical application of the subject invention or work object. Any such determination shall be on the record after an opportunity for an agency hearing. Any action commenced for judicial review of such determination shall be brought within sixty days after notification of such determination.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3020; subsection (b)(4) added and subsections (a), (b)(1), (b)(2), (c)(4), (c)(5), and (c)(7) amended Nov. 8, 1984, Public Law 98-620, sec. 501, 98 Stat. 3364; subsection (b)(3) amended Dec. 10, 1991, Public Law 102-204, sec. 10, 105 Stat. 1641; subsection (a) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-583 (S. 1948 sec. 4732(a)(12)); subsection (e) amended Nov. 1, 2000, Public Law 106-404, sec. 6(1), 114 Stat. 1745; subsections (b)(4), (c)(4), and (c)(5) amended Nov. 2, 2002, Public Law 107-273, sec. 13206, 116 Stat. 1905.)

35 U.S.C. 203 March-in rights.

(a) With respect to any subject invention in which a small business firm or nonprofit organization has acquired title under this chapter, the Federal agency under whose funding agreement the subject invention was made shall have the right, in accordance with such procedures as are provided in regulations promulgated hereunder, to require the contractor, an assignee, or exclusive licensee of a subject invention to grant a nonexclusive, partially exclusive, or exclusive license in any field of use to a responsible applicant or applicants, upon terms that are reasonable under the circumstances, and if the contractor, assignee, or exclusive licensee refuses

such request, to grant such a license itself, if the Federal agency determines that such —

(1) action is necessary because the contractor or assignee has not taken, or is not expected to take within a reasonable time, effective steps to achieve practical application of the subject invention in such field of use;

(2) action is necessary to alleviate health or safety needs which are not reasonably satisfied by the contractor, assignee, or their licensees;

(3) action is necessary to meet requirements for public use specified by Federal regulations and such requirements are not reasonably satisfied by the contractor, assignee, or licensees; or

(4) action is necessary because the agreement required by section 204 has not been obtained or waived or because a licensee of the exclusive right to use or sell any subject invention in the United States is in breach of its agreement obtained pursuant to section 204.

(b) A determination pursuant to this section or section 202(b)(4) shall not be subject to the Contract Disputes Act (41 U.S.C. § 601 et seq.). An administrative appeals procedure shall be established by regulations promulgated in accordance with section 206. Additionally, any contractor, inventor, assignee, or exclusive licensee adversely affected by a determination under this section may, at any time within sixty days after the determination is issued, file a petition in the United States Court of Federal Claims, which shall have jurisdiction to determine the appeal on the record and to affirm, reverse, remand or modify, as appropriate, the determination of the Federal agency. In cases described in paragraphs (1) and (3) of subsection (a), the agency's determination shall be held in abeyance pending the exhaustion of appeals or petitions filed under the preceding sentence.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3022; amended Nov. 8, 1984, Public Law 98-620, sec. 501(9), 98 Stat. 3367; Oct. 29, 1992, Public Law 102-572, sec. 902(b)(1), 106 Stat. 4516; amended Nov. 2, 2002, Public Law 107-273, sec. 13206, 116 Stat. 1905.)

35 U.S.C. 204 Preference for United States industry.

Notwithstanding any other provision of this chapter, no small business firm or nonprofit organization which receives title to any subject invention and no assignee of any such small business firm or nonprofit

organization shall grant to any person the exclusive right to use or sell any subject invention in the United States unless such person agrees that any products embodying the subject invention or produced through the use of the subject invention will be manufactured substantially in the United States. However, in individual cases, the requirement for such an agreement may be waived by the Federal agency under whose funding agreement the invention was made upon a showing by the small business firm, nonprofit organization, or assignee that reasonable but unsuccessful efforts have been made to grant licenses on similar terms to potential licensees that would be likely to manufacture substantially in the United States or that under the circumstances domestic manufacture is not commercially feasible.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3023.)

35 U.S.C. 205 Confidentiality.

Federal agencies are authorized to withhold from disclosure to the public information disclosing any invention in which the Federal Government owns or may own a right, title, or interest (including a nonexclusive license) for a reasonable time in order for a patent application to be filed. Furthermore, Federal agencies shall not be required to release copies of any document which is part of an application for patent filed with the United States Patent and Trademark Office or with any foreign patent office.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3023.)

35 U.S.C. 206 Uniform clauses and regulations.

The Secretary of Commerce may issue regulations which may be made applicable to Federal agencies implementing the provisions of sections 202 through 204 of this chapter and shall establish standard funding agreement provisions required under this chapter. The regulations and the standard funding agreement shall be subject to public comment before their issuance.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3023; amended Nov. 8, 1984, Public Law 98-620, sec. 501(10), 98 Stat. 3367.)

35 U.S.C. 207 Domestic and foreign protection of federally owned inventions.

(a) Each Federal agency is authorized to —

(1) apply for, obtain, and maintain patents or other forms of protection in the United States and in foreign countries on inventions in which the Federal Government owns a right, title, or interest;

(2) grant nonexclusive, exclusive, or partially exclusive licenses under federally owned inventions, royalty-free or for royalties or other consideration, and on such terms and conditions, including the grant to the licensee of the right of enforcement pursuant to the provisions of chapter 29 of this title as determined appropriate in the public interest;

(3) undertake all other suitable and necessary steps to protect and administer rights to federally owned inventions on behalf of the Federal Government either directly or through contract, including acquiring rights for and administering royalties to the Federal Government in any invention, but only to the extent the party from whom the rights are acquired voluntarily enters into the transaction, to facilitate the licensing of a federally owned invention; and

(4) transfer custody and administration, in whole or in part, to another Federal agency, of the right, title, or interest in any federally owned invention.

(b) For the purpose of assuring the effective management of Government-owned inventions, the Secretary of Commerce authorized to -

(1) assist Federal agency efforts to promote the licensing and utilization of Government-owned inventions;

(2) assist Federal agencies in seeking protection and maintaining inventions in foreign countries, including the payment of fees and costs connected therewith; and

(3) consult with and advise Federal agencies as to areas of science and technology research and development with potential for commercial utilization.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3023; amended Nov. 8, 1984, Public Law 98-620, sec. 501(11), 98 Stat. 3367; subsections (a)(2) and (a)(3) amended Nov. 1, 2000, Public Law 106-404, sec. 6(2), 114 Stat. 1745.)

35 U.S.C. 208 Regulations governing Federal licensing.

The Secretary of Commerce is authorized to promulgate regulations specifying the terms and conditions upon which any federally owned invention, other than inventions owned by the Tennessee Valley Authority, may be licensed on a nonexclusive, partially exclusive, or exclusive basis.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3024; amended Nov. 8, 1984, Public Law 98-620, sec. 501(12), 98 Stat. 3367.)

35 U.S.C. 209 Licensing federally owned inventions.

(a) **AUTHORITY.**—A Federal agency may grant an exclusive or partially exclusive license on a federally owned invention under section 207(a)(2) only if—

(1) granting the license is a reasonable and necessary incentive to—

(A) call forth the investment capital and expenditures needed to bring the invention to practical application; or

(B) otherwise promote the invention's utilization by the public;

(2) the Federal agency finds that the public will be served by the granting of the license, as indicated by the applicant's intentions, plans, and ability to bring the invention to practical application or otherwise promote the invention's utilization by the public, and that the proposed scope of exclusivity is not greater than reasonably necessary to provide the incentive for bringing the invention to practical application, as proposed by the applicant, or otherwise to promote the invention's utilization by the public;

(3) the applicant makes a commitment to achieve practical application of the invention within a reasonable time, which time may be extended by the agency upon the applicant's request and the applicant's demonstration that the refusal of such extension would be unreasonable;

(4) granting the license will not tend to substantially lessen competition or create or maintain a violation of the Federal antitrust laws; and

(5) in the case of an invention covered by a foreign patent application or patent, the interests of the Federal Government or United States industry in foreign commerce will be enhanced.

(b) **MANUFACTURE IN UNITED STATES.**—A Federal agency shall normally grant a license under section 207(a)(2) to use or sell any federally owned invention in the United States only to a licensee who agrees that any products embodying the invention or produced through the use of the invention will be manufactured substantially in the United States.

(c) **SMALL BUSINESS.**—First preference for the granting of any exclusive or partially exclusive licenses under section 207(a)(2) shall be given to small business firms having equal or greater likelihood as other applicants to bring the invention to practical application within a reasonable time.

(d) **TERMS AND CONDITIONS.**—Any licenses granted under section 207(a)(2) shall contain such terms and conditions as the granting agency considers appropriate, and shall include provisions—

(1) retaining a nontransferrable, irrevocable, paid-up license for any Federal agency to practice the invention or have the invention practiced throughout the world by or on behalf of the Government of the United States;

(2) requiring periodic reporting on utilization of the invention, and utilization efforts, by the licensee, but only to the extent necessary to enable the Federal agency to determine whether the terms of the license are being complied with, except that any such report shall be treated by the Federal agency as commercial and financial information obtained from a person and privileged and confidential and not subject to disclosure under section 552 of title 5; and

(3) empowering the Federal agency to terminate the license in whole or in part if the agency determines that—

(A) the licensee is not executing its commitment to achieve practical application of the invention, including commitments contained in any plan submitted in support of its request for a license, and the licensee cannot otherwise demonstrate to the satisfaction of the Federal agency that it has taken, or can be expected to take within a reasonable time, effective steps to achieve practical application of the invention;

(B) the licensee is in breach of an agreement described in subsection (b);

(C) termination is necessary to meet requirements for public use specified by Federal regulations issued after the date of the license, and such

requirements are not reasonably satisfied by the licensee; or

(D) the licensee has been found by a court of competent jurisdiction to have violated the Federal antitrust laws in connection with its performance under the license agreement.

(e) PUBLIC NOTICE.—No exclusive or partially exclusive license may be granted under section 207(a)(2) unless public notice of the intention to grant an exclusive or partially exclusive license on a federally owned invention has been provided in an appropriate manner at least 15 days before the license is granted, and the Federal agency has considered all comments received before the end of the comment period in response to that public notice. This subsection shall not apply to the licensing of inventions made under a cooperative research and development agreement entered into under section 12 of the Stevenson-Wydler Technology Innovation Act of 1980 (15 U.S.C. 3710a).

(f) PLAN.—No Federal agency shall grant any license under a patent or patent application on a federally owned invention unless the person requesting the license has supplied the agency with a plan for development or marketing of the invention, except that any such plan shall be treated by the Federal agency as commercial and financial information obtained from a person and privileged and confidential and not subject to disclosure under section 552 of title 5.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3024; amended Nov. 1, 2000, Public Law 106-404, sec. 4, 114 Stat. 1743; subsections (d)(2) and (f) amended Nov. 2, 2002, Public Law 107-273, sec. 13206, 116 Stat. 1905.)

35 U.S.C. 210 Precedence of chapter.

(a) This chapter shall take precedence over any other Act which would require a disposition of rights in subject inventions of small business firms or non-profit organizations contractors in a manner that is inconsistent with this chapter, including but not necessarily limited to the following:

(1) section 10(a) of the Act of June 29, 1935, as added by title I of the Act of August 14, 1946 (7 U.S.C. 427i(a); 60 Stat. 1085);

(2) section 205(a) of the Act of August 14, 1946 (7 U.S.C. 1624(a); 60 Stat. 1090);

(3) section 501(c) of the Federal Mine Safety and Health Act of 1977 (30 U.S.C. 951(c); 83 Stat. 742);

(4) section 30168(e) of title 49;

(5) section 12 of the National Science Foundation Act of 1950 (42 U.S.C. 1871(a); 82 Stat. 360);

(6) section 152 of the Atomic Energy Act of 1954 (42 U.S.C. 2182; 68 Stat. 943);

(7) section 305 of the National Aeronautics and Space Act of 1958 (42 U.S.C. 2457);

(8) section 6 of the Coal Research and Development Act of 1960 (30 U.S.C. 666; 74 Stat. 337);

(9) section 4 of the Helium Act Amendments of 1960 (50 U.S.C. 167b; 74 Stat. 920);

(10) section 32 of the Arms Control and Disarmament Act of 1961 (22 U.S.C. 2572; 75 Stat. 634);

(11) section 9 of the Federal Nonnuclear Energy Research and Development Act of 1974 (42 U.S.C. 5908; 88 Stat. 1878);

(12) section 5(d) of the Consumer Product Safety Act (15 U.S.C. 2054(d); 86 Stat. 1211);

(13) section 3 of the Act of April 5, 1944 (30 U.S.C. 323; 58 Stat. 191);

(14) section 8001(c)(3) of the Solid Waste Disposal Act (42 U.S.C. 6981(c); 90 Stat. 2829);

(15) section 219 of the Foreign Assistance Act of 1961 (22 U.S.C. 2179; 83 Stat. 806);

(16) section 427(b) of the Federal Mine Health and Safety Act of 1977 (30 U.S.C. 937(b); 86 Stat. 155);

(17) section 306(d) of the Surface Mining and Reclamation Act of 1977 (30 U.S.C. 1226(d); 91 Stat. 455);

(18) section 21(d) of the Federal Fire Prevention and Control Act of 1974 (15 U.S.C. 2218(d); 88 Stat. 1548);

(19) section 6(b) of the Solar Photovoltaic Energy Research Development and Demonstration Act of 1978 (42 U.S.C. 5585(b); 92 Stat. 2516);

(20) section 12 of the Native Latex Commercialization and Economic Development Act of 1978 (7 U.S.C. 178j; 92 Stat. 2533); and

(21) section 408 of the Water Resources and Development Act of 1978 (42 U.S.C. 7879; 92 Stat. 1360).

The Act creating this chapter shall be construed to take precedence over any future Act unless

that Act specifically cites this Act and provides that it shall take precedence over this Act.

(b) Nothing in this chapter is intended to alter the effect of the laws cited in paragraph (a) of this section or any other laws with respect to the disposition of rights in inventions made in the performance of funding agreements with persons other than nonprofit organizations or small business firms.

(c) Nothing in this chapter is intended to limit the authority of agencies to agree to the disposition of rights in inventions made in the performance of work under funding agreements with persons other than nonprofit organizations or small business firms in accordance with the Statement of Government Patent Policy issued on February 18, 1983, agency regulations, or other applicable regulations or to otherwise limit the authority of agencies to allow such persons to retain ownership of inventions, except that all funding agreements, including those with other than small business firms and nonprofit organizations, shall include the requirements established in section 202(c)(4) and section 203 of this title. Any disposition of rights in inventions made in accordance with the Statement or implementing regulations, including any disposition occurring before enactment of this section, are hereby authorized.

(d) Nothing in this chapter shall be construed to require the disclosure of intelligence sources or methods or to otherwise affect the authority granted to the Director of Central Intelligence by statute or Executive order for the protection of intelligence sources or methods.

(e) The provisions of the Stevenson-Wydler Technology Innovation Act of 1980 shall take precedence over the provisions of this chapter to the extent that they permit or require a disposition of rights in subject inventions which is inconsistent with this chapter.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3026.)

(Subsection (c) amended Nov. 8, 1984, Public Law 98-620, sec. 501(13), 98 Stat. 3367.)

(Subsection (e) added Oct. 20, 1986, Public Law 99-502, sec. 9(c), 100 Stat. 1796.)

(Subsection (a)(4) amended July 5, 1994, Public Law 103-272, sec. 5(j), 108 Stat. 1375.)

(Subsection (e) amended Mar. 7, 1996, Public Law 104-113, sec. 7, 110 Stat. 779.)

(Subsection (a) amended Nov. 13, 1998, Public Law 105-393, sec. 220(c)(2), 112 Stat. 3625.)

(Subsections (a)(11), (a)(20), and (c) amended Nov. 2, 2002, Public Law 107-273, sec. 13206, 116 Stat. 1905.)

(Subsection (a)(8) amended Aug. 8, 2005, Public Law 109-58, sec. 1009(a)(2), 119 Stat. 984.)

35 U.S.C. 211 Relationship to antitrust laws.

Nothing in this chapter shall be deemed to convey to any person immunity from civil or criminal liability, or to create any defenses to actions, under any antitrust law.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3027.)

35 U.S.C. 212 Disposition of rights in educational awards.

No scholarship, fellowship, training grant, or other funding agreement made by a Federal agency primarily to an awardee for educational purposes will contain any provision giving the Federal agency any rights to inventions made by the awardee.

(Added Nov. 8, 1984, Public Law 98-620, sec. 501(14), 98 Stat. 3368.)

PART III — PATENTS AND PROTECTION OF PATENT RIGHTS

CHAPTER 25 — AMENDMENT AND CORRECTION OF PATENTS

Sec.	
251	Reissue of defective patents.
252	Effect of reissue.
253	Disclaimer.
254	Certificate of correction of Patent and Trademark Office mistake.
255	Certificate of correction of applicant's mistake.
256	Correction of named inventor.

35 U.S.C. 251 Reissue of defective patents.

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and

the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

(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. 252 Effect of reissue.

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are substantially identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are substantially identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

A reissued patent shall not abridge or affect the right of any person or that person's successors in business who, prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to continue the use of, to offer to sell, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported unless the making, using, offering for sale, or selling of such

thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use, offer for sale, or sale of the thing made, purchased, offered for sale, used, or imported as specified, or for the manufacture, use, offer for sale, or sale in the United States of which substantial preparation was made before the grant of the reissue, and the court may also provide for the continued practice of any process patented by the reissue that is practiced, or for the practice of which substantial preparation was made, before the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

(Amended Dec. 8, 1994, Public Law 103-465, sec. 533(b)(2), 108 Stat. 4989; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-566 (S. 1948 sec. 4507(8)).)

35 U.S.C. 253 Disclaimer.

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent and Trademark Office, and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

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

35 U.S.C. 254 Certificate of correction of Patent and Trademark Office mistake.

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Director may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A

printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Director may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

(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. 255 Certificate of correction of applicant's mistake.

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

(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. 256 Correction of named inventor.

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties con-

cerned and the Director shall issue a certificate accordingly.

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

CHAPTER 26 — OWNERSHIP AND ASSIGNMENT

Sec.

261 Ownership; assignment.

262 Joint owners.

35 U.S.C. 261 Ownership; assignment.

Subject to the provisions of this title, patents shall have the attributes of personal property.

Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States, or, in a foreign country, of a diplomatic or consular officer of the United States or an officer authorized to administer oaths whose authority is proved by a 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, shall be *prima facie* evidence of the execution of an assignment, grant, or conveyance of a patent or application for patent.

An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Aug. 27, 1982, Public Law 97-247, sec. 14(b), 96 Stat. 321.)

35 U.S.C. 262 Joint owners.

In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use,

offer to sell, or sell the patented invention within the United States, or import the patented invention into the United States, without the consent of and without accounting to the other owners.

(Amended Dec. 8, 1994, Public Law 103-465, sec. 533(b)(3), 108 Stat. 4989.)

CHAPTER 27 — GOVERNMENT INTERESTS IN PATENTS

Sec.

266 [Repealed.]

267 Time for taking action in Government applications.

35 U.S.C. 266 [Repealed.]

(Repealed July 24, 1965, Public Law 89-83, sec. 8, 79 Stat. 261.)

35 U.S.C. 267 Time for taking action in Government applications.

Notwithstanding the provisions of sections 133 and 151 of this title, the Director may extend the time for taking any action to three years, when an application has become the property of the United States and the head of the appropriate department or agency of the Government has certified to the Director that the invention disclosed therein is important to the armament or defense of the United States.

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

CHAPTER 28 — INFRINGEMENT OF PATENTS

Sec.

271 Infringement of patent.

272 Temporary presence in the United States.

273 Defense to infringement based on earlier inventor.

35 U.S.C. 271 Infringement of patent.

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States, or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination, or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial non-infringing use, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement; (4) refused to license or use any rights to the patent; or (5) conditioned the license of any rights to the patent or the sale of the patented product on the acquisition of a license to rights in another patent or purchase of a separate product, unless, in view of the circumstances, the patent owner has market power in the relevant market for the patent or patented product on which the license or sale is conditioned.

(e)(1) It shall not be an act of infringement to make, use, offer to sell, or sell within the United States or import into the United States a patented invention (other than a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Act of March 4, 1913) which is primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques) solely for uses reasonably related to the development and submission of information under a Federal law which regulates the manufacture, use, or sale of drugs or veterinary biological products.

(2) It shall be an act of infringement to submit —

(A) an application under section 505(j) of the Federal Food, Drug, and Cosmetic Act or described in section 505(b)(2) of such Act for a drug claimed in a patent or the use of which is claimed in a patent, or

(B) an application under section 512 of such Act or under the Act of March 4, 1913 (21 U.S.C. 151 - 158) for a drug or veterinary biological product which is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques and which is claimed in a patent or the use of which is claimed in a patent, if the purpose of such submission is to obtain approval under such Act to engage in the commercial manufacture, use, or sale of a drug or veterinary biological product claimed in a patent or the use of which is claimed in a patent before the expiration of such patent.

(3) In any action for patent infringement brought under this section, no injunctive or other relief may be granted which would prohibit the making, using, offering to sell, or selling within the United States or importing into the United States of a patented invention under paragraph (1).

(4) For an act of infringement described in paragraph (2)—

(A) the court shall order the effective date of any approval of the drug or veterinary biological product involved in the infringement to be a date which is not earlier than the date of the expiration of the patent which has been infringed,

(B) injunctive relief may be granted against an infringer to prevent the commercial manufacture, use, offer to sell, or sale within the United States or importation into the United States of an approved drug or veterinary biological product, and

(C) damages or other monetary relief may be awarded against an infringer only if there has been commercial manufacture, use, offer to sell, or sale within the United States or importation into the United States of an approved drug or veterinary biological product.

The remedies prescribed by subparagraphs (A), (B), and (C) are the only remedies which may be granted by a court for an act of infringement

described in paragraph (2), except that a court may award attorney fees under section 285.

(5) Where a person has filed an application described in paragraph (2) that includes a certification under subsection (b)(2)(A)(iv) or (j)(2)(A)(vii)(IV) of section 505 of the Federal Food, Drug, and Cosmetic Act (21 U.S.C. 355), and neither the owner of the patent that is the subject of the certification nor the holder of the approved application under subsection (b) of such section for the drug that is claimed by the patent or a use of which is claimed by the patent brought an action for infringement of such patent before the expiration of 45 days after the date on which the notice given under subsection (b)(3) or (j)(2)(B) of such section was received, the courts of the United States shall, to the extent consistent with the Constitution, have subject matter jurisdiction in any action brought by such person under section 2201 of title 28 for a declaratory judgment that such patent is invalid or not infringed.

(f)(1) Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

(2) Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

(g) Whoever without authority imports into the United States or offers to sell, sells, or uses within the United States a product which is made by a process patented in the United States shall be liable as an infringer, if the importation, offer to sell, sale, or use

of the product occurs during the term of such process patent. In an action for infringement of a process patent, no remedy may be granted for infringement on account of the noncommercial use or retail sale of a product unless there is no adequate remedy under this title for infringement on account of the importation or other use, offer to sell, or sale of that product. A product which is made by a patented process will, for purposes of this title, not be considered to be so made after —

(1) it is materially changed by subsequent processes; or

(2) it becomes a trivial and nonessential component of another product.

(h) As used in this section, the term “whoever” includes any State, any instrumentality of a State, any officer or employee of a State or instrumentality of a State acting in his official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this title in the same manner and to the same extent as any nongovernmental entity.

(i) As used in this section, an “offer for sale” or an “offer to sell” by a person other than the patentee or any assignee of the patentee, is that in which the sale will occur before the expiration of the term of the patent.

(Subsection (e) added Sept. 24, 1984, Public Law 98-417, sec. 202, 98 Stat. 1603.)

(Subsection (f) added Nov. 8, 1984, Public Law 98-622, sec. 101(a), 98 Stat. 3383.)

(Subsection (g) added Aug. 23, 1988, Public Law 100-418, sec. 9003, 102 Stat. 1564.)

(Subsection (e) amended Nov. 16, 1988, Public Law 100-670, sec. 201(i), 102 Stat. 3988.)

(Subsection (d) amended Nov. 19, 1988, Public Law 100-703, sec. 201, 102 Stat. 4676.)

(Subsection (h) added Oct. 28, 1992, Public Law 102-560, sec. 2(a)(1), 106 Stat. 4230.)

(Subsections (a), (c), (e), and (g) amended Dec. 8, 1994, Public Law 103-465, sec. 533(a), 108 Stat. 4988.)

(Subsection (i) added Dec. 8, 1994, Public Law 103-465, sec. 533(a), 108 Stat. 4988.)

(Subsection (e)(5) added Dec. 8, 2003, Public Law 108-173, sec. 1101(d), 117 Stat. 2457.)

35 U.S.C. 272 Temporary presence in the United States.

The use of any invention in any vessel, aircraft or vehicle of any country which affords similar privileges to vessels, aircraft, or vehicles of the United States, entering the United States temporarily or accidentally, shall not constitute infringement of any patent, if the invention is used exclusively for the needs of the vessel, aircraft, or vehicle and is not offered for sale or sold in or used for the manufacture of anything to be sold in or exported from the United States.

(Amended Dec. 8, 1994, Public Law 103-465, sec. 533(b)(4), 108 Stat. 4989.)

35 U.S.C. 273 Defense to infringement based on earlier inventor.

(a) DEFINITIONS.— For purposes of this section—

(1) the terms “commercially used” and “commercial use” mean use of a method in the United States, so long as such use is in connection with an internal commercial use or an actual arm’s-length sale or other arm’s-length commercial transfer of a useful end result, whether or not the subject matter at issue is accessible to or otherwise known to the public, except that the subject matter for which commercial marketing or use is subject to a premarketing regulatory review period during which the safety or efficacy of the subject matter is established, including any period specified in section 156(g), shall be deemed “commercially used” and in “commercial use” during such regulatory review period;

(2) in the case of activities performed by a nonprofit research laboratory, or nonprofit entity such as a university, research center, or hospital, a use for which the public is the intended beneficiary shall be considered to be a use described in paragraph (1), except that the use—

(A) may be asserted as a defense under this section only for continued use by and in the laboratory or nonprofit entity; and

(B) may not be asserted as a defense with respect to any subsequent commercialization or use outside such laboratory or nonprofit entity;

(3) the term “method” means a method of doing or conducting business; and

(4) the “effective filing date” of a patent is the earlier of the actual filing date of the application

for the patent or the filing date of any earlier United States, foreign, or international application to which the subject matter at issue is entitled under section 119, 120, or 365 of this title.

(b) DEFENSE TO INFRINGEMENT.—

(1) IN GENERAL.— It shall be a defense to an action for infringement under section 271 of this title with respect to any subject matter that would otherwise infringe one or more claims for a method in the patent being asserted against a person, if such person had, acting in good faith, actually reduced the subject matter to practice at least 1 year before the effective filing date of such patent, and commercially used the subject matter before the effective filing date of such patent.

(2) EXHAUSTION OF RIGHT.— The sale or other disposition of a useful end product produced by a patented method, by a person entitled to assert a defense under this section with respect to that useful end result shall exhaust the patent owner's rights under the patent to the extent such rights would have been exhausted had such sale or other disposition been made by the patent owner.

(3) LIMITATIONS AND QUALIFICATIONS OF DEFENSE.— The defense to infringement under this section is subject to the following:

(A) PATENT.— A person may not assert the defense under this section unless the invention for which the defense is asserted is for a method.

(B) DERIVATION.— A person may not assert the defense under this section if the subject matter on which the defense is based was derived from the patentee or persons in privity with the patentee.

(C) NOT A GENERAL LICENSE.— The defense asserted by a person under this section is not a general license under all claims of the patent at issue, but extends only to the specific subject matter claimed in the patent with respect to which the person can assert a defense under this chapter, except that the defense shall also extend to variations in the quantity or volume of use of the claimed subject matter, and to improvements in the claimed subject matter that do not infringe additional specifically claimed subject matter of the patent.

(4) BURDEN OF PROOF.— A person asserting the defense under this section shall have the

burden of establishing the defense by clear and convincing evidence.

(5) ABANDONMENT OF USE.— A person who has abandoned commercial use of subject matter may not rely on activities performed before the date of such abandonment in establishing a defense under this section with respect to actions taken after the date of such abandonment.

(6) PERSONAL DEFENSE.— The defense under this section may be asserted only by the person who performed the acts necessary to establish the defense and, except for any transfer to the patent owner, the right to assert the defense shall not be licensed or assigned or transferred to another person except as an ancillary and subordinate part of a good faith assignment or transfer for other reasons of the entire enterprise or line of business to which the defense relates.

(7) LIMITATION ON SITES.— A defense under this section, when acquired as part of a good faith assignment or transfer of an entire enterprise or line of business to which the defense relates, may only be asserted for uses at sites where the subject matter that would otherwise infringe one or more of the claims is in use before the later of the effective filing date of the patent or the date of the assignment or transfer of such enterprise or line of business.

(8) UNSUCCESSFUL ASSERTION OF DEFENSE.— If the defense under this section is pleaded by a person who is found to infringe the patent and who subsequently fails to demonstrate a reasonable basis for asserting the defense, the court shall find the case exceptional for the purpose of awarding attorney fees under section 285 of this title.

(9) INVALIDITY.— A patent shall not be deemed to be invalid under section 102 or 103 of this title solely because a defense is raised or established under this section.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-555 (S. 1948 sec. 4302).)

CHAPTER 29 — REMEDIES FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

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35 U.S.C. 281 Remedy for infringement of patent.

A patentee shall have remedy by civil action for infringement of his patent.

35 U.S.C. 282 Presumption of validity; defenses.

A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. Notwithstanding the preceding sentence, if a claim to a composition of matter is held invalid and that claim was the basis of a determination of nonobviousness under section 103(b)(1), the process shall no longer be considered nonobvious solely on the basis of section 103(b)(1). The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

- (1) Noninfringement, absence of liability for infringement, or unenforceability,
- (2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Federal Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires.

Invalidity of the extension of a patent term or any portion thereof under section 154(b) or 156 of this title because of the material failure—

- (1) by the applicant for the extension, or
- (2) by the Director, to comply with the requirements of such section shall be a defense in any action involving the infringement of a patent during the period of the extension of its term and shall be pleaded. A due diligence determination under section 156(d)(2) is not subject to review in such an action.

(Amended July 24, 1965, Public Law 89-83, sec. 10, 79 Stat. 261; Nov. 14, 1975, Public Law 94-131, sec. 10, 89 Stat. 692; Apr. 2, 1982, Public Law 97-164, sec. 161(7), 96 Stat. 49; Sept. 24, 1984, Public Law 98-417, sec. 203, 98 Stat. 1603; Oct. 29, 1992, Public Law 102-572, sec. 902(b)(1), 106 Stat. 4516; Nov. 1, 1995, Public Law 104-41, sec. 2, 109 Stat. 352; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-560, 582 (S. 1948 secs. 4402(b)(1) and 4732(a)(10)(A)).

35 U.S.C. 283 Injunction.

The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.

35 U.S.C. 284 Damages.

Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed. Increased damages under this paragraph shall not apply to provisional rights under section 154(d) of this title.

The court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances.

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

35 U.S.C. 285 Attorney fees.

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

35 U.S.C. 286 Time limitation on damages.

Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.

In the case of claims against the United States Government for use of a patented invention, the period before bringing suit, up to six years, between the date of receipt of a written claim for compensation by the department or agency of the Government having authority to settle such claim, and the date of mailing by the Government of a notice to the claimant that his claim has been denied shall not be counted as a part of the period referred to in the preceding paragraph.

35 U.S.C. 287 Limitation on damages and other remedies; marking and notice.

(a) Patentees, and persons making, offering for sale, or selling within the United States any patented article for or under them, or importing any patented article into the United States, may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation "pat.", together with the number of the patent, or when, from the character of the article, this cannot be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In

the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.

(b)(1) An infringer under section 271(g) shall be subject to all the provisions of this title relating to damages and injunctions except to the extent those remedies are modified by this subsection or section 9006 of the Process Patent Amendments Act of 1988. The modifications of remedies provided in this subsection shall not be available to any person who —

(A) practiced the patented process;

(B) owns or controls, or is owned or controlled by, the person who practiced the patented process; or

(C) had knowledge before the infringement that a patented process was used to make the product the importation, use, offer for sale, or sale of which constitutes the infringement.

(2) No remedies for infringement under section 271(g) of this title shall be available with respect to any product in the possession of, or in transit to, the person subject to liability under such section before that person had notice of infringement with respect to that product. The person subject to liability shall bear the burden of proving any such possession or transit.

(3)(A) In making a determination with respect to the remedy in an action brought for infringement under section 271(g), the court shall consider—

(i) the good faith demonstrated by the defendant with respect to a request for disclosure;

(ii) the good faith demonstrated by the plaintiff with respect to a request for disclosure, and

(iii) the need to restore the exclusive rights secured by the patent.

(B) For purposes of subparagraph (A), the following are evidence of good faith:

(i) a request for disclosure made by the defendant;

(ii) a response within a reasonable time by the person receiving the request for disclosure; and

(iii) the submission of the response by the defendant to the manufacturer, or if the manufacturer is not known, to the supplier, of the product to be purchased by the defendant, together with a request

for a written statement that the process claimed in any patent disclosed in the response is not used to produce such product.

The failure to perform any acts described in the preceding sentence is evidence of absence of good faith unless there are mitigating circumstances. Mitigating circumstances include the case in which, due to the nature of the product, the number of sources for the product, or like commercial circumstances, a request for disclosure is not necessary or practicable to avoid infringement.

(4)(A) For purposes of this subsection, a “request for disclosure” means a written request made to a person then engaged in the manufacture of a product to identify all process patents owned by or licensed to that person, as of the time of the request, that the person then reasonably believes could be asserted to be infringed under section 271(g) if that product were imported into, or sold, offered for sale, or used in, the United States by an unauthorized person. A request for disclosure is further limited to a request —

(i) which is made by a person regularly engaged in the United States in the sale of the type of products as those manufactured by the person to whom the request is directed, or which includes facts showing that the person making the request plans to engage in the sale of such products in the United States;

(ii) which is made by such person before the person’s first importation, use, offer for sale, or sale of units of the product produced by an infringing process and before the person had notice of infringement with respect to the product; and

(iii) which includes a representation by the person making the request that such person will promptly submit the patents identified pursuant to the request to the manufacturer, or if the manufacturer is not known, to the supplier, of the product to be purchased by the person making the request, and will request from that manufacturer or supplier a written statement that none of the processes claimed in those patents is used in the manufacture of the product.

(B) In the case of a request for disclosure received by a person to whom a patent is licensed, that person shall either identify the patent or promptly notify the licensor of the request for disclosure.

(C) A person who has marked, in the manner prescribed by subsection (a), the number of the process patent on all products made by the patented process which have been offered for sale or sold by that person in the United States, or imported by the person into the United States, before a request for disclosure is received is not required to respond to the request for disclosure. For purposes of the preceding sentence, the term “all products” does not include products made before the effective date of the Process Patent Amendments Act of 1988.

(5)(A) For purposes of this subsection, notice of infringement means actual knowledge, or receipt by a person of a written notification, or a combination thereof, of information sufficient to persuade a reasonable person that it is likely that a product was made by a process patented in the United States.

(B) A written notification from the patent holder charging a person with infringement shall specify the patented process alleged to have been used and the reasons for a good faith belief that such process was used. The patent holder shall include in the notification such information as is reasonably necessary to explain fairly the patent holder’s belief, except that the patent holder is not required to disclose any trade secret information.

(C) A person who receives a written notification described in subparagraph (B) or a written response to a request for disclosure described in paragraph (4) shall be deemed to have notice of infringement with respect to any patent referred to in such written notification or response unless that person, absent mitigating circumstances—

(i) promptly transmits the written notification or response to the manufacturer or, if the manufacturer is not known, to the supplier, of the product purchased or to be purchased by that person; and

(ii) receives a written statement from the manufacturer or supplier which on its face sets forth a well grounded factual basis for a belief that the identified patents are not infringed.

(D) For purposes of this subsection, a person who obtains a product made by a process patented in the United States in a quantity which is abnormally large in relation to the volume of business of such person or an efficient inventory level shall be rebuttably

presumed to have actual knowledge that the product was made by such patented process.

(6) A person who receives a response to a request for disclosure under this subsection shall pay to the person to whom the request was made a reasonable fee to cover actual costs incurred in complying with the request, which may not exceed the cost of a commercially available automated patent search of the matter involved, but in no case more than \$500.

(c)(1) With respect to a medical practitioner's performance of a medical activity that constitutes an infringement under section 271(a) or (b) of this title, the provisions of sections 281, 283, 284, and 285 of this title shall not apply against the medical practitioner or against a related health care entity with respect to such medical activity.

(2) For the purposes of this subsection:

(A) the term "medical activity" means the performance of a medical or surgical procedure on a body, but shall not include (i) the use of a patented machine, manufacture, or composition of matter in violation of such patent, (ii) the practice of a patented use of a composition of matter in violation of such patent, or (iii) the practice of a process in violation of a biotechnology patent.

(B) the term "medical practitioner" means any natural person who is licensed by a State to provide the medical activity described in subsection (c)(1) or who is acting under the direction of such person in the performance of the medical activity.

(C) the term "related health care entity" shall mean an entity with which a medical practitioner has a professional affiliation under which the medical practitioner performs the medical activity, including but not limited to a nursing home, hospital, university, medical school, health maintenance organization, group medical practice, or a medical clinic.

(D) the term "professional affiliation" shall mean staff privileges, medical staff membership, employment or contractual relationship, partnership or ownership interest, academic appointment, or other affiliation under which a medical practitioner provides the medical activity on behalf of, or in association with, the health care entity.

(E) the term "body" shall mean a human body, organ or cadaver, or a nonhuman animal used in medical research or instruction directly relating to the treatment of humans.

(F) the term "patented use of a composition of matter" does not include a claim for a method of performing a medical or surgical procedure on a body that recites the use of a composition of matter where the use of that composition of matter does not directly contribute to achievement of the objective of the claimed method.

(G) the term "State" shall mean any state or territory of the United States, the District of Columbia, and the Commonwealth of Puerto Rico.

(3) This subsection does not apply to the activities of any person, or employee or agent of such person (regardless of whether such person is a tax exempt organization under section 501(c) of the Internal Revenue Code), who is engaged in the commercial development, manufacture, sale, importation, or distribution of a machine, manufacture, or composition of matter or the provision of pharmacy or clinical laboratory services (other than clinical laboratory services provided in a physician's office), where such activities are:

(A) directly related to the commercial development, manufacture, sale, importation, or distribution of a machine, manufacture, or composition of matter or the provision of pharmacy or clinical laboratory services (other than clinical laboratory services provided in a physician's office), and

(B) regulated under the Federal Food, Drug, and Cosmetic Act, the Public Health Service Act, or the Clinical Laboratories Improvement Act.

(4) This subsection shall not apply to any patent issued based on an application the earliest effective filing date of which is prior to September 30, 1996.

(Amended Aug. 23, 1988, Public Law 100-418, sec. 9004(a), 102 Stat. 1564; Dec. 8, 1994, Public Law 103-465, sec. 533(b)(5), 108 Stat. 4989.)

(Subsection (c) added Sept. 30, 1996, Public Law 104-208, sec. 616, 110 Stat. 3009-67.)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-589 (S. 1948 sec. 4803).)

35 U.S.C. 288 Action for infringement of a patent containing an invalid claim.

Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a dis-

claimer of the invalid claim has been entered at the Patent and Trademark Office before the commencement of the suit.

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

35 U.S.C. 289 Additional remedy for infringement of design patent.

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250, recoverable in any United States district court having jurisdiction of the parties.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.

35 U.S.C. 290 Notice of patent suits.

The clerks of the courts of the United States, within one month after the filing of an action under this title, shall give notice thereof in writing to the Director, setting forth so far as known the names and addresses of the parties, name of the inventor, and the designating number of the patent upon which the action has been brought. If any other patent is subsequently included in the action he shall give like notice thereof. Within one month after the decision is rendered or a judgment issued the clerk of the court shall give notice thereof to the Director. The Director shall, on receipt of such notices, enter the same in the file of such patent.

(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. 291 Interfering patents.

The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section.

35 U.S.C. 292 False marking.

(a) Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used, offered for sale, or sold by such person within the United States, or imported by the person into the United States, the name or any imitation of the name of the patentee, the patent number, or the words “patent,” “patentee,” or the like, with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made, offered for sale, sold, or imported into the United States by or with the consent of the patentee; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article the word “patent” or any word or number importing the same is patented, for the purpose of deceiving the public; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any article the words “patent applied for,” “patent pending,” or any word importing that an application for patent has been made, when no application for patent has been made, or if made, is not pending, for the purpose of deceiving the public —

Shall be fined not more than \$500 for every such offense.

(b) Any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States.

(Subsection (a) amended Dec. 8, 1994, Public Law 103-465, sec. 533(b)(6), 108 Stat. 4990.)

35 U.S.C. 293 Nonresident patentee; service and notice.

Every patentee not residing in the United States may file in the Patent and Trademark Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. If the person designated cannot be found at the address given in the last designation, or if no person has been designated, the United States District Court for the District of Columbia shall have jurisdiction and summons shall be served by publication or otherwise as the court directs. The court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it

would have if the patentee were personally within the jurisdiction of the court.

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

35 U.S.C. 294 Voluntary arbitration.

(a) A contract involving a patent or any right under a patent may contain a provision requiring arbitration of any dispute relating to patent validity or infringement arising under the contract. In the absence of such a provision, the parties to an existing patent validity or infringement dispute may agree in writing to settle such dispute by arbitration. Any such provision or agreement shall be valid, irrevocable, and enforceable, except for any grounds that exist at law or in equity for revocation of a contract.

(b) Arbitration of such disputes, awards by arbitrators, and confirmation of awards shall be governed by title 9, to the extent such title is not inconsistent with this section. In any such arbitration proceeding, the defenses provided for under section 282 of this title shall be considered by the arbitrator if raised by any party to the proceeding.

(c) An award by an arbitrator shall be final and binding between the parties to the arbitration but shall have no force or effect on any other person. The parties to an arbitration may agree that in the event a patent which is the subject matter of an award is subsequently determined to be invalid or unenforceable in a judgment rendered by a court of competent jurisdiction from which no appeal can or has been taken, such award may be modified by any court of competent jurisdiction upon application by any party to the arbitration. Any such modification shall govern the rights and obligations between such parties from the date of such modification.

(d) When an award is made by an arbitrator, the patentee, his assignee or licensee shall give notice thereof in writing to the Director. There shall be a separate notice prepared for each patent involved in such proceeding. Such notice shall set forth the names and addresses of the parties, the name of the inventor, and the name of the patent owner, shall designate the number of the patent, and shall contain a copy of the award. If an award is modified by a court, the party requesting such modification shall give notice of such modification to the Director. The Director shall, upon receipt of either notice, enter the same in the record of the prosecution of such patent. If the required notice is

not filed with the Director, any party to the proceeding may provide such notice to the Director.

(e) The award shall be unenforceable until the notice required by subsection (d) is received by the Director.

(Added Aug. 27, 1982, Public Law 97-247, sec. 17(b)(1), 96 Stat. 322; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)); subsections (b) and (c) amended Nov. 2, 2002, Public Law 107-273, sec. 13206, 116 Stat. 1905.)

35 U.S.C. 295 Presumption: Product made by patented process.

In actions alleging infringement of a process patent based on the importation, sale, offered for sale, or use of a product which is made from a process patented in the United States, if the court finds—

(1) that a substantial likelihood exists that the product was made by the patented process, and

(2) that the plaintiff has made a reasonable effort to determine the process actually used in the production of the product and was unable so to determine, the product shall be presumed to have been so made, and the burden of establishing that the product was not made by the process shall be on the party asserting that it was not so made.

(Added Aug. 23, 1988, Public Law 100-418, sec. 9005(a), 102 Stat. 1566; amended Dec. 8, 1994, Public Law 103-465, sec. 533(b)(7), 108 Stat. 4990.)

35 U.S.C. 296 Liability of States, instrumentalities of States, and State officials for infringement of patents.

(a) **IN GENERAL.** - Any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State, acting in his official capacity, shall not be immune, under the eleventh amendment of the Constitution of the United States or under any other doctrine of sovereign immunity, from suit in Federal court by any person, including any governmental or nongovernmental entity, for infringement of a patent under section 271, or for any other violation under this title.

(b) **REMEDIES.** - In a suit described in subsection (a) for a violation described in that subsection, remedies (including remedies both at law and in equity) are available for the violation to the same extent as such remedies are available for such a violation in a suit against any private entity. Such remedies

include damages, interest, costs, and treble damages under section 284, attorney fees under section 285, and the additional remedy for infringement of design patents under section 289.

(Added Oct. 28, 1992, Public Law 102-560, sec. 2(a)(2), 106 Stat. 4230.)

35 U.S.C. 297 Improper and deceptive invention promotion.

(a) **IN GENERAL.**— An invention promoter shall have a duty to disclose the following information to a customer in writing, prior to entering into a contract for invention promotion services:

(1) the total number of inventions evaluated by the invention promoter for commercial potential in the past 5 years, as well as the number of those inventions that received positive evaluations, and the number of those inventions that received negative evaluations;

(2) the total number of customers who have contracted with the invention promoter in the past 5 years, not including customers who have purchased trade show services, research, advertising, or other nonmarketing services from the invention promoter, or who have defaulted in their payment to the invention promoter;

(3) the total number of customers known by the invention promoter to have received a net financial profit as a direct result of the invention promotion services provided by such invention promoter;

(4) the total number of customers known by the invention promoter to have received license agreements for their inventions as a direct result of the invention promotion services provided by such invention promoter; and

(5) the names and addresses of all previous invention promotion companies with which the invention promoter or its officers have collectively or individually been affiliated in the previous 10 years.

(b) **CIVIL ACTION.**—

(1) Any customer who enters into a contract with an invention promoter and who is found by a court to have been injured by any material false or fraudulent statement or representation, or any omission of material fact, by that invention promoter (or any agent, employee, director, officer, partner, or independent contractor of such invention promoter), or by the failure of that invention promoter to disclose such information as required under subsection (a),

may recover in a civil action against the invention promoter (or the officers, directors, or partners of such invention promoter), in addition to reasonable costs and attorneys' fees--

(A) the amount of actual damages incurred by the customer; or

(B) at the election of the customer at any time before final judgment is rendered, statutory damages in a sum of not more than \$5,000, as the court considers just.

(2) Notwithstanding paragraph (1), in a case where the customer sustains the burden of proof, and the court finds, that the invention promoter intentionally misrepresented or omitted a material fact to such customer, or willfully failed to disclose such information as required under subsection (a), with the purpose of deceiving that customer, the court may increase damages to not more than three times the amount awarded, taking into account past complaints made against the invention promoter that resulted in regulatory sanctions or other corrective actions based on those records compiled by the Commissioner of Patents under subsection (d).

(c) **DEFINITIONS.**— For purposes of this section—

(1) a “contract for invention promotion services” means a contract by which an invention promoter undertakes invention promotion services for a customer;

(2) a “customer” is any individual who enters into a contract with an invention promoter for invention promotion services;

(3) the term “invention promoter” means any person, firm, partnership, corporation, or other entity who offers to perform or performs invention promotion services for, or on behalf of, a customer, and who holds itself out through advertising in any mass media as providing such services, but does not include—

(A) any department or agency of the Federal Government or of a State or local government;

(B) any nonprofit, charitable, scientific, or educational organization, qualified under applicable State law or described under section 170(b)(1)(A) of the Internal Revenue Code of 1986;

(C) any person or entity involved in the evaluation to determine commercial potential of, or offering to license or sell, a utility patent or a previously filed nonprovisional utility patent application;

(D) any party participating in a transaction involving the sale of the stock or assets of a business; or

(E) any party who directly engages in the business of retail sales of products or the distribution of products; and

(4) the term “invention promotion services” means the procurement or attempted procurement for a customer of a firm, corporation, or other entity to develop and market products or services that include the invention of the customer.

(d) **RECORDS OF COMPLAINTS.—**

(1) **RELEASE OF COMPLAINTS.—** The Commissioner of Patents shall make all complaints received by the Patent and Trademark Office involving invention promoters publicly available, together with any response of the invention promoters. The Commissioner of Patents shall notify the invention promoter of a complaint and provide a reasonable opportunity to reply prior to making such complaint publicly available.

(2) **REQUEST FOR COMPLAINTS.—** The Commissioner of Patents may request complaints relating to invention promotion services from any Federal or State agency and include such complaints in the records maintained under paragraph (1), together with any response of the invention promoters.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-552 (S. 1948 sec. 4102(a)).)

CHAPTER 30 — PRIOR ART CITATIONS TO OFFICE AND EX PARTE REEXAMINATION OF PATENTS

Sec.

301 Citation of prior art.

302 Request for reexamination.

303 Determination of issue by Director.

304 Reexamination order by Director.

305 Conduct of reexamination proceedings.

306 Appeal.

307 Certificate of patentability, unpatentability, and claim cancellation.

35 U.S.C. 301 Citation of prior art.

Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing

on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential.

(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3015.)

35 U.S.C. 302 Request for reexamination.

Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title. The request must be in writing and must be accompanied by payment of a reexamination fee established by the Director pursuant to the provisions of section 41 of this title. The request must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested. Unless the requesting person is the owner of the patent, the Director promptly will send a copy of the request to the owner of record of the patent.

(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3015; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(8) and 4732(a)(10)(A)).)

35 U.S.C. 303 Determination of issue by Director.

(a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On his own initiative, and any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

(b) A record of the Director’s determination under subsection (a) of this section will be placed in the official file of the patent, and a copy promptly will

be given or mailed to the owner of record of the patent and to the person requesting reexamination, if any.

(c) A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3015; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-581, 582 (S. 1948 secs. 4732(a)(9) and (4732(a)(10)(A))); subsection (a) amended Nov. 2, 2002, Public Law 107-273, sec. 13105, 116 Stat. 1900.)

35 U.S.C. 304 Reexamination order by Director.

If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed.

(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3016; 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. 305 Conduct of reexamination proceedings.

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the

patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3016; amended Nov. 8, 1984, Public Law 98-622, sec. 204(c), 98 Stat. 3388.)

35 U.S.C. 306 Appeal.

The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent.

(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3016.)

35 U.S.C. 307 Certificate of patentability, unpatentability, and claim cancellation.

(a) In a reexamination proceeding under this chapter, when the time for appeal has expired or any appeal proceeding has terminated, the Director will issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent any proposed amended or new claim determined to be patentable.

(b) Any proposed amended or new claim determined to be patentable and incorporated into a patent following a reexamination proceeding will have the same effect as that specified in section 252 of this title for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation for the same, prior to issuance of a certificate under the provisions of subsection (a) of this section.

(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3016; amended Dec. 8, 1994, Public Law 103-465, sec. 533(b)(8), 108 Stat. 4990; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

CHAPTER 31 — OPTIONAL INTER PARTES REEXAMINATION PROCEDURES

Sec.

- 311 Request for inter partes reexamination.
- 312 Determination of issue by Director.
- 313 Inter partes reexamination order by Director.
- 314 Conduct of inter partes reexamination proceedings.
- 315 Appeal.
- 316 Certificate of patentability, unpatentability, and claim cancellation.
- 317 Inter partes reexamination prohibited.
- 318 Stay of litigation.

35 U.S.C. 311 Request for inter partes reexamination

(a) **IN GENERAL.**— Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

(b) **REQUIREMENTS.**— The request shall—

(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and

(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

(c) **COPY.**— The Director promptly shall send a copy of the request to the owner of record of the patent.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)); subsections (a) and (c) amended Nov. 2, 2002, Public Law 107-273, sec. 13202, 116 Stat. 1901.)

35 U.S.C. 312 Determination of issue by Director

(a) **REEXAMINATION.**— Not later than 3 months after the filing of a request for inter partes reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration

of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

(b) **RECORD.**— A record of the Director's determination under subsection (a) shall be placed in the official file of the patent, and a copy shall be promptly given or mailed to the owner of record of the patent and to the third-party requester.

(c) **FINAL DECISION.**— A determination by the Director under subsection (a) shall be final and non-appealable. Upon a determination that no substantial new question of patentability has been raised, the Director may refund a portion of the inter partes reexamination fee required under section 311.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)); subsections (a) and (b) amended Nov. 2, 2002, Public Law 107-273, secs. 13105 and 13202, 116 Stat. 1900-1901.)

35 U.S.C. 313 Inter partes reexamination order by Director

If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for inter partes reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the inter partes reexamination conducted in accordance with section 314.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)).)

35 U.S.C. 314 Conduct of inter partes reexamination proceedings

(a) **IN GENERAL.**— Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any inter partes reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

(b) RESPONSE.—

(1) With the exception of the inter partes reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party. In addition, the Office shall send to the third-party requester a copy of any communication sent by the Office to the patent owner concerning the patent subject to the inter partes reexamination proceeding.

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

(c) **SPECIAL DISPATCH.**— Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)); subsection (b)(1) amended Nov. 2, 2002, Public Law 107-273, sec. 13202, 116 Stat. 1901.)

35 U.S.C. 315 Appeal

(a) **PATENT OWNER.**— The patent owner involved in an inter partes reexamination proceeding under this chapter—

(1) may appeal under the provisions of section 134 and may appeal under the provisions of sections 141 through 144, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent; and

(2) may be a party to any appeal taken by a third-party requester under subsection (b).

(b) **THIRD-PARTY REQUESTER.**— A third-party requester—

(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; and

(2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144.

(c) **CIVIL ACTION.**— A third-party requester whose request for an inter partes reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the inter partes reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)); subsection (b) amended Nov. 2, 2002, Public Law 107-273, sec. 13106, 116 Stat. 1900; subsection (c) amended Nov. 2, 2002, Public Law 107-273, sec. 13202, 116 Stat. 1901.)

35 U.S.C. 316 Certificate of patentability, unpatentability and claim cancellation

(a) **IN GENERAL.**— In an inter partes reexamination proceeding under this chapter, when the time for appeal has expired or any appeal proceeding has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent any proposed amended or new claim determined to be patentable.

(b) **AMENDED OR NEW CLAIM.**— Any proposed amended or new claim determined to be patentable and incorporated into a patent following an inter partes reexamination proceeding shall have the same effect as that specified in section 252 of this title for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation therefor, prior to issuance of a certificate under the provisions of subsection (a) of this section.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)).)

35 U.S.C. 317 Inter partes reexamination prohibited

(a) **ORDER FOR REEXAMINATION.**— Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.

(b) **FINAL DECISION.**— Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)); subsections (a) and (b) amended Nov. 2, 2002, Public Law 107-273, sec. 13202, 116 Stat. 1901.)

35 U.S.C. 318 Stay of litigation

Once an order for inter partes reexamination of a patent has been issued under section 313, the patent owner may obtain a stay of any pending litigation which involves an issue of patentability of any claims of the patent which are the subject of the inter partes reexamination order, unless the court before which such litigation is pending determines that a stay would not serve the interests of justice.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)).)

PART IV — PATENT COOPERATION TREATY

CHAPTER 35 — DEFINITIONS

Sec.

351 Definitions.

35 U.S.C. 351 Definitions.

When used in this part unless the context otherwise indicates—

(a) The term “treaty” means the Patent Cooperation Treaty done at Washington, on June 19, 1970.

(b) The term “Regulations,” when capitalized, means the Regulations under the treaty, done at Washington on the same date as the treaty. The term “regulations,” when not capitalized, means the regulations established by the Director under this title.

(c) The term “international application” means an application filed under the treaty.

(d) The term “international application originating in the United States” means an international application filed in the Patent and Trademark Office when it is acting as a Receiving Office under the treaty, irrespective of whether or not the United States has been designated in that international application.

(e) The term “international application designating the United States” means an international application specifying the United States as a country in which a patent is sought, regardless where such international application is filed.

(f) The term “Receiving Office” means a national patent office or intergovernmental organization which receives and processes international applications as prescribed by the treaty and the Regulations.

(g) The terms “International Searching Authority” and “International Preliminary Examining Authority” mean a national patent office or intergovernmental organization as appointed under the treaty which processes international applications as prescribed by the treaty and the Regulations.

(h) The term “International Bureau” means the international intergovernmental organization which is recognized as the coordinating body under the treaty and the Regulations.

(i) Terms and expressions not defined in this part are to be taken in the sense indicated by the treaty and the Regulations.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 685; amended Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392; Nov. 6, 1986, Public Law 99-616, sec. 2 (a)-(c), 100 Stat. 3485; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

CHAPTER 36 — INTERNATIONAL STAGE

Sec.

- 361 Receiving Office.
- 362 International Searching Authority and International Preliminary Examining Authority.
- 363 International application designating the United States: Effect.
- 364 International stage: Procedure.
- 365 Right of priority; benefit of the filing date of a prior application.
- 366 Withdrawn international application.
- 367 Actions of other authorities: Review.
- 368 Secrecy of certain inventions; filing international applications in foreign countries.

35 U.S.C. 361 Receiving Office.

(a) The Patent and Trademark Office shall act as a Receiving Office for international applications filed by nationals or residents of the United States. In accordance with any agreement made between the United States and another country, the Patent and Trademark Office may also act as a Receiving Office for international applications filed by residents or nationals of such country who are entitled to file international applications.

(b) The Patent and Trademark Office shall perform all acts connected with the discharge of duties required of a Receiving Office, including the collection of international fees and their transmittal to the International Bureau.

(c) International applications filed in the Patent and Trademark Office shall be in the English language.

(d) The international fee, and the transmittal and search fees prescribed under section 376(a) of this part, shall either be paid on filing of an international application or within such later time as may be fixed by the Director.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 686; amended Nov. 8, 1984, Public Law 98-622, sec. 401(a), 403(a), 98 Stat. 3391-3392; Nov. 6, 1986, Public Law 99-616, sec. 2(d), 100 Stat. 3485; 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. 362 International Searching Authority and International Preliminary Examining Authority.

(a) The Patent and Trademark Office may act as an International Searching Authority and International Preliminary Examining Authority with respect to international applications in accordance with the terms and conditions of an agreement which may be concluded with the International Bureau, and may discharge all duties required of such Authorities, including the collection of handling fees and their transmittal to the International Bureau.

(b) The handling fee, preliminary examination fee, and any additional fees due for international preliminary examination shall be paid within such time as may be fixed by the Director.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 686; amended Nov. 8, 1984, Public Law 98-622, sec. 403 (a), 98 Stat. 3392; Nov. 6, 1986, Public Law 99-616, sec. 4, 100 Stat. 3485; 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. 363 International application designating the United States: Effect.

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 686; amended Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392.)

35 U.S.C. 364 International stage: Procedure.

(a) International applications shall be processed by the Patent and Trademark Office when acting as a Receiving Office, International Searching Authority, or International Preliminary Examining Authority, in accordance with the applicable provisions of the treaty, the Regulations, and this title.

(b) An applicant's failure to act within prescribed time limits in connection with requirements pertaining to a pending international application may be excused upon a showing satisfactory to the Director of unavoidable delay, to the extent not precluded by the treaty and the Regulations, and provided the conditions imposed by the treaty and the Regulations regarding the excuse of such failure to act are complied with.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 686; amended Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392.)

(Subsection (a) amended Nov. 6, 1986, Public Law 99-616, sec. 5, 100 Stat. 3485.)

(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. 365 Right of priority; benefit of the filing date of a prior application.

(a) In accordance with the conditions and requirements of subsections (a) through (d) of section 119 of this title, a national application shall be entitled to the right of priority based on a prior filed international application which designated at least one country other than the United States.

(b) In accordance with the conditions and requirements of section 119(a) of this title and the treaty and the Regulations, an international application designating the United States shall be entitled to the right of priority based on a prior foreign application, or a prior international application designating at least one country other than the United States.

(c) In accordance with the conditions and requirements of section 120 of this title, an international application designating the United States shall be entitled to the benefit of the filing date of a prior national application or a prior international application designating the United States, and a national application shall be entitled to the benefit of the filing date of a prior international application designating the United States. If any claim for the benefit of an earlier filing date is based on a prior international application which designated but did not originate in the United States, the Director may require the filing in the Patent and Trademark Office of a certified copy of such application together with a translation thereof

into the English language, if it was filed in another language.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 686; amended Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392; Dec. 8, 1994, Public Law 103-465, sec. 532(c)(4), 108 Stat. 4987; 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. 366 Withdrawn international application.

Subject to section 367 of this part, if an international application designating the United States is withdrawn or considered withdrawn, either generally or as to the United States, under the conditions of the treaty and the Regulations, before the applicant has complied with the applicable requirements prescribed by section 371(c) of this part, the designation of the United States shall have no effect after the date of withdrawal and shall be considered as not having been made, unless a claim for benefit of a prior filing date under section 365(c) of this section was made in a national application, or an international application designating the United States, filed before the date of such withdrawal. However, such withdrawn international application may serve as the basis for a claim of priority under section 365 (a) and (b) of this part, if it designated a country other than the United States.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 687; amended Nov. 8, 1984, Public Law 98-622, sec. 401(b), 98 Stat. 3391.)

35 U.S.C. 367 Actions of other authorities: Review.

(a) Where a Receiving Office other than the Patent and Trademark Office has refused to accord an international filing date to an international application designating the United States or where it has held such application to be withdrawn either generally or as to the United States, the applicant may request review of the matter by the Director, on compliance with the requirements of and within the time limits specified by the treaty and the Regulations. Such review may result in a determination that such application be considered as pending in the national stage.

(b) The review under subsection (a) of this section, subject to the same requirements and conditions, may also be requested in those instances where an international application designating the United States

is considered withdrawn due to a finding by the International Bureau under article 12 (3) of the treaty.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 687; amended Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392; 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. 368 Secrecy of certain inventions; filing international applications in foreign countries.

(a) International applications filed in the Patent and Trademark Office shall be subject to the provisions of chapter 17 of this title.

(b) In accordance with article 27 (8) of the treaty, the filing of an international application in a country other than the United States on the invention made in this country shall be considered to constitute the filing of an application in a foreign country within the meaning of chapter 17 of this title, whether or not the United States is designated in that international application.

(c) If a license to file in a foreign country is refused or if an international application is ordered to be kept secret and a permit refused, the Patent and Trademark Office when acting as a Receiving Office, International Searching Authority, or International Preliminary Examining Authority, may not disclose the contents of such application to anyone not authorized to receive such disclosure.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 687; amended Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392; Nov. 6, 1986, Public Law 99-616, sec. 6, 100 Stat. 3486.)

CHAPTER 37 — NATIONAL STAGE

Sec.

- 371 National stage: Commencement.
- 372 National stage: Requirements and procedure.
- 373 Improper applicant.
- 374 Publication of international application: Effect.
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- 376 Fees.

35 U.S.C. 371 National stage: Commencement.

(a) Receipt from the International Bureau of copies of international applications with any amendments to the claims, international search reports, and

international preliminary examination reports including any annexes thereto may be required in the case of international applications designating or electing the United States.

(b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22 (1) or (2), or under article 39 (1)(a) of the treaty.

(c) The applicant shall file in the Patent and Trademark Office —

(1) the national fee provided in section 41(a) of this title;

(2) a copy of the international application, unless not required under subsection (a) of this section or already communicated by the International Bureau, and a translation into the English language of the international application, if it was filed in another language;

(3) amendments, if any, to the claims in the international application, made under article 19 of the treaty, unless such amendments have been communicated to the Patent and Trademark Office by the International Bureau, and a translation into the English language if such amendments were made in another language;

(4) an oath or declaration of the inventor (or other person authorized under chapter 11 of this title) complying with the requirements of section 115 of this title and with regulations prescribed for oaths or declarations of applicants;

(5) a translation into the English language of any annexes to the international preliminary examination report, if such annexes were made in another language.

(d) The requirement with respect to the national fee referred to in subsection (c)(1), the translation referred to in subsection (c)(2), and the oath or declaration referred to in subsection (c)(4) of this section shall be complied with by the date of the commencement of the national stage or by such later time as may be fixed by the Director. The copy of the international application referred to in subsection (c)(2) shall be submitted by the date of the commencement of the national stage. Failure to comply with these requirements shall be regarded as abandonment of the application by the parties thereof, unless it be shown to the satisfaction of the Director that such failure to comply was unavoidable. The payment of a surcharge may be

required as a condition of accepting the national fee referred to in subsection (c)(1) or the oath or declaration referred to in subsection (c)(4) of this section if these requirements are not met by the date of the commencement of the national stage. The requirements of subsection (c)(3) of this section shall be complied with by the date of the commencement of the national stage, and failure to do so shall be regarded as a cancellation of the amendments to the claims in the international application made under article 19 of the treaty. The requirement of subsection (c)(5) shall be complied with at such time as may be fixed by the Director and failure to do so shall be regarded as cancellation of the amendments made under article 34 (2)(b) of the treaty.

(e) After an international application has entered the national stage, no patent may be granted or refused thereon before the expiration of the applicable time limit under article 28 or article 41 of the treaty, except with the express consent of the applicant. The applicant may present amendments to the specification, claims, and drawings of the application after the national stage has commenced.

(f) At the express request of the applicant, the national stage of processing may be commenced at any time at which the application is in order for such purpose and the applicable requirements of subsection (c) of this section have been complied with.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 688; amended Nov. 8, 1984, Public Law 98-622, sec. 402(a)-(d), 403(a), 98 Stat. 3391, 3392.)

(Subsections (a), (b), (c), (d), and (e) amended Nov. 6, 1986, Public Law, 99-616, sec. 7, 100 Stat. 3486.)

(Subsection (c)(1) amended Dec. 10, 1991, Public Law 102-204, sec. 5(g)(2), 105 Stat. 1641.)

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

(Subsection (d) amended Nov. 2, 2002, Public Law 107-273, sec. 13206, 116 Stat. 1905.)

35 U.S.C. 372 National stage: Requirements and procedure.

(a) All questions of substance and, within the scope of the requirements of the treaty and Regulations, procedure in an international application designating the United States shall be determined as in the

case of national applications regularly filed in the Patent and Trademark Office.

(b) In case of international applications designating but not originating in, the United States -

(1) the Director may cause to be reexamined questions relating to form and contents of the application in accordance with the requirements of the treaty and the Regulations;

(2) the Director may cause the question of unity of invention to be reexamined under section 121 of this title, within the scope of the requirements of the treaty and the Regulations; and

(3) the Director may require a verification of the translation of the international application or any other document pertaining to the application if the application or other document was filed in a language other than English.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 689; amended Nov. 8, 1984, Public Law 98-622, sec. 402(e), (f), 403(a), 98 Stat. 3392; 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. 373 Improper applicant.

An international application designating the United States, shall not be accepted by the Patent and Trademark Office for the national stage if it was filed by anyone not qualified under chapter 11 of this title to be an applicant for the purpose of filing a national application in the United States. Such international applications shall not serve as the basis for the benefit of an earlier filing date under section 120 of this title in a subsequently filed application, but may serve as the basis for a claim of the right of priority under subsections (a) through (d) of section 119 of this title, if the United States was not the sole country designated in such international application.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 689; amended Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392; Dec. 8, 1994, Public Law 103-465, sec. 532(c)(5), 108 Stat. 4987.)

35 U.S.C. 374 Publication of international application.

The publication under the treaty defined in section 351(a) of this title, of an international application designating the United States shall be deemed a publication under section 122(b), except as provided in sections 102(e) and 154(d) of this title.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 689; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-566 (S. 1948 sec. 4507(10)); amended Nov. 2, 2002, Public Law 107-273, sec.13205, 116 Stat. 1903.)

35 U.S.C. 375 Patent issued on international application: Effect.

(a) A patent may be issued by the Director based on an international application designating the United States, in accordance with the provisions of this title. Subject to section 102(e) of this title, such patent shall have the force and effect of a patent issued on a national application filed under the provisions of chapter 11 of this title.

(b) Where due to an incorrect translation the scope of a patent granted on an international application designating the United States, which was not originally filed in the English language, exceeds the scope of the international application in its original language, a court of competent jurisdiction may retroactively limit the scope of the patent, by declaring it unenforceable to the extent that it exceeds the scope of the international application in its original language.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 689; 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. 376 Fees.

(a) The required payment of the international fee and the handling fee, which amounts are specified in the Regulations, shall be paid in United States currency. The Patent and Trademark Office shall charge a national fee as provided in section 41(a), and may also charge the following fees:

- (1) A transmittal fee (see section 361(d)).
- (2) A search fee (see section 361(d)).
- (3) A supplemental search fee (to be paid when required).
- (4) A preliminary examination fee and any additional fees (see section 362(b)).
- (5) Such other fees as established by the Director.

(b) The amounts of fees specified in subsection (a) of this section, except the international fee and the handling fee, shall be prescribed by the Director. He may refund any sum paid by mistake or in excess of the fees so specified, or if required under the treaty

and the Regulations. The Director may also refund any part of the search fee, the national fee, the preliminary examination fee and any additional fees, where he determines such refund to be warranted.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 690, amended Nov. 8, 1984, Public Law 98-622, sec. 402(g), 403(a), 98 Stat. 3392; Nov. 6, 1986, Public Law 99-616, sec. 8(a) & (b), 100 Stat. 3486; Dec. 10, 1991, Public Law 102-204, sec. 5(g)(1), 105 Stat. 1640; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501-582 (S. 1948 sec. 4732(a)(10)(A)); subsections (a)(1)-(a)(3) amended Nov. 2, 2002, Public Law 107-273, sec. 13206, 116 Stat. 1905.)



LAWS NOT IN TITLE 35, UNITED STATES CODE

18 U.S.C. 1001 Statements or entries generally.

(a) Except as otherwise provided in this section, whoever, in any matter within the jurisdiction of the executive, legislative, or judicial branch of the Government of the United States, knowingly and willfully —

- (1) falsifies, conceals, or covers up by any trick, scheme, or device a material fact;
- (2) makes any materially false, fictitious, or fraudulent statement or representation; or
- (3) makes or uses any false writing or document knowing the same to contain any materially false, fictitious, or fraudulent statement or entry;

shall be fined under this title, imprisoned not more than 5 years or, if the offense involves international or domestic terrorism (as defined in section 2331), imprisoned not more than 8 years, or both. If the matter relates to an offense under chapter 109A, 109B, 110, or 117, or section 1591, then the term of imprisonment imposed under this section shall be not more than 8 years.

(b) Subsection (a) does not apply to a party to a judicial proceeding, or that party's counsel, for statements, representations, writings or documents submitted by such party or counsel to a judge or magistrate in that proceeding.

(c) With respect to any matter within the jurisdiction of the legislative branch, subsection (a) shall apply only to —

(1) administrative matters, including a claim for payment, a matter related to the procurement of property or services, personnel or employment practices, or support services, or a document required by law, rule, or regulation to be submitted to the Congress or any office or officer within the legislative branch; or

(2) any investigation or review, conducted pursuant to the authority of any committee, subcommittee, commission or office of the Congress, consistent with applicable rules of the House or Senate.

(Amended Sept. 13, 1994, Public Law 103-322, sec. 330016(1)(L), 108 Stat. 2147; Oct. 11, 1996, Public Law 104-292, Sec. 2, 110 Stat. 3459.)

(Subsection (a) amended Dec. 17, 2004, Public Law 108-458, sec. 6703 (a) , 118 Stat. 3766; July 27, 2006, Public Law 109-248, sec. 141(c), 120 Stat. 603.)

18 U.S.C. 2071 Concealment, removal, or mutilation generally.

(a) Whoever willfully and unlawfully conceals, removes, mutilates, obliterates, or destroys, or

attempts to do so, or, with intent to do so takes and carries away any record, proceeding, map, book, paper, document, or other thing, filed or deposited with any clerk or officer of any court of the United States, or in any public office, or with any judicial or public officer of the United States, shall be fined under this title or imprisoned not more than three years, or both.

(b) Whoever, having the custody of any such record, proceeding, map, book, document, paper, or other thing, willfully and unlawfully conceals, removes, mutilates, obliterates, falsifies, or destroys the same, shall be fined under this title or imprisoned not more than three years, or both; and shall forfeit his office and be disqualified from holding any office under the United States. As used in this subsection, the term “office” does not include the office held by any person as a retired officer of the Armed Forces of the United States.

(Amended Nov. 5, 1990, Public Law 101-510, sec. 552(a), 104 Stat. 1566; Sept. 13, 1994, Public Law 103-322, sec. 330016(1)(I), 108 Stat. 2147.)

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美國專利法

第一章 專利及商標局

第一節 組織設置，主管官員，職掌

1. 組織設置

商務部設專利商標局，其職掌除法律另有規定外，為保存及維護有關專利及商標之記錄，書籍，圖式、說明書及其他文件。

2. 局戳鋼印

專利商標局頒發專利證書，商標註冊證書及其他文件，皆應蓋局戳鋼印以確認證實。

3. 主管官員及職員

(a)專利商標局設局長一人、副局長一人，助理局長二人及依第七條所定之主任審查委員數人。局長出缺時，由副局長代理之，若副局長亦同時出缺，則由任職較早之資深助理局長代理之。局長、副局長及助理局長應由總統提名，經與參議院諮商同意後由總統任命之。專利商標局內其他官員及職員則經局長提名後，依法由商務部長任命。

(b)商務部長得依職權行使本法所定專利商標局及主管官員、職員之職掌，並得授權主管官員、職員行使之。

(c)商務部長得決定主任審查委員之每年基本薪資。但其數不得超過 1949 年修正之銓敘總全表第 17 級職等之最高額。

(d)局長由助理商務部長兼任，其薪資比照助理商務部長之薪資。

(e)專利商標訴願及爭議委員會之成員之薪資，不得超過第 5 標題第 5332 條之銓敘總表 GS-16 所列最高薪點。

4. 主管官員及職員申請專利權等利益之限制

專利商標局主管官員及職員，在任職期間及離職後一年內，除繼承或受遺贈外，不得申請有關專利及直接、間接受有專利權之任何利益。在離職後申請專利，主張之優先權日亦不得早於離職日起一年之期間。

5. (已廢止) 參考 June 6, 1972, Pub Law 92-310, Title II, 208(a), 86 Stat. 203.

6. 局長之職權

(a)局長受商務部長之指揮，依法指揮監督專利權之審查、發證及商標註冊事項，並得為國內外專利商標法事項之研究計畫及交流。局長綜理專利商標局行政事務，同時負責管理所

有專利商標局之財產。局長經商務部長之核可，在不抵觸法律之範圍內，得訂定有關專利商標行政程序上所需之規章。

- (b)局長受商務部長之指揮，行使本條(a)項之職權時，得立於與國務院同等之地位，與外國專利局或國際政府機構共同研究或計畫，亦得授權他人行使之。
- (c)局長受商務部長之指揮，並經國務卿之同意，得將編列予專利商標局之預算，每年以不超過十萬元之限度，轉交給國務院，作為政府國際組織間推動專利商標有關合作事宜之特別支出。此項特別支出於該國際組織已受領其他給付及捐款時，仍得為之，不受美國政府對其他給付或捐款數額規定之限制。

7. 專利訴願及爭議委員會

- (a)主任審查委員應由具備充足的法律知識及科技能力。專利訴願及爭議委員會應由局長、副局長、助理局長以及主任審查委員組成。
- (b)依據申請人之訴願申請書，專利訴願爭議委員會應複查審查委員所為不利之審定，並應依第 135(a)項之規定，決定發明之優先權及發明之可專利性，訴願及爭議申請案應由局長指定訴願及爭議委員會委員三人以上審查，只有訴願及爭議委員會有權准予再審查之申請。
- (c)局長為維持委員會工作之需，得指定具有必要能力且與主要審查委員同等或以上資格之審查委員，擔任主任審查委員，其期間不得逾六個月。前述被指定之主任審查委員，得充任委員會之委員，惟其參與委員會審理時，以一人為限，指定主任審查委員之年薪由商務部長核定，其數額不得超過第 5 標題第 5332 條之銓敘總表 G5-16 所列最高薪點。指定主任審查委員之基本薪資在任職終了前，須調回未被指定前之薪資。

8. 圖書館

局長應於專利商標局內設置圖書室，陳列國內外之科學相關著作期刊，以供各級官員參考並且順利執行其職務。

9. 專利分類

局長為迅速並且精確決定某一發明專利案之新穎性，對於美國專利證書其他專利證件刊物內容，得修正或維持其適當之分類。

10. 文件記錄之簽證

局長得依公眾需要或個人之申請，發給專利商標局所核准之專利說明書及圖示或其他局內資料之簽證本。

11. 出版刊物

- (a)局長得自行或交由他人印製下列項目：
 - 1.專利之說明書、圖示或其影印本，專利商標局為照相印刷之目的，得列印專利圖示之標題。
 - 2.商標註冊證書，包括說明書與圖示及其影本。
 - 3.美國專利商標局公報。
 - 4.專利與專利權人，及商標與註冊人之年鑑索引。
 - 5.專利與商標案件之判例年冊。
 - 6.專利法與專利法施行細則、商標法令及有關局內事務之傳閱物及其他刊物之彙編。
- (b)局長可將本條(a)項第 3、4、5 及 6 各款所列刊物，以專利商標局內使用之刊物代之。

12. 與其他國家交換專利之影本。

局長得以美國核准之專利專利說明書與圖示與其他國家交換其核准專利之說明書與圖示。

13. 供給公共圖書館核准專利之影本。

局長得依第 41 條(d)項之規定，酌收每年發行之費用。提供美國公共圖書館專利之說明書與圖示影本以供大眾使用。

14. 向國會提出年度報告

局長每年應向國會報告其全年之歲入歲出、局務統計，及其他對國會或大眾有用之資訊。

第二節 專利商標局之行政程序

21. 申請日及工作日

- (a)局長得規定以文件或規費交郵之日為到達專利商標局之日。因郵局關閉及局長所認定之緊急情致無法交郵者，亦同。
- (b)應至專利商標局辦理事務或繳交費用之期日或期間之末日為星期六、星期日或哥倫比亞特區之國定例假日者，以次日代之。

22. 申請文件之印刷、打字

局長得要求專利商標之申請文件需經印刷或打字。

23. 專利商標局案件之證詞

局長得規定專利商標局辦理案件之宣誓書及證詞。任何官員依法應向美國聯邦法院或其居住地州法院提供證詞者，得使用前開宣誓書或證詞。

24. 傳票、證人

美國法院之書記官在其法院管轄區內，為辦理專利商標局內爭議案需採用證詞時，經當事人之聲請，應發出傳票傳喚居住於轄區之證人，指定之時間內及地點，向其轄區內可接受證詞及宣誓書之官員報到作證。聯邦民事訴訟細則有關證人到場作證、文件及證物提示之規定，於專利商標局之爭議案件準用之。

受傳喚到場之證人，應比照美國聯邦地方法院支付到場證人之規定，支付膳食及旅行費用。前開法院之法官，在確定證人接到傳票後，無故拒絕到場時，得如同其所辦理之類似情況，強制依傳票內容到場，或懲罰違抗傳票命令。證人除在收受傳票時已經同時收取膳食費、往返旅費及至審查地點之一日出席費外，不得以違抗命令或藐視法庭定罪。除法院有適當之指示，亦不得因拒絕揭露某些秘密被認為藐視法庭。

25. 以宣誓書代替誓詞

- (a)依法令、規定須先經宣誓方可送至專利商標局之文件，得以局長訂定之制式宣誓書代之。
- (b)前開宣誓書須註明如有虛偽不實之陳述，將處以拘役或併科罰金。

26. 瑕疵文件之效力

送至專利商標局之文件，依法令須具備特定之方式者，局長得暫時受理，但於須指定之時限補正。

第三節 對律師及代理人等之規定

31. 對代理人及律師之規定

局長經商務部長之核准，得訂定規則，規範執業之代理人，律師或其他代表申請人或其他單位之人，並得在認可前述人員之前，責令其證明具優良品格及聲望，並且具備代理所必需資格，以代理申請手續或其他向專利商標局洽辦之業務。

32. 執行業務之暫停或禁止

任何人、代理人或律師不能勝任、名譽掃地，因重大過失犯罪、違反依第三十一條所訂之規則，或以語言、文字、廣告意圖為詐欺、欺罔或脅迫申請人、未來申請人或目前或未來與本局有業務往來者，局長經通知並給予聽證機會後，得暫時或全面禁止其執行一部或全部業務，前述暫停或禁止執業之理由應記錄存檔。哥倫比亞特區美國聯邦地區法院在接到被暫停或禁止執業者之申訴時，得覆查局長所作之處分。

33. 無權代理

任何人未經認可而自稱或使他人誤認已經核可，或有資格代辦專利而申請，執行業務者，每一違反行為處以一千元以下罰鍰。

第四節 專利規費

41. 專利規費；專利及商標檢索系統

(a)局長應收取下列規費：

(1)(A)除新式樣及植物案件之外，專利新申請：美金(以下同)500 元[730]。

(B)申請專利範圍獨立項超過三項時，每增加一項加收 52 元[76]，超過二十項(不論獨立或附屬)時，每項加收 14 元[22]，一申請案有多種附屬項時，每件加收 160[240]元。

(C)臨時專利申請專案：150 元。

(2)除新式樣或植物案件之外，申請核發專利證書或補發證書 820 元[1210]。

(3)新式樣或植物案件：

(A)新式樣之申請案：每件 200 元[300]

(B)植物案申請案：330 元[490]

(C)核發新式樣專利證書 290 元[420]

(D)核發植物專利證書 410 元[610]

(4)(A)申請補發專利證書：500 元[730]

(B)在申請時或申請後提出超過首次專利申請之獨立項數時，每增加一項加收 52 元[76]，超過二十項且超過首次申請之申請專利範圍項目時(無論是獨立或附屬)，每項加收 14 元[22]

(5)撤銷之申請案每件 78 元[110]。

(6)(A)向專利訴願及爭議委員會提起出訴願：190 元[280]。

(B)補提訴願理由書：190 元[280]，申請列席專利訴願及爭議委員會：每件收 160 元[240]

(7)請求恢復因疏忽而放棄之專利申請案或因疏忽而緩付之證書費：每件 820 元[1210]，前述申請如係第 133 條或第 151 條規定提出，則每件收費 78 元[110]。

(8)對於由局長指定之期限，請求展期一個月：

(A)首次請求 78 元[110]

(B)第二次請求每件 172 元[370]；及

(C)第三次及第三次以後之請求，340 元[870]

(9)國際申請案而以專利商標局為國際初步審查及檢索單位時，基本國內規費:450 元[660]。

(10)國際申請案，專利商標局僅為國際檢索單位而非國際初步審查單位時，基本國內規費:500 元[730]。

(11)國際申請案，而專利商標局既非國際檢索單位,又非國際初步審查單位時，基本國內規費:670 元[980]。

(12)國際申請案，其國際初步審查規費已經交付專利商標局，且於國際初步審查報告中提出申請案之所有申請專利範圍項目已符合國際專利合作條約第 33(2)、(3)法條規定者，其基本國內規費:66 元[92]。

(13)當國際申請案之申請專利範圍獨立項目超過三項時，每一獨立項目規費:52 元[76]。

(14)在國際申請案之申請專利範圍項目超過二十項時，(不論其為獨立項或附屬項)，每項 14 元[22]。

(15)國際申請案在國內階段含有多項附屬項時:160 元[240]。計算規費時，依第 112 條所定申請專利範圍內容多項附屬項或其他附屬項，均視為各該專利範圍之個別附屬項。

規費計算有出入時，得依局長所訂定之規費更正之。

(b)局長應收取下列規費，以便在 1980 年 12 月 12 日起申請之專利權持續有效:

(1)獲准專利權後三年六個月內:650 元[960]。

(2)獲准專利權後七年六個月:1310 元[1930]。

(3)獲准專利權後十一年六個月:1980 元[2900]。

上列各項規費應於到期日或到期日前至專利商標局繳納，未繳納者，得於到期日後六個月之緩衝期間內繳納，逾期專利權於緩衝期屆滿後失效。應六個月緩衝期內繳納者，局長得要求收取額外之權利之維護費用。但新式樣或植物專利不得收取此種額外費用。

(c)(1)若因不可避免之事由致無法於(b)所定之六個月緩衝期內繳納權利維護費用時，得於緩衝期滿後二十四個月內繳納維護費用，該專利權年費視為未逾期繳納。

(2)專利權年費已依本款規定支付而保持專利權有效者，任何專利權人或其繼承人在六個月緩衝期到期後，但是在本款之規定下收受專利權年費前製作、購買、要約銷售或使用其專利品者，其受保護之專利權將不被縮減或影響，而得繼續使用；或得出售給其他人或使用該項專利產品於美國境內，或在六個月緩衝期限過後，而在依本款收受年費前輸入受本專利保護之產品，得繼續使用、要約銷售或供他人轉售該項經由製造、採購、經銷、使用或進口之特殊產品。法院在該項有爭議專利產品於美國境內得繼續准其製造、使用、要約銷售，銷售已製成產品之採購、要約銷售及使用，或依本款規定，該產品之主要構件係於六個月緩衝期結束，但卻於繳交專利權維持費前所完成產品而輸入美國境內供製造、使用、要約銷售於美國境內者。此外，法院亦得依本款規定，在六個月緩衝期滿後，而在專利維持費被接受前已進行之製造程序之繼續實施，此種保護繼續提供至法院認為已在依本款規定六個月緩衝期間過後，而在繳納年費被接受前已進行投資或業已拓展業務者受到相當足夠且適宜之保護為止。

(d)局長應訂定其他業務手續費、服務費或有關專利而不在前列項目中列出之材料費用，以涵蓋本局承辦該項業務所需之手續、服務及材料之平均成本。此外，局長應針對下列服務費：

(1)變更有關專利所有權文件之記載，每件資產收費 40 元。

(2)影印每張收費 25 分。

(3)每件黑白專利證書:3 元。

依第 13 條規定，提供圖書館一年核發專利之說明書及圖式之印刷影本之年費 50 元。

(e)其他政府單位或官員偶然或臨時要求提供有關專利之服務或資料時，得經局長之核准，免予收費。局長得依第 132 條之規定，核發申請人專利審定通知書及有關該專利之說明書及圖式一份而不收取任何費用。

(f)從 1992 年 10 月 1 日起，局長得因勞工局所發行之物價波動指數，每年調整本條(a)及(b) 款所列之費用，以反應年度十二個月之物價波動，惟其變動之幅度如小於百分之一，則勿庸調整。

(g)局長依本條內容規定之費用，在聯邦註冊公報及專利商標局所發行之專利公報公告三十天後方可生效。

附註：依美國法典第 35 法案第 41(d)款內容規定，由專利商標局長所制定之費用得在聯邦註冊公報公告之一天後得在 1992 年度生效，美國法典 35 號第 41(g)款及美國法典第 5 號第 553 號則不得在 1992 年度制定生效。

(h)(1)依中小企業法令第 3 條內容規定之中小企業，或專利商標局長頒佈定義之發明人或非營利機構，在申請專利時，其依本條(a)及(b)款所應繳納之費用得減少百分之五十之額度收取。

(2)依款(1)在申請專利時，任何額外費用或依(c)及(d)款收取之費用，應不高於他人在同樣或類似情況下所繳納之費用。

(i)(1)專利商標局長應提供美國專利及外國專利文件資料及美國商標註冊公報於書本或微縮片，免費供大眾使用，檢索及查閱該項資料。專利商標局長不應對直接使用該項專利資料或對展示該項資料之房間或圖書館設備之使用收取任何費用。

(2)專利商標局長應全面實施專利商標資訊之自動檢索系統，以供大眾使用，並確保大眾可以全面使用該資訊，再以各種不同之自動化方式，包括電子看板以及使用者由遙遠地方進入使用大量儲存及取回系統以應用專利商標資訊之廣泛傳播運用。

(3)局長得訂定社會大眾使用專利商標局之自動檢索系統所需支付之合理費用，在訂定該項費用之後，對於為教育及訓練目的之使用者，得限量免費使用。局長得依本款規定，准許申請人在表示其需要或困難，而且符合公益情況下，免除其付費之義務。

(4)局長應向國會提供有關專利商標局自動檢索系統及大眾使用系統之年報，局長並應在聯邦註冊簿公布該項年報，同時，局長須使對該年報有興趣之社會人士有提供其意見及評語之機會。

(編者註：在中括號內所顯示之金額係於 1994 年 10 月 1 日開始生效之新費用)

第二章 發明之可專利性及專利權之授與

第十節 發明之可專利性

100. 定義

除另有規定外，本法名詞定義如下：

(a)發明係指發明或發現。

(b)方法係指方法、技術或步驟，並包括已知方法、機器、製品、物之組合或材料之新用途。

(c)美國及本國係指美利堅合眾國，其領土及屬地。

(d)專利權人係指獲頒專利之專利權人及其繼承人。

101. 可予專利之發明

任何人發明或發現新而有用之方法、機器、製品或物之組合，或新而有用之改良者，皆得依本法所定之規定及條件下獲得專利。

102. 可專利性之條件;新穎性及專利權之喪失

無下列情形之一者，得獲得專利：

- (a)在專利申請人發明及申請之前，已在本國為他人習知或使用，或在國內外已獲准專利或在印刷刊物上公開發表者，或
- (b)在美國申請專利一年前，該發明已在國內外獲准專利或在印刷刊物上公開發表，或在國內為公開使用或銷售者，或
- (c)已聲明放棄該項發明者，或
- (d)在美國申請專利或發明證書十二個月前，該發明由申請人或其法定代理人或受讓人，在他國已先取得專利，或即將取得專利，或取得發明證書上之標的者，或
- (e)在專利申請人發明之前，該發明已見於他人在美國申請且核准之專利，或他人之國際申請案，符合第 371 條(c)項第(1)(2)及(4)款之規定要件者，或
- (f)欲取得專利者並非該項發明標的之發明人，或
- (g)在專利申請人發明之前，該項發明已在本國由他人完成且其未在本國放棄、禁止發行或隱藏者。在決定發明之優先性時，不僅需考慮該發明之構想及實施日期之關聯，並且需顧及先於他人構想而晚於付諸實施者，在該他人構想前之合宜之努力。

103. 可專利性之條件；非顯而易知之主題標的

發明雖無依第 102 條規定，相同地被揭露或敘述之情事，惟請求專利主要標的與先前技術間之差異，為申請時熟悉該項技術具有通常技藝人士所顯而易知者，該申請案仍未能獲取專利，可專利性不可因為實施該發明之方式而遭否定。

專利之主題標的只有在依第 102 條之(f)或(g)款而作為先前技藝時，若該主要技術及所請求之發明，在發明完成時係由同一人所擁有，或經合法權利移轉給同一人時，即不得排除其發明申請之可專利性。

104. 國外之發明

(a)一般規定—

(1)審理—在專利商標局及法院之審理中，專利之申請人或專利權人，除第 119 條及第 365 條規定，及北美自由貿易協定國家或世界貿易組織成員國以外，不得引用其已在外國公知或已經使用及相關活動，以取得發明日期。

(2)權利—若發明係由一般百姓、居民或軍人所完成時—

(A)若係居住於美國境內，為任何其他國家工作，而從事與美國有關或為美國利益之任務者。

(B)若係居住於某一北美自由貿易協定之成員國境內，為任何其他國家工作，而從事與該北美自由貿易國家有關或為該北美自由貿易協定國家利益之任務者。

(C)若係居住於某一世界貿易組織成員國內，為任何其他國家工作，而從事與該世界貿易組織成

員國有關，或為該世界貿易組織成員國利益之任務者。該人士應享有與同為在美國境內，同為在北美自由貿易協定成員國，同為世界貿易組織成員國等之申請人所完成之發明所應該獲得之發明優先權。

(3)資訊之使用—若在專利商標局之流程中，任何一個北美自由貿易協定成員國家或任何一個世界貿易組織之成員國未能提供認定或否定有關發明日期所需之知識、使用或其他活動時，則法院、任何其他足以提供該資料供人使用於美國境內之權責機關得負責辦理，於該情況下，局長、法院或該權責機關應在法令規章之許可範圍內，導出適當之結論或採取其他行動，以幫忙於流程中請求需要該項資料之人員。

(b)定義—在本法內所使用者：

(1)“NAFTA country” 在北美自由貿易協定實施法案第 2(4)條中即有明確之說明。

(2)“WTO member country” 在烏拉圭回合協定法案第 2(10)條中即有明確之說明。

105. 外太空之發明

- (a)除非由美國參與簽定之國際協定中特別指定之太空物體或構件，或依發射入外太空之註冊公約所規定登記於其他國境之太空物體或構件之外，任何在美國法令管轄之太空物體中製造、使用或販賣之發明均應在本法之精神下，視為在美國境內所製造、使用或販賣。
- (b)若依發射入外太空之註冊公約內容規定，登記於其他國境之太空物體或構件內所製造、使用或販賣之任何發明，若美國與該註冊國訂有國際協定時，則該發明可依本法之精神，視為在美國境內所製造、使用或販賣。

第十一節 專利之申請

111. 申請

(a)一般規定

- (1)除本法另有規定外，專利申請應由發明人或由發明人所授權之人以書面向局長提出。
- (2)內容—該申請書應包括：
 - (A)依第 112 條所規定之說明書；
 - (B)依第 113 條所規定之圖式；及
 - (C)依第 115 條所規定之申請人宣誓書。
- (3)規費及宣誓書—本申請需與法令規費一併繳付，在說明書及所需之圖式均送齊後，申請費及宣誓書可在局長所准許之限定情況及限定時間內，連同滯納費一併繳納。
- (4)未繳交—除非局長認可其延遲繳納申請規費及宣誓書係屬天災人禍等不可避免之狀況，否則在規定之期限內未繳齊申請費及宣誓書，該專利申請即被視為放棄。專利申請日乃以說明書及所需圖式均備齊送至專利商標局之日期而言。

(b)臨時申請案

- (1)授權—除本法另有規定外，臨時申請案應由發明人本人或由其授權他人，以書面向局長提出，申請應包括：
 - (A)依第 112 條第一段規定之說明書；及
 - (B)依第 113 條規定之圖式。
- (2)申請專利範圍—臨時申請案並不需具備依第 112 條第二至第五段規定之申請專利範圍。
- (3)費用—(A)本申請需與法令所規定之費用一併繳付。
 - (B)在說明書及所需之圖式均送齊後，申請費可在局長所准許之限定情況及限定時間內，連同滯納費一併繳納。
 - (C)除非經局長認可其延遲繳納申請規費係屬天災人禍等不可避免之狀況，否則，在規定之期限內未繳齊申請費者，專利申請即被視為放棄。
- (4)申請日—臨時申請案之申請日應以說明書及所需圖式均齊備送至專利商標局之日期而言。
- (5)放棄—在專利申請之申請日起十二個月後，暫時專利申請案即視同放棄，而且，日後不得申請恢復。
- (6)臨時申請案之其他基本規定—經查符合本項及第 119(e)項內容規定，並經局長所述規定者，依(a)項內容規定提出之專利申請均可視為臨時專利申請案。
- (7)無優先權或最早申請日之利益—臨時專利申請案不得依第 119 條或第 365(a)項之規定而享有任何其他專利申請案之優先權日，亦不得依第 120 條、121 條或 365(c)項之規定享有在美國境內較早申請日之利益。
- (8)申請規定—除非有其他規定，否則，依本法規定之專利申請各項條款應適用暫時專利申請之情況。除外，暫時之專利申請不適用第 115 條、第 131 條、第 135 條及第 157 條規定。

112. 說明書

說明書應包括發明之文字敘述及其製造、使用方法和程序之敘述，使任何熟悉該行業有關人士或最具關聯人員，均得以該完整、清晰及精簡、正確之文詞即可製造並且使用其相同產品，且說明書應記載發明人實施其發明所可設想之最佳方式。

說明書應以單項或多項請求項特別清晰指出申請人所認為該項發明之主題標的。

申請專利範圍應以獨立項敘述，或在特殊情況下，得以附屬項或多重附屬項表達。

在如下述段敘述，附屬項應指出其在前所依附之請求項，並且明確指示該請求項之進一步限制，附屬項應明確分析指出其所附屬之請求項之所有限制。

多重附屬項形式之申請專利範圍，可參酌依附項數在前之一或多數請求項，作為進一步限制其申請主題標的之用。多重附屬項不應被其他多重附屬項目所依附。多重附屬項應併同所依附請求項以解釋權利範圍之限制內容。

多數元件組成之申請案其請求項內之元件可以不需複述其結構、材料或作用，而以裝置或方法步驟之表達來達成特定功效，此時，這些請求項之解釋應包括相關說明書及其均等之結構、材料及作用等內容。

113. 圖式

申請人應在必要之範圍內提供申請標的之圖式以輔助瞭解該申請案。若說明書所載技術本質需以圖式說明，而申請人未提供圖式。則局長得要求申請人在接到通知之二個月或二個月以上之時間內提出到局。在申請日以後所送之圖式不得作為(i)因揭示不足或不當揭示而用以補充說明書之不完整，或(ii)為解釋請求項之範圍而作基本揭示之補充。

114. 模型、樣品

局長得要求申請人提出適當尺寸之模型以展示發明之優點。

若發明係有關物之組合時，局長得要求申請人提供樣品或其成分以作檢查或進行實驗。

115. 申請人之宣誓

申請人應宣誓表達相信其係該項發明之原本及最先發明人，因而申請該方法、機器、製品或物之組合之專利，並應於其中敘述國籍。該項宣誓得在美國境內依法監誓，或在外國之大使館或領事館內有權監誓，或在任何申請人之其他有官印有權監誓之官員地方，其係由美國大使或領事館官員授權，或由外國政府所指定之常駐公使，其中外交協定或合約規定，得視為美國政府所指定官員之常駐人員，只要在該州或該國內合法即視為該宣誓有效。若依本法規定，申請人係由非發明人所提出時，則此宣誓格式可改變，以便於其宣誓。

116. (共同)發明人

除本法另有規定外，發明係由兩人或兩人以上共同為之，則此數發明人應共同申請專利，惟宣誓書則應分別製作。不同發明人得共同申請專利，雖然(1)他們並未實際的同時一起工作，(2)每個人並未提供同樣或相同分量之貢獻，或(3)每個人並未對所申請專利之標的主題之每一請求項均付出部分貢獻。

若某一共同發明人拒絕參加共同申請，或在經過相當勤奮努力工作後，無法連絡或通知，另一申請人得為他自己和被漏列之發明人而獨自提出申請。在經過相關事實及依規定通知之回執證明後，局長得在被漏列之發明人參加即可獲得相同權利之條件下，核發專利給這位提出申請之申請人，而且，這位被漏列之發明人得在事後參加此項專利申請案。

若因某種誤失而將某人列為專利之發明人，或因類似之誤失而未將發明人列於專利申請案中，如該誤失非出於詐欺故意時，局長得於一定期間內准許其申請案補正。

117. 發明人死亡或無行為能力

已死亡發明人之法定代理人或法律上無行為能力發明人之代理人，得在與發明人所需同樣之條件及情況，在符合專利要件下申請專利。

118. 由非發明人提出申請

若發明人拒絕執行專利之申請，或經適度之努力後，無法尋獲或連絡通知發明人，則經發明人所指定或以文字敘述轉讓此發明，或有足夠之資料證明此專利申請之重要性者，均可為發明人或作為代理人為其提出專利申請，以證明此種行動是保障雙方利益並且預防無可彌補之損害，只要在局長認為有足夠努力去通知連絡，則局長可依行政規定核發專利權給此種發明人。

119. 較早申請日之利益;優先權

- (a)任何申請人，其法定代理人或指定人若先向與在美國申請相同或給予美國公民同等優惠待遇之外國合法地申請專利者，應可在其向美國申請時，就同一發明享有與其在該外國相同申請日效力。但其在美國申請之日期不得遲於最初向外國提出申請之十二個月，而且，在向美國正式申請日之一年前已獲取專利、或已在任何其他國家之印刷刊物公開、或在申請前之一年前已公開使用或銷售者均不得在美國獲頒專利。
- (b)除非業經申請並且提出向外國提出之申請書、說明書及圖式之簽證本均在其獲准專利之前即已送至專利商標局，否則該案不可取得其申請專利之優先權，或在未審定前，局長認為有必要時，這些向外國申請之資料得在申請開始之六個月後規定期間提出。該份簽證本應由其所申請之外國專利局發出，且其中需包括說明書、其他資料及其申請日。倘若其原先所提出之文件係以其他語文敘述表達者，局長認為必要時得要求補送其申請資料之英文翻譯本。
- (c)在相同方式及條件下，本條所定權利，可不必基於第一個外國申請案，而係基於同一外國之第二合法申請案取得優先權。此時必須該較早之外國申請案已撤回、放棄或棄置，且未曾公開或留有任何權益，以及尚未被主張也無將被主張為優先權基礎案者。
- (d)若申請人在申請時係可享受巴黎公約之斯德哥爾摩修正條例內所可得到之優待，則若該申請人在外國有權決定選擇要申請發明人證書或專利證書，該申請人應同樣的在本國受到相當於本章所述之申請專利優先權類似之條件及要求。
- (e)(1)依第 111 條(a)項或第 363 條規定，由臨時專利申請案之單一發明人或複數發明人提出專利申請，而其內容符合第 112 條第一項方法揭露時，只要該申請案包含或修正後包含有關臨時專利之特別參考資料時，且在提出時依第 111 條(a)項或第 363 條規定，不遲於臨時專利申請之日起十二個月者，可視為該專利申請與依第 111 條(b)項規定之臨時專利申請之日期相同。

(2)除依第 41 條(a)項(1)款第(A)及(C)附款所定之費用已付，且依第 111 條(a)項或第 363 條規定該臨時專利已在審查中，否則依第 111 條(b)項所述之臨時專利申請不得於專利商標局之任何其他程序中被視為依據之案件。

120. 於美國較早申請日之利益

專利申請案若是基於較早在美國申請日，依本法 112 條第一段之方法揭示之申請案中之發明，或基於依 363 條所提出之較早申請案中之發明而申請時，該同一發明人所提出之較後申請案，在較早申請案或與其同樣享有該較早申請案之申請日利益之申請案核准專利、放棄或審查確定前，且較後申請案包括或與較早申請案有特定技術關聯性者，則該後案得享有較早申請案之申請日之效力。

121. 各別申請案（分割）

若在同一申請案中包括兩個或兩個以上之獨立且不同之發明，局長得要求此申請案限制於其中之一項發明。若其他發明符合第 120 條規定之基礎發明之申請日之可分割案所需要件時，則其應可享受原案申請日利益。依本條規定限制條件中而獲得專利者，可享受較早之申請日，此專利不能用來作為專利商標局之引證案或在法庭上以對抗可分割之專利申請案或其基礎案，此可分割之專利申請於另一申請案獲頒專利之前亦同。若分割案係直接取自原申請案所述及請求之主題標的時，則局長得免除發明人簽署。專利之有效性，不因局長未能要求申請案侷限於某一發明而受影響。

122. 申請案之保密

專利商標局對於專利申請資料應予保密，除非申請人或所有人之同意不得對外提供其申請專利之有關資料，但為實行國會所通過法案條款或局長所確認必須之特殊情事者，不在此限。

第十二節（專利）申請案之審查

131. 申請案之審查

局長應指定審查委員進行此發明申請案件之審查，若審查後認為此案合乎專利法規定所需要件，則局長應頒發專利證書。

132. 核駁之通知;再審查

於審查中，若申請專利範圍之任何項目須核駁，或有提出任何反對或要求，則局長應將核駁理由，反對或要求內容，連同用以制定繼續進行此申請案之資料或引證，一併通知申請人，若於收到該通知後，申請人仍堅持該申請專利範圍，不論修正與否，即對該申請案進行再審查。修正之過程中不得引進此發明之新事項。

133. 進行申請案之程序時間

經專利局通知，或寄發通知後六個月內，申請人未作任何有關本申請案之申復，或於局長所指定三十天以上六十天以下時間內需作回應而無答覆，除申請人可證明此種遲延不可避免，否則該申請案應視為已遭申請人放棄。

134. 向專利訴願爭議委員會上訴

任何申請人，在其申請案兩度遭核駁後，得於支付訴願費用後，向專利之訴願及爭議委員會訴願以撤銷該主要審查委員之審定。

135. 爭議

- (a)若局長認為任何一專利申請案，與審查中之申請案，或與專利權未消滅之專利有所侵犯，則此種侵權現象應受宣告，並且局長應將此宣告通知申請人、共同申請人或專利權人。專利之訴願及爭議委員會應決定發明優先問題，並且解決可予專利之問題。任何專利上訴願及爭議委員會之決議，若與申請人所請求之內容相反，則構成專利商標局對該申請內容之最後核駁決定，同時，局長得將專利頒發予被決定為先發明之人。若專利權人之專利受到不利之判決，而專利權人無上訴或複議之主張，則構成該專利申請之內容被撤銷，且專利商標局撤銷其專利後，在撤銷專利之通知應註明並且分送周知。
- (b)除在已有專利之案件取得專利之一年以前已經提出該項主張，否則，與已有專利之申請專利範圍內容相同，或大致相同之主題標的不得在申請案中提出。
- (c)任何有關專利爭議之雙方協定或同意，以及任何以終止專利爭議為目的之附帶協議皆應以書面為之，在終止爭議前由雙方達成協定或同意之文件應送至專利商標局存查。若其中一方要求，則此部分文件應與爭議案之檔案分別歸檔，僅於政府機關之書面要求，或有正當事由方得准予閱覽。怠於提出書面協定者，該協定或同意內容對於爭議當事人間，及日後爭議當事人間申請核准之專利，無執行力。局長對於延誤上述期間而有正當理由者，得容許爭議之雙方在爭議終止後六個月內將其協定或同意文件送至專利商標局存查。局長應在爭議終止前相當時間內，通知雙方當事人或其代理人本條所定之書面文件存查要求。若局長在爭議案終止後方才通知，不問遲延有無正當理由均得於收到通知後六十天內提出協定或同意書。局長依本項規定所為之措施，皆得依行政程序法第 10 條之規定複查。
- (d)爭議雙方當事人，得於局長依法令指定之期間內，將爭議之全部或一部交付仲裁。仲裁係依美國法典第九編內容規範進行，惟不得抵觸本項規定。爭議雙方當事人應將仲裁結果通知局長，此仲裁結果於通知送達局長後始有執行力，依本項規定所為之仲裁，不得排除局長對系爭專利之可專利性所為之認定。

第十三節 專利商標局決定之覆查

141. 向聯邦巡迴上訴法院上訴

依第 134 條向專利之訴願及爭議委員會上訴，而不服該委員會決定者，得向聯邦巡迴上訴法院提起上訴，提起上訴後，視為拋棄第 145 條所定之權利。在爭議中之任何一方，不服專利上訴及爭議委員會所為之審定者，得向聯邦巡迴上訴法院提起上訴，惟上訴人依第 142 條提起上訴後二十天內，如他造當事人以書面向局長通知選擇第 146 條規定進行訴訟時，則該上訴應予駁回。若上訴人在前述書面通知三十天內未依第 146 條提出民事訴訟，則上訴駁回之決定將拘束本案所有訴訟程序。

142. 上訴之通知

上訴人向聯邦巡迴上訴法院上訴人時，應即通知局長、並於局長指定期間內最長不超過六十日，向專利商標局長提出上訴理由。

143. 上訴程序

聯邦巡迴上訴法院依第 142 條踐行上訴程序時，局長應將檔卷整編目錄送法院，該法院得要求以調閱該文件之正本或認證本。在僅有一造當事人之案件，局長須以書面陳述該案審定理由，並敘明上訴意旨，法院在開庭聽證前，應通知局長及上訴人聽證之時間及地點。

144. 上訴判決

聯邦巡迴上訴法院應覆查專利商標局審定之記錄。為判決後，發布判決主文及理由，該判決應列入專利商標局之記錄，對於後續程序有拘束力。

145. 以民事訴訟取得專利

申請人不服第 134 條專利訴願及爭議委員會之決定者，除已向美國聯邦巡迴上訴法院提起上訴外，得向哥倫比亞特區聯邦地方法院提出民事訴訟請求救濟，其民事訴訟起訴時間應如局長所訂，不得少於決定書後六十天之時間內。法院得依據申請人主張之請求專利部分，訴願及上訴委員會決定書內所述之請求專利部分及全案事實，判決申請人有權取得發明專利，並由局長逕行頒發專利證書。民事訴訟程序費用由申請人負擔。

146. 爭議案之民事訴訟

爭議中之任何一方不服專利訴願及爭議委員會之決定者，得於局長所指定之時間，或於第 141 條所定之時間內循民事訴訟提起救濟，惟提出救濟時間不得短於委員會決定之六十天內，但該當事人曾向美國聯邦巡迴上訴法院提起上訴尚未判決或已判決者不得提起。專利商標局之資料應依爭議之任何一方提議而送達，且法院得斟酌該案之成本及費用以及不影響雙方權益下對證物做進一步查驗。專利商標局記錄之驗證及展示得視為在該訴訟案所提出及製作而成之相同原始資料功效。

此種民事訴訟可以專利商標局記錄上之利害關係人為被告，但任何利害關係人皆可能為提起訴訟之原告。若他造當事人分住數處不屬同州，或居於其他國家時，以哥倫比亞特區之美國聯邦地方法院為管轄法院，得對各居住區之法警發送達傳票傳喚該他造當事人。若另一方居於國外，則得以公告或其他法院所指定之方式行之。局長雖未必為當事人，但法院書記官應告知訴訟，局長得參加訴訟。在法官判決由一方申請人取得專利權時，專利商標局接獲判決書後，應依法令之規定發給專利證書。

第十四節 頒發專利

151. 頒發專利

經審查，認申請人應可取得專利時，應將核准通知書交付或郵寄申請人，通知書內應載明頒發證書之全部或一部費用，且應於送出後三個月內繳納。

申請人繳納費用後即頒發專利，未於規定時間內繳納者，視為放棄該申請案。

任何頒發費用餘額應於通知後三個月內繳納，逾期未繳納者，該專利權於三個月期限屆滿時消滅。在計算剩餘款項時，一頁或少於一頁之紙張費用得不予計算。

未依限繳納本條所定之費用，但隨後連同滯納費一起繳納，且其遲延為不可避免者，局長得接受該項費，該申請案視為未放棄或專利權視為未消滅。

152. 頒發專利證書給受讓人

除本法另有規定外，依發明人宣誓提出之說明書及其申請書，專利證書得核發給發明人在專利商標局記錄上所載之受讓人。

153. 頒發之方法

專利證書應以美利堅合眾國之名義頒發，並且蓋上專利商標局之局印，其下並由局長簽名，或蓋上其簽名章，並由局長所指定之專利商標局官員確認，同時該專利應記載於專利商標局之檔案內。

154. 專利權之內容及期間

(a) 一般原則

(1) 內容 — 每一個專利應包含發明之簡稱、專利權人、其繼承人或受讓人，專利權人得排除他人於美國境內製造、使用、販賣該項發明品；發明若為方法，並包括排除他人於美國境內使用、販賣或進口該方法所製成之產品。

(2) 經繳納所規定之費用後，專利權期間自發證日開始，截止於該專利之說明書向美國政府提出申請之日起二十年，若其依第 120、121 或 365(c) 條內容規定，或該申請書含有特定關聯之較早申請案，則依那些較原申請案中該申請所可取得之最早申請日起算二十年屆滿。

- (3)優先權 — 依第 119、365(a)或 365(b)條內容規定之優先權不計入專利權期限。
- (4)說明書及圖式 — 專利權證書應附上說明書及圖式、並作為該專利之一部分資料。

(b)延長期間

- (1)干擾延遲或秘密命令 — 若某一原始專利之核准係由於第 135(a)條內容規定之程序而延遲，或因為第 181 條內容規定將該專利申請置於保密狀態下，則該專利權之期間取得得於該延遲而獲得延長，唯該延長期間不得多於五年。
- (2)因上訴之覆審而延期 — 若因為專利之訴願及爭議委員會或因聯邦法院之上訴覆審而遲延，而且該專利之取得係因對於不具專利要件之決定，經由複審而改變無符合專利要件時，該專利期間得在不超過五年之期限內作某段時間程度之延長。若其專利已聲明將因他專利之獲准而放棄、且他專利技術內容又無法與該上訴專利顯著區隔時，該專利將不得因本款內容規定而獲准延期。
- (3)限制 — 在第(2)款內所可獲得之延長期間 —
 - (A)應包含依第 134 或 141 條所規定，提出訴願或請願之時間開始，或依第 145 條提起民事訴訟之起訴日期，直到對申請人有利之最後決定之日止。
 - (B)在提出專利申請日起之三年期限屆滿前由於上訴覆審所花費之時間應扣除；以及
 - (C)應扣除依局長核定，該專利申請人並未善盡其應盡義務之期間。
- (4)延長期間 — 依本項規定延長之全部期間不得超過五年。

(c)連續案 —

- (1)決定 — 某一有效之原專利期間，或在烏拉圭圓桌協定法案生效日起六個月內提出申請案之專利期間，究係(a)項所規定之二十年，或核准後十七年之較長時間，依其最終之放棄聲明而定。
- (2)救濟 — 依第 283、284、285 條內容規定之救濟不適用於下列法令 —
 - (A)在烏拉圭圓桌協定法案生效後六個月內已經開始，或已經投入相當之資金；以及
 - (B)因(1)款之理由而形成侵犯專利。
- (3)在(2)款內所述之措施，僅得在依第 28 節或第 29 節(除了第(2)款所排除之內容規定外)提出訴訟，而經判決應支付專利權人適當之財務後，方可繼續進行。

155. 延長專利期限

除第 154 之規定外，若專利包括需經聯邦食品藥物局規範審查之物質或製程，每依聯邦食品、藥品、化粧品法令所頒佈之規定得以在州際間分配及銷售該種物質或製程，也就因此而有依照聯邦藥品、食品、化粧品法令第 409 條而有核准規則之緩衝期間，且此緩衝期係由 1981 年元月 1 日起生效，該緩衝期限長度係自適用核准規則緩衝日起，至該核准程序完成而准予上市行銷為止。該專利權人、繼承人、受讓人或指定人應在適用本法條之日起九十天內，或核准規則緩衝日期解除，兩者之較晚日期通知專利商標局長，告知延展之專利號碼及適用該緩衝期間以及准予上市行銷之日期。局長接到該通知書後，應立即發給該局記錄上所登載之專利所有權人延展證書，蓋上官章，敘述延展期間，並指出該組成物或製程，及可適用應組成物之延展期限。該證書應記載於被延展之專利檔案卷宗，且其延展證書視為原來專利之一部份，除外，在專利商標局之專利公報應公開刊出一妥適之摘要通知。

155A. 專利期限之回復

(a)除第 154 條之規定之外，下述專利均依照本條規定內容延長：

- (1)任何專利內容，其涵蓋新藥品之物質組合，若在聯邦食品藥物局依規定審核中：
 - (A)在 1976 年 2 月 20 日以前，聯邦食品藥物局以信函通知專利權人，其所申請之新藥物產品不符聯邦食品、藥物及化粧品法令第 505(b)(1)條所規定內容；
 - (B)在 1977 年中，專利權人向聯邦食品藥物局提出評估該產品可能致癌之健康效應測試結果；
 - (C)在 1979 年 12 月 18 日前，聯邦食品藥物局以信件通知核准該項產品之新藥物申請。

(D)在 1981 年 5 月 26 日以前，聯邦食品藥物管理局以書面通知，核准包括生產該項產品之廠房設備之附帶申請。

(2)任何包括第(1)款內所述利用組合物的方法之專利。

(b)在(a)項所敘述之任何專利權期間，應該延長一段等同於自 1976 年 2 月 20 日起至 1981 年 5 月 26 日為止之期限，且該專利應被認為係自取得專利即具備如此之延長期限效應。

(c)在本法條(a)項所述專利權人，自本法生效日起九十天內，應告知專利商標局長所延展之專利項目，專利商標局長應於接獲其通知後，在其專利核准案內貼置簽條以為確認，並在專利商標局所發行之正式公報上刊行適當之展延事項通知。

156. 專利權期間之延長

(a)在請求一項產品，或使用某產品之方法，或製造產品之方法等之專利權期限長短，可依本法案所規定將其原來所定之專利權消滅日期往後延展，若

(1)該專利權期限在依(d)(1)項所規定之申請延展交付前尚未消滅；

(2)該專利權期間從未依本條(e)(1)項內容規定延展；

(3)其延展之申請係由專利權內所載之所有人或其代理人依(d)項(1)至(4)款內容所規定之條件申請。

(4)該產品在商業化行銷或使用前，已經按規定接受某一期間之法定規範審查。

(5)(A)除在(B)或(C)兩段文章所述內容之外，此項產品在經一定期間之法定審查後，依法定審查期限所依據之法令規定下，最先獲准商業化行銷或使用之該種產品。

(B)在專利案中包括請求製造該產品之方法，而其主要技術乃在於使用再合併去氧核糖核酸(Recombinant DNA)以製造該產品，則該專利所請求之程序係首先核准之商業化行銷或使用該產品，且已經法定審查期限後，依該項專利製造之產品准予商業化行銷或使用者，或

(C)依(A)段所述，若專利權中，其

(i)請求一種新穎動物藥品或一種家畜生理產品，而且(I)任何其他已被延展之專利並未包含其請求項目，及(II)已經獲准應用在非供食用動物或供食用動物之商業化行銷或使用；以及

(ii)未依非供食用動物應用之法定審查期間之原因而獲准延期；其在經過法定審查期間之原因而獲准延期；其在經過法定規範審查期限之原因而獲准得商業化行銷或使用該種藥品或產品於食用動物上，乃係首次該種藥品或產品在對食用動物之行政措施上，最先獲准商業化行銷或使用者。

第(4)及(5)段文章內所提及之產品，以下簡稱款。

(b)除第(d)(5)(F)項內規定外，任何專利其專利權依本法延展，得在該專利權期限之延展期間內

(1)若該專利係請求一種產品，則應限於該產品所准許之使用範圍—

(A)在專利權期限未消滅前—

(i)在所適用法定規範審查產生所依據之法律內容規定，或

(ii)在(g)項之(1)、(4)或(5)款所述法定規範審查發生所依據之法令內容規範，以及

(B)專利權期間之延展係依據法定規範審查期間之消滅或結束，及

(2)若該專利係請求使用一種產品之方法，則應限於該專利所請求之項目及由該產品所准許之使用範圍—

(A)在專利權期限未消滅前—

(i)在適用之法定規範審查產生所依據之法律內容規定，或

(ii)在(g)項之(1)、(4)或(5)款所述之法定規範審查產生所依據之法令內容定，以及

(B)專利權期間之延長係依據法定審查期間之消滅或結束，及

(3)假若一專利係請求某一產品之製造方法，應限制其製造方法僅用為製造—

(A)該已核准之產品，或

(B)該產品假設其已經接受由(g)項第(1)、(4)或(5)段款所述內容之法定審查期間。產品係指已核准之產品。

(c)依本條第(a)項可延展期限之專利，應可在其法定審查該項產品所需之期間延長，且其時間係由核發專利日起，至法定審查之時間長短為止，除非—

(1)每一件法定審查期間，應依本條(d)(2)(B)款所規定之期間縮短其時間，只要在該期間內，申請專利延期之申請人並未於法定審查期間展現其應有之努力表現者。

(2)在依第(1)款所縮短時間後，該延長期限應包括(g)項內(1)(B)(i)、(2)(B)(i)、(3)(B)(i)、(4)(B)(i)及(5)(B)(i)所敘述其殘餘時間之一半為限。

(3)若在已經核准之專利產品中，在依本法核准日期後，其由(1)及(2)款所述之法定審查期限；在總共所需時間超過 14 年時，則該期間應適當縮減，直至其兩期限總共所需時間不超過 14 年期限，及

(4)在任何情況下，不得有一種以上之不同專利可被依第(e)(i)項內容規定延長相同時間之法定審查期間，而卻皆係源於相同產品。

(d)(1)依本法條所規定以取得專利期限延長者，專利權記錄簿之所有人或其代理人應向局長提出該項申請，而且，除款(5)所述之內容外，該項申請應僅在依本法所規定，准予在商品化行銷或使用所核可法定規範審查期限開始日起六十天內提出。該項申請應包括：

(A)此核准產品之特徵及其應接受之法定審查所遵循之聯辦法規。

(B)要求延長專利期間之專利特徵，及該專利之每一項申請專利範圍之特徵內容。

(C)使局長得以依(a)及(b)項所規定足以獲得專利權期限延長之資訊，及其延長後因而獲致之權利，另提供局長及衛生及人類服務部長及農業部長得以按(g)項內容所規定延長專利期限所需之資訊。

(D)申請人有關該獲准專利產品在其應遵循法定審查期間所為事項之摘要敘述，及各該進行事項之特殊期間。

(E)局長所需有關該項專利之其他各種資料。

(2)(A)在依款(1)所定專利權期限延長之申請提出後六十天內，局長應通知—

(i)農業部長以決定該藥品或使用及製造該藥品之申請專利範圍項目所請求是否應受 Virus-Serum-Toxin Act 法案所規範，及

(ii)健康及人類服務部長，是否該藥品、醫藥器材或食品添加物、顏色添加物，或使用或製造產品、器材、添加物之製程，其專利內之申請專利範圍項目所請求之產品、器材及添加物應受食品藥物化粧品法律所規範，

—已提出延期申請，並附送該有關部長一份申請書之影本。在接獲專利商標局長所附送該項申請之影本三十天內，該有關部長應檢視(1)(C)款內所載日期，決定其所適用之法定規範審查期限，告知局長其所決定之期限，並在聯邦註冊簿上刊登該決定之通知書。

(B)(i)若某一請願案係依(A)項款之規定提送至部長以待決定，且其係在依(A)項款之決定公告後 180 天內送達，於其決定中可相當合理地相信該申請人並未於法定規範審查期限內表現其應有之勤奮努力，部長應在其所制定頒佈之法律規章所限定範圍內，裁決該申請人是否在法定規範審查期限內呈現其所應盡之勤奮努力。除外，部長應在收到訴願案之九十天內作出決定，若屬聯邦食品藥物化粧品法或公共健康服務法所規範之藥品、器材或添加物，則衛生及服務部長不得將此款所敘述之決定階層授權至食品藥物管理局長以下。若係由 Virus-Serum-Toxin 法案所規範之產品，則農業部長不得將本篇所敘述之決定階層授權至行銷及檢驗服務之助理部長以下之階層。

(ii)在部長依(i)段款內文章所敘述內容作成決議後，應在告知局長其決定後，並且連同實務及法律上之依據作成通知，公佈於聯邦註冊登錄簿上。任何利害關係人，在其決定公佈日開始六十天內，均得向部長要求進行有關該決定之非正式聽證會。如果該項請求是在該期間內提出，則作成該決定之部長應在收到請求之三十天內舉行聽證，惟不得超過提出日起六十天之期間。舉辦聽證之部長應通知有關該聽證之專利權所有人及

其他利害關係人使之有機會參與聽證會。在舉辦完成聽證會後三十天內，該部長應確認或修正其有關該聽證會主題所作之決定，並將任何修訂告知局長，另在聯邦註冊登錄簿上印行刊出。

- (3)款(2)(B)之使用目的而言，「盡力」(Due Diligence) 這名詞之意義乃在於，法定審查期間之過程中，某一員工所施加注意力至某程度，加上連續之直接努力，以及一般所展現之可合理預期之具時效反應。
- (4)專利權期限延長之作用，係由局長所制定之揭露需求款內所規範管轄。
- (5)(A)若專利權記錄簿之所有人或其代理人合理地期望著，依(g)項之(1)(B)(ii)、(2)(B)(ii)、(3)(B)(ii)、(4)(B)(ii)或(5)(B)(ii)款之內容敘述所適用於某一獲准專利產品所進行之法定規範期限極可能在該專利權期間失效後獲得延期，則該所有人或其代理人得在該專利權到期前之六個月至到期前十五天內，向局長提出過渡延期之申請，該申請書內容應包括—
- (i)受法定規範審查及聯邦法案內容規範而正進行審查中產品之特徵；
 - (ii)正提出過渡延期申請之專利之特徵內容及正接受法定規範審查之產品或使用及製造該產品之某程序之專利權之每一項申請專利範圍特徵。
 - (iii)依(a)(1)、(2)及(3)項內容規定，讓局長決定該專利權是否合於獲准延期之決定所需之資訊。
 - (iv)提供該申請人在適用法定審查其間內，記載針對該接受審查之產品所作之活動，以及進行該類活定所較為顯著之日期之簡單描述。
 - (v)其他局長可能要求之專利權或其他資訊內容。
- (B)除了准許該產品之商業上行銷或使用之許可外，若局長確定該專利權得依本條內容獲准延期，則局長得在聯邦註冊簿上刊載該項決定之告示，其內容包括接受法定規範審查之產品所具之特徵，爾後在不超過一年之期限內核發給予申請人一紙過渡延期之證明。
- (C)在依(B)款獲准過渡延期之所有人或其代理人，得在依本款內容規定申請不超過四個後續過渡延期，除(g)(6)(C)所定之專利權外，專利權人或其代理人得在前述過渡延長期限到期之六十天前至三十天前，提出其後續之過渡延期之申請。
- (D)依本款所核發之過渡延期證明應載於專利之正式卷宗，且該證明應被視為原始專利之部分資料。
- (E)任何有關產品，在依本款獲准過渡延期之有效期間係由該產品獲准商業性行銷或使用之日起六十天為止。除非，在該六十天期間，該申請人向局長告知其核可，並且依(1)款規定，提出原申請過渡延期之申請中所未曾提出之額外資料，則本專利可依本條規定再次獲得延期—
- (i)在原專利權期間消滅日起之五年內；或
 - (ii)若此原專利權係受(g)(6)(C)內容規範，則係由該有關產品獲准商業性行銷或使用之日起。
- (F)在依本款規定，由任何專利權延伸出之權益之期限，在過渡延長期間—
- (i)若該專利係主張一產品，則侷限於其接受法定規範審查之任何用途；
 - (ii)若該專利權主張使用某一產品之方法，則法定審查應限定於該用途專利；及
 - (iii)若該專利權主張製造某一產品之方法專利，則應侷限於原先所接受法定規範審查內用來製造該產品之方法專利。
- (e)(1)專利權是否能夠合乎延期之決定得由局長判斷，其判斷之依據僅在於其所提出之書面資料所顯示之專利權延期後之各種作用。若局長判定依本條(a)項規定符合延期之條件，且亦具備本條(d)項規定所需要件，則局長應該核准給予該申請人其專利權延期之證書，附上鋼印局戳，而其期間則係(c)項所規定之期限，該證書應包含於專利之正式文卷記錄，且應被視為係原始專利之一部分。

(2)如果依本條(d)項規定，原專利期限在提出申請被核准或拒絕前即將依款(1)內容規定先到期，則若局長認為該延長期限之申請合乎延期之條件，則局長應在未正式決定前將其原專利權期限延長至不超過一年之期間。

(f)在本法條之目的下：

(1)“產品”名稱係指：

(A)一種藥物產品。

(B)任何在聯邦食品藥物及化粧品管理法內所規範之醫葯器材、食品添加物及顏料添加物。

(2)“葯物產品”名稱係指下列之活性成分—

(A)一種新葯品、抗生物葯品或人類生理產品（即如在聯邦食品、葯物及化粧品法及公共衛生健康服務法內所使用之詞彙），或

(B)一種新動物用葯品或獸醫用生理產品（如在聯邦食品、葯品及化粧品法及 Virus-Serum-Toxin 法案所使用之名稱），並非再合併去氧核醣核酸（recombinant DNA），亦非再合併過氧核醣核酸（Recombinant RNA）技術或其他製程，包括附屬之特殊基因操縱技術、活性元素組成之任何鹽或酯(ester)，其可作為單一元素或與其他活性元素所共同組成而製造出之主要產品。

(3)“主要健康及環境效應試驗”係指合理地有關一產品之健康或環境效應之評估，且該項試驗需要至少六個月時間去進行，其結果之數據則被提出用為申請商品化行銷或使用之許可所需資料。若進行一項試驗需要至少六個月時間，則分析或評鑑該試驗數據結果之期間將不會被包括於其決定時間之內。

(4)(A)任何第 351 條之註釋均係公共健康服務法第 351 條之註釋。

(B)第 503、505、507、512 或 515 條之註釋均係聯邦食品藥物及化粧品法第 503、505、507、512 或 515 條之註釋。

(C)有關 Virus-Serum-Toxin 法案之註釋均係由 1913 年 3 月 4 日專利法之註釋（21 U.S.C. 151-158）。

(5)“非正式聽證”係指聯邦食品、葯物及化粧品法第 201(y)條內所述之涵意。

(6)“專利權”係指美國專利商標局所核發之專利權而言。

(7)“製定日期”在本法條內容係指 1984 年 9 月 24 日，同時，針對人類葯物產品，一種醫葯器材、食品添加物，或顏料添加物而言。

(8)“製定日期”在本條所包含之意義係指遺傳動物葯品及專利期限恢復法案適用於動物性葯品或獸醫生理產品之製定日期。

(g)“法定審查期限”具有下列數種解釋：

(1)(A)如果產品係指新葯品、抗生葯品，或人類生理產品而言，此名詞指在(B)副款所敘述之期間，且其僅限於在款(6)之範圍內。

(B)對於新葯品、抗生葯品，或人類生理產品而言，法定審查期間係包括下列幾項：

(i)本期間始於依第 505 條第(i)款或第 507 條第(d)款之免除計算之開始生效，直至依第 351、505 或 507 條規定提出新葯品之最初申請為止，及

(ii)依第 351 條、第 505 條(b)項及第 507 條規定，本期間係由已核准專利產品之延期申請提出開始，至於該申請案依法核准之日期為止。

(2)(A)若產品係食品添加物或顏料添加物之情況，則此期間係指副款(B)所敘述，而僅止於款(6)所敘述之範圍內適用。

(B)食物或顏料添加物之法定規範審查期間係指下列期間之總和—

(i)其期間係指由一主要之健康或環境效應測驗開始之日起，直到依聯邦食品、葯物及化粧品管理法下所規範之產品項目，經提出核發該項產品使用規則之請願之日止，及

(ii)其期間係自聯邦食品、葯物及化粧品法所規範之有關產品送件申請核發使用產品之規則之日開始，直至該規則生效，或針對該規則之相對案送件為止，或至反對

事由解決，並且准予商業促銷為止；或，在商業促銷核可准許後，又因等待某些相對案件之解決而暫時撤銷，直至該相對案件解決而且准予商業行銷為止。

- (3)(A)若產品係醫療器具，則在副款(B)內所敘述條件之期限可用所述款(6)期間使用。
- (B)醫療器材之法定規範審查期間係由以下期限相加總和而成—
- (i)該期間乃係由有關此器材臨床使用於人體檢查之日起，直至依第 515 條規定，有關該器材之一種應用實例開始送件之日期為止，及
- (ii)該期間乃由依第 515 條之規定，有關該器材之一種應用實例開始送件之日起，直至該應用實例在該法條之規定下被核准，或是在另一期限而依第 515(f)(5)條規定，由某一產品發展製成之樣品完成開始送達通知之日起，直至依第 515(f)(6)條規定該樣品宣告完成之日止。
- (4)(A)如該產品是一種新動物藥品，則此條件係副款(B)內所描述之期間而在款(6)所描述之極限內所適用者。
- (B)一種新動物藥類產品之法定規範審查期限係由下列所相加組合—
- (i)某期間係由較早之一種重要健康或環境測驗於藥品肇始之日起，或依第 512 條(j)項內容規定對該核准動物類藥物產品免試生效之日起，直至依第 512 條規定，該動物藥類產品之一種應用實例呈送申請之日為止。
- (ii)某期間由依第 512 條(b)項規定，此核准之動物藥類產品之一種應用實例呈送之日起，直至該應用實例依本法容條核准為止。
- (5)(A)如果此產品係家畜生理產品，則此條件係由副款(B)所述期間，而且在款(6)所述之限度內適用。
- (B)一種家畜生理藥品之法定規範期限乃係由下列項目相加組成—
- (i)該期間係由依 Virus-Serum-Toxin 法案內容所規定，有效授權準備進行實驗性生理產品開始，直至依 Virus-Serum-Toxin 法案內容規定提出執照之日為止，及
- (ii)該期間係由依 Virus-Serum-Toxin 法案內容規定，提出申請執照文書資料送件受審查之日起，直至該執照核發之日為止。
- (6)依前列任何款所制定之期限應受下列各種限制：
- (A)如果所述專利權係在依本條法令生效後始取得，則其法定規範審查期限在依任何款所規定而延長之期限均不得超過五年。
- (B)如果所述專利權係本條法制定前取得，及(i)無依款(1)(B)或(4)(B)所述之免除要求已被提出，且亦依無款(5)(B)所述之權利被提出申請。
- (ii)無依款(2)(B)或(4)(B)所述之重大衛生或環境之影響測驗被提起，而無依該款所述之法規訴願或註冊申請經呈送提出；或
- (iii)無依款(3)所述之臨床檢驗或該款所述之產品發展之樣品經呈送提出—於該核可產品之法令生效日前，依前述各款內所述之法定審查期間所延長之期限均不得超過五年。
- (C)若所述之專利權係在本條法令製成之日以前取得，且副款(B)所述之法律行為在本法條施行前即對該核准產品有意見而經提出，在施行日之前該產品之商品化行銷及使用均未經核准，則依該款所述之法定規範審查期限所核定之延長期限不得超過兩年。若該核准產品係一種新動物用藥品或家畜生理產品(如聯邦食品藥物及化粧品管理法或 Virus-Serum-Toxin 法案所用之名詞)，其時限為三年。
- (h)專利商標局長得視情況，決定專利商標局依法接受及開始應用本法條所規定，涵蓋所提出之各種申請所需之適當成本以收取適當之費用。

157. 法定發明註冊

- (a)除本法其他章節所設規定之外，專利商標局長得不經審查程序，而逕自刊行經由正常程序申請之專利，且包括說明書及圖式於法令之發明註冊本上，若申請人：
- (1)合乎第 112 條內容所需要件；
- (2)如局長所頒定規則內容，符合印刷所需要件；及
- (3)於局長所設定之時限內，放棄取得有關此發明之專利權之取得；及

- (4)已支付申請、刊行及局長所設定之其他各項手續費。
- (b)在條第(a)(3)項內所述由申請人放棄之事項，在法定發明註冊本刊行後立即生效
- (c)在本條所規定而公開之法定發明註冊應具備本法所稱合於專利之形式要件，除第 183 條及自第 271 條至第 289 條所定則不包括其中。一種法定發明註冊不應包含本法之外其他法令所規定合於專利要件之敘述。依局長所頒之規定，一種法定發明註冊在依本法條印行時，應合乎本項前段之內容，給予社會大眾一個適當之通知。依第 292 條所述標的內容，已刊行之法定發明證書所指之發明並不具專利性。
- (d)商務部長應每年向國會報告法定發明註冊之使用情形，且在報告中應包括聯邦政府之使用單位，及其使用法定發明註冊系統之有效應用程度評估，及該系統幫助聯邦政府推展工程技術之經營有效性，以及使用該程序後對於聯邦政府節約成本之評估。

第 15 節 植物專利

161. 植物專利

凡發明、發現及無性繁殖任何特殊及新植物品種，包括耕種培養之變化、變種、混合及新發現之植物種苗者，得依本法規定取得專利，但塊莖突起繁殖或野生植物不在此限。

本法關於發明專利之規定除另有規定外，於植物專利適用之。

162. 說明書，申請專利範圍

若說明書所敘述之內容已經在可能之範圍內詳盡的表達，則任何植物專利皆不能因與第 112 條之規定不符而宣告無效。

說明書內申請專利範圍所示及所敘之植物，應使用正式植物名詞。

163. 准予專利

植物專利，得排除他人無性繁殖此類植物、販賣及使用以其方法無性繁殖之植物。

164. 農業部之協助

總統得依專利商標局長之要求，為執行本法有關植物之規定，以行政命令指示農業部長(1)提供農業部門內可供使用之資訊，(2)針對特別項目進行研究，且經由適當之局或處級單位完成部內研究，或(3)選派農業部門主管或職員協助局長。

第 16 節 新式樣

171. 新式樣專利

任何人創作具新穎、原創及裝飾性之產品新式樣，得依本法之規定及要件取得專利。

172. 優先權

第 119 條(a)至(d)項有關優先權之規定，及第 102(d)條所指定之時間，在新式樣為六個月，第 119(e)條關於優先權之規定不適用於新式樣。

173. 新式樣專利之期限

新式樣之專利權期間為自核准專利之日起 14 年。

第 17 節 發明之保密及向國外提出申請

181. 發明之保密及向國外提出專利之保留

為政府具有所有權利益關係之證明，當經由核發專利而公佈或揭露其內容時，在有關政府單位首長之看法上，可能有害於國家安全時，在告知此事件後，專利商標局長應下令保持該發明之秘密，且在下文所述之條件下保留該專利之核發。

為政府並不具有所有權利益關係之發明，當經由核發專利公佈或揭露該發明後，在專利商標局長之看法上，可能有害於國家安全，他應將該專利申請案提供給，其中包括原子能委員會、國防部長，或任何由總統指定為國防單位之部門或單位主管，檢查發明得否被揭露之。

任何收到該專利申請案揭露內容之人士，均應簽署具日期之收條，並將該收條收納於申請案卷內。如果不論是原子能委員會、國防部長或經指定之部門或單位主管指出，在核發專利並公佈或揭露該發明將有害於國家安全，則原子能委員會、國防部長或指定官員應告知專利商標局長，而後專利商標局長應下令保持該發明之秘密，並在國家安全之需要下保留該專利權之核發，然後通知該專利申請人。在部門或單位主管提出發佈保密之命令，而且充分的表達該專利審查可能有害於國家安全後，專利商標局長應將該申請案保留於密封狀況，而後告知申請人該情形。該申請案遭到保密之申請人應在法令許可之範圍內向商務部長提出該保密命令之申訴。

下令保持發明之秘密以及保留核發專利都不應超過一年，專利商標局長可於期間屆滿，或任何到期日延續更新其命令追加一年，惟應由提起頒佈該項命令之部門主管或單位主要負責官員確認其繼續保持國家安全之需要。若係於美國交戰期間生效或頒佈之命令應在其戰爭期間繼續有效，直至其戰事交惡結束後一年為止。若由總統宣佈國家緊急狀況期間生效之命令則應於緊急狀況存續期間繼續有效，直至該狀況終止後六個月為止。專利商標局長亦可在其權責下取消此命令，只要提出之部門主管或單位首長告知此種發明之公佈或揭露不會再發生對國家安全造成傷害之情況。

182. 捨棄未經許可即揭露之發明

第 181 條規定發明專利申請，在未經專利商標局長同意，違反保密命令，而將其發明公佈或揭露，或由發明人、其繼承人、受讓者、法定代理人或有關之任何人向外國申請專利時，將因受裁定而捨棄該專利申請。此種捨棄情形應被視為自違犯該命令即發生。專利商標局長不得在未經提出此項保密命令之部門主管或單位首長同意，而逕自同意認其揭露或向外申請。在經裁定捨棄某專利申請，即構成申請人，其繼承人、受讓人，法定代理人或任何有關人士在該項專利申請案上拋棄其對美國之所有追索權。

183. 補償權

依上述規定而被核定保留之專利申請人、其繼承人、受讓人或法定代理人，在接獲若無該項命令，則其專利申請案應可被核准之通知，或自 1952 年 2 月 1 日起任何較遲之日為準，直至專利核准後六年為止，得向提出發佈保密或保留之部門或單位首長申請，及／或因政府之使用該發明而揭露，請求其因而引起之各種損失，此種補償權自政府首次實施該項發明之日起。在經提出補償請求後，部門或單位首長有權與申請人、其繼承人、受讓人或法定代理人商洽以完全解決其損害抑／或實施之補償。縱使其他法令有其他之規定，該項解決協議應是概括而確定。若兩方無法獲得全面之解決，該部門或單位首長得在其認為適當之範疇內授與並給

付其確認金額之百分之七十五以下。求償人得向美國權利請求法院或求償人所在美國聯邦區域法院向美國政府起訴，求償已付金額與損害或實施其發明所應得之補償金額之差異數額。若依第 181 條之規定受保密命令拘束，未依上述規定申請求償，而經核發取得專利之所有人，在取得專利後，得向美國聯邦權利請求法院起訴，求償因保密命令或政府使用而致揭露其發明所受到損失之合理公正補償金額。實施之補償請求權始於自政府首先施行其發明之日起。在依本法條規定訴訟中，美國政府得依第 28 篇法典內第 1498 條規定，開放己身使用訴訟上所有可能之抗辯防禦。對於發明人專任就職或服務於美國政府期間之發現、發明或形成之發明案，本法條所規定內容，對於其本人、繼承人、受讓人或法定代理人均不得求償亦不具起訴之權利。

184. 向外國提出申請

關於在美國所完成之發明，經向美國提出申請後之前六個月，除非由專利商標局長處得授權許可證書外，任何人不得在外國自行提出或使人或授權他人申請發明專利，或新型註冊，工業設計或模型登記。依第 181 條規定頒佈保密命令之發明，除非經促請發佈保密命令之部門首長或單位主管之同意，不得頒行同意許可證。若因錯誤或欺騙意圖而在國外提出申請，且該申請並無揭露第 181 條範圍內所述之發明，則該同意許可證得追溯頒發核可。

本節所稱之“申請”包括各種申請及任何修正、更改及其補充或分割而言。

同意許可證之範圍應包括准許其後之修正、更改及額外資料之補充，只要提出同意許可證要求之內容並不需依第 181 條所述準備妥適以接受檢查，而且各種修正、更改及補充並不會變更原申請內容之實質以致得依第 181 條內容準備接受檢查。無論如何，只要在美國提出之專利申請並不需依第 181 條規定備妥送檢，且其後之修正、更改及補充並未變更該發明之實質內容，以致得依第 181 條之規定備妥送檢，則該許可證並不需要申請取得以在外國送件提出申請，甚至於其後之修正，更正及補充亦不需要同意許可證。

185. 無許可證而向外申請則禁止取得專利

即使法律另有其他規定，任何人及其繼承人、受讓人或法定代理人，未經第 184 條規定取得同意許可證，就所完成之發明而自行提出、或同意、幫助他人，完成在外國申請發明專利，或有關該發明之新型註冊，工業設計或模型者，不得獲取美國之發明專利。除非未取得同意許可證係由於錯誤且無欺騙意圖，且該專利並不揭露第 181 條所規範之主要事項，否則上述人員、其繼承人、受讓人或法定代理人所獲得之美國專利權應屬無效。

186. 罰則

任何人在依第 181 條規定被命令應保持秘密之發明，且應扣留專利權核發之期間內，知悉有該命令而且未經授權即擅自發表或揭露其發明，且授權或致使該發明或主要內容遭發表或揭露者；或故意違犯第 184 條規定內容，就美國所完成之任何發明擅自提出或致使其被授權向外國申請發明專利、新型、新式樣或模型之登記者，應處兩年以下有期徒刑，或科，或併科一萬元以下罰金。

187. 某些人員排除適用

本節所述之禁止及處罰規定，對於在職權內承辦之官員或職員，或經由書面指示或准許之特定人員，均不適用之。

188. 法令及規章，委任之權力

原子能委員會、國防部長、由總統所指派作為負責美國國防任務之其他機關或單位主管及商務部長，均得分別單獨頒佈法令及規章，以促使其所掌轄之部門或單位施行本節所述內容，並得委任本節所給予各主管之權力。

第 18 節 接受聯邦政府補助所製成發明之專利權

200. 政策與目標

國會之政策與目標係運用專利制度以推動聯邦政府所贊助之研究發展，並且鼓勵中小企業全力參與聯邦政府贊助之研究發展；推動商業團體與包括大學在內之非營利機構間之合作；其目的在確保非營利機構與中小企業所製成之發明係用以推展自由競爭及自由企業；再用以推展利用美國企業及勞工製成之美國製發明品之全面商品化及大眾使用；另者用以取得足夠權利以確保該項由聯邦政府所贊助之發明達到政府所需之作用，並保障大眾免於受不施行或無理使用該發明之損害；最後儘可能之限度降低施行該方面政策所需成本。

201. 定義

在本節中所使用—

- (a)“聯邦單位”係指如美國法典五號第 105 條所謂之行政單位，以及美國法典五號第 102 條內所定義之軍事部門。
- (b)“財源合同”係指除田納西山谷當局以外之任何聯邦單位與任何包商所訂定之合約、贊助，或合作協定而言，其目的在於進行由聯邦政府全數或部分補助其金額之實驗、發展或研究工作。
該名詞亦包括此處所定義之財源合約中，以進行實驗發展，或研究工作之指定分配，多方面之置換，以及任何形式之轉承包之工作而言。
- (c)“承包商”係指財源合約中一方所指之任何人，中小企業公司，或非營利組織而言。
- (d)“發明”係指任何已經或可能依此法令獲得專利或保獲之發明或發現，或依植物變化品種保護法（7 U.S.C.2321 et esq.）所可能保護之任何新品種之植物而言。
- (e)“發明主題”係指在贊助合同下，承包商所承製工作上構思或首次付諸實施之發明而言。假設，在植物新品種之案例，決定日期（如植物新品種保護法（7）U.S.C.2401(d)之第 41(d)條定義））必須在合約承製期間內發生才行。
- (f)“實際運用”乃係指合成物或產品之製造、或製程或步驟之演練，或機器或整體系統之操作；在每一種情況皆係在法令或政府規章所允許設立，而以適當之條件下供應社會大眾，且其情況可應用該發明而且可裨益社會大眾而言。
- (g)“製作”，在與任何發明聯結使用時，係指該發明之構思或初次付諸實踐而言。
- (h)“中小企業公司”係指依公共法 85-536 第二條（15 U.S.C.632）所定義，而且施行中小企業處之規則，所規範之中小企業而言。
- (i)“非營利機構”，係指大學或其他高等教育機構，或依 1954 年國稅法第 501(c)(3)條(26 U.S.C.501(c))所定型之公司，並且依 1954 年國稅法 501(c)第 501(a)條(26 U.S.C.501(c))所規定免稅，或合於依某一州非營利事業組織條例所定之任何非營利之科學或教育組織而言。

202. 權利之讓與

- (a)每一非營利機構或中小企業公司在本條之(c)(1)項所需揭露後之一段時間，皆可能試圖保有該發明之所有權，除非贊助款項合同提供其他條件如(i)該承包商所在地並非於美國境內，或在美國境內無營業處所，或由某一外國政府控制管理，(ii)在某些特定之情況下，主管單位認定對某一發明本體之取得所有權作限制或取消其申請，將可更妥適推展本章所述之政策及標的，(iii)依法定或行政命令所授權之政府權責單位所決定，由進行情報或反情報之活

動所得知，對於該項發明專利所有權之限制或取消係屬必要，以確保該情報行動之安全或，(iv)若果財源合同內包括政府所有，而外包運作之能源部門設施之整體作業，且其主要目的係在提供海軍核子推進器或其有關之武器發展，則在財源合同內所述，依外包商所發展之發明標的所有權限制之副篇幅，將僅限於能源部門所主導之上述兩項案件範圍內。非營利機構及中小企業之權利範圍應依本法條(c)篇幅內容所述或本章有關之其他內容所規範。

- (b)(1)在(a)項所列之政府權利，除非經(a)項中(i)至(iii)款至少一種所述情況之外，不應由任何一聯邦政府單位所主張執行。若係在第(a)(iii)款之例外情形下，該單位在獲得適當之財源合同後之三十天內，應將該決定書函知商務部長。若果該項決定係依第(a)(ii)項內容規定所進行，則該陳述說明應包括評估該決定之分析報告。若該項決定係適用於與中小企業有關之財源合同，則該文件亦應送至輔導中小企業處之首席法律顧問手中。若果商務部長認為其中一種決定或一系列之決定與本章內容所述之政策與方針相違背，或具有任何與本章內容所述不相符合時，商務部長應告知有關之聯邦單位主管以及聯邦採購政策局之行政主管，並且建議其應採行之矯正行動。
- (2)無論何時，只要聯邦採購政策局之行政主管確定，依(a)項第(i)或(ii)款之規定內容，而使用該內容所具效力之一個或多個聯邦單位，有違反本章所述政策或方針時，該行政主管得逕行頒佈法令規章，指出各聯邦單位不得施行各款內容權限之詳細情況。
- (3)每年至少一次，主計長應在其認為適當之情況下，向參議院及眾議員之法制委員會呈送一份報告，陳述依本章內容規定而由聯邦單位或其他政府機構執行，有關由聯邦贊助之發明，所獲專利之政策及實務執行效果。
- (4)如承包商認為該項決定違反本章內容所述之政策及方針，或構成該單位濫用其職權，則該項決定應依第 203(2)條內容最後一段篇幅所述規定辦理。
- (c)每件與中小企業公司或非營利機構所訂定之財源合約，應包括適當之合約內容以施行完成下列情況：
- (1)在該承包商內負責專利行政事務之人員知曉該專利後之一定合理時間內，向聯邦單位揭露其發明標的內容，而且，聯邦政府可能在該期間內獲得屬於合約內，而未向其揭露之其他有關該合約之專利標的。
- (2)承包商在向聯邦政府揭露該發明後兩年內（或聯邦政府單位核准之其他額外時間），以書面表示其是否欲保有該發明標之所有權；假設，無論是刊行、銷售或公開使用皆已使在美國境內可以取得有效專利之一年法定期限起算，而該抉擇期限可能在法定期限內依聯邦政府單位之指示而縮短六十天以下；進一步假設，如果承包商未選擇保留專利權，或未在該期間內選擇，則聯邦政府即可能取得該項發明標之專利所有權。
- (3)某一承包商在其專利權因為公開發表、銷售或公開使用之法定禁止期限到期前，同意申請其發明標之專利權，然後，願向國外申請其相同之專利並且保持適當期限之專利權。除外，聯邦政府得在承包商並未以該發明標的向美國或其他國家申請專利之期限內，以該發明申請並且保有其專利。
- (4)至於任何由該承包商選擇取得專利權之發明，該聯邦政府單位應有非獨佔、不可轉讓、不可取消並已全數付款之許可證，供美國在全世界施行或繼續施行其發明標的。假設，在財源合約內得提供額外之權利，包括該發明標的之國外專利權之授與或已經授與，或由該單位所決定而須符合美國與外國所訂之條約內容之應盡義務，或合作之協定，相互瞭解之備忘錄，或其他有關武器開發及生產合約之類似協定。
- (5)應包含由聯邦政府單位向承包商或其授證或讓受個體要求，定期呈報其使用或取得使用之努力程度。假設，任何有關資訊以及其使用情形或取得資訊之努力程度情形，皆係依

本章第 203 條規定列為部分程序時，應以聯邦政府單位向某特定人士取得特殊保密之商業及財務資料，不應受美國五號法典第 552 條之揭露規定辦理。

(6)如某一美國專利係由該承包商或其讓受人提出且為其本身之利益而申請時，應規範該承包商這一方面之義務，其中應包括所申請之說明書內容及因此而頒發之專利，以及明確指出該發明係由聯邦政府所贊助之聲明，且聯邦政府應在該發明上有某部分權利。

(7)若係某一非營利機構，

(A)禁止在未經聯邦政府單位之同意前，於美國境內讓受某一發明標的物之權利，除非該讓與係讓給某一公司，而其中部分主要之營業項目機能為經營各種發明品假設該受讓人與承包商皆受同樣之法令規範)；

(B)要求承包商與發明人分享專利權使用受益；

(C)除了有關政府所有，而由承包商負責操作之廠房之財源合約之外，由該發明所取得之權利金或所得，在支付與該發明產品有關(包括付給發明人)之費用之結餘，應該被運用於發展科學研究之教育；

(D)除非在合理之調查後，證實給中小企業實施不可行，否則該使用執照應頒發給中小企業；

以及

(E)有關政府擁有，而由承包商運作之廠房經營之財源合約，要項

(i)在支付專利申請成本，使用執照成本，支付給發明人，及支付有關該發明產品經營管理之其他費用後，在由承包商所收受及保留之權利金及收入之盈餘之百分之百，而且在達到該廠房設施年度預算之百分之五金額之程度內，應由承包商在配合該廠房設施之研究發展任務及目標之情況下，應用於該廠房之研究發展及教育工作上，其中包括該廠房設施內已有發明之使用執照取得之各項活動在內；倘若，該結餘超過廠房設施年度預算之百分之五，則其超過部分之百分之七十五應付給美國財政部，而其剩餘之百分之二十五則應用於如前列(D)目所示之相同目的；及

(ii)在本合約提供最有效之技術移轉之程度內，本發明主體標的之使用執照應由該廠房內之承包商職員所經營及管理。

(8)本章第 203 及 204 條內容規定所需要件。

(d)若依本條所規定內容之事例，承包商選擇不保有該發明標的之所有權，則聯邦政府單位可能在與該承包商洽詢討論後，逕自在本法條所規定，及其後所公佈之各項規則所述，核發由發明人保有該發明標的之請求。

(e)無論如何，只要某一位聯邦職員係依某一財源合約內容規定，而成為與某一非營利機構或中小企業之任何一發明之共同發明人，該共同發明人所服務之聯邦單位有權在依本節所述情況下，將該職員由其發明標的內所可能取得之任何權利，移轉或指定給該合約承包商。

(f)(1)除非某聯邦單位之主管同意，而且已經簽字並以書面證實，否則任何與非營利機構或與中小企業所簽訂之財源合約內，均不得含有允許聯邦單位要求其承包商，在準備容許第三者使用其非該發明標的之其他發明時，尚須取得使用執照之規定。任何該類規定均須明確指出，與該項發明標的有關，或特別標明事物，或兩者是否需要使用執照。該聯邦單位主管不得將本篇幅所述之內容規定授權他人同意或簽署證實。

(2)除非聯邦單位之主管確定，其他人員使用該發明對該發明標的之實施或財源合約內之某工作項目確屬必須，而且要求使用執照對達到發明標的或工作項目之實際運用亦為需要，否則，聯邦單位不應要求第三者依本節規定提出使用執照。在單位內舉行公聽會後，

任何該類事項之決定必須保留存檔，而任何有關該類決定之司法審查之訴訟，應在決定通知送達後六十天內提起。

203. 前進施行權利

- (1)若果聯邦政府單位確定有下列(a)、(b)、(c)、(d)四種情況時，該聯邦單位在提供財源合約以完成某一發明標的，而在某一中小企業或非營利機構在依本章內容規定取得該發明標的之所有權後，應有權依本章規則所公佈之程序內容所述，要求承包商、其讓受人，或該發明標的之專有總代理商，准予合理之單一或多數申請人在任何一行業領域取得非專有代理，部分專有代理或全部專有代理之使用執照，如果該承包商、其讓受人或專有總代理商拒絕該要求，則該聯邦單位可逕自核可其使用執照，上列四種情況分述如下：
- (a)該動作係屬必要，因為此承包商或讓受人尚未，或在可預見之未來將不會採取有效之步驟，使該發明標的在特定行業領域達到有效的實際應用。
- (b)該動作係屬必要以緩和或安全之需要，因為承包商、讓受人或其許可人未能使需要合理的達到滿足。
- (c)該動作特別係依聯邦規定需達到公共使用之要求，而承包商、讓受人或其許可人不能合理的滿足該項內容需求。
- (d)該動作並不需要，因為依第 204 條所定之合約並未被取得或豁免，或取得許可專有在美國使用或販賣該發明標的之許可人，依第 204 條所規定，已違犯該合約內容。
- (2)在依據本條或第 202(b)(4)條所為之決定，應不受契約爭議法案內容規定（41 U.S.C. § 601 及其後法條）所拘束。若有行政救濟事件，其程序應依第 206 條內容所規定之程序進行。除外，任何承包商、發明人，或專有許可代理商，在依本條所作決定而受到不利之影響，可在該決定發佈之六十天內，向美國聯邦求償法院提起訴訟，該法院應有其權限，適當地針對申訴案件中，該聯邦單位之決定，作確認、撤銷、發回或修正之較妥適決定。在(a)及(c)篇幅內所述之情況中，該聯邦單位之決定應暫時中止進行，直到依前文所述之申訴或訴訟程序結束為止。

204. 優先採納美國企業

除本節另有規定外，任何由本發明標的取得所有權之中小企業、非營利機構，或該中小企業及營利機構之使用人在內，均不得將其專有使用或銷售該發明標的之權利讓與任意第三人，除非該第三人同意涵蓋該發明標的，或經由使用該發明標的所生產之物品主要均製造於美國境內。然而，在個別案件中，此種在美國製造之要求可能在財源契約中經聯邦單位得到豁免，只要在經由中小企業、非營利機構或其指定人，曾經合理的嘗試將該發明標的之許可在美國境內製造其主要部分而未成功，或在國內製造並不合乎成本效益之理想情況者亦可。

205. 保密

聯邦單位有權在相當時期內向社會大眾保持緘默不宣洩其專利機密，尤其是聯邦政府所擁有或可能擁有一部分之專利權利、所有權或利益（含非專有之執照），以便能夠提出專利申請，尤其，聯邦單位不得公開已向美國專利商標局提出專利申請，或已向任何外國專利主管機關提出申請之任何專利說明書及其相關申請資料。

206. 統一之條款及規則

商務部長得頒佈有關之規則，適用聯邦政府單位進行第 202 條至 204 條所規範之內容，並且依本章所規範內容訂定標準之財務來源協定。在頒佈本條內容所述之規則及財源協定前，應先經大眾評論。

207. 聯邦擁有發明之國內及對國外之保護

(a)每一聯邦政府單位有權—

- (1)向美國或其他國家申請、取得並且保持專利或其他形式之保護，只要這些(發明)均係由聯邦政府擁有權利、所有權或是利益之發明。
- (2)在聯邦所擁有之專利實施、專利權，或其他形式取得之保護中，在免權利金、有當權利金或其他相當對價之條件下，可准予非專有使用、專有使用，或部分專有使用執照。而且，在此種條件及情形下，亦可授與被授權之執照所有者在第 29 章之規範下，經研判對社會大眾有益之情況實施專利。
- (3)直接或經由契約接受聯邦政府之委託，承擔進行所有其他適當而且必需之步驟，以保護及經營聯邦所擁有之發明權利。
- (4)移轉聯邦所擁有發明之全部或部分權利，所有權或利益之監護及經營職責予任何其他聯邦單位。

(b)為了確實有效的經營管理聯邦所擁有之發明，商務部長應有權利—

- (1)輔助聯邦政府單位努力推展發證授權及使用聯邦所擁有之發明。
- (2)輔助聯邦政府單位尋求外國政府對其發明之保護及持有，包括有關該發明所需之年費及其他成本。
- (3)諮詢及建議聯邦政府單位有關科學及技術範圍之研究及發展，及其付諸商業化使用之可能性。

208. 掌管聯邦證照適用之法規

商務部長依法得公佈除田納西各當局擁有之發明外，任何依聯邦法獲得之發明應被授與非專有、部分專有或獨有之專利權之依據。

209. 對聯邦所擁有之發明授證的限制

- (a)除個人已提供該政府機構發展或行銷計劃外，任何政府機構皆不得將聯邦所有之發明授證予個人。但如果政府機構可將此計劃視為取自個人之商業及財務性資訊，且為依法豁免享有特權及私密性，及按美國專利法典第 552 條第五項所規定無需揭露者除外。
- (b)一般而言，政府機構可在美國境內授權個人使用或將任何聯邦所有之發明售與個人。但被授權實施者必須同意任何具備此發明之產品，或生產過程中用及此發明之產品絕大部分均係在美國製造。
- (c)(1)如在公告及舉發期後，被認定有下列各種情形，則任何一個政府機構均可授權專有或部分專有予任何聯邦所有之國內專利或申請中專利所涵蓋之發明—
 - (A)申請授證人之意願、計劃及將此發明實際應用之能力，或增進公眾對此發明之利用，為對聯邦政府及公眾提供最佳利益者。
 - (B)已授與或可授與之非專有性發明使用證照，在沒有得到合適的實用性申請，或於近期出現此申請之可能性不高者。
 - (C)專有或部分專有性授證為合理及必要之誘因，以收到風險性資本及經費，將此發明實用化或增進公眾對此發明之利用。且，

(D)所提出專有性之條件及範圍未超過提供合理必要之誘因，以將此發明實用化或增進公眾對此發明之利用程度。

(2)若一聯邦政府機構確定在准許證照後，將相當程度地降低競爭力，或導致某些商業產品不適當之集中有關此項技術之證照授與，或製造或持續違背反托拉斯法之情形時，該聯邦機構將不會授與依本條第(1)章節內所規範之專有或部分專有之證照。

(3)有關此聯邦所有之發明應該優先考慮授與專有或部分專有證照與中小企業，只要該機構確定其申請之中小企業有能力或同樣有能力，將該發明付諸實施，而且其所呈送之計劃書與非中小企業之計劃書所需具備之能力相同或相近似者。

(d)在經過審查美國聯邦政府或美國在海外之企業是否會強化後，任何聯邦機構可能授與其在外國申請中之專利或已有之專利權給予專有或部分專有之證照，係在大眾已獲准專利公告通知且有機會發出異議申請之後；除外，若果聯邦機構確定授與該項使用證照將會相當地降低競爭力，或導致與該授權使用有關技術之產品會產生在美國部分區域不適當之集中，或製造或延續違背反托拉斯法之規定者，將不核發授與專有或部分專有之使用證照。

(e)聯邦機構應保留核發專有或部分專有證照之決定記錄。

(f)由聯邦機構所核發之證照，其中需包含經確認係可適宜保障美國聯邦政府及社會大眾利益之條件及狀況，其中並包含下列所述：

(1)定期的針對提出特別註解參考之授證者敘述報導其使用情形，或取得使用之努力情形：假設，該聯邦機構可能將該資訊當作由一位具有特權及機密人工所獲取之具商業性及財務性之資訊，且依美國 5 號法典第 552 條之內容規定不需揭露者。

(2)如該聯邦機構確定其證照持有者並未依其申請證照所述之內容執行，而且，該持有證照者又未能顯示其已著手，或在短期內著手開始執行有效之程序以達成實際施行該發明專利時，聯邦機構得全面或片面終止該證照。

(3)如證照持有人違反依本條(b)篇幅之內容規定之合約時，該聯邦機構得全面或片面終止該項執照。

(4)如該聯邦機構確認某些措施乃必要，以符合在證照所有權取得日後由聯邦所頒佈以供大眾使用之規則，並未為證照使用人合理的達到該新規則之要求，則該聯邦機構有權得終止全部或部分該項證照。

210. 本節優先適用階層

(a)本節所述規定內容優先適用於任何中小企業或非營利事業機構之承包商依其他法律規章需處分有關本發明之所有權，且該法律規章與本節所述規定內容不相符合時，其中包括但不限於下列所述：

(1)在 1946 年 8 月 14 日之本法典第一案所增訂，有關 1935 年 6 月 29 日第 10(a)條(7 U.S.C.427i(a)；60 Stat.1085)；

(2)1946 年 8 月 14 日本法典第 205(a)條，(7 U.S.C.1624(a)；60 Stat.1090)；

(3)1977 年聯邦礦業及健康法典第 501(c)條，(30 U.S.C. 951(c)；83 Stat.742)；

(4)1966 年國家交通及汽車安全法典第 106(c)條，(15 U.S.C.1395(c)；80 Stat.721)；

(5)1950 年國家科學基金法典第 12 條(42 U.S.C.1871(a)；82 Stat.360)；

(6)1954 年原子能法典第 152 條 (42 U.S.C.2182；68 Stat.943)；

(7)1958 年國家航空及太空法典第 305 條 (42 U.S.C.2457)；

(8)1960 年煤礦研究開發法典第 6 條(30 U.S.C.666；74 Stat.337)；

(9)1960 年氬氣法典修正案第 4 條(50 U.S.C. 197b；74 Stat. 920)；

(10)1961 年武器控制及解除法典第 32 條(22 U.S.C. 2572；75 Stat. 634)；

(11)1965 年阿帕拉磯區域開發法典第 302 條第(e)款(40 U.S.C.App. 302(e)；79 Stat.5)；

(12)1974 年聯邦非核子能研究及開發法典第 9 條(42 U.S.C. 5901；88 Stat.1878)；

(13)消費者產品安全法典第 5(d)條(15 U.S.C.2054(d)；86 Stat.1211)；

(14)1944 年 4 月 5 日本法典第 3 條(30 U.S.C.323；58 Stat.191)；

- (15)固態廢物排除法第 8001(c)(3)條，(42 U.S.C.6981(c)；90 Stat.2829)；
- (16)1961 年對外援助法典第 219 條(22 U.S.C.2179；83 Stat.806)；
- (17)1977 年聯邦礦業健康及安全法典第 427(b)條(30 U.S.C.937(b)；86 Stat.155)；
- (18)1977 年地面採礦及復原法典第 306(d)條(30 U.S.C.1226(d)；91 Stat.455)；
- (19)1974 年聯邦火災預防及控制法典第 21(d)條(15 U.S.C. 2218(d)；88 Stat.1548)；
- (20)1978 年太陽能光電能量研究開發及展示法典第 6(b)條(42 U.S.C. 5585(b)；92 Stat.2516)；
- (21)1978 年天然乳膠商品化及經濟開發法典第 12 條(7 U.S.C. 178(j)，92 Stat.2533)；以及
- (22)1978 年水資源開發法典第 408 條(42 U.S.C. 7879；92 Stat.1360)

創出本節之法典應被歸納推斷為優先適用其後之法典，除非其他之法典特別引證本法典而且指明其優先適用超越本法典之內容規定。

- (b)有關與非營利機構或中小企業以外之任何人所訂財源合約之執行，本節並未提出改變本條(a)篇幅或其他法律有關該發明權利出售所引證之法令內容。
- (c)本節並無任何意圖去限制任何依 1983 年 2 月 18 日政府專利政策聲明敘述[36 Fed Reg 16887]內容規定或機關規定，或其他適合規定之機關，出售其與非營利機構或中小企業以外之任何人所簽訂之財源合約內容規定，出售其發明之權利；或限制該機關之權責，准許該人士保有該發明之所有權，除非所有該財源合約，包含有那些中小企業及非營利機構以外之單位在內之合約內容，具有本法典第 202(c)(4)篇幅及第 203 條之要項。任何依此聲明或有效適用之規則內容規定出售發明權利，包含在本條法律施行前已經出售之發明，均在授權准許之列。
- (d)在本節內並無任何規定以推斷需要揭露機密來源或程序，亦無法律規定內容足以影響已由法令或行政命令准予中央情報局長有權保護機密情報之來源及程序之既有情況。
- (e)在 1980 年通過之史蒂芬生—懷德科技更新法案內容，且 1986 年由聯邦科技移轉法案修正之內容，較本節內容所述較具優先權，且准予或需要出售與本節內容不相一致之發明權利。

211. 本法與反托拉斯法之關係

在本節所述內容規定，並無任何可幫任何人逃避或豁免於民法或刑法之責任，亦不能在反托拉斯法內用為抗辯之理由。

212. 在教學獎勵上拋棄權利

在任何由聯邦機構主要為教育目的所贊助受獎人之獎學金、學術獎勵金、訓練補助或其他財源合約，均不包含任何由受獎人完成，而由聯邦機構取得發明權利之任何內容規定。

第三章 專利與專利權之保護

第 25 節 專利證書之修正與更正

251. 瑕疵證書之換發

專利權人非因詐欺發生錯誤，致說明書或圖示有瑕疵，或其申請專利範圍之部分超過或未達其應請求之權利範圍，致專利證書之全部或一部分無法生效或無效者，於繳回該專利權證書並繳納法定規費後，局長應就新修正之申請，依原已公開之發明換發專利證書，其有效期限至原專利權期限為止，換發之申請不得加入新實質內容。

經申請人之要求，且已繳納換發證書之各項法定規費，局長得就原專利可區別之部分，分別換發數個不同之專利證書。

本法有關申請專利之規定，準用於換發專利證書之申請，如換發專利證書申請並未擴大原專利之申請專利範圍，其換發證書之申請得由受讓全部利益之受讓人宣誓後進行辦理手續。

原專利證書取得之日起二年內，未申請換發專利證書者，於二年期滿後所換發之專利證書之申請專利範圍，不得超過原專利證書所涵蓋之申請專利範圍。

252. 換發之效力

原專利權之喪失，係自換發新專利證書之發給日起生效，每一換發之專利證書，在因其後所發生之原因而涉訟時，與最初即以此修正後之內容核發之證書，具有相同之法律效力，但在原專利證書與換發後之專利證書之申請專利範圍內容相同時，原專利證書之拋棄並不影響繫屬中之訴訟，或使現存訴訟原因歸於無效，且換發之專利證書，於其申請專利範圍與原申請專利範圍相同內容部分，應屬原專利證書之延續，且溯自原專利證書核發之日起，繼續有效。

在換發之證書核發前，已在美國境內或輸入美國境內，供商業上之實際製造、購買、要約銷售或使用屬於換發證書之專利產品者，對於該行為人或其繼承人，不得因換發證書而剝奪或影響其繼續使用、要約銷售，或售予他人以便使用、要約促銷或出售其特別製造、購買、要約促銷、使用之特定物品項目之權利，但如其製造、使用、要約促銷、配售之產品侵害原專利證書所既有，且為換發證書之有效申請專利範圍內容時，則不在此限。負責審理此類案件之法院，得對在美國境內依原專利證書所敘述內容製造、購買、要約促銷或進口之該項物品，准予其繼續製造、使用、要約促銷或銷售；或對於換發證書核准前已完成實質準備者，准其製造、使用、要約促銷或銷售於美國境內；法院對於核准換發證書前業已實施，或繼續實施之專利方法，或在換發證書前已完成實施準備者，准其實施，但其範圍與條件，應以換發證書前已作投資，或已開始營業者作適當之保護為限。

253. 放棄權利

專利權內之一部分申請專利範圍在無詐欺之意圖情況下變成無效時，其餘之申請專利範圍並不隨之無效，專利權人不論擁有專利權之全部或部分利益，得於繳納法定規費，並且指明該專利之權利範圍後，放棄其全部或部分申請專利範圍。棄權行為應以書面為之，並登記於專利商標局，且該棄權行為造成之影響及其聲明事項視為原專利之一部分。

專利權人或申請人，亦得將所核准或即將核准之專利有效期限或部分有效期限之專利權，全部放棄或提供予社會大眾。

254. 因專利商標局之錯誤而更正證書

專利證書因可歸責於專利商標局之錯誤疏失，且業已明白揭露於局內所保留之記錄者，局長得免費核發更正證書，並於其中載明錯誤之事實與性質，蓋上局印，並登載於專利之存卷記錄上。其更正後之副本應附於原專利之副本，且該專利證書應被視為原專利證書之一部分，此種附有更正證書之專利證書，若於其後發生法律訴訟時，將被視為與更正後之專利證書具有相同之法律效力，局長得免費發給更正後之專利證書以代替更正證書，其效力與更正證書同。

255. 因申請人之錯誤而更正證書

專利證書上有不可歸責於專利商標局之任何抄寫、印刷或小錯誤，且其錯誤經證實係出於善意者，局長得於申請人繳納規費後，發給更正證書，但其更正內容不得包含新事項，或需為再審查之資料。此種附有更正證書之專利證書，若因更正後之任何原因發生法律訴訟情況時，視為與更正之專利證書，具有相同之法律效力。

256. 更正錯誤之發明人

因作業之疏失，於專利證書上將第三者列為發明人，或漏列發明人之姓名，且經查證並無詐欺意圖時，局長得依據全體當事人及受讓人之申請，經證明其事實與其他必要事項，核發更正錯誤之證書。

非發明人或漏列發明人而可依本條規定更正者，該專利證書並不因之無效，審理有此類爭議問題之法院，經通知並聽訊全體當事人之陳述後，得命令專利商標局更正，局長並得依該命令核發更正證書。

第 26 節 所有權與讓與

261. 所有權、讓與

依本法之規定，專利權具有動產之性質，專利申請權、專利權，或任何與其有關之權益，均得依法以書面方式讓與，專利申請人、專利權人，其受讓人或法定代理人，得依同樣之方式，將專利申請權或專利權，在全美國境內或特定區域內，讓與他人。

承認證明書，經國內由有權監司宣誓之官員，或於外國由美國外交官或領事或經其授權之官員，或依協約、協定得由外國政府指定之人員署名，並加蓋關防者，得作為專利權或專利申請之讓與、授與之初步證據。

讓與、授與，非於其行為日起三個月內，或其後之買賣或設定抵押權前，向專利商標局登記者，倘未經通知不得對抗於其後支付相當代價之買受人或抵押權人，或受讓人。

262. 共同所有權人

除有其他相反之約定外，共同所有權人，得不經其他共有人之同意，亦無需向其他共有人說明，得逕自於美國境內製造、使用、要約銷售或銷售已獲得專利之發明產品，或將該已獲得專利之發明產品輸入至美國境內。

第 27 節 政府在專利權之權益

[266 廢止，1965 年 7 月 24 日廢止，Public Law 89-83，sec.8, 79 Stat.261]

267. 政府申請所需之時間

縱令有第 135 條及第 151 條之規定，如專利申請已成為美國財產，且政府有關部會、機關首長曾經向專利商標局長確認，該項發明之揭露對於美國之軍備或國防具有重要意義時，局長得將期限延長至三年，以供其於該期限內採取任何行動措施。

第 28 節 專利權之侵害

271. 專利權之侵害

(a)除本法另有規定外，於專利權存續期間，未經許可於美國境內製造、使用、要約銷售，或銷售已獲准專利之發明產品，或將該專利產品由外國輸入至美國境內，即屬侵害專利權。

(b)積極教唆他人侵害專利權者，應負侵權責任。

(c)要約銷售或銷售，或由外國進口，屬方法專利重要部分之機器構件、製品組合物或化合物，或實施方法專利權所使用之材料或裝置，且明知該特別製作或特別引用乃係作為侵犯該項專利權，當上述情形並非作為主要或屬不具實體侵害作用之商業上物品時，應負幫助侵權者之責任。

(d)侵害專利權，或幫助侵害之事情發生時，有權行使侵權救濟之專利權人，不得因有下列各款情事之一而否定其行使救濟之權益，或被視為專利權之濫用或不法之權利擴張：

(1) 因他人實行未經專利權人同意幫助侵害行為而使專利權人獲得利益者；

(2) 許可或授權他人之行為，該行為若未經其同意而執行時，即構成幫助侵害專利權行為者；

(3) 為抑止受侵害或受到協助侵害其專利而尋求實施其專利權內容者；

(4) 拒絕授權他人實施或使用其專利權者；或(5) 附加專利授權之條件或需購買其他專利以銷售其專利品，或需採購不同產品以銷售其專利品，但專利權人在該相關產品市場具有相當銷售能力者，不在此限。

(e)(1) 在美國境內製造、使用、要約銷售或銷售專利產品依聯邦法令之規定，係為藥品、家畜生理產品之發展而合理使用或提供資訊者，不得視為侵權行為〔但新動物藥品或家畜生理產品，而該產品係主要由去氧核糖核酸(DNA)之再結合，或核糖核酸(RNA)再結合，混合配種技術，或其他有關配置特殊基因運用之技術過程不在此限(在 1913 年 3 月 4 日由食品、藥物及化粧品法案及本法案所使用之術語)〕。

(2) 提出下列所述文件係屬侵權行為—

(A) 依聯邦食品、藥物、化粧品管理法第 505(j) 條內容規定提出申請，或依該法第 505(b)(2) 條提出之申請包含他人專利內所含之藥品或使用該專利權內所涵蓋之藥品。

(B) 依聯邦食品、藥物、化粧品管理法第 512 條或依 1913 年 3 月 4 日之法(21 U.S.C. 151~158) 提出藥品或家畜生理產品之申請，而該產品並非由去氧核糖核酸(DNA)再結合，核糖核酸 (RNA) 再結合，混合配種技術或含有配置特殊基因運用之技術過程，而包含於某專利之申請專利範圍內，或所使用之產品係已包含於其申請專利範圍之內者，若該項資料之提出係用以依該法令規定內容取得核准，以便在該專利權失效之前，著手製造、使用或銷售泛商業性藥品或家畜生理產品。

(3) 依本條規定提起之專利侵害訴訟，關於第(1)款所述於美國境內製造、使用、要約銷售或銷售，或由外國輸入專利品者之規定，不得以禁止命令或其他方式處罰。

(4) 依第(2)款所述之侵權行為中—

(A) 審理法院應下令，涉及侵權行為之藥品或家畜生理產品之核可生效日期，不得早於受侵害專利權屆滿之日。

(B) 為達到禁止於美國境內之商業性製造、使用或銷售藥品或家畜生理產品，或輸入該產品至美國國內，得准予禁止命令或其他類處罰，及

(C) 若侵權者已在美國境內從事商業性之製造、使用、要約銷售或銷售已獲准專利之藥品或家畜生理產品，或輸入該類產品至美國境內時，法官得判決侵權者損害賠償或其他金錢救濟。

在副款(A)、(B)、及(C)中所敘述之賠償，係指法院依第(2)款所述之侵權行為給予之賠償，另外，法院亦可依第 285 條之規定判給律師費之補償。

(f)(1) 未經許可提供或使人提供在美國境內或由美國境內所生產專利產品之全部或主要部分，該全部或主要部分係指尚未組合之狀態下，若於在美國境外將該主要部分加以組合，恰如其在美國境內將該專利加以組合，應視為侵權者而負其責任。

(2) 任何人在未經許可下，提供或使人提供在美國境內或由美國境內核可之專利部分產品，而該產品係特別製造或特別適用於該發明，但非作為主要或屬不具實質侵害作用之商業上物品時，將該類產品於美國境外組合，恰如其在美國境內組合，均為侵害該專利權，應視為侵權者而負其責任。

- (g)在方法專利之有效期限內，未經許可而擅自進口該項方法專利產品，或於美國境內擅自要約銷售或使用該方法，視為侵權者而負其責任，方法專利之侵權訴訟，不因屬非商業性使用或零售該項產品而不得請求損害賠償，但無適當之進口、其他用途、要約銷售或銷售該產品者，不在此限。但下列情形所製造之產品不視為依方法專利所製造者：
- (1)方法係經顯著改變者；或
 - (2)該產品僅為其他產品之非重要組件者。
- (h)本條所述之，”任何人”包括任何州、任何州之單位、任何州政府之官員或職員或在已視之核可授權範圍執行州政府任務之單位，在本法規定範圍內，任何州、任何該類單位、官員、職員與任何非政府個體享有同樣程度之權責規範。
- (i)本條所述，非專利權人或其受讓人之”要約促銷”或”要約銷售”，係指該銷售行為在專利權期限屆滿前完成者。

272. 暫時存在於美國

凡外國給予美國之船隻、航空飛機或車輛享有與該國家相同特權者，在該國家所屬船隻、航空飛機或車輛暫時或偶然進入美國境內時，在此交通工具上所使用之發明物將不構成對任何專利權之侵害，但以該發明物為專供船隻、航空飛機或車輛之使用為限，且該發明物不得在美國境內要約銷售、銷售或使用於製造完成在美國境內販賣，或由美國輸出之任何產品。

第 29 節 專利權侵害之救濟及其他訴訟

281. 專利權侵害之救濟

專利權人對專利權之侵害得提起民事訴訟請求救濟。

282. 有效性之推定、抗辯

專利權應被推定為有效，每一申請專利範圍項目（無論係獨立項、附屬項或多項附屬項型式）均應推定為獨立有效，而不受其他申請專利範圍項目之影響；縱使所依附之申請專利範圍部分無效，附屬項或多項附屬項之申請專利範圍仍應視為有效，主張專利權全部或其中任何部分申請專利範圍無效之舉證責任，應由主張者擔負之。

涉及專利權之效力或侵害之訴訟，得以下列諸款理由，據以提出抗辯。

- (1)無侵權行為、欠缺侵權責任或有不得主張專利權之情事者。
- (2)以未具第二章有關取得專利要件之規定為理由，於訴訟中主張專利權或任何申請專利範圍項目為無效者。
- (3)因不符第 112 條或 251 條之要件，而使專利權或任何申請專利範圍項目為無效者。
- (4)其他依本法足以構成答辯之事實或行為者。

關於專利權效力或侵害之訴訟，主張無效或無侵害行為之當事人，至少應於審理之三十日前，以答辯狀或其他書面，將下述事項通知對造，其中包括該專利權之國名、號數、日期及專利權人之姓名，以及專利訴訟所據以為引證之刊物標題、日期、頁數號碼，除美國請求法院以外，該項資料所顯示之技術及可認為較早發明者或較早知悉者之姓名與住所，或已先行使用或販賣該項發明者，若怠為上項通知時，除符合法院所訂條件外，上述事項之證明不得於審判時提出。

依第 156 條之規定，專利權或其部分權利之延展無效，係因下列人員之重大過失—

- (1)申請延展之申請人，或
- (2)專利商標局長

在有關該延長期間內之專利侵害訴訟中得據以提出抗辯，但是否已依第 156(d)(2)條規定善盡注意之判定，非該訴訟審理之範圍。

283. 禁止命令

依本法規定，對於訴訟有管轄權之各法院，為防止專利權益受到危害，得依衡平原則及法院認為合理之情況下，發佈禁止命令。

284. 損害賠償

根據有利於原告之證據顯示，法院應對原告因專利受侵害之程度作出判決，給予足夠之賠償，其數目不得少於侵權人實施發明所需之合理權利金，以及法院所定之利息及訴訟費用之總和。陪審團如未能確認損害賠償額，法院應估定之，以上任一種情形下，法院均得將決定或估定之損害賠償額增加至三倍。

法院得請專家作證，以協助決定損害賠償或在該狀況下合理之權利金。

285. 律師費

在例外之情況下，法院得判決敗訴者支付合理的律師費用給予勝訴者。

286. 損害賠償之時間限制

除法律另有規定外，對於提起侵害之訴或其反訴前六年以上之侵權損害，不得請求賠償。因使用已獲准專利之發明，而對美國政府提出損害賠償請求時，在提起訴訟前，自有權處理此種請求之政府部會首長受理賠償之書面請求後，至該受理單位對於請求人寄發拒絕其請求通知之期間，未超過六年之範圍內，不計入前項期間內之一部分。

287. 損害及其他賠償之限制、標示及通知

- (a) 專利權人與為其工作或依其指示於美國境內製造、要約銷售或銷售獲有專利之產品，或將專利產品輸入美國境內者，得於其產品附上專利(patent)或其縮寫(pat)之字樣與專利號碼；如因產品之性質不能附上前述字樣時，得將含有該字樣之標籤附在產品上，或含有一個或數個產品之包裝物上，以告示社會大眾。如未為上述標示，專利權人不得於侵害訴訟請求損害賠償，但如能證明侵權者已受侵害之通知，仍未停止其侵害行為，則通知後續行侵害之部分得請求損害賠償。侵害訴訟之提起，視為侵害通知。
- (b)(1) 依第 271(g)條規定所述之侵權人，應依本法有關損害賠償及禁止命令之規定辦理，但依 1988 年方法專利修正案第 9006 條之規定；及下述之人不適用之—
 - (A) 已先使用該專利之方法；
 - (B) 擁有或控制他人，或受他人所擁有或控制，已先使用該專利之方法；或
 - (C) 在侵權行為發生前已知悉，該專利之方法係專門用以製造某產品，且該產品之輸入、使用、要約銷售或銷售者。
- (2) 於知悉其產品侵害專利權前之持有或運送，不負 271(g)規定之侵權賠償責任，但行為人應對其持有，運送負舉證責任。
- (3)(A) 依第 271(g)條規定提起侵害訴訟時，法院應斟酌下列情事—
 - (i) 要求被告揭露事項時所顯示之善意表現。
 - (ii) 要求原告揭露事項時所顯示之善意表現。
 - (iii) 為恢復專利權所應享有之專有排他權之需求。
- (B) 下列乃善意表現之證據：
 - (i) i. 被告提出依請求所揭露之事實。
 - (ii) 依請求揭露之事實，在合理之時間內加以適當之回應者；

(iii)由被告提出回覆資料給製造商，(若不知製造商，則提供給經銷商)，向其指明被告所採購之產品，及要求廠商述明，在回覆資料中所述之專利製程方法並非用以製造該產品之書面聲明。

除有其他減緩情況之反證外，若未顯示上列情形所述之行為者視為缺乏善意表現之例證，前述減緩情況係包括所涉訴訟產品之特性，因該產品之不同來源，以及其他相類似之商業情況，或請求揭露之事實對避免專利侵權係不必要或不實際者。

(4)(A)本副款所指，“請求揭露”係指向從事於該項產品之製造者，以書面聲明，明確指出其所擁有之全部方法專利或許可使用之方法專利，依第 271(g)條所述，被無授權使用者輸入、銷售、要約銷售或使用於美國境內之情況發生，即可據以主張其專利權遭侵害。一個要求揭露更被限定於該要求—

(i)係由要求揭露者於美國境內經常地從事於銷售、製造相同產品，或提出要求揭露者試圖於美國境內銷售相同之產品。

(ii)係由於初次進口、使用、要約銷售或銷售該產品之前，或該人員知曉其產品侵犯專利前；以及

(iii)係包括由提出要求之人公開陳述，其將迅速地向製造商要求，若不知製造商則向供應商要求，針對其所欲採購之產品，要求廠商以書面聲明在製造該產品時，並未使用該方法專利內所包含之申請專利範圍內容項目。

(B)若要求揭露係由授權使用該專利之廠商所接獲時，該被授權許可廠商可直接指明其專利內容，或立即轉交該要求揭露之訊息給原專利授權人。

(C)於要求揭露之申請收到前，已於要約銷售或銷售於美國之產品，或輸入美國境內之所有產品上，依(a)項之內容規定，標示依該專利方法所製造完成之方法專利號碼者，無需對該要求揭露之行為作出回覆，在上列句子內所述“所有產品”，不包含 1988 年方法專利修正法案生效前所製造之產品。

(5)(A)依本副款所述，知悉侵害係指確實知曉，或已接獲書面通知，或前兩情況之組合，由所獲得之訊息足夠使任何一個普通人認知該產品極有可能係由方法專利之製程所作成者。

(B)專利所有權人告知侵權之書面通知，應明確指明其聲稱受侵害之方法專利內容，以及其善意相信該方法專利已經被使用之原因。在該通知書內，專利權人應當合理地表達其專利權之意見，惟商業上之機密資料，則無需揭露。

(C)自接獲副款(B)所述之書面通知，或第(4)款內所述之對要求揭露所作回覆之書面反應時，視為已接獲該書面通知或書面反應之專利權受侵害之通知，除該人在無減緩情況下—

(i)立即將該書面通知或反應傳送給製造商，若不知製造廠，則傳送給供應商，其所購買或即將購買產品之有關資料；及

(ii)接獲由製造廠或供應商所提出之書面聲明，明確指出其所聲稱之專利權並未被侵害之真實基本資料。

(D)依本附款內容所述，當持有依方法專利內容所製成之鉅量產品，且該數量遠超過該商人一般營業量，或其一般之有效庫存量，則該情況將被視為知悉該產品係由該方法專利製成之反證資料。

(6)依本規定，於接獲針對要求揭露之申請所作之回應時，應對該回覆者給付符合該需求之合理而實際之支出費用，該費用以不超過商業性之自動專利檢索費用，或不超過 500 元為限。

288. 含有無效申請專利範圍之專利權侵害訴訟

非意圖欺騙，致專利權之部分申請專利範圍無效時，仍得就有效之申請專利範圍部分提起侵害訴訟，但於訴訟開始前，專利權人需就無效之申請專利範圍放棄並已登記於專利商標局，否則專利權人不得獲得任何費用。

289. 新式樣專利侵害之附加救濟

凡於新式樣專利權存續期間，未經專利權人許可(1)以銷售為目的在產品上使用已獲准專利之設計，或其仿效者，或(2)將新式樣或仿效新式樣販賣或以販賣之展示為目的，經向具有管轄權之美國地方法院提起訴訟，應就其總利益之範圍內，對專利權人負損害賠償責任，但不得少於 250 元。

本條規定，並不妨害、減少或排除專利被侵害之專利權人依本法所定之其他救濟方法，但亦不得重複請求損害賠償。

290. 專利訴訟之通知

於依本法規定提起訴訟後一個月內，美國法院書記官，應將訴訟內容以書面通知專利商標局長，通知書上應記載已知之當事人姓名與地址、發明人姓名以及涉案之專利號碼，其後如有其他專利涉入該訴訟中，書記官應作相同之通知，於決定交付後或判決後一個月內，法院書記官應通知局長，局長於接獲通知後，應將該內容記載於各專利檔案內。

291. 具爭議之專利權

具爭議專利之所有權人，得以另一所有權人為被告，提起民事訴訟請求救濟，法院得就任一有爭議之專利權之效力，作全體或部分之判決，第 146 條第二項之規定，準用於依本條所提起之訴訟。

292. 虛偽標示

(a)未經專利權人之同意，意圖偽造或仿造專利權人之標示，或意圖欺瞞公眾，使公眾誤認其產品為專利權人於美國境內所製造、要約銷售或銷售，或由專利權人輸入至美國境內，或經其同意者，而將專利權人之姓名或仿名、專利號碼，或“專利”、“專利權人”等類似之字樣、標示、黏貼或使用於其所製造、使用、要約銷售、銷售於美國境內或輸入美國境內之任何產品；或以欺瞞公眾為目的，將“專利”或任何隱含已獲准專利之字樣或號碼，標示、黏貼或使用於未准專利產品之廣告上；或以欺瞞公眾為目的，於申請專利前，或雖申請而已遭核駁之狀態下，將“專利申請中”，或“專利審查中”，或隱含專利已提出申請等字樣，標示、黏貼或使用於其產品之廣告上者—每一違反行為，處五百元以下之罰金。

(b)任何人均得訴請前項罰則，於該情況下，告訴人可得罰金之一半，而另一半則歸美國政府所有。

293. 無住所於美國之專利權人，服務及通知

於美國境內無住所之專利權人，得向專利商標局提出書面委任書，載明該居住於美國境內受委任人之姓名及地址，以便專利商標局向該受委任人寄送有關該專利權或其相關權益之手續或通知，若該受任人，依最後委任書上之住所無法連繫，或未委任他人時，美國哥倫比亞特區地方法院有管轄權，其傳喚應依公告或法院所定方法為之，該法院就專利權或相關權益之訴訟所具之管轄權，與專利權人係居住於其管轄權內者相同。

294. 仲裁

- (a)有關任何專利權益之契約書中，得包含專利有效性或侵權糾紛得透過仲裁解決之約定，如契約書中並無上述內容約定，當事人得另以書面同意以仲裁解決糾紛，任何約定或同意書應為有效，不可撤回，且為可執行者，但依現行法或依財產權益可撤銷該契約者不在此限。
- (b)於糾紛之仲裁，仲裁人之金錢裁定，及金額之確認均須依美國法典第九篇之規定辦理，但需不違反本條規定之情況為限，任何仲裁程序進行中，若爭議中之任一造提出，第 282 條所述規定即應受到仲裁者之詳細考量。
- (c)由仲裁者決定之仲裁金額應為確定，並對該仲裁之兩造具有拘束力，但對其他第三人則不具拘束力，仲裁中之兩造得相互同意，如涉及賠償金額之專利標的，於爾後由具有法律管轄權之法院宣判為無效或不可執行且不能上訴或未被提起上訴而確定時，該仲裁金額可由仲裁之任一方提起，經具有管轄權之法院作適當之調整，在調整後爭議雙方之權利及義務自法院作成調整之日起生效。
- (d)在仲裁人決定仲裁金額之後，該專利權人、其指定人，或授權使用人應以書面通知局長其結果，在仲裁進行中相關之每項專利均應有一份書面通知告知局長，在通知書中應包含仲裁雙方之姓名、地址、發明人姓名，及專利權人姓名，並應指出專利號碼；另須附上仲裁金額之影本，若該仲裁金額遭法院調整，則向法院要求調整之一方應將該調整通知書寄給局長，而在局長接獲該通知書後，應將其內容記載於該專利訴訟法律之記錄，若應寄發之通知書未送至局長處，則仲裁程序中有關之任一方均可將該書面通知提供給局長。
- (e)除非在(d)項內之書面通知寄達至局長處，否則，該仲裁金額將無法執行生效。

295. 推定：以獲有專利製程方法製作之產品

依美國所核發之方法專利製作完成之產品，於進口、要約銷售、銷售或使用該產品，而主張方法專利受侵害之訴訟中，若法院發現—

- (1)該涉及侵害之產品與由此方法專利所製造之產品間存在相當程度之近似性，及
- (2)原告業已相當盡力以確定製造出該涉及侵害產品之製造方法，惟仍舊無法完全確定，則該涉及侵害之產品仍應被推定為係由該專利方法所製作，而舉證此產品並非由該專利方法所製作之責任，應由主張該產品並非由此方法專利所製成之一方證明之。

第 30 節 向官方提出前案資料及專利之爭議審查

301. 列舉前案資料

於專利有效期間內，任何人只要相信與該專利任何一個申請專利範圍項目之專利性有關，均得以書面方式提出其他專利或其他印刷刊物，並寄至專利商標局，當該前案資料已適當說明該專利中至少一個申請專利範圍項目有關之書面解釋時，則該引證之前案資料及其解釋將成為該專利之部分正式檔案資料，只要該提出前案資料人士以書面聲請，該人士之姓名特徵資料將受保密，而不保存於該專利檔案資料之內。

302. 申請再審查

在專利權期間內，任何人均得依第 301 條規定所引證之前案資料，向主管單位提出再審查之申請，該申請必須以書面提出，且附上依第 41 條規定，由專利局長所訂定之再審查費用支票，該申請書必須明白指出應用該引證前案於有關該專利案所包含之每一相關申請專利範圍項目之適切性及方式，除非該申請人是專利權人，否則局長應立即將申請書影本送至名冊所載之專利權人處。

303. 由局長決定專利事宜

- (a)在依第 302 條規定提出再審查之三個月內，對該再審查之申請，無論是否斟酌其他專利或公開資料，局長將決定該專利之任何申請專利範圍有無重要之專利性問題，在任何時候，局長均得主動依其所發現之專利及刊物，或依第 301 條規定所提引證資料，決定該專利是否具有重要之專利性問題。
- (b)依本條(a)項規定之決定，應將該決定書將納入專利檔案資料內，其副本則立即送到或寄到名冊所載之專利權人及申請再審查之人。
- (c)若依本條(a)項內容規定，並無重要之新的專利性問題，則該決定即屬確定而不得上訴，此種決定局長得退回依第 302 條規定之再審查費用之部分金額。

304. 局長下令進行再審查

因申請專利範圍具有重要之新的專利性問題要件成立，而依第 303(a)項規定為決定時，該決定書中應指出因再審查申請所需解決之問題，在決定書送達或寄達之日起二個月以上之合理期限內，該專利權人可對該問題提出申復，其中可包括對於專利之修正，或提出新申請專利範圍項目供再審查案併案辦理。專利權人提出申復說明時，應依第 302 條，函送一份副本予提出再審查申請之人，其於提出申復說明之二個月內，可針對其所申請之再審查及專利權人之申復說明作適當之回覆，同時函送一份副本予專利權人。

305. 再審查程序之進行

依第 304 條規定所提出之申復說明及回覆後，再審查之程序將比照第 132 條及第 133 條所定之初審程序進行。依本章規定進行再審查時，專利權人可提出專利之任何修正，或任何新申請專利範圍項目，以與依第 301 條規定所提出之前案資料加以區分，或對其專利某一申請專利範圍項目之不利決定作適當反應，在本節規定之再審查進行中，所提出修正內容或新申請專利範圍項目不得擴大該專利之申請專利範圍，依本條規定所進行之再審查，包括向專利訴願及爭議委員會提出之訴願案在內，均須於局內以最速件之程序式進行。

306. 訴願

依本節內容規定，涉及爭議專利審查程序之專利權人，在其專利之原申請專利範圍項目，或重新提出之修正或新申請專利範圍接獲不利之審查決定時，得依第 134 條內容規定提起訴願，或依第 141 至 145 條法令之規定，請求法院覆議。

307. 具專利性，不具專利性，及取消申請專利範圍項目之證書

- (a)依本節內容進行再審查程序中，若已超過訴願期間，或其他任何訴願程序已經終止，局長將發佈並公告任何經審查確定為不具專利性之申請專利範圍項目，並確認在專利權內仍具專利性之申請專利範圍項目，再將任何重新提出而經審查確定，任何具專利性之修正後及新申請專利範圍項目均涵蓋於該專利權內。
- (b)經再審查審定為具有專利性時，涵蓋於專利權內之任何重新提出之修正或新申請專利範圍項目，和同與依第 252 條規定所再核發專利者具有相同效力。即依本條(a)項規定核發之證

書其效力及於美國境內製造、採購或使用、輸入美國境內，依上述修正或新申請專利範圍項目製作之產品，或專有提供上述產品主要準備之專利權。

第四章 專利合作條約

351. 定義

除本法另有規定外，本章所用名稱定義如下—

- (a)“條約”，係指 1970 年 6 月 19 日於華盛頓所訂之專利合作條約。
- (b)“條例(Regulations)”於大寫時，係指與訂定“條約”同一天於華盛頓所訂定之條約內之條例，小寫時，係指局長依本法所訂定之條例。
- (c)“國際申請案”係指依條約所提出之申請案。
- (d)“源自美國之國際申請案”係指依條約規定，以專利商標局為收文單位之國際申請案，而不論該國際申請案是否指定美國為申請國。
- (e)“係指定美國之國際申請案”係指一專利之國際申請案特別指定美國為申請專利之國家，而不論該國際申請案係於何地提出申請。
- (f)“收文單位”，係指該條約或條例之規定，收受及辦理國際間專利申請之國內專利局或相關政府機構。
- (g)“國際檢索權責單位”及“國際初步審查權責單位”等詞句，係指依據條約指定之國內專利局或相關政府機構，並依條約及條例內容規定處理國際申請案之單位。
- (e)“國際局”係依條約及條例規定，公認為協調團體之國際間相關政府機構。
- (i)未於本章敘述定義之名詞及辭句，應探求條約及條例之真意解釋。

第 36 節 國際階段

361. 收文單位

- (a)專利商標局應為美國人民或居民提出國際申請案之收文單位，另依據美國與其他國家所訂定之合同，專利商標局亦得為其他有權提出國際申請案之其他國家居民或國民提出國際申請案之收文單位。
- (b)專利商標局應執行收文單位所釋出委託應辦理業務之事項，包括收受及移交國際費用至國際局之工作在內。
- (c)向專利商標局所提出之國際申請案應以英文說明。
- (d)依本章第 376(a)項規定所述之國際費用、傳輸費用與檢索費用，應於提出國際申請案時繳交，或於局長所指定之較遲期限內繳交。

362. 國際檢索權責單位或國際初步審查權責單位

- (a)專利商標局得依與國際局所達成之合約內容條件及規定，作為國際申請案之國際檢索權責單位或初步審查權責單位，亦可將該權責單位所需之各項任務，包括收受各項手續費及移交之工作全部釋出委託予國際局統籌辦理。
- (b)手續費，初步審查費及國際初步審查費所須之任何其他費用應於局長所指定之期限內繳付。

363. 指定美國之國際申請案：效力

指定美國之國際申請案，除第 102(e)項另有規定外，應依條約第 11 條所規定之國際申請日起，享有與向專利商標局提出之一般專利申請案相同之效力。

364. 國際階段：程序

- (a)專利商標局應以收文單位、國際檢索權責單位或國際初步審查單位之身分，依本條約、條例及本法之規定內容，處理國際申請案之進行。
- (b)申請人未於國際申請案所訂期限內提出申請所需要之行為時，得向局長提出不可避免之延遲藉口而免責，但以未經條約及條例所排除者為限，並須符合條約及條例所規定有關此種不行為之情形為限。

365. 優先權；取得先申請案所具申請日之優待

- (a)依第 119 條(a)至(d)項所規定之條件及要項，一件國內申請案可具有優先權，而該優先權係由先申請之國際申請案指定美國及至少一個其他國家而取得。
- (b)依第 119(a)條及條約與條例規定之條件及要件，一指定美國之國際申請案具有優先權，且該優先權係由外國之先申請案，或指定美國及至少一個其他國家之國際申請案所取得。
- (c)依第 120 條之規定條件與要件，一指定美國之國際申請案應具有國內先申請案，或指定美國之國際先申請案之先申請日之優待，而國內申請案則應享有指定美國之國際先申請案之先申請日之優待。若任何取得先申請日優待之申請專利範圍項目係基於一國際申請案，但卻非源自於美國之國際申請案，則局長得要求其補送該申請案之簽證本至專利商標局，若該申請案係以他國語言申請，則應附上英譯本到局。

366. 國際申請案之撤回

依本章第 367 條之規定，任何指定美國之國際申請案之撤回或考慮撤回，無論其係為一般性，或者僅止於美國，依條約或條例內所規定情況，在申請人符合第 371(c)項規定所需要件前，在撤回後其對美國之指定即屬無效，並應視為自始無效，除依本章第 365(c)項之規定，取得先申請日之申請專利範圍項目於撤回前，已提出國內申請案，或提出國際申請案而指定美國。但該撤回之國際申請案係指定美國以外之其他任何國家時，則依本章第 365(a)及(b)項之規定，作為申請專利範圍項目之優先權基礎。

367. 其他權責機關之行為：審核

- (a)專利商標以外之收文單位拒絕將國際申請日給予指定美國之國際申請案，或認為該申請案已一般性的或針對美國撤回時，申請人得依條約或條例之規定要件及期限，請求局長審核本案，該項審核程序可能導致決定該申請案被認定為國內申請案之審查中階段。
- (b)符合本條第(a)項審核所需相同之要件及條件，若因國際局審查後認為，依條約第 12(3)條規定，指定美國之國際申請案已撤回之案件，得向局長提出審核要求。

368. 發明之保密；在外國提出國際申請案

- (a)向專利商標局提出申請之國際申請案，應依第 17 節之內容規定辦理。
- (b)依條約第 27 條第(8)項之規定，對於在美國境內發明，而於美國以外之國家提出國際申請之案件，應視為構成依第 17 節之規定，於外國提出專利申請案，而不論該國際申請案是否指定美國。
- (c)若提出向外國申請之證照被駁回，或某一國際申請案被下令保密而許可證被駁回，專利商標局在作為收文單位，國際檢索權責單位或國際初步審查權責單位時，不得對任何非權責單任之人員揭露該申請案之內容。

第 37 節 國內階段

371. 國內階段：開始

- (a)在指定美國或選擇美國之國際申請案，由國際局收受國際申請案之申請專利範圍項目之修正、國際檢索報告及包括追加案之國際初步審查報告均為申請所需之文件資料。
- (b)依本條(f)項規定，國內階段應起始於依條約第 22 條(1)或(2)項，或 39(1)(a)款規定期限之到期日。
- (c)申請人應向專利商標局提出：
 - (1)依第 41 條(a)項所述之國內規費；
 - (2)一份國際申請案之副本，除依本條(a)項規定不需附送，或已由國際局傳送者，若以其他國家之語文申請，應附一份英譯本。
 - (3)依條約第 19 條規定修正之國際申請案之申請專利範圍項目之修正本，除該修正本已由國際局傳送至專利商標局，若修正本係以其他國語言進行，應附一份英譯本。
 - (4)發明人(或依第 11 節經授權之其他人)之宣誓書或聲明，應符合第 115 條所需要件，或應符合條例所述之申請人之宣誓書或聲明。
 - (5)附加報告係以其他國家語言提出時，需附一份國際初步審查報告之任何附加報告之英譯本。
- (d)在本條(c)(1)款所述之國內費用，本條(c)(2)款所述之翻譯本，及本條(c)(4)款所述之宣誓書及聲明所需要件，均須於國內階段開始之日起，或由局長所定之較遲時間內符合其內容要件，在(c)(2)款所述之國際申請附本應於國內階段之開始日提出。若未能符合上述各項所需要件，將被認為該申請人放棄其申請，除其符合局長所認定係因不可避免之原因而未能符合要求。若未能在國內階段開始時符合其所需要件，則額外規費之收受可視為依本條第(c)(1)款所述之國內費用或依本條(c)(4)款所述之宣誓書或聲明所可被接受之條件。申請人應於國內階段開始之日起即符合本條第(c)(3)款所述規定，若未能符合其規定，即被視為取消依條約第 19 條所規定之國際申請案之申請專利範圍項目之修正。本條第(c)(5)款之規定應於局長所規定之時間內為之，未能符合該規定視為取消依條約第 34(2)(b)款所述之修正項目。
- (e)除申請人同意外，在國際申請案進入國內階段後，依條約第 28 條或第 41 條所規定之期限內，不得准予或駁回其專利，且申請人得於國內階段開始後，提出說明書、申請專利範圍或圖式之修正。
- (f)經申請人請求，國內階段之審查程序得自該申請案已準備就緒，且本條第(c)項所需要件均已符合之任何時間開始進行。

372. 國內階段：要件及程序

- (a)所有實質問題，依條約及條例規定之各要件，及指定美國之國際申請案之程序等，皆應與向專利商標局提出之一般案件相同之審查程序。
- (b)國際申請案指定美國但非源自美國者—
 - (1)局長得依條約及條例所述要件，要求重新審查申請案之形式及內容有關之問題。
 - (2)局長得於條約及條例所需要件範圍內，提出依第 121 條所述之發明單一性之重新審查。
 - (3)若申請案或任何文件係以非英文之其他國家語言提出，局長得要求提出有關該國際申請之譯本，或任何與該申請有關文件譯本之確認。

373. 不適格之申請人

指定美國之國際申請案，如依第 11 節內容所述係由不適宜向美國提出國內專利之申請人所提出時，將不為專利商標局所接受以進行國內階段申請，該國際申請案亦不得依第 120 條內容規定，作為爾後申請案主張先申請日優惠之基礎，但美國非該國際申請案之唯一指定國家時，則該申請案可作為依第 119 條(a)項至(d)項規定，作為爾後主張優先權之依據。

374. 國際申請案之公開：效力

依條約公開之國際申請案不享有任何權利，且依本法規定無任何效力，僅為一印刷刊物。

375. 國際專利申請案頒發專利證書：效力

- (a) 局長得依本法規定，對一指定美國之國際申請案發給專利證書，依第 102 條(e)項規定，該專利應享有依第 11 節申請之國內專利證書所具之作用及效力。
- (b) 如指定美國之國際申請案原係以非英文提出申請，因不當翻譯導致其獲准之專利範圍超過其以原來語言提出之國際申請案之專利範圍，則具有管轄權之法院得追溯限制其專利範圍，聲明其超過以其原來語文提出之國際專利之專利範圍無效。

376. 規費

- (a) 國際費用及處理費用應以美金繳納，而其金額應依條例所訂數目為限，專利商標局亦得要求繳納下列規費：
 - (1) 傳送費用(見第 361 條(d)項)；
 - (2) 檢索費用(見第 361 條(d)項)；
 - (3) 額外檢索費用(視需要繳納)；
 - (4) 初步審查費用及額外費用(見第 362 條(b)項)；
 - (5) 局長所訂之其他項費用。
- (b) 本條(a)項所訂之各項規費，除國際費用及處理費用外，其金額數目應由局長決定，局長得退還誤繳或溢繳之各項規費金額，或依條約及條例規定應退還之金額，局長亦得經由其認定，退還其認為正確之部分檢索費用、部分初步審查費用及任何額外之費用。