

§ 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 Pub. L. 96-517, §1, Dec. 12, 1980, 94 Stat. 3016; amended Pub. L. 98-622, title II, §204(c), Nov. 8, 1984, 98 Stat. 3388; Pub. L. 112-29, §§3(j)(1), 20(j), Sept. 16, 2011, 125 Stat. 290, 335.)

AMENDMENT OF SECTION

Pub. L. 112-29, §20(j), (l), Sept. 16, 2011, 125 Stat. 335, provided that, effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, this section is amended by striking “of this title” each place that term appears. See 2011 Amendment note below.

Pub. L. 112-29, §3(j)(1), (n), Sept. 16, 2011, 125 Stat. 290, 293, provided that, effective upon the expiration of the 18-month period beginning on Sept. 16, 2011, and applicable to certain applications for patent and any patents issuing thereon, this section is amended by striking “Board of Patent Appeals and Interferences” each place it appears and inserting “Patent Trial and Appeal Board”. See 2011 Amendment note below.

AMENDMENTS

2011—Pub. L. 112-29, §20(j), struck out “of this title” after “304”, after “133”, and after “301”.

Pub. L. 112-29, §3(j)(1), substituted “Patent Trial and Appeal Board” for “Board of Patent Appeals and Interferences”.

1984—Pub. L. 98-622, §204(c), substituted “Patent Appeals and Interferences” for “Appeals”.

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 3(j)(1) of Pub. L. 112-29 effective upon the expiration of the 18-month period beginning on Sept. 16, 2011, and applicable to certain applications for patent and any patents issuing thereon, see section 3(n) of Pub. L. 112-29, set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title.

Amendment by section 20(j) of Pub. L. 112-29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112-29, set out as a note under section 2 of this title.

EFFECTIVE DATE OF 1984 AMENDMENT

Amendment by Pub. L. 98-622 effective three months after Nov. 8, 1984, see section 207 of Pub. L. 98-622, set out as a note under section 41 of this title.

§ 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 144 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 Pub. L. 96-517, §1, Dec. 12, 1980, 94 Stat. 3016; amended Pub. L. 112-29, §§6(h)(2)(A), 20(j), Sept. 16, 2011, 125 Stat. 312, 335.)

AMENDMENT OF SECTION

Pub. L. 112-29, §20(j), (l), Sept. 16, 2011, 125 Stat. 335, provided that, effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, this section is amended by striking “of this title” each place that term appears. See 2011 Amendment note below.

AMENDMENTS

2011—Pub. L. 112-29, §20(j), struck out “of this title” after “134” and after “144”.

Pub. L. 112-29, §6(h)(2)(A), substituted “144” for “145”.

EFFECTIVE DATE OF 2011 AMENDMENT

Pub. L. 112-29, §6(h)(2)(B), Sept. 16, 2011, 125 Stat. 312, provided that: “The amendment made by this paragraph [amending this section] shall take effect on the date of the enactment of this Act [Sept. 16, 2011] and shall apply to any appeal of a reexamination before the Board of Patent Appeals and Interferences or the Patent Trial and Appeal Board that is pending on, or brought on or after, the date of the enactment of this Act.”

Amendment by section 20(j) of Pub. L. 112-29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112-29, set out as a note under section 2 of this title.

§ 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 Pub. L. 96-517, §1, Dec. 12, 1980, 94 Stat. 3016; amended Pub. L. 103-465, title V, §533(b)(8), Dec. 8, 1994, 108 Stat. 4990; Pub. L. 106-113, div. B,

§ 1000(a)(9) [title IV, § 4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-582; Pub. L. 107-273, div. C, title III, § 13206(b)(1)(B), Nov. 2, 2002, 116 Stat. 1906; Pub. L. 112-29, § 20(j), Sept. 16, 2011, 125 Stat. 335.)

AMENDMENT OF SECTION

Pub. L. 112-29, § 20(j), (l), Sept. 16, 2011, 125 Stat. 335, provided that, effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, this section is amended by striking “of this title” each place that term appears. See 2011 Amendment note below.

AMENDMENTS

2011—Subsec. (b). Pub. L. 112-29 struck out “of this title” after “252”.

2002—Subsec. (a). Pub. L. 107-273 made technical correction to directory language of Pub. L. 106-113. See 1999 Amendment note below.

1999—Subsec. (a). Pub. L. 106-113, as amended by Pub. L. 107-273, substituted “Director” for “Commissioner”.

1994—Subsec. (b). Pub. L. 103-465 substituted “used within the United States, or imported into the United States, anything” for “used anything”.

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by Pub. L. 112-29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112-29, set out as a note under section 2 of this title.

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106-113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, § 4731] of Pub. L. 106-113, set out as a note under section 1 of this title.

EFFECTIVE DATE OF 1994 AMENDMENT

Amendment by Pub. L. 103-465 effective on date that is one year after date on which the WTO Agreement enters into force with respect to the United States [Jan. 1, 1995], with provisions relating to earliest filed patent application, see section 534(a), (b)(3) of Pub. L. 103-465, set out as a note under section 154 of this title.

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.

AMENDMENT OF CHAPTER HEADING AND ANALYSIS

Pub. L. 112-29, § 6(a), (c)(2), Sept. 16, 2011, 125 Stat. 299, 304, provided that, effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, this chapter heading and analysis are amended generally, substituting “INTER PARTES REVIEW” for existing chapter heading, substituting item 311 “Inter partes review.”, item 312 “Petitions.”, item 313 “Preliminary response to

petition.”, item 314 “Institution of inter partes review.”, item 315 “Relation to other proceedings or actions.”, item 316 “Conduct of inter partes review.”, item 317 “Settlement.”, and item 318 “Decision of the Board.” for existing items 311 to 318, respectively, and adding item 319 “Appeal.” See 2011 Amendment note below.

AMENDMENTS

2011—Pub. L. 112-29, § 6(a), Sept. 16, 2011, 125 Stat. 299, substituted “INTER PARTES REVIEW” for “OPTIONAL INTER PARTES REEXAMINATION PROCEDURES” in chapter heading and amended analysis generally, adding items 311 to 319, and striking out former items 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”, and 318 “Stay of litigation”.

2002—Pub. L. 107-273, div. C, title III, § 13202(c)(1), Nov. 2, 2002, 116 Stat. 1902, made technical correction to directory language of Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-567, which enacted this chapter.

§ 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 Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-567; amended Pub. L. 107-273, div. C, title III, § 13202(a)(1), (c)(1), Nov. 2, 2002, 116 Stat. 1901, 1902; Pub. L. 112-29, § 6(a), Sept. 16, 2011, 125 Stat. 299.)

AMENDMENT OF SECTION

Pub. L. 112-29, § 6(a), (c)(2), Sept. 16, 2011, 125 Stat. 299, 304, provided that, effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, this section is amended to read as follows:

§ 311. Inter partes review

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

(b) Scope.—A petitioner in an inter partes review may request to cancel as unpatentable 1 or more