

(3) *Scope of claims.*—An amendment under this subsection may not enlarge the scope of the claims of the patent or introduce new matter.

(e) *Evidentiary Standards.*—In an inter partes review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.

See 2011 Amendment note below.

AMENDMENTS

2011—Pub. L. 112-29 amended section generally. Prior to amendment, section related to certificate of patentability, unpatentability, and claim cancellation.

2002—Pub. L. 107-273 made technical correction to directory language of Pub. L. 106-113, which enacted this section.

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 any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112-29, set out as a note under section 311 of this title.

§ 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,¹ 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 28,¹ 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 Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-570; amended Pub. L. 107-273, div. C, title III, §13202(a)(5), (c)(1), Nov. 2, 2002, 116 Stat. 1901, 1902; Pub. L. 112-29, §6(a), Sept. 16, 2011, 125 Stat. 303.)

AMENDMENT OF SECTION

Pub. L. 112-29, §6(a), (c)(2), Sept. 16, 2011, 125 Stat. 303, 304, provided that, effective upon the

¹ So in original. The comma probably should not appear.

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:

§ 317. Settlement

(a) **In General.**—An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed. If the inter partes review is terminated with respect to a petitioner under this section, no estoppel under section 315(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner, on the basis of that petitioner's institution of that inter partes review. If no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).

(b) **Agreements in Writing.**—Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the inter partes review as between the parties. At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.

See 2011 Amendment note below.

AMENDMENTS

2011—Pub. L. 112-29 amended section generally. Prior to amendment, section related to restriction on subsequent request for inter partes reexamination.

2002—Pub. L. 107-273, §13202(c)(1), made technical correction to directory language of Pub. L. 106-113, which enacted this section.

Subsec. (a). Pub. L. 107-273, §13202(a)(5)(A), substituted "third-party requester nor its privies" for "patent owner nor the third-party requester, if any, nor privies of either".

Subsec. (b). Pub. L. 107-273, §13202(a)(5)(B), struck out "United States Code," after "title 28,".

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 any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112-29, set out as a note under section 311 of this title.

§ 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 Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4604(a)], Nov. 29, 1999, 113 Stat. 1536,

1501A–570; amended Pub. L. 107–273, div. C, title III, §13202(c)(1), Nov. 2, 2002, 116 Stat. 1902; Pub. L. 112–29, §6(a), Sept. 16, 2011, 125 Stat. 303.)

AMENDMENT OF SECTION

Pub. L. 112–29, §6(a), (c)(2), Sept. 16, 2011, 125 Stat. 303, 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:

§ 318. Decision of the Board

(a) *Final Written Decision.*—If an inter partes review is instituted and not dismissed under this chapter, the Patent Trial and Appeal Board shall issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 316(d).

(b) *Certificate.*—If the Patent Trial and Appeal Board issues a final written decision under subsection (a) and the time for appeal has expired or any appeal 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 by operation of the certificate any new or amended claim determined to be patentable.

(c) *Intervening Rights.*—Any proposed amended or new claim determined to be patentable and incorporated into a patent following an inter partes review under this chapter shall have the same effect as that specified in section 252 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, before the issuance of a certificate under subsection (b).

(d) *Data on Length of Review.*—The Office shall make available to the public data describing the length of time between the institution of, and the issuance of a final written decision under subsection (a) for, each inter partes review.

See 2011 Amendment note below.

AMENDMENTS

2011—Pub. L. 112–29 amended section generally. Prior to amendment, text read as follows: “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.”

2002—Pub. L. 107–273 made technical correction to directory language of Pub. L. 106–113, which enacted this section.

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 any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112–29, set out as a note under section 311 of this title.

§ 319. Appeal

A party dissatisfied with the final written decision of the Patent Trial and Appeal Board

under section 318(a) may appeal the decision pursuant to sections 141 through 144. Any party to the inter partes review shall have the right to be a party to the appeal.

(Added Pub. L. 112–29, §6(a), Sept. 16, 2011, 125 Stat. 304.)

EFFECTIVE DATE

Section 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, see section 6(c)(2) of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment note under section 311 of this title.

CHAPTER 32—POST-GRANT REVIEW

Sec.	
321.	Post-grant review.
322.	Petitions.
323.	Preliminary response to petition.
324.	Institution of post-grant review.
325.	Relation to other proceedings or actions.
326.	Conduct of post-grant review.
327.	Settlement.
328.	Decision of the Board.
329.	Appeal.

§ 321. Post-grant review

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

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

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

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

EFFECTIVE DATE

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

“(2) **APPLICABILITY.**—

“(A) **IN GENERAL.**—The amendments made by subsection (d) [enacting this chapter] shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act [Sept. 16, 2011] and, except as provided in section 18 [set out as a note below] and in paragraph (3), shall apply only to patents described in section 3(n)(1) [set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title].

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