

(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 Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4102(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A–552.)

REFERENCES IN TEXT

Section 170(b)(1)(A) of the Internal Revenue Code of 1986, referred to in subsec. (c)(3)(B), is classified to section 170(b)(1)(A) of Title 26, Internal Revenue Code.

EFFECTIVE DATE

Pub. L. 106–113, div. B, §1000(a)(9) [title IV, subtitle A, §4103], Nov. 29, 1999, 113 Stat. 1536, 1501A–554, provided that: “This subtitle [enacting this section and provisions set out as a note under section 1 of this title] and the amendments made by this subtitle shall take effect 60 days after the date of the enactment of this Act [Nov. 29, 1999].”

§ 298. Advice of counsel

The failure of an infringer to obtain the advice of counsel with respect to any allegedly infringed patent, or the failure of the infringer to present such advice to the court or jury, may not be used to prove that the accused infringer willfully infringed the patent or that the infringer intended to induce infringement of the patent.

(Added Pub. L. 112–29, §17(a), Sept. 16, 2011, 125 Stat. 329.)

EFFECTIVE DATE

Pub. L. 112–274, §1(a), Jan. 14, 2013, 126 Stat. 2456, provided that: “Notwithstanding section 35 of the Leahy-Smith America Invents Act [Pub. L. 112–29] (35 U.S.C. 1 note), section 298 of title 35, United States Code, shall apply to any civil action commenced on or after the date of the enactment of this Act [Jan. 14, 2013].”

Except as otherwise provided in Pub. L. 112–29, section effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued on or after that effective date, see section 35 of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment note under section 1 of this title.

§ 299. Joinder of parties

(a) JOINDER OF ACCUSED INFRINGERS.—With respect to any civil action arising under any Act

of Congress relating to patents, other than an action or trial in which an act of infringement under section 271(e)(2) has been pled, parties that are accused infringers may be joined in one action as defendants or counterclaim defendants, or have their actions consolidated for trial, only if—

(1) any right to relief is asserted against the parties jointly, severally, or in the alternative with respect to or arising out of the same transaction, occurrence, or series of transactions or occurrences relating to the making, using, importing into the United States, offering for sale, or selling of the same accused product or process; and

(2) questions of fact common to all defendants or counterclaim defendants will arise in the action.

(b) ALLEGATIONS INSUFFICIENT FOR JOINDER.—For purposes of this subsection, accused infringers may not be joined in one action as defendants or counterclaim defendants, or have their actions consolidated for trial, based solely on allegations that they each have infringed the patent or patents in suit.

(c) WAIVER.—A party that is an accused infringer may waive the limitations set forth in this section with respect to that party.

(Added Pub. L. 112–29, §19(d)(1), Sept. 16, 2011, 125 Stat. 332; amended Pub. L. 112–274, §1(c), Jan. 14, 2013, 126 Stat. 2456.)

AMENDMENTS

2013—Subsec. (a). Pub. L. 112–274 substituted “only if” for “or counterclaim defendants only if” in introductory provisions.

EFFECTIVE DATE OF 2013 AMENDMENT

Amendment by Pub. L. 112–274 effective Jan. 14, 2013, and applicable to proceedings commenced on or after such date, see section 1(n) of Pub. L. 112–274, set out as a note under section 5 of this title.

EFFECTIVE DATE

Section applicable to any civil action commenced on or after Sept. 16, 2011, see section 19(e) of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment note under section 1295 of Title 28, Judiciary and Judicial Procedure.

CHAPTER 30—PRIOR ART CITATIONS TO OFFICE AND EX PARTE REEXAMINATION OF PATENTS

Sec.

- 301. Citation of prior art and written statements.
- 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.

AMENDMENTS

2011—Pub. L. 112–29, §6(g)(2), Sept. 16, 2011, 125 Stat. 312, amended item 301 generally, substituting “Citation of prior art and written statements” for “Citation of prior art”.

2002—Pub. L. 107–273, div. C, title III, §13206(b)(1)(B), Nov. 2, 2002, 116 Stat. 1906, made technical correction to directory language of Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A–582. See 1999 Amendment note below.

1999—Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-582, as amended by Pub. L. 107-273, div. C, title III, §13206(b)(1)(B), Nov. 2, 2002, 116 Stat. 1906, substituted “Director” for “Commissioner” in item 304.

Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §§4602, 4732(a)(9)(B)], Nov. 29, 1999, 113 Stat. 1536, 1501A-567, 1501A-582, inserted “EX PARTE” before “REEXAMINATION” in chapter heading and substituted “Director” for “Commissioner” in item 303.

### § 301. Citation of prior art and written statements

(a) IN GENERAL.—Any person at any time may cite to the Office in writing—

(1) 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; or

(2) statements of the patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of a particular patent.

(b) OFFICIAL FILE.—If the person citing prior art or written statements pursuant to subsection (a) explains in writing the pertinence and manner of applying the prior art or written statements to at least 1 claim of the patent, the citation of the prior art or written statements and the explanation thereof shall become a part of the official file of the patent.

(c) ADDITIONAL INFORMATION.—A party that submits a written statement pursuant to subsection (a)(2) shall include any other documents, pleadings, or evidence from the proceeding in which the statement was filed that addresses the written statement.

(d) LIMITATIONS.—A written statement submitted pursuant to subsection (a)(2), and additional information submitted pursuant to subsection (c), shall not be considered by the Office for any purpose other than to determine the proper meaning of a patent claim in a proceeding that is ordered or instituted pursuant to section 304, 314, or 324. If any such written statement or additional information is subject to an applicable protective order, such statement or information shall be redacted to exclude information that is subject to that order.

(e) CONFIDENTIALITY.—Upon the written request of the person citing prior art or written statements pursuant to subsection (a), that person’s identity shall be excluded from the patent file and kept confidential.

(Added Pub. L. 96-517, §1, Dec. 12, 1980, 94 Stat. 3015; amended Pub. L. 112-29, §6(g)(1), Sept. 16, 2011, 125 Stat. 311.)

#### AMENDMENTS

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

#### EFFECTIVE DATE OF 2011 AMENDMENT

Pub. L. 112-29, §6(g)(3), Sept. 16, 2011, 125 Stat. 312, provided that: “The amendments made by this subsection [amending this section] 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 shall apply to any patent issued before, on, or after that effective date.”

#### EFFECTIVE DATE

Chapter effective July 1, 1981, and applicable to patents in force as of July 1, 1981, or issued thereafter, see section 8(b) of Pub. L. 96-517, set out as an Effective Date of 1980 Amendment note under section 41 of this title.

### § 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. 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. 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 Pub. L. 96-517, §1, Dec. 12, 1980, 94 Stat. 3015; amended Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4732(a)(8), (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.)

#### AMENDMENTS

2011—Pub. L. 112-29 struck out “of this title” after “301” and after “41”.

2002—Pub. L. 107-273 made technical correction to directory language of Pub. L. 106-113, §1000(a)(9) [title IV, §4732(a)(10)(A)]. See 1999 Amendment note below.

1999—Pub. L. 106-113, §1000(a)(9) [title IV, §4732(a)(10)(A)], as amended by Pub. L. 107-273, substituted “Director promptly” for “Commissioner promptly”.

Pub. L. 106-113, §1000(a)(9) [title IV, §4732(a)(8)], substituted “Director pursuant” for “Commissioner of Patents pursuant”.

#### 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.

### § 303. Determination of issue by Director

(a) Within three months following the filing of a request for reexamination under the provisions of section 302, 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 publi-