

cant 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).

(July 19, 1952, ch. 950, 66 Stat. 801; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §§4403, 4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-560, 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.)

#### HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §51 (R.S. 4903, amended Aug. 5, 1939, ch. 452, §1, 53 Stat. 1213).

The first paragraph of the corresponding section of existing statute is revised in language and amplified to incorporate present practice; the second paragraph of the existing statute is placed in section 135.

The last sentence relating to new matter is added but represents no departure from present practice.

#### AMENDMENTS

2011—Subsec. (b). Pub. L. 112-29 struck out “of this title” after “41(h)(1)”.

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” for “Commissioner”.

Pub. L. 106-113, §1000(a)(9) [title IV, §4403], designated existing provisions as subsec. (a) and added subsec. (b).

#### 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

Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4405(b)], Nov. 29, 1999, 113 Stat. 1536, 1501A-560, provided that: “The amendments made by section 4403 [amending this section]—

“(1) shall take effect on the date that is 6 months after the date of the enactment of this Act [Nov. 29, 1999], and shall apply to all applications filed under section 111(a) of title 35, United States Code, on or after June 8, 1995, and all applications complying with section 371 of title 35, United States Code, that resulted from international applications filed on or after June 8, 1995; and

“(2) do not apply to applications for design patents under chapter 16 of title 35, United States Code.”

Amendment by section 1000(a)(9) [title IV, §4732(a)(10)(A)] of 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.

### § 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.

(July 19, 1952, ch. 950, 66 Stat. 801; 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. 112-211, title II, §202(b)(5), Dec. 18, 2012, 126 Stat. 1536.)

#### HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §37 (R.S. 4894, amended (1) Mar. 3, 1897, ch. 391, §4, 29 Stat. 692, 693, (2) July 6, 1916, ch. 225, §1, 39 Stat. 345, 347-8, (3) Mar. 2, 1927, ch. 273, §1, 44 Stat. 1335, (4) Aug. 7, 1939, ch. 568, 53 Stat. 1264).

The opening clause of the corresponding section of existing statute is omitted as having no present day meaning or value and the last two sentences are omitted for inclusion in section 267. The notice is stated as given or mailed. Language is revised.

#### AMENDMENTS

2012—Pub. L. 112-211 struck out “, unless it be shown to the satisfaction of the Director that such delay was unavoidable” before period at end.

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

1999—Pub. L. 106-113, as amended by Pub. L. 107-273, substituted “Director” for “Commissioner” in two places.

#### EFFECTIVE DATE OF 2012 AMENDMENT

Amendment by Pub. L. 112-211 effective on the date that is 1 year after Dec. 18, 2012, applicable to patents issued before, on, or after that effective date and patent applications pending on or filed after that effective date, and not effective with respect to patents in litigation commenced before that effective date, see section 203 of Pub. L. 112-211, set out as an Effective Date note under section 27 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.

### § 134. Appeal to the Patent Trial and Appeal Board

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

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

(July 19, 1952, ch. 950, 66 Stat. 801; Pub. L. 98-622, title II, §204(b)(1), Nov. 8, 1984, 98 Stat. 3388; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4605(b)], Nov. 29, 1999, 113 Stat. 1536, 1501A-570; Pub. L. 107-273, div. C, title III, §§13106(b), 13202(b)(1), Nov. 2, 2002, 116 Stat. 1901; Pub. L. 112-29, §§3(j)(1), (3), 7(b), Sept. 16, 2011, 125 Stat. 290, 313.)

## HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., § 57 (R.S. 4909 amended (1) Mar. 2, 1927, ch. 273, § 5, 44 Stat. 1335, 1336, (2) Aug. 5, 1939, ch. 451, § 2, 53 Stat. 1212).

Reference to reissues is omitted in view of the general provision in section 251. Minor changes in language are made.

## AMENDMENTS

2011—Pub. L. 112–29, § 3(j)(3), amended section catchline generally. Prior to amendment, section catchline read as follows: “Appeal to the Board of Patent Appeals and Interferences”.

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

Subsec. (b). Pub. L. 112–29, § 7(b)(1), substituted “a reexamination” for “any reexamination proceeding”.

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

Subsec. (c). Pub. L. 112–29, § 7(b)(2), struck out subsec. (c). Prior to amendment, text read as follows: “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.”

2002—Subsecs. (a), (b). Pub. L. 107–273, § 13202(b)(1), substituted “primary examiner” for “administrative patent judge”.

Subsec. (c). Pub. L. 107–273, § 13202(b)(1), substituted “primary examiner” for “administrative patent judge”.

Pub. L. 107–273, § 13106(b), struck out at end “The third-party requester may not appeal the decision of the Board of Patent Appeals and Interferences.”

1999—Pub. L. 106–113 reenacted section catchline without change and amended text generally. Prior to amendment, text read as follows: “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.”

1984—Pub. L. 98–622 substituted “Patent Appeals and Interferences” for “Appeals” in section catchline and text.

## EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 3(j)(1), (3) 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 7(b) 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, with certain exceptions, see section 7(e) of Pub. L. 112–29, set out as a note under section 6 of this title.

## EFFECTIVE DATE OF 2002 AMENDMENT

Pub. L. 107–273, div. C, title III, § 13106(d), Nov. 2, 2002, 116 Stat. 1901, provided that: “The amendments made by this section [amending this section and sections 141 and 315 of this title] apply with respect to any reexamination proceeding commenced on or after the date of enactment of this Act [Nov. 2, 2002].”

## EFFECTIVE DATE OF 1999 AMENDMENT

Pub. L. 107–273, div. C, title III, § 13202(d), Nov. 2, 2002, 116 Stat. 1902, provided that: “The amendments made by section 4605(b), (c), and (e) of the Intellectual Property and Communications Omnibus Reform Act, as enacted by section 1000(a)(9) of Public Law 106–113

[amending this section and sections 141 and 145 of this title], shall apply to any reexamination filed in the United States Patent and Trademark Office on or after the date of enactment of Public Law 106–113 [Nov. 29, 1999].”

Amendment by Pub. L. 106–113 effective Nov. 29, 1999, and applicable to any patent issuing from an original application filed in the United States on or after that date, see section 1000(a)(9) [title IV, § 4608(a)] of Pub. L. 106–113, set out as a note under section 41 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.

## § 135. Derivation proceedings

## (a) INSTITUTION OF PROCEEDING.—

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

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

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

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

(b) DETERMINATION BY PATENT TRIAL AND APPEAL BOARD.—In a derivation proceeding instituted under subsection (a), the Patent Trial and Appeal Board shall determine whether an inventor named in the earlier application derived the claimed invention from an inventor named in the petitioner’s application and, without authorization, the earlier application claiming such invention was filed. In appropriate circumstances, the Patent Trial and Appeal Board may correct the naming of the inventor in any application or patent at issue. The Director shall pre-