

the provisions of section 134, and may seek court review under the provisions of sections 141 to 144, 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.)

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 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.)

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—INTER PARTES REVIEW

Sec.	
311.	Inter partes review.
312.	Petitions.
313.	Preliminary response to petition.
314.	Institution of inter partes review.
315.	Relation to other proceedings or actions.
316.	Conduct of inter partes review.
317.	Settlement.
318.	Decision of the Board.
319.	Appeal.

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. 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 claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.

(c) FILING DEADLINE.—A petition for inter partes review shall be filed after the later of either—

(1) the date that is 9 months after the grant of a patent; or

(2) if a post-grant review is instituted under chapter 32, the date of the termination of such post-grant review.

(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; Pub. L. 112–274, §1(d)(2), Jan. 14, 2013, 126 Stat. 2456.)

AMENDMENTS

2013—Subsec. (c)(1). Pub. L. 112–274 struck out “or issuance of a reissue of a patent” after “grant of a patent”.

2011—Pub. L. 112–29 amended section generally. Prior to amendment, section related to 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)(1)(A), substituted “third-party requester” for “person”.

Subsec. (c). Pub. L. 107–273, §13202(a)(1)(B), substituted “The” for “Unless the requesting person is the owner of the patent, the”.

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 OF 2011 AMENDMENT

Pub. L. 112–29, §6(c)(2), Sept. 16, 2011, 125 Stat. 304, provided that:

“(A) IN GENERAL.—The amendments made by subsection (a) [enacting section 319 of this title and amending this section and sections 312 to 318 of this title] 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.

“(B) GRADUATED IMPLEMENTATION.—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 inter partes reviews that may be instituted under chapter 31 of title 35, United States Code, during each of the first 4 1-year periods in which the amendments made by subsection (a) are in effect, if such number in each year equals or exceeds the number of inter partes reexaminations that are ordered under chapter 31 of title 35, United States Code, in the last fiscal year ending before the effective date of the amendments made by subsection (a).”

EFFECTIVE DATE

Chapter 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 an Effective Date of 1999 Amendment note under section 41 of this title.

REGULATIONS

Pub. L. 112–29, §6(c)(1), Sept. 16, 2011, 125 Stat. 304, provided that: “The Director [Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] shall, not later than the date that is 1 year after the date of the enactment of this Act [Sept. 16, 2011], issue regulations to carry out chapter 31 of title 35, United States Code, as amended by subsection (a) of this section.”

APPLICABILITY OF FILING DEADLINE

Pub. L. 112–274, §1(d)(1), Jan. 14, 2013, 126 Stat. 2456, provided that: “Section 311(c) of title 35, United States Code, shall not apply to a petition to institute an inter partes review of a patent that is not a patent described

in section 3(n)(1) of the Leahy-Smith America Invents Act [Pub. L. 112–29] (35 U.S.C. 100 note).”

REPORT TO CONGRESS

Pub. L. 106–113, div. B, §1000(a)(9) [title IV, subtitle F, §4606], Nov. 29, 1999, 113 Stat. 1536, 1501A–571, required the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office to submit to Congress a report on possible inequities of certain inter partes reexamination proceedings no later than 5 years after Nov. 29, 1999.

§ 312. Petitions

(a) REQUIREMENTS OF PETITION.—A petition filed under section 311 may be considered only if—

(1) the petition is accompanied by payment of the fee established by the Director under section 311;

(2) the petition identifies all real parties in interest;

(3) the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim, including—

(A) copies of patents and printed publications that the petitioner relies upon in support of the petition; and

(B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on expert opinions;

(4) the petition provides such other information as the Director may require by regulation; and

(5) the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner.

(b) PUBLIC AVAILABILITY.—As soon as practicable after the receipt of a petition under section 311, the Director shall make the petition available to the public.

(Added Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A–568; amended Pub. L. 107–273, div. C, title III, §§13105(a), 13202(a)(2), (c)(1), Nov. 2, 2002, 116 Stat. 1900–1902; Pub. L. 112–29, §6(a), (c)(3)(A)(i), Sept. 16, 2011, 125 Stat. 300, 305.)

AMENDMENTS

2011—Pub. L. 112–29, §6(a), amended section generally. Prior to amendment, section related to determination of issue by Director.

Subsec. (a). Pub. L. 112–29, §6(c)(3)(A)(i)(I), substituted “the information presented in the request shows that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request,” for “a substantial new question of patentability affecting any claim of the patent concerned is raised by the request,” and “A showing that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request” for “The existence of a substantial new question of patentability”.

Subsec. (c). Pub. L. 112–29, §6(c)(3)(A)(i)(II), substituted “the showing required by subsection (a) has not been made,” for “no substantial new question of patentability has been raised,”.