

(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 a post-grant 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 post-grant 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.

(Added Pub. L. 112-29, §6(d), Sept. 16, 2011, 125 Stat. 310.)

EFFECTIVE DATE

Section effective upon the expiration of the 1-year period beginning Sept. 16, 2011, and applicable only to patents described in section 3(n)(1) of Pub. L. 112-29 (35 U.S.C. 100 note), with certain exceptions and limitations, see section 6(f)(2), (3) of Pub. L. 112-29, set out as a note under section 321 of this title.

§ 328. Decision of the Board

(a) FINAL WRITTEN DECISION.—If a post-grant 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 326(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 a post-grant 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 post-grant review.

(Added and amended Pub. L. 112-29, §§6(d), 20(j), Sept. 16, 2011, 125 Stat. 310, 335.)

AMENDMENTS

2011—Subsec. (c). Pub. L. 112-29, §20(j), struck out “of this title” after “252”.

EFFECTIVE DATE OF 2011 AMENDMENT

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

Section effective upon the expiration of the 1-year period beginning Sept. 16, 2011, and applicable only to patents described in section 3(n)(1) of Pub. L. 112-29 (35 U.S.C. 100 note), with certain exceptions and limitations, see section 6(f)(2), (3) of Pub. L. 112-29, set out as a note under section 321 of this title.

§ 329. Appeal

A party dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 328(a) may appeal the decision pursuant to sections 141 through 144. Any party to the post-grant review shall have the right to be a party to the appeal.

(Added Pub. L. 112-29, §6(d), Sept. 16, 2011, 125 Stat. 311.)

EFFECTIVE DATE

Section effective upon the expiration of the 1-year period beginning Sept. 16, 2011, and applicable only to patents described in section 3(n)(1) of Pub. L. 112-29 (35 U.S.C. 100 note), with certain exceptions and limitations, see section 6(f)(2), (3) of Pub. L. 112-29, set out as a note under section 321 of this title.

PART IV—PATENT COOPERATION TREATY

Table with 2 columns: Chap. and Sec.
35. Definitions 351
36. International Stage 361
37. National Stage 371

CODIFICATION

Analysis of chapters editorially supplied. Part IV added by Pub. L. 94-131 without adding analysis for chapters 35, 36, and 37.

Pub. L. 96-517 purported to amend the table of chapters of title 35 by adding after the item for chapter 37 the following: “38. Patent Rights in Inventions Made with Federal Assistance”. Title 35 did not contain a table of chapters, and section 6(b) of Pub. L. 96-517 and the purported amendment made by it were repealed by Pub. L. 97-256. See chapter 18 (§200 et seq.) of this title.

CHAPTER 35—DEFINITIONS

Table with 2 columns: Sec. and Definitions.
351. Definitions.

§ 351. Definitions

When used in this part unless the context otherwise indicates—

(a) The term “treaty” means the Patent Cooperation Treaty done at Washington, on June 19, 1970.

(b) The term “Regulations”, when capitalized, means the Regulations under the treaty, done at Washington on the same date as the treaty. The term “regulations”, when not capitalized, means the regulations established by the Director under this title.

(c) The term “international application” means an application filed under the treaty.

(d) The term “international application originating in the United States” means an international application filed in the Patent and

Trademark Office when it is acting as a Receiving Office under the treaty, irrespective of whether or not the United States has been designated in that international application.

(e) The term “international application designating the United States” means an international application specifying the United States as a country in which a patent is sought, regardless where such international application is filed.

(f) The term “Receiving Office” means a national patent office or intergovernmental organization which receives and processes international applications as prescribed by the treaty and the Regulations.

(g) The terms “International Searching Authority” and “International Preliminary Examining Authority” mean a national patent office or intergovernmental organization as appointed under the treaty which processes international applications as prescribed by the treaty and the Regulations.

(h) The term “International Bureau” means the international intergovernmental organization which is recognized as the coordinating body under the treaty and the Regulations.

(i) Terms and expressions not defined in this part are to be taken in the sense indicated by the treaty and the Regulations.

(Added Pub. L. 94-131, § 1, Nov. 14, 1975, 89 Stat. 685; amended Pub. L. 98-622, title IV, § 403(a), Nov. 8, 1984, 98 Stat. 3392; Pub. L. 99-616, § 2(a)-(c), Nov. 6, 1986, 100 Stat. 3485; 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.)

AMENDMENTS

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

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

1986—Subsec. (a). Pub. L. 99-616, § 2(a), struck out “, excluding chapter II thereof” after “June 19, 1970”.

Subsec. (b). Pub. L. 99-616, § 2(b), struck out “excluding part C thereof” after “under the treaty”.

Subsec. (g). Pub. L. 99-616, § 2(c), substituted “The terms ‘International Searching Authority’ and ‘International Preliminary Examining Authority’ mean” for “The term ‘International Searching Authority’ means”.

1984—Subsec. (d). Pub. L. 98-622 substituted “Patent and Trademark Office” for “Patent Office”.

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 1986 AMENDMENT

Pub. L. 99-616, § 9, Nov. 6, 1986, 100 Stat. 3487, provided that: “Sections 2 through 8 of this Act [amending this section and sections 361, 362, 364, 368, 371, and 376 of this title] shall come into force on the same day as the effective date of entry into force of chapter II of the Patent Cooperation Treaty with respect to the United States, by virtue of the withdrawal of the declaration under article 64(1)(a) of the Patent Cooperation Treaty. It shall apply to all international applications pending before or after its effective date.”

[The Patent Cooperation Treaty became effective for the United States on Jan. 24, 1978. The United States,

however, was one of six countries (out of the 40 countries who have ratified or acceded to the Treaty) which had reservations not to be bound by Chapter II. The document removing the reservation as to Chapter II was deposited with the Director General of the World Intellectual Property Organization on Apr. 1, 1987. Accordingly, Chapter II of the Treaty for the United States of America and Pub. L. 99-616 became effective 3 months later on July 1, 1987. See 52 F.R. 20038, 20041, May 28, 1987.]

EFFECTIVE DATE OF 1984 AMENDMENT

Pub. L. 98-622, title IV, § 406(a), Nov. 8, 1984, 98 Stat. 3393, provided that: “Section 404 of this Act [set out as a note under section 41 of this title] and the amendments made by section 403 of this Act [amending this section and sections 104, 361, 362, 363, 364, 365, 367, 368, 371, 372, 373, and 376 of this title] shall take effect on the date of the enactment of this Act [Nov. 8, 1984].”

EFFECTIVE DATE

Pub. L. 94-131, § 11, Nov. 14, 1975, 89 Stat. 692, provided that:

“(a) Section 1 of this Act [enacting this part] shall come into force on the same day as the entry into force of the Patent Cooperation Treaty with respect to the United States. It shall apply to international and national applications filed on and after this effective date, even though entitled to the benefit of an earlier filing date, and to patents issued on such applications.

“(b) Sections 2 to 10 of this Act [amending sections 6, 41, 42, 102, 104, 112, 113, 120, and 282 of this title] shall take effect on the same day as section 1 of this Act [enacting this part] and shall apply to all applications for patent actually filed in the United States on and after this effective date, as well as to international applications where applicable.

“(c) Applications for patent on file in the Patent Office [now the Patent and Trademark Office] on the effective date of this Act, and patents issued on such applications, shall be governed by the provisions of title 35, United States Code, in effect immediately prior to the effective date of this Act.”

[The Patent Cooperation Treaty entered into force with respect to the United States on Jan. 24, 1978, with the exception of Chapter II.]

SHORT TITLE OF 1986 AMENDMENT

Pub. L. 99-616, § 1, Nov. 6, 1986, 100 Stat. 3485, provided: “That this Act [amending this section and sections 361, 362, 364, 368, 371, and 376 of this title and enacting provisions set out as a note above] may be cited as the ‘Act to authorize the United States to participate in chapter II of the Patent Cooperation Treaty’.”

CHAPTER 36—INTERNATIONAL STAGE

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| Sec. 361. | Receiving Office. |
| 362. | International Searching Authority and International Preliminary Examining Authority. |
| 363. | International application designating the United States: Effect. |
| 364. | International stage: Procedure. |
| 365. | Right of priority; benefit of the filing date of a prior application. |
| 366. | Withdrawn international application. |
| 367. | Actions of other authorities: Review. |
| 368. | Secrecy of certain inventions; filing international applications in foreign countries. |

AMENDMENTS

1986—Pub. L. 99-616, § 3, Nov. 6, 1986, 100 Stat. 3485, amended item 362 generally.

§ 361. Receiving Office

(a) The Patent and Trademark Office shall act as a Receiving Office for international applica-