

§ 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.

Editorial Notes

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.

Statutory Notes and Related Subsidiaries

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 be-

ginning 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 re-

spect 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 prescribe regulations setting forth standards for the conduct of derivation proceedings, including requiring parties to provide sufficient evidence to prove and rebut a claim of derivation.

(c) DEFERRAL OF DECISION.—The Patent Trial and Appeal Board may defer action on a petition for a derivation proceeding until the expiration of the 3-month period beginning on the date on which the Director issues a patent that includes the claimed invention that is the subject of the petition. The Patent Trial and Appeal Board also may defer action on a petition for a derivation proceeding, or stay the proceeding after it has been instituted, until the termination of a proceeding under chapter 30, 31, or 32 involving the patent of the earlier applicant.

(d) EFFECT OF FINAL DECISION.—The final decision of the Patent Trial and Appeal Board, if adverse to claims in an application for patent, shall constitute the final refusal by the Office on those claims. The final decision of the Patent Trial and Appeal Board, if adverse to claims in a patent, shall, if no appeal or other review of the decision has been or can be taken or had, constitute cancellation of those claims, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation.

(e) SETTLEMENT.—Parties to a proceeding instituted under subsection (a) may terminate the proceeding by filing a written statement reflecting the agreement of the parties as to the correct inventor of the claimed invention in dispute. Unless the Patent Trial and Appeal Board finds the agreement to be inconsistent with the evidence of record, if any, it shall take action consistent with the agreement. Any written settlement or understanding of the parties shall be filed with the Director. 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 or applications, and shall be made available only to Government agencies on written request, or to any person on a showing of good cause.

(f) ARBITRATION.—Parties to a proceeding instituted under subsection (a) may, within such

time as may be specified by the Director by regulation, determine such contest or any aspect thereof by arbitration. Such arbitration shall be governed by the provisions of title 9, to the extent such title is not inconsistent with this section. The parties shall give notice of any arbitration award to the Director, and such award shall, as between the parties to the arbitration, be dispositive of the issues to which it relates. The arbitration award shall be unenforceable until such notice is given. Nothing in this subsection shall preclude the Director from determining the patentability of the claimed inventions involved in the proceeding.

(July 19, 1952, ch. 950, 66 Stat. 801; Pub. L. 87-831, Oct. 15, 1962, 76 Stat. 958; Pub. L. 93-596, § 1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 98-622, title I, § 105, title II, § 202, Nov. 8, 1984, 98 Stat. 3385, 3386; Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, §§ 4507(11), 4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-566, 1501A-582; Pub. L. 107-273, div. C, title III, § 13206(b)(1)(B), Nov. 2, 2002, 116 Stat. 1906; Pub. L. 112-29, §§ 3(i), 20(j), Sept. 16, 2011, 125 Stat. 289, 335; Pub. L. 112-274, § 1(e)(1), (k)(1), Jan. 14, 2013, 126 Stat. 2456, 2457.)

HISTORICAL AND REVISION NOTES

The first paragraph is based on Title 35, U.S.C., 1946 ed., § 52 (R.S. 4904 amended (1) Mar. 2, 1927, ch. 273, § 4, 44 Stat. 1335, 1336, (2) Aug. 5, 1939, ch. 451, § 1, 53 Stat. 1212).

The first paragraph states the existing corresponding statute with a few changes in language. An explicit statement that the Office decision on priority constitutes a final refusal by the Office of the claims involved, is added. The last sentence is new and provides that judgment adverse to a patentee constitutes cancellation of the claims of the patent involved after the judgment has become final, the patentee has a right of appeal (sec. 141) and is given a right of review by civil action (sec. 146).

The second paragraph is based on Title 35, U.S.C., 1946 ed., § 51, (R.S. 4903, amended Aug. 5, 1939, ch. 452, § 1, 53 Stat. 1213). Changes in language are made.

Editorial Notes

AMENDMENTS

2013—Subsec. (a). Pub. L. 112-274, § 1(k)(1), amended subsec. (a) generally. Prior to amendment, text read as follows: "An applicant for patent may file a petition to institute a derivation proceeding in the Office. The petition shall set forth with particularity the basis for finding that an inventor named in an 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. Any such petition may be filed only within the 1-year period beginning on the date of the first publication of a claim to an invention that is the same or substantially the same as the earlier application's claim to the invention, shall be made under oath, and shall be supported by substantial evidence. 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. The determination by the Director whether to institute a derivation proceeding shall be final and nonappealable."

Subsec. (e). Pub. L. 112-274, § 1(e)(1), substituted "correct inventor" for "correct inventors".

2011—Pub. L. 112-29, § 3(i), amended section generally. Prior to amendment, section related to interferences.

Subsec. (b)(2). Pub. L. 112-29, § 20(j), struck out "of this title" after "122(b)".

2002—Subsecs. (a), (c), (d). 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 notes below.

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

Subsec. (b). Pub. L. 106-113, §1000(a)(9) [title IV, §4507(11)], designated existing provisions as par. (1) and added par. (2).

Subsecs. (c), (d). Pub. L. 106-113, §1000(a)(9) [title IV, §4732(a)(10)(A)], as amended by Pub. L. 107-273, substituted “Director” for “Commissioner” wherever appearing.

1984—Subsec. (a). Pub. L. 98-622, §202, amended subsec. (a) generally, substituting “, an interference may be declared and the Commissioner shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be” for “he shall give notice thereof to the applicants, or applicant and patentee, as the case may be” and substituting provisions vesting jurisdiction for determining questions of interference in the Board of Patent Appeals and Interferences for provisions vesting such jurisdiction in a board of patent interferences.

Subsec. (d). Pub. L. 98-622, §105, added subsec. (d).

1975—Subsecs. (a), (c). Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office” wherever appearing.

1962—Pub. L. 87-831 designated first and second pars. as subsecs. (a) and (b) and added subsec. (c).

Statutory Notes and Related Subsidiaries

EFFECTIVE DATE OF 2013 AMENDMENT

Pub. L. 112-274, §1(e)(2), Jan. 14, 2013, 126 Stat. 2456, provided that: “The amendment made by paragraph (1) [amending this section] shall be effective as if included in the amendment made by section 3(i) of the Leahy-Smith America Invents Act [Pub. L. 112-29].”

Pub. L. 112-274, §1(k)(2), Jan. 14, 2013, 126 Stat. 2458, provided that: “The amendment made by paragraph (1) [amending this section] shall be effective as if included in the amendment made by section 3(i) of the Leahy-Smith America Invents Act [Pub. L. 112-29].”

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 3(i) 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 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 OF 1999 AMENDMENT

Amendment by section 1000(a)(9) [title IV, §4507(11)] of Pub. L. 106-113 effective Nov. 29, 2000, and applicable only to applications (including international applications designating the United States) filed on or after that date, see section 1000(a)(9) [title IV, §4508] of Pub. L. 106-113, as amended, set out as a note under section 10 of this title.

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.

EFFECTIVE DATE OF 1984 AMENDMENT

Amendment by section 105 of Pub. L. 98-622 applicable to all United States patents granted before, on, or after Nov. 8, 1984, and to all applications for United States

patents pending on or filed after that date, except as otherwise provided, see section 106 of Pub. L. 98-622, set out as a note under section 103 of this title.

Amendment by section 202 of 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.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of Title 15, Commerce and Trade.

SAVINGS PROVISIONS

Pub. L. 112-274, §1(k)(3), Jan. 14, 2013, 126 Stat. 2458, provided that: “The provisions of sections 6 and 141 of title 35, United States Code, and section 1295(a)(4)(A) of title 28, United States Code, as in effect on September 15, 2012, shall apply to interference proceedings that are declared after September 15, 2012, under section 135 of title 35, United States Code, as in effect before the effective date under section 3(n) of the Leahy-Smith America Invents Act [Pub. L. 112-29, set out as a note under section 100 of this title]. The Patent Trial and Appeal Board may be deemed to be the Board of Patent Appeals and Interferences for purposes of such interference proceedings.”

Provisions of 35 U.S.C. 135, as in effect on the day before the expiration of the 18-month period beginning on Sept. 16, 2011, apply to each claim of certain applications for patent, and certain patents issued thereon, for which the amendments made by section 3 of Pub. L. 112-29 also apply, see section 3(n)(2) of Pub. L. 112-29, set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title.

CHAPTER 13—REVIEW OF PATENT AND TRADEMARK OFFICE DECISIONS

Sec.	
141.	Appeal to Court of Appeals for the Federal Circuit.
142.	Notice of appeal.
143.	Proceedings on appeal.
144.	Decision on appeal.
145.	Civil action to obtain patent.
146.	Civil action in case of derivation proceeding.

Editorial Notes

AMENDMENTS

2011—Pub. L. 112-29, §3(j)(6), Sept. 16, 2011, 125 Stat. 291, amended item 146 generally, substituting “Civil action in case of derivation proceeding” for “Civil action in case of interference”.

1982—Pub. L. 97-164, title I, §163(b)(1), Apr. 2, 1982, 96 Stat. 49, substituted “Court of Appeals for the Federal Circuit” for “Court of Customs and Patent Appeals” in item 141.

1975—Pub. L. 93-596, §1, Jan. 2, 1975, 88 Stat. 1949, substituted “PATENT AND TRADEMARK OFFICE” for “PATENT OFFICE” in chapter heading.

§ 141. Appeal to Court of Appeals for the Federal Circuit

(a) EXAMINATIONS.—An applicant who is dissatisfied with the final decision in an appeal to the Patent Trial and Appeal Board under section 134(a) may appeal the Board’s decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal, the applicant waives his or her right to proceed under section 145.

(b) REEXAMINATIONS.—A patent owner who is dissatisfied with the final decision in an appeal of a reexamination to the Patent Trial and Appeal Board under section 134(b) may appeal the Board’s decision only to the United States Court of Appeals for the Federal Circuit.