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, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

(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.)

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

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 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 Board of Patent Appeals and Interferences

(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 Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

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

(c) THIRD-PARTY.—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.

(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.)

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

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 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. Interferences

(a) Whenever an application is made for a patent which, in the opinion of the Director, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the Director shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability. Any final decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent and Trademark Office of the claims involved, and the Director may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved in the patent, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation by the Patent and Trademark Office.

(b)(1) A claim which is the same as, or for the same or substantially the same subject matter

as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

(2) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an application published under section 122(b) of this title may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published.

(c) Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent and Trademark Office before the termination of the interference as between the said parties to the agreement or understanding. If any party filing the same so requests, the copy shall be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person on a showing of good cause. Failure to file the copy of such agreement or understanding shall render permanently unenforceable such agreement or understanding and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved. The Director may, however, on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six-month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

The Director shall give notice to the parties or their attorneys of record, a reasonable time prior to said termination, of the filing requirement of this section. If the Director gives such notice at a later time, irrespective of the right to file such agreement or understanding within the six-month period on a showing of good cause, the parties may file such agreement or understanding within sixty days of the receipt of such notice.

Any discretionary action of the Director under this subsection shall be reviewable under section 10 of the Administrative Procedure Act.

(d) Parties to a patent interference, within such time as may be specified by the Director by regulation, may 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 patentability of the invention involved in the interference.

(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.)

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.

REFERENCES IN TEXT

Section 10 of the Administrative Procedure Act, referred to in subsec. (c), is section 10 of act June 11, 1946, ch. 324, 60 Stat. 243, which was repealed by Pub. L. 89–554, §8(a), Sept. 6, 1966, 80 Stat. 632, and reenacted by the first section thereof as chapter 7 (§701 et seq.) of Title 5, Government Organization and Employees.

AMENDMENTS

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).

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.

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 interference.

AMENDMENTS

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

An applicant dissatisfied with the decision in an appeal to the Board of Patent Appeals and Interferences under section 134 of this title may appeal the 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 of this title. A patent owner, or a third-party requester in an inter partes reexamination proceeding, who is in any reexamination proceeding dissatisfied with the final decision in an appeal to the Board of Patent Appeals and Interferences under section 134 may appeal the decision only to the United States Court of Appeals for the Federal Circuit. A party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences on the interference may appeal the decision to the United States Court of Appeals for the Federal Circuit, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal in accordance with section 142 of this title, files notice with the Director that the party elects to have all further proceedings conducted as provided in section 146 of this title. If the appellant does not, within thirty days after the filing of such notice by the adverse party, file a civil action under section 146, the decision appealed from shall govern the further proceedings in the case.

(July 19, 1952, ch. 950, 66 Stat. 802; Pub. L. 97–164, title I, § 163(a)(7), (b)(2), Apr. 2, 1982, 96 Stat. 49, 50; Pub. L. 98–622, title II, § 203(a), Nov. 8, 1984, 98 Stat. 3387; Pub. L. 106–113, div. B, § 1000(a)(9) [title IV, §§ 4605(c), 4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A–571, 1501A–582; Pub. L. 107–273, div. C, title III, §§ 13106(c), 13206(b)(1)(B), Nov. 2, 2002, 116 Stat. 1901, 1906.)

HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., § 59a (R.S. 4911, amended (1) Mar. 2, 1927, ch. 273, § 8, 44 Stat. 1336, (2) Mar. 2, 1929, ch. 488, § 2a, 45 Stat. 1476, (3) Aug. 5, 1939, ch. 451, § 3, 53 Stat. 1212).

Changes in language are made.

AMENDMENTS

2002—Pub. L. 107–273, § 13206(b)(1)(B), 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.

Pub. L. 107–273, § 13106(c), inserted '', or a third-party requester in an inter partes reexamination proceeding, who is'' after ''patent owner'' in third sentence.

1999—Pub. L. 106–113, § 1000(a)(9) [title IV, § 4732(a)(10)(A)], as amended by Pub. L. 107–273, § 13206(b)(1)(B), substituted ''Director'' for ''Commissioner''.

Pub. L. 106–113, § 1000(a)(9) [title IV, § 4605(c)], inserted after second sentence ''A patent owner in any reexamination proceeding dissatisfied with the final decision in an appeal to the Board of Patent Appeals and Interferences under section 134 may appeal the decision only to the United States Court of Appeals for the Federal Circuit.''

1984—Pub. L. 98–622, § 203(a)(1)(A), substituted ''in an appeal to the Board of Patent Appeals and Interferences under section 134 of this title may appeal the decision'' for ''of the Board of Patent Appeals may appeal'' in first sentence.

Pub. L. 98–622, § 203(a)(1)(B), substituted ''. By filing such an appeal the applicant waives his or her right'' for '', thereby waiving his right'' in first sentence.

Pub. L. 98–622, § 203(a)(2)(A), substituted ''Board of Patent Appeals and Interferences on the interference may appeal the decision'' for ''board of patent interferences on the question of priority of appeal'' in second sentence.

Pub. L. 98–622, § 203(a)(2)(B), substituted ''In accordance with'' for ''according to'' in second sentence.

Pub. L. 98–622, § 203(a)(2)(C), substituted ''the party'' for ''he'' in second sentence.

Pub. L. 98–622, § 203(a)(3), reenacted last sentence with minor changes in wording.

1982—Pub. L. 97–164, § 163(b)(2), substituted ''Court of Appeals for the Federal Circuit'' for ''Court of Customs and Patent Appeals'' in section catchline.

Pub. L. 97–164, § 163(a)(7), substituted ''Court of Appeals for the Federal Circuit'' for ''Court of Customs and Patent Appeals'' in two places.

EFFECTIVE DATE OF 2002 AMENDMENT

Amendment by section 13106(c) of Pub. L. 107–273 applicable with respect to any reexamination proceeding commenced on or after Nov. 2, 2002, see section 13106(d) of Pub. L. 107–273, set out as a note under section 134 of this title.

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by section 1000(a)(9) [title IV, § 4605(c)] of Pub. L. 106–113 applicable to any reexamination filed in the United States Patent and Trademark Office on or after Nov. 2, 2002, see section 13202(d) of Pub. L. 107–273, set out as a note under section 134 of this title.

Amendment by section 1000(a)(9) [title IV, § 4605(c)] of 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.

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 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.