

from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the inter partes reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

(Added Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A–569; amended Pub. L. 107–273, div. C, title III, §§13106(a), 13202(a)(4), (c)(1), Nov. 2, 2002, 116 Stat. 1900–1902.)

#### AMENDMENTS

2002—Pub. L. 107–273, §13202(c)(1), made technical correction to directory language of Pub. L. 106–113, which enacted this section.

Subsec. (b). Pub. L. 107–273, §13106(a), reenacted heading without change and amended text generally. Prior to amendment, text read as follows: “A third-party requester may—

“(1) appeal under the provisions of section 134 with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; or

“(2) be a party to any appeal taken by the patent owner under the provisions of section 134, subject to subsection (c).”

Subsec. (c). Pub. L. 107–273, §13202(a)(4), struck out “United States Code,” after “title 28,”.

#### EFFECTIVE DATE OF 2002 AMENDMENT

Amendment by section 13106(a) 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.

#### ESTOPPEL EFFECT OF REEXAMINATION

Pub. L. 106–113, div. B, §1000(a)(9) [title IV, subtitle F, §4607], Nov. 29, 1999, 113 Stat. 1536, 1501A–571, provided that: “Any party who requests an inter partes reexamination under section 311 of title 35, United States Code, is estopped from challenging at a later time, in any civil action, any fact determined during the process of such reexamination, except with respect to a fact determination later proved to be erroneous based on information unavailable at the time of the inter partes reexamination decision. If this section is held to be unenforceable, the enforceability of the remainder of this subtitle [see Short Title of 1999 Amendment note set out under section 1 of this title] or of this title [see Tables for classification] shall not be denied as a result.”

### § 316. Certificate of patentability, unpatentability, and claim cancellation

(a) IN GENERAL.—In an inter partes reexamination proceeding under this chapter, when the time for appeal has expired or any appeal proceeding 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 any proposed amended or new claim determined to be patentable.

(b) AMENDED OR NEW CLAIM.—Any proposed amended or new claim determined to be patent-

able and incorporated into a patent following an inter partes reexamination proceeding shall have the same effect as that specified in section 252 of this title 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, prior to issuance of a certificate under the provisions of subsection (a) of this section.

(Added Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A–569; amended Pub. L. 107–273, div. C, title III, §13202(c)(1), Nov. 2, 2002, 116 Stat. 1902.)

#### AMENDMENTS

2002—Pub. L. 107–273 made technical correction to directory language of Pub. L. 106–113, which enacted this section.

### § 317. Inter partes reexamination prohibited

(a) ORDER FOR REEXAMINATION.—Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies,<sup>1</sup> may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.

(b) FINAL DECISION.—Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28,<sup>1</sup> that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

(Added Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A–570; amended Pub. L. 107–273, div. C, title III, §13202(a)(5), (c)(1), Nov. 2, 2002, 116 Stat. 1901, 1902.)

#### AMENDMENTS

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)(5)(A), substituted “third-party requester nor its privies” for “patent owner nor the third-party requester, if any, nor privies of either”.

<sup>1</sup> So in original. The comma probably should not appear.

Subsec. (b). Pub. L. 107-273, § 13202(a)(5)(B), struck out “United States Code,” after “title 28.”

§ 318. Stay of litigation

Once an order for inter partes reexamination of a patent has been issued under section 313, the patent owner may obtain a stay of any pending litigation which involves an issue of patentability of any claims of the patent which are the subject of the inter partes reexamination order, unless the court before which such litigation is pending determines that a stay would not serve the interests of justice.

(Added Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-570; amended Pub. L. 107-273, div. C, title III, § 13202(c)(1), Nov. 2, 2002, 116 Stat. 1902.)

AMENDMENTS

2002—Pub. L. 107-273 made technical correction to directory language of Pub. L. 106-113, which enacted this section.

PART IV—PATENT COOPERATION TREATY

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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

Section 9 of Pub. L. 99-616 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.]