

## EFFECTIVE DATE OF 1984 AMENDMENT

Amendment by 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.

## EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-247 effective six months after Aug. 27, 1982, see section 17(c) of Pub. L. 97-247, set out as an Effective Date note under section 294 of this title.

**§ 117. Death or incapacity of inventor**

Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

(July 19, 1952, ch. 950, 66 Stat. 799.)

## HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., § 46 (R.S. 4896, amended (1) Feb. 28, 1899, ch. 227, 30 Stat. 915, (2) Mar. 3, 1903, ch. 1019, § 3, 32 Stat. 1225, 1226, (3) May 23, 1908, ch. 188, 35 Stat. 245).

The language has been considerably simplified.

**§ 118. Filing by other than inventor**

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Director may grant a patent to such inventor upon such notice to him as the Director deems sufficient, and on compliance with such regulations as he prescribes.

(July 19, 1952, ch. 950, 66 Stat. 799; 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

This section is new and provides for the filing of an application by another on behalf of the inventor in certain special hardship situations.

## 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.

**§ 119. Benefit of earlier filing date; right of priority**

(a) An application for patent for an invention filed in this country by any person who has, or

whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

(b)(1) No application for patent shall be entitled to this right of priority unless a claim is filed in the Patent and Trademark Office, identifying the foreign application by specifying the application number on that foreign application, the intellectual property authority or country in or for which the application was filed, and the date of filing the application, at such time during the pendency of the application as required by the Director.

(2) The Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed claim under this section.

(3) The Director may require a certified copy of the original foreign application, specification, and drawings upon which it is based, a translation if not in the English language, and such other information as the Director considers necessary. Any such certification shall be made by the foreign intellectual property authority in which the foreign application was filed and show the date of the application and of the filing of the specification and other papers.

(c) In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in the same foreign country instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

(d) Applications for inventors' certificates filed in a foreign country in which applicants have a right to apply, at their discretion, either for a patent or for an inventor's certificate shall be treated in this country in the same manner and have the same effect for purpose of the right of priority under this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents, provided such applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of such filing.

(e)(1) An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application.

(2) A provisional application filed under section 111(b) of this title may not be relied upon in any proceeding in the Patent and Trademark Office unless the fee set forth in subparagraph (A) or (C) of section 41(a)(1) of this title has been paid.

(3) If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

(f) Applications for plant breeder's rights filed in a WTO member country (or in a foreign UPOV Contracting Party) shall have the same effect for the purpose of the right of priority under subsections (a) through (c) of this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents.

(g) As used in this section—

(1) the term “WTO member country” has the same meaning as the term is defined in section 104(b)(2) of this title; and

(2) the term “UPOV Contracting Party” means a member of the International Convention for the Protection of New Varieties of Plants.

(July 19, 1952, ch. 950, 66 Stat. 800; Pub. L. 87-333, § 1, Oct. 3, 1961, 75 Stat. 748; Pub. L. 92-358, § 1, July 28, 1972, 86 Stat. 501; Pub. L. 93-596, § 1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 103-465, title V, § 532(b)(1), Dec. 8, 1994, 108 Stat. 4985; Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, §§ 4503(a), (b)(2), 4801(b), (c), 4802], Nov. 29, 1999, 113 Stat. 1536, 1501A-563, 1501A-564, 1501A-588, 1501A-589; Pub. L. 107-273, div. C, title III, § 13206(b)(2), Nov. 2, 2002, 116 Stat. 1906.)

#### HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., § 32, second paragraph (R.S. 4887, second paragraph, amended (1) Mar. 3,

1903, ch. 1019, § 1, 32 Stat. 1225, 1226, (2) June 19, 1936, ch. 594, 49 Stat. 1529, (3) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

The first paragraph is the same as the present law with changes in language. The references to designs have been removed for inclusion in another section and the opening clause has been modified to accord with actual practice and the requirements of the International Convention for the Protection of Industrial Property.

The second paragraph is new, making an additional procedural requirement for obtaining the right of priority. Copies of the foreign papers on which the right of priority is based are required so that the record of the United States patent will be complete in this country.

#### REFERENCES IN TEXT

The Stockholm Revision of the Paris Convention, referred to in subsec. (d), means the Convention revising the Convention of the Union of Paris of Mar. 20, 1883, as revised, for the protection of industrial property, done at Stockholm July 14, 1967, entered into force for the United States Sept. 5, 1970, with the exception of Articles 1 through 12 which entered into force for the United States Aug. 25, 1973. See 21 UST 1583; 24 UST 2140; TIAS 6293, 7727.

#### AMENDMENTS

2002—Subsec. (a). Pub. L. 107-273 made technical correction to directory language of Pub. L. 106-113, § 1000(a)(9) [title IV, § 4802(1)]. See 1999 Amendment note below.

1999—Subsec. (a). Pub. L. 106-113, § 1000(a)(9) [title IV, § 4802(1)], as amended by Pub. L. 107-273, inserted “or in a WTO member country,” after “or to citizens of the United States.”

Subsec. (b). Pub. L. 106-113, § 1000(a)(9) [title IV, § 4503(a)], amended subsec. (b) generally. Prior to amendment, subsec. (b) read as follows: “No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent and Trademark Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he deems necessary.”

Subsec. (e)(1). Pub. L. 106-113, § 1000(a)(9) [title IV, § 4503(b)(2)], inserted at end: “No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application.”

Subsec. (e)(2). Pub. L. 106-113, § 1000(a)(9) [title IV, § 4801(c)], struck out before period at end “and the provisional application was pending on the filing date of the application for patent under section 111(a) or section 363 of this title”.

Subsec. (e)(3). Pub. L. 106-113, § 1000(a)(9) [title IV, § 4801(b)], added par. (3).

Subsecs. (f), (g). Pub. L. 106-113, § 1000(a)(9) [title IV, § 4802(2)], added subsecs. (f) and (g).

1994—Pub. L. 103-465, in section catchline, struck out “in foreign country” after “date”, designated four undesignated paragraphs as subsecs. (a) to (d), and added subsec. (e).

1975—Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1972—Pub. L. 92-358 inserted last paragraph providing that under certain circumstances, applications for inventors’ certificate filed in a foreign country would be given the same priority as applications for patents, if the applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of filing.

1961—Pub. L. 87-333 authorized the right provided by this section to be based upon a subsequent application in the same foreign country, instead of the first application, provided that any foreign application filed prior to such subsequent one was withdrawn, or otherwise disposed of, without having been open to public inspection and without leaving any rights outstanding, nor any basis for claiming priority.

#### EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by section 1000(a)(9) [title IV, § 4503(a), (b)(2)] 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.

Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4801(d), Nov. 29, 1999, 113 Stat. 1536, 1501A-589, provided that: “The amendments made by this section [amending this section and section 111 of this title] shall take effect on the date of the enactment of this Act [Nov. 29, 1999] and shall apply to any provisional application filed on or after June 8, 1995, except that the amendments made by subsections (b) and (c) [amending this section] shall have no effect with respect to any patent which is the subject of litigation in an action commenced before such date of enactment.”

#### EFFECTIVE DATE OF 1994 AMENDMENT

Amendment by Pub. L. 103-465 effective 6 months after Dec. 8, 1994, and applicable to all patent applications filed in the United States on or after that effective date, with provisions relating to earliest filed patent application, see section 534(b)(1), (3) of Pub. L. 103-465, set out as a note under section 154 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.

#### EFFECTIVE DATE OF 1972 AMENDMENT

Section 3(a) of Pub. L. 92-358 provided that: “Section 1 of this Act [amending this section] shall take effect on the date when Articles 1-12 of the Paris Convention of March 20, 1883, for the Protection of Industrial Property, as revised at Stockholm, July 14, 1967, come into force with respect to the United States [Aug. 25, 1973] and shall apply only to applications thereafter filed in the United States.”

#### EFFECTIVE DATE OF 1961 AMENDMENT

Amendment by Pub. L. 87-333 effective on the date when the Convention of Paris for the Protection of Industrial Property of March 20, 1883, as revised at Lisbon, Oct. 31, 1958, comes into force with respect to the United States [Jan. 4, 1962] and shall apply only to applications thereafter filed in the United States by persons entitled to the benefit of said convention, as revised at the time of such filing, see section 3 of Pub. L. 87-333, set out as a note under section 1126 of Title 15, Commerce and Trade.

#### JAPANESE AND CERTAIN GERMAN NATIONALS; TEMPORARY EXTENSION OF PRIORITY RIGHTS

Act Aug. 23, 1954, ch. 823, 68 Stat. 764, provided that the priority rights specified in section 101 of former Title 35, Patents, which arose before Apr. 1, 1950, were

extended, with respect to inventions made subsequent to Jan. 1, 1946, in favor of certain Japanese and German nationals, to a date nine months after Aug. 23, 1954, subject to conditions and limitations specified in sections 104, 110, 112, and 114 of former title 35.

#### § 120. Benefit of earlier filing date in the United States

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

(July 19, 1952, ch. 950, 66 Stat. 800; Pub. L. 94-131, § 9, Nov. 14, 1975, 89 Stat. 691; Pub. L. 98-622, title I, § 104(b), Nov. 8, 1984, 98 Stat. 3385; Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4503(b)(1)], Nov. 29, 1999, 113 Stat. 1536, 1501A-563.)

#### HISTORICAL AND REVISION NOTES

This section represents present law not expressed in the statute, except for the added requirement that the first application must be specifically mentioned in the second.

#### AMENDMENTS

1999—Pub. L. 106-113 inserted at end “No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.”

1984—Pub. L. 98-622 substituted “which is filed by an inventor or inventors named in the previously filed application” for “by the same inventor”.

1975—Pub. L. 94-131 inserted “, or as provided by section 363 of this title,” after “filed in the United States”.

#### EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by 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.