

cision of the Patent Trial and Appeal Board in the proceeding 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 derivation proceeding, within 20 days after the appellant has filed notice of appeal in accordance with section 142, files notice with the Director that the party elects to have all further proceedings conducted as provided in section 146. If the appellant does not, within 30 days after the filing of such notice by the adverse party, file a civil action under section 146, the Board's decision shall govern the further proceedings in the case.

See 2011 Amendment note below.

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

2011—Pub. L. 112-29 amended section generally. Prior to amendment, section related to appeals to the Court of Appeals for the Federal Circuit.

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 2011 AMENDMENT

Amendment by 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

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.

EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-164 effective Oct. 1, 1982, see section 402 of Pub. L. 97-164, set out as a note under section 171 of Title 28, Judiciary and Judicial Procedure.

§ 142. Notice of appeal

When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

(July 19, 1952, ch. 950, 66 Stat. 802; Pub. L. 93-596, §1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 97-164, title I, §163(a)(7), Apr. 2, 1982, 96 Stat. 49; Pub. L. 98-620, title IV, §414(a), Nov. 8, 1984, 98 Stat. 3362; 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., §60 (R.S. 4912, amended (1) Mar. 2, 1927, ch. 273, §9, 44 Stat. 1336, (2) Mar. 2, 1929, ch. 488, §2(b), 45 Stat. 1476).

Changes in language are made.

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.

1984—Pub. L. 98-620 amended section generally, substituting “the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Commissioner, within such time after the date of the decision from which the appeal is taken as the Commissioner prescribes, but in no case less than 60 days after that date” for “the appellant shall give notice thereof to the Commissioner, and shall file in the

Patent and Trademark Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints”.

1982—Pub. L. 97-164 substituted “Court of Appeals for the Federal Circuit” for “Court of Customs and Patent Appeals”.

1975—Pub. L. 93-596 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 1984 AMENDMENT

Section 414(c) of Pub. L. 98-620 provided that: “The amendments made by this section [amending this section, sections 143 and 144 of this title, and section 1071 of Title 15, Commerce and Trade] shall apply to proceedings pending in the Patent and Trademark Office on the date of the enactment of this Act [Nov. 8, 1984] and to appeals pending in the United States Court of Appeals for the Federal Circuit on such date.”

EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-164 effective Oct. 1, 1982, see section 402 of Pub. L. 97-164, set out as a note under section 171 of Title 28, Judiciary and Judicial Procedure.

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.

§ 143. Proceedings on appeal

With respect to an appeal described in section 142 of this title, the Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the Director forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case or any reexamination case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.¹

(July 19, 1952, ch. 950, 66 Stat. 802; Pub. L. 93-596, §1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 97-164, title I, §163(a)(7), Apr. 2, 1982, 96 Stat. 49; Pub. L. 98-620, title IV, §414(a), Nov. 8, 1984, 98 Stat. 3363; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §§4605(d), 4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-571, 1501A-582; Pub. L. 107-273, div. C, title III, §§13202(b)(2), 13206(b)(1)(B), Nov. 2, 2002, 116 Stat. 1901, 1906; Pub. L. 112-29, §§7(c)(3), 20(j), Sept. 16, 2011, 125 Stat. 314, 335.)

AMENDMENT OF SECTION

Pub. L. 112-29, §20(j), (l), Sept. 16, 2011, 125 Stat. 335, provided that, effective upon the expi-

ration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, this section is amended by striking “of this title” each place that term appears. See 2011 Amendment note below.

Pub. L. 112-29, §7(c)(3), (e), Sept. 16, 2011, 125 Stat. 314, 315, provided that, 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, this section is amended:

(1) by striking the third sentence and inserting the following: “In an ex parte case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all of the issues raised in the appeal. The Director shall have the right to intervene in an appeal from a decision entered by the Patent Trial and Appeal Board in a derivation proceeding under section 135 or in an inter partes or post-grant review under chapter 31 or 32.”; and

(2) by striking the last sentence.

See 2011 Amendment note below.

HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §61 (R.S. 4913, amended Mar. 2, 1927, ch. 273, §10, 44 Stat. 1336).

Language is changed. The requirement that the Commissioner notify the parties is omitted and a requirement that the court notify the parties is added. The statement relating to filing the papers and testimony is made more explicit.

AMENDMENTS

2011—Pub. L. 112-29, §20(j), struck out “of this title” after “142”.

Pub. L. 112-29, §7(c)(3), substituted “In an ex parte case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all of the issues raised in the appeal. The Director shall have the right to intervene in an appeal from a decision entered by the Patent Trial and Appeal Board in a derivation proceeding under section 135 or in an inter partes or post-grant review under chapter 31 or 32.” for “In an ex parte case or any reexamination case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal.” and struck out “The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.” at the end.

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, §13202(b)(2), amended third sentence generally and added fourth sentence identical to existing fourth (now fifth) sentence. Prior to amendment, third sentence read as follows: “In any reexamination case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal.”

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” the first, second, and fourth places appearing.

Pub. L. 106-113, §1000(a)(9) [title IV, §4605(d)], amended third sentence generally. Prior to amendment, third sentence read as follows: “In an ex parte case, the Commissioner shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal.”

¹ So in original. Fourth and fifth sentences are identical.