

Board of Patent Appeals and Interferences, as the facts in the case may appear and such adjudication shall authorize the Director to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

(July 19, 1952, ch. 950, 66 Stat. 803; Pub. L. 97-164, title I, §163(a)(7), Apr. 2, 1982, 96 Stat. 49; Pub. L. 98-622, title II, §203(b), Nov. 8, 1984, 98 Stat. 3387; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4605(e), 4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-571, 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(j)(1), 9(a), 20(j), Sept. 16, 2011, 125 Stat. 290, 316, 335.)

AMENDMENT OF SECTION

Pub. L. 112-29, §20(j), (l), Sept. 16, 2011, 125 Stat. 335, 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, this section is amended by striking “of this title” each place that term appears. See 2011 Amendment note below.

Pub. L. 112-29, §3(j)(1), (n), Sept. 16, 2011, 125 Stat. 290, 293, provided that, 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, this section is amended by striking “Board of Patent Appeals and Interferences” each place it appears and inserting “Patent Trial and Appeal Board”. See 2011 Amendment note below.

HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §63 (R.S. 4915, amended (1) Mar. 2, 1927, ch. 273, §11, 44 Stat. 1336, (2) Mar. 2, 1929, ch. 488, §2(b), 45 Stat. 1476, (3) Aug. 5, 1939, ch. 451, §4, 53 Stat. 1212).

Bill in equity is changed to civil action and the section is restricted to exclude interferences which are covered by the next section. The time for filing the action is changed to the same as the time for appeal. The requirement for the applicant to file a copy of the decision in the Patent Office is omitted.

Language is changed.

AMENDMENTS

2011—Pub. L. 112-29, §20(j), struck out “of this title” after “134(a)”.

Pub. L. 112-29, §9(a), substituted “United States District Court for the Eastern District of Virginia” for “United States District Court for the District of Columbia”.

Pub. L. 112-29, §3(j)(1), substituted “Patent Trial and Appeal Board” for “Board of Patent Appeals and Interferences” in two places.

2002—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 note below.

1999—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.

Pub. L. 106-113, §1000(a)(9) [title IV, §4605(e)], inserted “(a)” after “section 134”.

1984—Pub. L. 98-622 substituted “Patent Appeals and Interferences in an appeal under section 134 of this title may,” for “Appeals may” in first sentence and “Patent Appeals and Interferences” for “Appeals” in second sentence.

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

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 3(j)(1) 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 9(a) of Pub. L. 112-29 effective Sept. 16, 2011, and applicable to any civil action commenced on or after that date, see section 9(b) of Pub. L. 112-29, set out as a note under section 1071 of Title 15, Commerce and Trade.

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, §4605(e)] 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(e)] 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.

§ 146. Civil action in case of interference

Any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences on the interference, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Director appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Appeals for the Federal Circuit, and such appeal is pending or has been decided. In such suits the record in the Patent and Trademark Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of dis-

tricts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the Eastern District of Virginia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Director shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Director to issue such patent on the filing in the Patent and Trademark Office of a certified copy of the judgment and on compliance with the requirements of law.

(July 19, 1952, ch. 950, 66 Stat. 803; 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. 98-622, title II, §203(c), Nov. 8, 1984, 98 Stat. 3387; 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; Pub. L. 112-29, §§3(j)(1), (2)(A), (4), 9(a), 20(j), Sept. 16, 2011, 125 Stat. 290, 316, 335.)

AMENDMENT OF SECTION

Pub. L. 112-29, §20(j), (l), Sept. 16, 2011, 125 Stat. 335, 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, this section is amended by striking “of this title” each place that term appears. See 2011 Amendment note below.

Pub. L. 112-29, §3(j)(1), (2)(A), (4), (n), Sept. 16, 2011, 125 Stat. 290, 293, provided that, 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, this section is amended by:

- (1) striking “Board of Patent Appeals and Interferences” each place it appears and inserting “Patent Trial and Appeal Board”;*
- (2) striking “an interference” and inserting “a derivation proceeding”;*
- (3) striking “the interference” and inserting “the derivation proceeding”;* and
- (4) amending the section catchline to read as follows: “Civil action in case of derivation proceeding”.*

See 2011 Amendment note below.

HISTORICAL AND REVISION NOTES

The first paragraph and parts of the second paragraph are based on Title 35, U.S.C., 1946 ed., §63 (R.S. 4915, amended (1) Mar. 2, 1927, ch. 273, §11, 44 Stat. 1336, (2) Mar. 2, 1929, ch. 488, §2(b), 45 Stat. 1476, (3) Aug. 5, 1939, ch. 451, §4, 53 Stat. 1212), limited to interferences and making some changes. The action is not restricted to applicants, but a patentee may also bring the action. The time for bringing the action is made the same as for appeals.

In the second paragraph the first sentence is new and eliminates difficulties arising from unrecorded interests.

The second sentence is based on Title 35, U.S.C., 1946 ed., §72a (Mar. 3, 1927, ch. 364, 44 Stat. 1394, reenacted

Oct. 31, 1951, ch. 655, §53a, 65 Stat. 728) with changes in language.

The fourth sentence is new and prevents such suits from being filed against the Commissioner as a defendant; however, the Commissioner has the right to intervene.

Language is changed.

AMENDMENTS

2011—Pub. L. 112-29, §20(j), struck out “of this title” after “141”.

Pub. L. 112-29, §9(a), substituted “United States District Court for the Eastern District of Virginia” for “United States District Court for the District of Columbia”.

Pub. L. 112-29, §3(j)(1), (2)(A), (4), amended section catchline generally, substituting “Civil action in case of derivation proceeding” for “Civil action in case of interference”, and substituted in text “a derivation proceeding” for “an interference”, “Patent Trial and Appeal Board” for “Board of Patent Appeals and Interferences”, and “the derivation proceeding” for “the interference”.

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” wherever appearing.

1984—Pub. L. 98-622 substituted “Board of Patent Appeals and Interferences on the interference” for “board of patent interference on the question of priority”.

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” wherever appearing.

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 3(j)(1), (2)(A), (4) 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 9(a) of Pub. L. 112-29 effective Sept. 16, 2011, and applicable to any civil action commenced on or after that date, see section 9(b) of Pub. L. 112-29, set out as a note under section 1071 of Title 15, Commerce and Trade.

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 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.

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 14—ISSUE OF PATENT

Sec.	
151.	Issue of patent.
152.	Issue of patent to assignee.
153.	How issued.
154.	Contents and term of patent; provisional rights.
155.	Patent term extension.
155A.	Patent term restoration.
156.	Extension of patent term.
157.	Statutory invention registration.

AMENDMENT OF ANALYSIS

Pub. L. 112-29, § 20(k), (l), Sept. 16, 2011, 125 Stat. 335, 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, this analysis is amended by striking out items 155 and 155A. See 2011 Amendment notes below.

Pub. L. 112-29, § 3(e)(1), (3), Sept. 16, 2011, 125 Stat. 287, 288, provided that, effective upon the expiration of the 18-month period beginning on Sept. 16, 2011, and applicable to any request for a statutory invention registration filed on or after that effective date, this analysis is amended by striking out item 157. See 2011 Amendment notes below.

AMENDMENTS

2011—Pub. L. 112-29, § 20(k), Sept. 16, 2011, 125 Stat. 335, struck out items 155 “Patent term extension” and 155A “Patent term restoration”.

Pub. L. 112-29, § 3(e)(1), Sept. 16, 2011, 125 Stat. 287, struck out item 157 “Statutory invention registration”.

1999—Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4507(6)], Nov. 29, 1999, 113 Stat. 1536, 1501A-566, inserted “; provisional rights” after “patent” in item 154.

1984—Pub. L. 98-622, title I, § 102(b), Nov. 8, 1984, 98 Stat. 3384, added item 157.

Pub. L. 98-417, title II, § 201(b), Sept. 24, 1984, 98 Stat. 1602, added item 156.

1983—Pub. L. 98-127, § 4(b), Oct. 13, 1983, 97 Stat. 833, added item 155A.

Pub. L. 97-414, § 11(b), Jan. 4, 1983, 96 Stat. 2066, added item 155.

1965—Pub. L. 89-83, § 6, July 24, 1965, 79 Stat. 261, substituted “Issue of patent” for “Time of issue of patent” in item 151.

§ 151. Issue of patent

If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.

Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof and, if not paid, the patent shall lapse at the termination of this three-month period. In calculating the amount of a remaining balance, charges for a page or less may be disregarded.

If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be ac-

cepted by the Director as though no abandonment or lapse had ever occurred.

(July 19, 1952, ch. 950, 66 Stat. 803; Pub. L. 89-83, § 4, July 24, 1965, 79 Stat. 260; Pub. L. 93-601, § 3, Jan. 2, 1975, 88 Stat. 1956; 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., § 41 (R.S. 4885, amended (1) May 23, 1908, ch. 189, 35 Stat. 246, (2) Aug. 9, 1939, § 2, ch. 619, 53 Stat. 1293).

Language is changed.

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 last par. 1975—Pub. L. 93-601 substituted “and the delay in payment is shown to have been unavoidable,” for “within three months after the due date and sufficient cause is shown for the late payment,” in last par.

1965—Pub. L. 89-83 substituted provisions requiring a notice of allowance to be sent to the applicant, the notice of allowance to specify a sum, constituting the issue fee or a portion thereof, which shall be paid within 3 months thereafter, the patent to issue upon payment of this sum, the application to be deemed abandoned if the sum is not paid, and any remaining balance of the fee to be paid within 3 months after issuance of the patent shall lapse, and permitting the Commissioner within 3 months after the due date of an unpaid fee on a showing of sufficient cause to accept late payment as though no abandonment or lapse had occurred, for provisions which required a notice of allowance to be sent to the applicant, the final fee to be paid within 6 months after the notice, the patent to be issued within 3 months from the date of the payment, and which permitted delayed payment of the issue fee up to 1 year.

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 1975 AMENDMENT

Amendment by Pub. L. 93-601 effective Jan. 2, 1975, with examiners-in-chief in office on such date to continue with existing appointment, see section 4(b) of Pub. L. 93-601, set out as a note under section 3 of this title.

EFFECTIVE DATE OF 1965 AMENDMENT

Amendment by Pub. L. 89-83 effective three months after July 24, 1965, see section 7(a) of Pub. L. 89-83, set out as a note under section 41 of this title.

ACCEPTANCE OF LATE PAYMENT OF ISSUE FEES BY COMMISSIONER

Section 4(a) of Pub. L. 93-601 provided that: “The Commissioner of Patents [now Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] may, in accordance with Section 3 of this Act [amending this section], accept late payment of issue fees, the payment of which was governed by the provisions of Public Law 89-93 [probably should refer to Public Law 89-83, which amended sections 41, 112, and 151 of this title and section 1113 of Title 15, Commerce and Trade]; *Provided:* the term of the patent for which late payment of such an issue fee is accepted shall expire earlier than the