

## HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., § 70, part (R.S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

This is the last sentence of R.S. 4921, third paragraph, with minor changes in language.

## 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” wherever appearing.

## 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.

**§ 291. Interfering patents**

The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of the validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section.

(July 19, 1952, ch. 950, 66 Stat. 814; Pub. L. 112-29, §§3(h)(1), 20(j), Sept. 16, 2011, 125 Stat. 288, 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(h)(1), (n), Sept. 16, 2011, 125 Stat. 288, 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 to read as follows:*

**§ 291. Derived patents**

(a) *In General.*—The owner of a patent may have relief by civil action against the owner of another patent that claims the same invention and has an earlier effective filing date, if the invention claimed in such other patent was derived from the inventor of the invention claimed in the patent owned by the person seeking relief under this section.

(b) *Filing Limitation.*—An action under this section may be filed only before the end of the 1-year period beginning on the date of the issuance of the first patent containing a claim to the allegedly derived invention and naming an individual alleged to have derived such invention as the inventor or joint inventor.

See 2011 Amendment note below.

## HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., § 66 (R.S. 4918, amended Mar. 2, 1927, ch. 273, § 12, 44 Stat. 1337). Language is changed.

## AMENDMENTS

2011—Pub. L. 112-29, § 20(j), struck out “of this title” after “146”.

Pub. L. 112-29, § 3(h)(1), amended section generally. Prior to amendment, text read as follows: “The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of the validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 shall apply to actions brought under this section.”

## EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 3(h)(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 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.

## SAVINGS PROVISIONS

Provisions of 35 U.S.C. 291, as in effect on the day before the expiration of the 18-month period beginning on Sept. 16, 2011, apply to each claim of certain applications for patent, and certain patents issued thereon, for which the amendments made by section 3 of Pub. L. 112-29 also apply, see section 3(n)(2) of Pub. L. 112-29, set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title.

**§ 292. False marking**

(a) Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used, offered for sale, or sold by such person within the United States, or imported by the person into the United States, the name or any imitation of the name of the patentee, the patent number, or the words “patent,” “patentee,” or the like, with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made, offered for sale, sold, or imported into the United States by or with the consent of the patentee; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article, the word “patent” or any word or number importing that the same is patented for the purpose of deceiving the public; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any article, the words “patent applied for,” “patent pending,” or any word importing that an application for patent has been made, when no application for patent has been made, or if made, is not pending, for the purpose of deceiving the public—

Shall be fined not more than \$500 for every such offense. Only the United States may sue for the penalty authorized by this subsection.

(b) A person who has suffered a competitive injury as a result of a violation of this section may file a civil action in a district court of the United States for recovery of damages adequate to compensate for the injury.

(c) The marking of a product, in a manner described in subsection (a), with matter relating to a patent that covered that product but has expired is not a violation of this section.

(July 19, 1952, ch. 950, 66 Stat. 814; Pub. L. 103-465, title V, § 533(b)(6), Dec. 8, 1994, 108 Stat.

4990; Pub. L. 112-29, §16(b)(1)–(3), Sept. 16, 2011, 125 Stat. 329.)

#### HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §50 (R.S. 4901).

This is a criminal provision. The first two paragraphs of the corresponding section of existing statute are consolidated, a new paragraph relating to false marking of “patent applied for” is added, and false advertising is included in all the offenses. The minimum fine which has been interpreted by the courts as a maximum, is replaced by a higher maximum. The informer action is included as additional to an ordinary criminal action.

#### AMENDMENTS

2011—Subsec. (a). Pub. L. 112-29, §16(b)(1), inserted at end “Only the United States may sue for the penalty authorized by this subsection.”

Subsec. (b). Pub. L. 112-29, §16(b)(2), amended subsec. (b) generally. Prior to amendment, subsec. (b) read as follows: “Any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States.”

Subsec. (c). Pub. L. 112-29, §16(b)(3), added subsec. (c).

1994—Subsec. (a). Pub. L. 103-465, in first par., substituted “used, offered for sale, or sold by such person within the United States, or imported by the person into the United States” for “used, or sold by him” and “made, offered for sale, sold, or imported into the United States” for “made or sold”.

#### EFFECTIVE DATE OF 2011 AMENDMENT

Pub. L. 112-29, §16(b)(4), Sept. 16, 2011, 125 Stat. 329, provided that: “The amendments made by this subsection [amending this section] shall apply to all cases, without exception, that are pending on, or commenced on or after, the date of the enactment of this Act [Sept. 16, 2011].”

#### EFFECTIVE DATE OF 1994 AMENDMENT

Amendment by Pub. L. 103-465 effective on date that is one year after date on which the WTO Agreement enters into force with respect to the United States [Jan. 1, 1995], with provisions relating to earliest filed patent application, see section 534(a), (b)(3) of Pub. L. 103-465, set out as a note under section 154 of this title.

### § 293. Nonresident patentee; service and notice

Every patentee not residing in the United States may file in the Patent and Trademark Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. If the person designated cannot be found at the address given in the last designation, or if no person has been designated, the United States District Court for the Eastern District of Virginia shall have jurisdiction and summons shall be served by publication or otherwise as the court directs. The court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally within the jurisdiction of the court.

(July 19, 1952, ch. 950, 66 Stat. 814; Pub. L. 93-596, §1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 112-29, §9(a), Sept. 16, 2011, 125 Stat. 316.)

#### HISTORICAL AND REVISION NOTES

This section provides for service on non-resident patentees.

#### AMENDMENTS

2011—Pub. L. 112-29 substituted “United States District Court for the Eastern District of Virginia” for

“United States District Court for the District of Columbia”.

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

#### EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by 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.

#### 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.

### § 294. Voluntary arbitration

(a) A contract involving a patent or any right under a patent may contain a provision requiring arbitration of any dispute relating to patent validity or infringement arising under the contract. In the absence of such a provision, the parties to an existing patent validity or infringement dispute may agree in writing to settle such dispute by arbitration. Any such provision or agreement shall be valid, irrevocable, and enforceable, except for any grounds that exist at law or in equity for revocation of a contract.

(b) Arbitration of such disputes, awards by arbitrators and confirmation of awards shall be governed by title 9, to the extent such title is not inconsistent with this section. In any such arbitration proceeding, the defenses provided for under section 282 of this title shall be considered by the arbitrator if raised by any party to the proceeding.

(c) An award by an arbitrator shall be final and binding between the parties to the arbitration but shall have no force or effect on any other person. The parties to an arbitration may agree that in the event a patent which is the subject matter of an award is subsequently determined to be invalid or unenforceable in a judgment rendered by a court of competent jurisdiction from which no appeal can or has been taken, such award may be modified by any court of competent jurisdiction upon application by any party to the arbitration. Any such modification shall govern the rights and obligations between such parties from the date of such modification.

(d) When an award is made by an arbitrator, the patentee, his assignee or licensee shall give notice thereof in writing to the Director. There shall be a separate notice prepared for each patent involved in such proceeding. Such notice shall set forth the names and addresses of the parties, the name of the inventor, and the name of the patent owner, shall designate the number of the patent, and shall contain a copy of the award. If an award is modified by a court, the party requesting such modification shall give notice of such modification to the Director. The Director shall, upon receipt of either notice, enter the same in the record of the prosecution of such patent. If the required notice is not filed with the Director, any party to the proceeding may provide such notice to the Director.

(e) The award shall be unenforceable until the notice required by subsection (d) is received by the Director.