

§ 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, § 20(j), Sept. 16, 2011, 125 Stat. 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.*

AMENDMENTS

2011—Subsec. (b). Pub. L. 112-29 struck out “of this title” after “252”.

2002—Subsec. (a). Pub. L. 107-273 made technical correction to directory language of Pub. L. 106-113. See 1999 Amendment note below.

1999—Subsec. (a). Pub. L. 106-113, as amended by Pub. L. 107-273, substituted “Director” for “Commissioner”.

1994—Subsec. (b). Pub. L. 103-465 substituted “used within the United States, or imported into the United States, anything” for “used anything”.

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, 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 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.

**CHAPTER 31—OPTIONAL INTER PARTES REEXAMINATION PROCEDURES**

- Sec.
- 311. Request for inter partes reexamination.
- 312. Determination of issue by Director.
- 313. Inter partes reexamination order by Director.
- 314. Conduct of inter partes reexamination proceedings.
- 315. Appeal.
- 316. Certificate of patentability, unpatentability, and claim cancellation.
- 317. Inter partes reexamination prohibited.
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AMENDMENT OF CHAPTER HEADING AND ANALYSIS

*Pub. L. 112-29, § 6(a), (c)(2), Sept. 16, 2011, 125 Stat. 299, 304, provided that, effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, this chapter heading and analysis are amended generally, substituting “INTER PARTES REVIEW” for existing chapter heading, substituting item 311 “Inter partes review.”, item 312 “Petitions.”, item 313 “Preliminary response to*

*petition.”, item 314 “Institution of inter partes review.”, item 315 “Relation to other proceedings or actions.”, item 316 “Conduct of inter partes review.”, item 317 “Settlement.”, and item 318 “Decision of the Board.” for existing items 311 to 318, respectively, and adding item 319 “Appeal.” See 2011 Amendment note below.*

AMENDMENTS

2011—Pub. L. 112-29, § 6(a), Sept. 16, 2011, 125 Stat. 299, substituted “INTER PARTES REVIEW” for “OPTIONAL INTER PARTES REEXAMINATION PROCEDURES” in chapter heading and amended analysis generally, adding items 311 to 319, and striking out former items 311 “Request for inter partes reexamination”, 312 “Determination of issue by Director”, 313 “Inter partes reexamination order by Director”, 314 “Conduct of inter partes reexamination proceedings”, 315 “Appeal”, 316 “Certificate of patentability, unpatentability, and claim cancellation”, 317 “Inter partes reexamination prohibited”, and 318 “Stay of litigation”.

2002—Pub. L. 107-273, div. C, title III, § 13202(c)(1), Nov. 2, 2002, 116 Stat. 1902, made technical correction to directory language of Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-567, which enacted this chapter.

**§ 311. Request for inter partes reexamination**

(a) IN GENERAL.—Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

(b) REQUIREMENTS.—The request shall—

(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and

(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

(c) COPY.—The Director promptly shall send a copy of the request to the owner of record of the patent.

(Added Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-567; amended Pub. L. 107-273, div. C, title III, § 13202(a)(1), (c)(1), Nov. 2, 2002, 116 Stat. 1901, 1902; Pub. L. 112-29, § 6(a), Sept. 16, 2011, 125 Stat. 299.)

AMENDMENT OF SECTION

*Pub. L. 112-29, § 6(a), (c)(2), Sept. 16, 2011, 125 Stat. 299, 304, provided that, effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, this section is amended to read as follows:*

**§ 311. Inter partes review**

(a) In General.—Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent. The Director shall establish, by regulation, fees to be paid by the person requesting the review, in such amounts as the Director determines to be reasonable, considering the aggregate costs of the review.

(b) Scope.—A petitioner in an inter partes review may request to cancel as unpatentable 1 or more

*claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.*

(c) *Filing Deadline.*—A petition for inter partes review shall be filed after the later of either—

- (1) the date that is 9 months after the grant of a patent or issuance of a reissue of a patent; or
- (2) if a post-grant review is instituted under chapter 32, the date of the termination of such post-grant review.

See 2011 Amendment note below.

#### AMENDMENTS

2011—Pub. L. 112-29 amended section generally. Prior to amendment, section related to request for inter partes reexamination.

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)(1)(A), substituted “third-party requester” for “person”.

Subsec. (c). Pub. L. 107-273, § 13202(a)(1)(B), substituted “The” for “Unless the requesting person is the owner of the patent, the”.

#### EFFECTIVE DATE OF 2011 AMENDMENT

Pub. L. 112-29, § 6(c)(2), Sept. 16, 2011, 125 Stat. 304, provided that:

“(A) IN GENERAL.—The amendments made by subsection (a) [enacting section 319 of this title and amending this section and sections 312 to 318 of this title] shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act [Sept. 16, 2011] and shall apply to any patent issued before, on, or after that effective date.

“(B) GRADUATED IMPLEMENTATION.—The Director [Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] may impose a limit on the number of inter partes reviews that may be instituted under chapter 31 of title 35, United States Code, during each of the first 4 1-year periods in which the amendments made by subsection (a) are in effect, if such number in each year equals or exceeds the number of inter partes reexaminations that are ordered under chapter 31 of title 35, United States Code, in the last fiscal year ending before the effective date of the amendments made by subsection (a).”

#### EFFECTIVE DATE

Chapter 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 an Effective Date of 1999 Amendment note under section 41 of this title.

#### REGULATIONS

Pub. L. 112-29, § 6(c)(1), Sept. 16, 2011, 125 Stat. 304, provided that: “The Director [Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] shall, not later than the date that is 1 year after the date of the enactment of this Act [Sept. 16, 2011], issue regulations to carry out chapter 31 of title 35, United States Code, as amended by subsection (a) of this section.”

#### REPORT TO CONGRESS

Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, subtitle F, § 4606], Nov. 29, 1999, 113 Stat. 1536, 1501A-571, provided that: “Not later than 5 years after the date of the enactment of this Act [Nov. 29, 1999], the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office shall submit to the Congress a report evaluating whether the inter partes reexamination proceedings established

under the amendments made by this subtitle [see Short Title of 1999 Amendment note set out under section 1 of this title] are inequitable to any of the parties in interest and, if so, the report shall contain recommendations for changes to the amendments made by this subtitle to remove such inequity.”

#### § 312. Determination of issue by Director

(a) REEXAMINATION.—Not later than 3 months after the filing of a request for inter partes reexamination under section 311, the Director shall determine whether the information presented in the request shows that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request, with or without consideration of other patents or printed publications. A showing that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

(b) RECORD.—A record of the Director’s determination under subsection (a) shall be placed in the official file of the patent, and a copy shall be promptly given or mailed to the owner of record of the patent and to the third-party requester.

(c) FINAL DECISION.—A determination by the Director under subsection (a) shall be final and non-appealable. Upon a determination that the showing required by subsection (a) has not been made, the Director may refund a portion of the inter partes reexamination fee required under section 311.

(Added Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-568; amended Pub. L. 107-273, div. C, title III, §§ 13105(a), 13202(a)(2), (c)(1), Nov. 2, 2002, 116 Stat. 1900-1902; Pub. L. 112-29, § 6(a), (c)(3)(A)(i), Sept. 16, 2011, 125 Stat. 300, 305.)

#### AMENDMENT OF SECTION

*Pub. L. 112-29, § 6(a), (c)(2), Sept. 16, 2011, 125 Stat. 300, 304, provided that, effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, this section is amended to read as follows:*

#### § 312. Petitions

(a) *Requirements of Petition.*—A petition filed under section 311 may be considered only if—

(1) the petition is accompanied by payment of the fee established by the Director under section 311;

(2) the petition identifies all real parties in interest;

(3) the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim, including—

(A) copies of patents and printed publications that the petitioner relies upon in support of the petition; and

(B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on expert opinions;

(4) the petition provides such other information as the Director may require by regulation; and

(5) the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner.

(b) *Public Availability.*—As soon as practicable after the receipt of a petition under section 311, the Director shall make the petition available to the public.

See 2011 Amendment note below.

#### AMENDMENTS

2011—Pub. L. 112-29, §6(a), amended section generally. Prior to amendment, section related to determination of issue by Director.

Subsec. (a). Pub. L. 112-29, §6(c)(3)(A)(i)(I), substituted “the information presented in the request shows that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request,” for “a substantial new question of patentability affecting any claim of the patent concerned is raised by the request,” and “A showing that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request” for “The existence of a substantial new question of patentability”.

Subsec. (c). Pub. L. 112-29, §6(c)(3)(A)(i)(II), substituted “the showing required by subsection (a) has not been made,” for “no substantial new question of patentability has been raised.”

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)(2)(A), struck out second sentence which read as follows: “On the Director’s initiative, and at any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications.”

Pub. L. 107-273, §13105(a), inserted at end “The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.”

Subsec. (b). Pub. L. 107-273, §13202(a)(2)(B), struck out “, if any” after “third-party requester”.

#### EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 6(a) of Pub. L. 112-29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112-29, set out as a note under section 311 of this title.

Pub. L. 112-29, §6(c)(3)(B), (C), Sept. 16, 2011, 125 Stat. 305, provided that:

“(B) APPLICATION.—The amendments made by this paragraph [amending this section and section 313 of this title]—

“(i) shall take effect on the date of the enactment of this Act [Sept. 16, 2011]; and

“(ii) shall apply to requests for inter partes reexamination that are filed on or after such date of enactment, but before the effective date set forth in paragraph (2)(A) of this subsection [set out as a note under section 311 of this title].

“(C) CONTINUED APPLICABILITY OF PRIOR PROVISIONS.—The provisions of chapter 31 of title 35, United States Code, as amended by this paragraph [amending this section and section 313 of this title], shall continue to apply to requests for inter partes reexamination that are filed before the effective date set forth in paragraph (2)(A) as if subsection (a) [enacting section 319 of this title and amending this section and sections 312 to 318 of this title] had not been enacted.”

#### EFFECTIVE DATE OF 2002 AMENDMENT

Amendment by section 13105(a) of Pub. L. 107-273 applicable with respect to any determination of the Di-

rector of the United States Patent and Trademark Office that is made on or after Nov. 2, 2002, see section 13105(b) of Pub. L. 107-273, set out as a note under section 303 of this title.

#### § 313. Inter partes reexamination order by Director

If, in a determination made under section 312(a), the Director finds that it has been shown that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request, the determination shall include an order for inter partes reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the inter partes reexamination conducted in accordance with section 314.

(Added Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-568; amended Pub. L. 107-273, div. C, title III, §13202(c)(1), Nov. 2, 2002, 116 Stat. 1902; Pub. L. 112-29, §6(a), (c)(3)(A)(ii), Sept. 16, 2011, 125 Stat. 300, 305.)

#### AMENDMENT OF SECTION

*Pub. L. 112-29, §6(a), (c)(2), Sept. 16, 2011, 125 Stat. 300, 304, provided that, effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, this section is amended to read as follows:*

#### § 313. Preliminary response to petition

*If an inter partes review petition is filed under section 311, the patent owner shall have the right to file a preliminary response to the petition, within a time period set by the Director, that sets forth reasons why no inter partes review should be instituted based upon the failure of the petition to meet any requirement of this chapter.*

See 2011 Amendment note below.

#### AMENDMENTS

2011—Pub. L. 112-29, §6(c)(3)(A)(ii), which directed substitution of “it has been shown that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request” for “a substantial new question of patentability affecting a claim of the patent is raised”, was executed by making the substitution for “a substantial new question of patentability affecting a claim of a patent is raised”, to reflect the probable intent of Congress.

Pub. L. 112-29, §6(a), amended section generally. Prior to amendment, text read as follows: “If, in a determination made under section 312(a), the Director finds that it has been shown that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request, the determination shall include an order for inter partes reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the inter partes reexamination conducted in accordance with section 314.”

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

#### EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 6(a) of Pub. L. 112-29 effective upon the expiration of the 1-year period beginning on

Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112-29, set out as a note under section 311 of this title.

Amendment by section 6(c)(3)(A)(ii) of Pub. L. 112-29 effective Sept. 16, 2011, and applicable to requests for inter partes reexamination filed on or after Sept. 16, 2011, but before the effective date set forth in section 6(c)(2)(A) of Pub. L. 112-29, with continued applicability of prior provisions, see section 6(c)(3)(B), (C) of Pub. L. 112-29, set out as a note under section 312 of this title.

#### § 314. Conduct of inter partes reexamination proceedings

(a) **IN GENERAL.**—Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any inter partes reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

(b) **RESPONSE.**—(1) With the exception of the inter partes reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party. In addition, the Office shall send to the third-party requester a copy of any communication sent by the Office to the patent owner concerning the patent subject to the inter partes reexamination proceeding.

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

(c) **SPECIAL DISPATCH.**—Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

(Added Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4604(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-568; amended Pub. L. 107-273, div. C, title III, § 13202(a)(3), (c)(1), Nov. 2, 2002, 116 Stat. 1901, 1902; Pub. L. 112-29, § 6(a), Sept. 16, 2011, 125 Stat. 300.)

##### AMENDMENT OF SECTION

*Pub. L. 112-29, § 6(a), (c)(2), Sept. 16, 2011, 125 Stat. 300, 304, provided that, effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, this section is amended to read as follows:*

#### § 314. Institution of inter partes review

(a) **Threshold.**—*The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would pre-*

*vail with respect to at least 1 of the claims challenged in the petition.*

(b) **Timing.**—*The Director shall determine whether to institute an inter partes review under this chapter pursuant to a petition filed under section 311 within 3 months after—*

*(1) receiving a preliminary response to the petition under section 313; or*

*(2) if no such preliminary response is filed, the last date on which such response may be filed.*

(c) **Notice.**—*The Director shall notify the petitioner and patent owner, in writing, of the Director's determination under subsection (a), and shall make such notice available to the public as soon as is practicable. Such notice shall include the date on which the review shall commence.*

(d) **No Appeal.**—*The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.*

*See 2011 Amendment note below.*

##### AMENDMENTS

2011—Pub. L. 112-29 amended section generally. Prior to amendment, section related to conduct of inter partes reexamination proceedings.

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, § 13202(a)(3), redesignated par. (2) as (1), substituted "the Office shall send to the third-party requester a copy" for "the third-party requester shall receive a copy", redesignated par. (3) as (2), and struck out former par. (1) which read as follows: "This subsection shall apply to any inter partes reexamination proceeding in which the order for inter partes reexamination is based upon a request by a third-party requester."

##### 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 any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112-29, set out as a note under section 311 of this title.

#### § 315. Appeal

(a) **PATENT OWNER.**—The patent owner involved in an inter partes reexamination proceeding under this chapter—

(1) may appeal under the provisions of section 134 and may appeal under the provisions of sections 141 through 144, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent; and

(2) may be a party to any appeal taken by a third-party requester under subsection (b).

(b) **THIRD-PARTY REQUESTER.**—A third-party requester—

(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; and

(2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144.

(c) **CIVIL ACTION.**—A third-party requester whose request for an inter partes reexamination

results in an order under section 313 is estopped 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; Pub. L. 112-29, §6(a), Sept. 16, 2011, 125 Stat. 300.)

#### AMENDMENT OF SECTION

*Pub. L. 112-29, §6(a), (c)(2), Sept. 16, 2011, 125 Stat. 300, 304, provided that, effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, this section is amended to read as follows:*

#### § 315. Relation to other proceedings or actions

##### (a) Infringer's Civil Action.—

(1) *Inter partes review barred by civil action.—An inter partes review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.*

(2) *Stay of civil action.—If the petitioner or real party in interest files a civil action challenging the validity of a claim of the patent on or after the date on which the petitioner files a petition for inter partes review of the patent, that civil action shall be automatically stayed until either—*

(A) *the patent owner moves the court to lift the stay;*

(B) *the patent owner files a civil action or counterclaim alleging that the petitioner or real party in interest has infringed the patent; or*

(C) *the petitioner or real party in interest moves the court to dismiss the civil action.*

(3) *Treatment of counterclaim.—A counterclaim challenging the validity of a claim of a patent does not constitute a civil action challenging the validity of a claim of a patent for purposes of this subsection.*

(b) *Patent Owner's Action.—An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).*

(c) *Joinder.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants*

*the institution of an inter partes review under section 314.*

(d) *Multiple Proceedings.—Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of an inter partes review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.*

##### (e) Estoppel.—

(1) *Proceedings before the office.—The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.*

(2) *Civil actions and other proceedings.—The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not assert either in a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.*

*See 2011 Amendment note below.*

#### AMENDMENTS

2011—Pub. L. 112-29 amended section generally. Prior to amendment, section related to appeals.

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 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 any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112-29, set out as a note under section 311 of this title.

#### 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 reexam-

ination 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 patentable 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; Pub. L. 112–29, § 6(a), Sept. 16, 2011, 125 Stat. 302.)

**AMENDMENT OF SECTION**

*Pub. L. 112–29, § 6(a), (c)(2), Sept. 16, 2011, 125 Stat. 302, 304, provided that, effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, this section is amended to read as follows:*

**§ 316. Conduct of inter partes review**

(a) **Regulations.**—The Director shall prescribe regulations—

(1) providing that the file of any proceeding under this chapter shall be made available to the public, except that any petition or document filed with the intent that it be sealed shall, if accompanied by a motion to seal, be treated as sealed pending the outcome of the ruling on the motion;

(2) setting forth the standards for the showing of sufficient grounds to institute a review under section 314(a);

(3) establishing procedures for the submission of supplemental information after the petition is filed;

(4) establishing and governing inter partes review under this chapter and the relationship of such review to other proceedings under this title;

(5) setting forth standards and procedures for discovery of relevant evidence, including that such discovery shall be limited to—

(A) the deposition of witnesses submitting affidavits or declarations; and

(B) what is otherwise necessary in the interest of justice;

(6) prescribing sanctions for abuse of discovery, abuse of process, or any other improper use of the proceeding, such as to harass or to cause unnecessary delay or an unnecessary increase in the cost of the proceeding;

(7) providing for protective orders governing the exchange and submission of confidential information;

(8) providing for the filing by the patent owner of a response to the petition under section 313 after an inter partes review has been instituted, and requiring that the patent owner file with such response, through affidavits or declarations, any additional factual evidence and expert opinions on which the patent owner relies in support of the response;

(9) setting forth standards and procedures for allowing the patent owner to move to amend the patent under subsection (d) to cancel a challenged claim or propose a reasonable number of substitute claims, and ensuring that any information submitted by the patent owner in support of any amendment entered under subsection (d) is made available to the public as part of the prosecution history of the patent;

(10) providing either party with the right to an oral hearing as part of the proceeding;

(11) requiring that the final determination in an inter partes review be issued not later than 1 year after the date on which the Director notices the institution of a review under this chapter, except that the Director may, for good cause shown, extend the 1-year period by not more than 6 months, and may adjust the time periods in this paragraph in the case of joinder under section 315(c);

(12) setting a time period for requesting joinder under section 315(c); and

(13) providing the petitioner with at least 1 opportunity to file written comments within a time period established by the Director.

(b) **Considerations.**—In prescribing regulations under this section, the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.

(c) **Patent Trial and Appeal Board.**—The Patent Trial and Appeal Board shall, in accordance with section 6, conduct each inter partes review instituted under this chapter.

(d) **Amendment of the Patent.**—

(1) **In general.**—During an inter partes review instituted under this chapter, the patent owner may file 1 motion to amend the patent in 1 or more of the following ways:

(A) Cancel any challenged patent claim.

(B) For each challenged claim, propose a reasonable number of substitute claims.

(2) **Additional motions.**—Additional motions to amend may be permitted upon the joint request of the petitioner and the patent owner to materially advance the settlement of a proceeding under section 317, or as permitted by regulations prescribed by the Director.

(3) *Scope of claims.*—An amendment under this subsection may not enlarge the scope of the claims of the patent or introduce new matter.

(e) *Evidentiary Standards.*—In an inter partes review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.

See 2011 Amendment note below.

#### AMENDMENTS

2011—Pub. L. 112-29 amended section generally. Prior to amendment, section related to certificate of patentability, unpatentability, and claim cancellation.

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

#### 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 any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112-29, set out as a note under section 311 of this title.

### § 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; Pub. L. 112-29, §6(a), Sept. 16, 2011, 125 Stat. 303.)

#### AMENDMENT OF SECTION

*Pub. L. 112-29, §6(a), (c)(2), Sept. 16, 2011, 125 Stat. 303, 304, provided that, effective upon the*

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

expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, this section is amended to read as follows:

#### § 317. Settlement

(a) **In General.**—An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed. If the inter partes review is terminated with respect to a petitioner under this section, no estoppel under section 315(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner, on the basis of that petitioner's institution of that inter partes review. If no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).

(b) **Agreements in Writing.**—Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the inter partes review as between the parties. At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.

See 2011 Amendment note below.

#### AMENDMENTS

2011—Pub. L. 112-29 amended section generally. Prior to amendment, section related to restriction on subsequent request for inter partes reexamination.

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".

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

#### 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 any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112-29, set out as a note under section 311 of this title.

### § 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; Pub. L. 112–29, §6(a), Sept. 16, 2011, 125 Stat. 303.)

#### AMENDMENT OF SECTION

*Pub. L. 112–29, §6(a), (c)(2), Sept. 16, 2011, 125 Stat. 303, 304, provided that, effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, this section is amended to read as follows:*

#### § 318. Decision of the Board

(a) *Final Written Decision.*—If an inter partes review is instituted and not dismissed under this chapter, the Patent Trial and Appeal Board shall issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 316(d).

(b) *Certificate.*—If the Patent Trial and Appeal Board issues a final written decision under subsection (a) and the time for appeal has expired or any appeal 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 by operation of the certificate any new or amended claim determined to be patentable.

(c) *Intervening Rights.*—Any proposed amended or new claim determined to be patentable and incorporated into a patent following an inter partes review under this chapter shall have the same effect as that specified in section 252 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, before the issuance of a certificate under subsection (b).

(d) *Data on Length of Review.*—The Office shall make available to the public data describing the length of time between the institution of, and the issuance of a final written decision under subsection (a) for, each inter partes review.

See 2011 Amendment note below.

#### AMENDMENTS

2011—Pub. L. 112–29 amended section generally. Prior to amendment, text read as follows: “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.”

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

#### 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 any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112–29, set out as a note under section 311 of this title.

#### § 319. Appeal

A party dissatisfied with the final written decision of the Patent Trial and Appeal Board

under section 318(a) may appeal the decision pursuant to sections 141 through 144. Any party to the inter partes review shall have the right to be a party to the appeal.

(Added Pub. L. 112–29, §6(a), Sept. 16, 2011, 125 Stat. 304.)

#### EFFECTIVE DATE

Section effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment note under section 311 of this title.

### CHAPTER 32—POST-GRANT REVIEW

Sec.	
321.	Post-grant review.
322.	Petitions.
323.	Preliminary response to petition.
324.	Institution of post-grant review.
325.	Relation to other proceedings or actions.
326.	Conduct of post-grant review.
327.	Settlement.
328.	Decision of the Board.
329.	Appeal.

#### § 321. Post-grant review

(a) **IN GENERAL.**—Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute a post-grant review of the patent. The Director shall establish, by regulation, fees to be paid by the person requesting the review, in such amounts as the Director determines to be reasonable, considering the aggregate costs of the post-grant review.

(b) **SCOPE.**—A petitioner in a post-grant review may request to cancel as unpatentable 1 or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of section 282(b) (relating to invalidity of the patent or any claim).

(c) **FILING DEADLINE.**—A petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a re-issue patent (as the case may be).

(Added Pub. L. 112–29, §6(d), Sept. 16, 2011, 125 Stat. 306.)

#### EFFECTIVE DATE

Pub. L. 112–29, §6(f)(2), (3), Sept. 16, 2011, 125 Stat. 311, provided that:

“(2) **APPLICABILITY.**—

“(A) **IN GENERAL.**—The amendments made by subsection (d) [enacting this chapter] shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act [Sept. 16, 2011] and, except as provided in section 18 [set out as a note below] and in paragraph (3), shall apply only to patents described in section 3(n)(1) [set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title].

“(B) **LIMITATION.**—The Director [Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] may impose a limit on the number of post-grant reviews that may be instituted under chapter 32 of title 35, United States Code, during each of the first 4 1-year periods in which the amendments made by subsection (d) are in effect.