

35 U.S.C. 6

- (a) IN GENERAL.—There shall be in the Office a Patent Trial and Appeal Board. The Director, the Deputy Director, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Patent Trial and Appeal Board. The administrative patent judges shall be persons of competent legal knowledge and scientific ability who are appointed by the Secretary, in consultation with the Director. Any reference in any Federal law, Executive order, rule, regulation, or delegation of authority, or any document of or pertaining to the Board of Patent Appeals and Interferences is deemed to refer to the Patent Trial and Appeal Board.
- (b) DUTIES.—The Patent Trial and Appeal Board shall—
- (1) on written appeal of an applicant, review adverse decisions of examiners upon applications for patents pursuant to section 134(a);
 - (2) review appeals of reexaminations pursuant to section 134(b);
 - (3) conduct derivation proceedings pursuant to section 135; and
 - (4) conduct inter partes reviews and post-grant reviews pursuant to chapters 31 and 32.
- (c) 3-MEMBER PANELS.—
- (1) IN GENERAL.—Each appeal, derivation proceeding, post-grant review, and inter partes review shall be heard by at least 3 members of the Patent Trial and Appeal Board, who shall be designated by the Director.
 - (2) INELIGIBILITY TO HEAR REVIEW.—A member of the Patent Trial and Appeal Board who participates in the decision to institute a post-grant review or an inter partes review of a patent shall be ineligible to hear the review.
 - (3) REHEARINGS.—Only the Patent Trial and Appeal Board may grant rehearings.
- (d) TREATMENT OF PRIOR APPOINTMENTS.—The Secretary of Commerce may, in the Secretary's discretion, deem the appointment of an administrative patent judge who, before the date of the enactment of this subsection, held office pursuant to an appointment by the Director to take effect on the date on which the Director initially appointed the administrative patent judge. It shall be a defense to a challenge to the appointment of an administrative patent judge on the basis of the judge's having been originally appointed by the Director that the administrative patent judge so appointed was acting as a de facto officer.

35 U.S.C. 42

- (a) All fees for services performed by or materials furnished by the Patent and Trademark Office will be payable to the Director.
- (b) All fees paid to the Director and all appropriations for defraying the costs of the activities of the Patent and Trademark Office will be credited to the Patent and Trademark Office ~~Appropriation Account~~ Innovation Promotion Fund in the Treasury of the United States.
- (c) (1) ~~To the extent and in the amounts provided in advance in appropriations Acts, fees~~ Fees authorized in this title or any other Act to be charged or established by the Director ~~shall be collected by and shall, subject to paragraph (3), be available to the Director~~ shall be collected by the Director and shall be available to the Director until expended to carry out the activities of the Patent and Trademark Office.

~~(2) There is established in the Treasury a Patent and Trademark Fee Reserve Fund. If fee collections by the Patent and Trademark Office for a fiscal year exceed the amount appropriated to the Office for that fiscal year, fees collected in excess of the appropriated amount shall be deposited in the Patent and Trademark Fee Reserve Fund. To the extent and in the amounts provided in appropriations Acts, amounts in the Fund shall be made available until expended only for obligation and expenditure by the Office in accordance with paragraph (3).~~

- ~~(3)~~(2) (A) Any fees that are collected under this title, and any surcharges on such fees, may only be used for expenses of the Office relating to the processing of patent applications and for other activities, services, and materials relating to patents and to cover a proportionate share of the administrative costs of the Office.
- (B) Any fees that are collected under section 31 of the Trademark Act of 1946, and any surcharges on such fees, may only be used for expenses of the Office relating to the processing of trademark registrations and for other activities, services, and materials relating to trademarks and to cover a proportionate share of the administrative costs of the Office.

(d) REVOLVING FUND.—

(1) DEFINITIONS.—In this subsection—

(A) the term ‘Fund’ means the United States Patent and Trademark Office Innovation Promotion Fund established under paragraph (2); and

(B) the term ‘Trademark Act of 1946’ means the Act entitled ‘An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes’, approved July 5, 1946 (15 U.S.C. 1051 et seq.) (commonly referred to as the ‘Trademark Act of 1946’ or the ‘Lanham Act’).

(2) ESTABLISHMENT.—There is established in the Treasury a revolving fund to be known as the ‘United States Patent and Trademark Office Innovation Promotion Fund’.

(3) DERIVATION OF RESOURCES.—There shall be deposited into the Fund any fees collected under—

(A) this title; or

(B) the Trademark Act of 1946.

(4) EXPENSES.—Amounts deposited into the Fund under paragraph (3) shall be available, without fiscal year limitation, to cover—

(A) all expenses to the extent consistent with the limitation on the use of fees set forth in subsection (c), including all administrative and operating expenses, determined in the discretion of the Director to be ordinary and reasonable, incurred by the Director for the continued operation of all services, programs, activities, and duties of the Office relating to patents and trademarks, as such services, programs, activities, and duties are described under—

(i) this title; and

(ii) the Trademark Act of 1946; and

(B) all expenses incurred pursuant to any obligation, representation, or other commitment of the Office.

~~(d)~~ (e) REFUNDS.—The Director may refund any fee paid by mistake or any amount paid in excess of that required.

~~(e)~~ (f) REPORT.—The Secretary of Commerce shall, on the day each year on which the President submits the annual budget to the Congress, provide to the Committees on the Judiciary of the Senate and the House of Representatives:

- (1) a list of patent and trademark fee collections by the Patent and Trademark Office during the preceding fiscal year;
- (2) a list of activities of the Patent and Trademark Office during the preceding fiscal year which were supported by patent fee expenditures, trademark fee expenditures, and appropriations;
- (3) budget plans for significant programs, projects, and activities of the Office, including out-year funding estimates;
- (4) any proposed disposition of surplus fees by the Office; and
- (5) such other information as the committees consider necessary.

35 U.S.C. 123

(a) **IN GENERAL.**—For purposes of this title, the term "micro entity" means an applicant who makes a certification that the applicant—

- (1) qualifies as a small entity, as defined in regulations issued by the Director;
- (2) has not been named as an inventor on more than 4 previously filed patent applications, other than applications filed in another country, provisional applications under section 111(b), or international applications filed under the treaty defined in section 351(a) for which the basic national fee under section 41(a) was not paid;
- (3) did not, in the calendar year preceding the calendar year in which the applicable fee is being paid, have a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding 3 times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census; and
- (4) has not assigned, granted, or conveyed, and is not under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding 3 times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

(b) **APPLICATIONS RESULTING FROM PRIOR EMPLOYMENT.**—An applicant is not considered to be named on a previously filed application for purposes of subsection (a)(2) if the applicant has assigned, or is under an obligation by contract or law to assign, all ownership rights in the application as the result of the applicant's previous employment.

(c) **FOREIGN CURRENCY EXCHANGE RATE.**—If an applicant's or entity's gross income in the preceding calendar year is not in United States dollars, the average currency exchange rate, as reported by the Internal Revenue Service, during that calendar year shall be used to determine whether the

applicant's or entity's gross income exceeds the threshold specified in paragraphs (3) or (4) of subsection (a).

(d) INSTITUTIONS OF HIGHER EDUCATION.—For purposes of this section, a micro entity shall include an applicant who certifies that—

(1) the applicant's employer, from which the applicant obtains the majority of the applicant's income, is an institution of higher education as defined in section 101(a) of the Higher Education Act of 1965 (20 U.S.C. 1001(a)); ~~or~~

(2) the applicant has assigned, granted, conveyed, or is under an obligation by contract or law, to assign, grant, or convey, a license or other ownership interest in the particular applications to such an institution of higher education[.];

(3) the applicant is an institution of higher education as defined in section 101(a) of the Higher Education Act of 1965 (20 U.S.C. 1001(a)); or

(4) the applicant is an organization described in section 501(c)(3) of the Internal Revenue Code of 1986 and exempt from taxation under section 501(a) of such Code that holds title to patents and patent applications on behalf of such an institution of higher education for the purpose of facilitating commercialization of the technologies of the patents and patent applications.

(e) DIRECTOR'S AUTHORITY.—In addition to the limits imposed by this section, the Director may, in the Director's discretion, impose income limits, annual filing limits, or other limits on who may qualify as a micro entity pursuant to this section if the Director determines that such additional limits are reasonably necessary to avoid an undue impact on other patent applicants or owners or are otherwise reasonably necessary and appropriate. At least 3 months before any limits proposed to be imposed pursuant to this subsection take effect, the Director shall inform the Committee on the Judiciary of the House of Representatives and the Committee on the Judiciary of the Senate of any such proposed limits.

35 U.S.C. 134

(a) PATENT APPLICANT.— An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

(b) PATENT OWNER.— A patent owner in a reexamination may appeal from the final rejection of any claim by the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

(c) PATENT OWNER IN EXPEDITED EXAMINATION.—A patent owner may appeal from the final rejection of any substitute claim by the primary examiner in an expedited IPR examination under section 316A(d) or expedited PGR examination under section 326A(d) to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

35 U.S.C. 141

(a) EXAMINATIONS.—An applicant who is dissatisfied with the final decision in an appeal to the Patent Trial and Appeal Board under section 134(a) may appeal the Board's decision to the United

States Court of Appeals for the Federal Circuit. By filing such an appeal, the applicant waives his or her right to proceed under section 145.

(b) REEXAMINATIONS.—A patent owner who is dissatisfied with the final decision in an appeal of a reexamination to the Patent Trial and Appeal Board under section 134(a) may appeal the Board's decision only to the United States Court of Appeals for the Federal Circuit.

(c) EXPEDITED EXAMINATIONS.—A patent owner who is dissatisfied with the final decision in an appeal to the Patent Trial and Appeal Board under section 134(c) of an expedited IPR examination or expedited PGR examination may appeal the Board's decision to the United States Court of Appeals for the Federal Circuit.

~~(c)~~(d) POST-GRANT AND INTER PARTES REVIEWS.—A party to an inter partes review or a post-grant review who is dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) or 328(a) (as the case may be) may appeal the Board's decision only to the United States Court of Appeals for the Federal Circuit.

~~(d)~~(e) DERIVATION PROCEEDINGS.—A party to a derivation proceeding who is dissatisfied with the final decision 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.

35 U.S.C. 271

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States, or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer upon a showing that the accused infringer intended to cause the acts that constitute infringement, without regard to whether the accused infringer knew of the patent.

(c) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination, or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement; (4) refused to license or use

any rights to the patent; or (5) conditioned the license of any rights to the patent or the sale of the patented product on the acquisition of a license to rights in another patent or purchase of a separate product, unless, in view of the circumstances, the patent owner has market power in the relevant market for the patent or patented product on which the license or sale is conditioned.

- (e)
 - (1) It shall not be an act of infringement to make, use, offer to sell, or sell within the United States or import into the United States a patented invention (other than a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Act of March 4, 1913) which is primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques) solely for uses reasonably related to the development and submission of information under a Federal law which regulates the manufacture, use, or sale of drugs or veterinary biological products.
 - (2) It shall be an act of infringement to submit — (A) an application under section 505(j) of the Federal Food, Drug, and Cosmetic Act or described in section 505(b)(2) of such Act for a drug claimed in a patent or the use of which is claimed in a patent,
(B) an application under section 512 of such Act or under the Act of March 4, 1913 (21 U.S.C. 151 - 158) for a drug or veterinary biological product which is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques and which is claimed in a patent or the use of which is claimed in a patent, or
(C)
 - (i) with respect to a patent that is identified in the list of patents described in section 351(l)(3) of the Public Health Service Act (including as provided under section 351(l)(7) of such Act), an application seeking approval of a biological product, or
 - (ii) if the applicant for the application fails to provide the application and information required under section 351(l)(2)(A) of such Act, an application seeking approval of a biological product for a patent that could be identified pursuant to section 351(l)(3)(A)(i) of such Act,if the purpose of such submission is to obtain approval under such Act to engage in the commercial manufacture, use, or sale of a drug, veterinary biological product, or biological product claimed in a patent or the use of which is claimed in a patent before the expiration of such patent.
 - (3) In any action for patent infringement brought under this section, no injunctive or other relief may be granted which would prohibit the making, using, offering to sell, or selling within the United States or importing into the United States of a patented invention under paragraph (1).
 - (4) For an act of infringement described in paragraph (2)— (A) the court shall order the effective date of any approval of the drug or veterinary biological product involved in the infringement to be a date which is not earlier than the date of the expiration of the patent which has been infringed,
(B) injunctive relief may be granted against an infringer to prevent the commercial manufacture, use, offer to sell, or sale within the United States or importation

into the United States of an approved drug, veterinary biological product, or biological product,

(C) damages or other monetary relief may be awarded against an infringer only if there has been commercial manufacture, use, offer to sell, or sale within the United States or importation into the United States of an approved drug, veterinary biological product, or biological product, and

(D) the court shall order a permanent injunction prohibiting any infringement of the patent by the biological product involved in the infringement until a date which is not earlier than the date of the expiration of the patent that has been infringed under paragraph (2)(C), provided the patent is the subject of a final court decision, as defined in section 351(k)(6) of the Public Health Service Act, in an action for infringement of the patent under section 351(l)(6) of such Act, and the biological product has not yet been approved because of section 351(k)(7) of such Act.

The remedies prescribed by subparagraphs (A), (B), (C), and (D) are the only remedies which may be granted by a court for an act of infringement described in paragraph (2), except that a court may award attorney fees under section 285.

(5) Where a person has filed an application described in paragraph (2) that includes a certification under subsection (b)(2)(A)(iv) or (j) (2)(A)(vii)(IV) of section 505 of the Federal Food, Drug, and Cosmetic Act (21 U.S.C. 355), and neither the owner of the patent that is the subject of the certification nor the holder of the approved application under subsection (b) of such section for the drug that is claimed by the patent or a use of which is claimed by the patent brought an action for infringement of such patent before the expiration of 45 days after the date on which the notice given under subsection (b)(3) or (j) (2)(B) of such section was received, the courts of the United States shall, to the extent consistent with the Constitution, have subject matter jurisdiction in any action brought by such person under section 2201 of title 28 for a declaratory judgment that such patent is invalid or not infringed.

(6) (A) Subparagraph (B) applies, in lieu of paragraph (4), in the case of a patent- (i) that is identified, as applicable, in the list of patents described in section 351(l)(4) of the Public Health Service Act or the lists of patents described in section 351(l)(5)(B) of such Act with respect to a biological product; and (ii) for which an action for infringement of the patent with respect to the biological product— (I) was brought after the expiration of the 30-day period described in subparagraph (A) or (B), as applicable, of section 351(l)(6) of such Act; or (II) was brought before the expiration of the 30-day period described in subclause (I), but which was dismissed without prejudice or was not prosecuted to judgment in good faith.

(B) In an action for infringement of a patent described in subparagraph (A), the sole and exclusive remedy that may be granted by a court, upon a finding that the making, using, offering to sell, selling, or importation into the United States of

the biological product that is the subject of the action infringed the patent, shall be a reasonable royalty.

(C) The owner of a patent that should have been included in the list described in section 351(l)(3)(A) of the Public Health Service Act, including as provided under section 351(l)(7) of such Act for a biological product, but was not timely included in such list, may not bring an action under this section for infringement of the patent with respect to the biological product.

- (f) (1) Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.
- (2) Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.
- (3) (A) Whoever, without authority, supplies or causes to be supplied in or from the United States a design for a product embodying a patented invention in such manner as to actively induce the making of that product outside the United States in a manner that would infringe the patent if made in the United States, shall be liable as an infringer.
- (B) Whoever, without authority, supplies or causes to be supplied in or from the United States a specification for performing a patented process or method in such manner as to actively induce the performance of that process or method outside the United States in a manner that would infringe the patent if performed in the United States, shall be liable as an infringer.
- (g) Whoever without authority imports into the United States or offers to sell, sells, or uses within the United States a product which is made by a process patented in the United States shall be liable as an infringer, if the importation, offer to sell, sale, or use of the product occurs during the term of such process patent. In an action for infringement of a process patent, no remedy may be granted for infringement on account of the noncommercial use or retail sale of a product unless there is no adequate remedy under this title for infringement on account of the importation or other use, offer to sell, or sale of that product. A product which is made by a patented process will, for purposes of this title, not be considered to be so made after —
- (1) it is materially changed by subsequent processes; or
- (2) it becomes a trivial and nonessential component of another product.

- (h) As used in this section, the term "whoever" includes any State, any instrumentality of a State, any officer or employee of a State or instrumentality of a State acting in his official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this title in the same manner and to the same extent as any nongovernmental entity.
- (i) As used in this section, an "offer for sale" or an "offer to sell" by a person other than the patentee or any assignee of the patentee, is that in which the sale will occur before the expiration of the term of the patent.
- (j) For a finding of liability for actively inducing infringement of a process patent under subsection (b), or for contributory infringement of a process patent under subsection (c), it shall not be a requirement that the steps of the patented process be practiced by a single entity.

35 U.S.C. 283

- (a) IN GENERAL.—The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.
- (b) INJUNCTION.—Upon a finding by a court of infringement of a patent not proven invalid or unenforceable, the court shall presume that—
 - (1) further infringement of the patent would cause irreparable injury; and
 - (2) remedies available at law are inadequate to compensate for that injury.

35 U.S.C. 302

Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301. The request must be in writing and must be accompanied by payment of a reexamination fee established by the Director pursuant to the provisions of section 41. The request must identify all real parties in interest and certify that reexamination is not barred under section 303(d). The request must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested. Unless the requesting person is the owner of the patent, the Director promptly will send a copy of the request to the owner of record of the patent.

35 U.S.C. 303

- (a) Within three months following the filing of a request for reexamination under the provisions of section 302, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On his own initiative, and any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 or 302. 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.

- (b) A record of the Director's determination under subsection (a) of this section will be placed in the official file of the patent, and a copy promptly will be given or mailed to the owner of record of the patent and to the person requesting reexamination, if any.
- (c) A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302.
- (d) An ex parte reexamination may not be instituted if the request for reexamination is filed more than 1 year after the date on which the requester or a real party in interest or privy of the requester is served with a complaint alleging infringement of the patent.

35 U.S.C. 311

- (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
 - (2) if a post-grant review is instituted under chapter 32, the date of the termination of such post-grant review.
- (d) PERSONS THAT MAY PETITION.—
 - (1) DEFINITION.—In this subsection, the term 'charged with infringement' means a real and substantial controversy regarding infringement of a patent exists such that the petitioner would have standing to bring a declaratory judgment action in Federal court.
 - (2) NECESSARY CONDITIONS.—A person may not file with the Office a petition to institute an inter partes review of a patent unless the person, or a real party in interest or privy of the person, has been—
 - (A) sued for infringement of the patent; or
 - (B) charged with infringement under the patent.

35 U.S.C. 314

- (a) THRESHOLD.—
 - (1) LIKELIHOOD OF PREVAILING.—Subject to paragraph (2), [T]he Director [may]shall 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 prevail with respect to at least one of the claims challenged in the petition.

- (2) PREVIOUS INSTITUTION.—The Director shall not authorize an inter partes review to be instituted on a claim challenged in a petition if the Director has previously instituted an inter partes review or post-grant review with respect to that claim.
- (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 A~~ determination by the Director not to whether to institute an inter partes review under this section shall be final and nonappealable.
- (e) INTERLOCUTORY APPEAL.—
- (1) RIGHT OF APPEAL.—A determination by the Director to institute an inter partes review under this section may be appealed to the United States Court of Appeals for the Federal Circuit.
 - (2) TIMING.—A party shall file a notice of interlocutory appeal under paragraph (1) not later than 7 days after the date on which the Director enters the institution decision.
 - (3) LIMITATION.—An interlocutory appeal filed under paragraph (1) may challenge the institution decision on any basis except for the determination made under section 314(a)(1).
 - (4) EFFECT ON PROCEEDINGS.—An interlocutory appeal filed under paragraph (1) shall not stay proceedings in the inter partes review unless the Director or the United States Court of Appeals for the Federal Circuit so orders.
 - (5) DECISION.—An interlocutory appeal filed under paragraph (1) may be granted at the discretion of the United States Court of Appeals for the Federal Circuit, which may include consideration of whether—
 - (A) the institution decision appears to be in error and mere institution presents a risk of immediate, irreparable injury to the patent owner;
 - (B) the institution decision presents an unsettled and fundamental issue of law, important both to the specific proceeding and generally, that is likely to evade end-of-the-proceeding review; or
 - (C) the institution decision is manifestly erroneous.

35 U.S.C. 315

- (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)~~ (d).

(c) FEDERAL COURT VALIDITY DETERMINATIONS.—

(1) INSTITUTION BARRED.—An inter partes review of a patent claim may not be instituted if, 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 (19 U.S.C. 1337), a court has entered a final judgment—

(A) that decides the validity of the patent claim with respect to section 102 or 103; and

(B) from which an appeal under section 1295 of title 28 may be taken, or from which an appeal under section 1295 of title 28 was previously available but is no longer available.

(2) STAY OF PROCEEDINGS.—

(A) IN GENERAL.—If, 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 (19 U.S.C. 1337), a court has entered a final judgment that decides the validity of a patent claim with respect to section 102 or 103 and from which an appeal under section 1295 of title 28 may be taken, the Patent Trial and Appeal Board shall stay any ongoing inter partes review of that patent claim pending a final decision of the court or Commission, as applicable.

(B) TERMINATION.—If the validity of a patent claim described in subparagraph (A) is finally upheld by a court or the International Trade Commission, as applicable, the Patent Trial and Appeal Board shall terminate the inter partes review.

~~(c)~~ (d) 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)~~ (e) 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)~~ (f) ESTOPPEL.—

(1) PROCEEDINGS BEFORE THE OFFICE.—

~~The petitioner in—~~ A person petitioning for 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 petition for a subsequent inter partes review before the Office with respect to that claim patent on any ground that the petitioner raised or reasonably could have raised during that inter partes review in the initial petition, unless, after the filing of the initial petition, the petitioner, or the real party in interest or privy of the petitioner, is charged with infringement of additional claims of the patent.

(2) CIVIL ACTIONS AND OTHER PROCEEDINGS.—~~The petitioner in—~~ A person petitioning for an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a) an institution decision under section 314, 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 (19 U.S.C. 1337) that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review based on section 102 or 103 of this title, unless the invalidity argument is based on allegations that the claimed invention was in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.

(g) PETITIONER.—For purposes of this chapter, a person that directly or through an affiliate, subsidiary, or proxy, makes a financial contribution to the preparation for, or conduct during, an inter partes review on behalf of the petitioner shall be considered a real party in interest of the petitioner.

35 U.S.C. § 316

(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) evidence identifying the petitioner's real parties in interest; and
 - ~~(B)-(C)~~ 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)~~ section 316A to cancel a challenged claim or propose a reasonable number of substitute claims including the standard for how substitute claims should be construed, and ensuring that any information submitted by the patent owner in support of any amendment entered under ~~subsection (d)~~ section 316A 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(e)~~ 315(d);
 - (12) setting a time period for requesting joinder under ~~section 315(e)~~ 315(d); ~~and~~
 - (13) providing the petitioner with at least 1 opportunity to file written comments within a time period established by the Director[.]; and
 - (14) providing that for all purposes under this chapter—
 - (A) each challenged claim of a patent shall be construed as the claim would be construed under section 282(b) in an action to in validate a patent, including by construing each challenged claim of the patent in accordance with—
 - (i) the ordinary and customary meaning of the claim as understood by a person having ordinary skill in the art to which the claimed invention pertains;
 - and
 - (ii) the prosecution history pertaining to the patent; and
 - (B) if a court has previously construed a challenged claim of a patent or a challenged claim term in a civil action to which the patent owner was a party, the Office shall consider that claim construction.
- (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)-(d)~~ EVIDENTIARY STANDARDS.—

(1) PRESUMPTION OF VALIDITY.—The presumption of validity under section 282(a) shall apply to a previously issued claim that is challenged during an inter partes review under this chapter.

(2) BURDEN OF PROOF.—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 of a previously issued claim by clear and convincing evidence.

35 U.S.C. § 316A

(a) ACTIONS PERMITTED.—During an inter partes review instituted under this chapter, the patent owner may move to take one or more of the following actions with respect to any challenged patent claim being reviewed:

(1) Cancel the claim.

(2) Propose a reasonable number of substitute claims whose patentability will be adjudicated by the Patent Trial and Appeal Board in accordance with subsection (c).

(3) Propose a reasonable number of substitute claims to be examined in an expedited IPR reexamination in accordance with subsection (d).

(b) SCOPE OF CLAIMS.—An amendment to a patent under this section may not enlarge the scope of the claims of the patent or introduce new matter.

(c) AMENDMENT PRACTICE BEFORE THE PATENT TRIAL AND APPEAL BOARD.—

(1) PATENT OWNER'S INITIAL MOTION.—For each challenged claim for which the patent owner seeks to propose a reasonable number of substitute claims, the patent owner shall be required to make a prima facie showing that each substitute claim—

(A) responds to each ground of unpatentability on which the inter partes review was instituted;

(B) meets the written description requirement under section 112(a); and

(C) meets the requirement under subsection (b) of this section.

(2) NEW EVIDENCE.—

(A) PETITIONER.—The petitioner may respond to the patent owner’s initial motion under paragraph (1) by presenting new evidence.

(B) PATENT OWNER.—The patent owner shall have not less than 1 opportunity to respond to any new evidence presented under subparagraph (A).

(3) EXPEDITED PATENTABILITY REPORT.—

(A) IN GENERAL.—Upon the filing of a motion under paragraph (1), the Patent Trial and Appeal Board, in its discretion, may order an expedited patentability report from a patent examiner on a substitute claim.

(B) CONTENTS OF REPORT.—In ordering an expedited patentability report, the Patent Trial and Appeal Board may—

(i) order examination of any ground of patentability that is assessed by a patent examiner under chapter 12; and

(ii) request a non-binding recommendation as to the patentability of a substitute claim.

(C) RIGHT OF REPLY.—Any party to the inter partes review may file supplemental briefing, including new evidence, addressing the expedited patentability report.

(D) TIMING.—The production of the expedited patentability report shall be expedited.

(E) GOOD CAUSE.—The ordering of a patentability report shall constitute good cause, for purposes of section 316(a)(11), to extend the 1-year period for the inter partes review.

(4) ADJUDICATION OF PATENTABILITY.—

(A) NO REBUTTAL.—A patent owner shall be entitled to a substitute claim if the prima facie showing required under paragraph (1) is not rebutted.

(B) ADDITIONAL EVIDENCE.—If additional evidence of record is presented, the patent owner shall be entitled to a substitute claim unless a preponderance of that evidence proves that the patent owner is not so entitled.

(5) PATENT TRIAL AND APPEAL BOARD’S DISCRETION TO ORDER EXPEDITED IPR

REEXAMINATION.—Upon issuing a final written decision with respect to each challenged claim, the Patent Trial and Appeal Board may order an expedited IPR reexamination to be conducted under section (d)(2) to consider a substitute claim in lieu of issuing a final written decision on that claim.

(6) AMENDMENTS TO ADVANCE SETTLEMENT.—The Patent Trial and Appeal Board may consider additional motions to amend upon the joint request of the petitioner and the patent owner to materially advance the settlement of a proceeding under section 317 if the patent owner makes the prima facie showing required under paragraph (1).

(d) AMENDMENT PRACTICE BEFORE A PATENT EXAMINER.—

(1) MOTION TO CONVERT TO EXPEDITED IPR EXAMINATION.—

(A) IN GENERAL.—If the Director determines to institute an inter partes review on a challenged claim under section 314, a patent owner may, before any further substantive briefing on the patentability of an instituted claim, move to

terminate the inter partes review in favor of an expedited IPR reexamination under paragraph (2) of this subsection.

(B) CONTENTS OF MOTION.—A patent owner shall be required to show good cause for why an expedited IPR reexamination would further the goals of the patent system, including consideration of whether there are substantial—

(i) investments in research directly related to the claimed invention;

(ii) secondary indicia of non-obviousness, such as commercial success, long-felt but unsolved needs, or failures of persons skilled in the art to develop the claimed invention; or

(iii) changes in case law governing relevant substantive patentability requirements since the patent was issued.

(C) NEW EVIDENCE ALLOWED.—The opening motion and opposition briefs under this paragraph may include new evidence, and further rebuttal evidence may be allowed at the discretion of the Patent Trial and Appeal Board.

(2) CONDUCT OF EXPEDITED IPR EXAMINATION.—

(A) IN GENERAL.—If the Patent Trial and Appeal Board grants a motion filed under paragraph (1), the patent owner shall cancel each instituted claim and submit a reasonable number of substitute claims for consideration by the patent examiner in an expedited IPR examination under this paragraph.

(B) TIMING.—A patent examiner shall complete an expedited IPR examination, excluding any time for appeals, within 18 months.

(C) PROCEDURES.—Consideration of the substitute claims in an expedited IPR examination shall follow the procedures established for initial examination under sections 132 and 133, subject to subsection (b) of this section and modified as necessary to ensure that the procedures are expedited.

(D) APPEAL.—

(i) PATENT EXAMINER DECISION.— If the final decision of a patent examiner in an expedited IPR examination is adverse to the patentability of a substitute claim, the patent owner may appeal the decision to the Patent Trial and Appeal Board under section 134(c).

(ii) PATENT TRIAL AND APPEAL BOARD DECISION.—If the final decision in an appeal of an expedited IPR reexamination to the Patent Trial and Appeal Board under section 134(c) is adverse to the patentability of a substitute claim, the patent owner may appeal the decision to the United States Court of Appeals for the Federal Circuit in accordance with sections 141 through 144.

(E) CERTIFICATE.—If the patent examiner determines in an expedited IPR examination that a substitute claim is patentable, and the time for appeal has expired or any appeal proceeding has terminated, the Director shall issue and publish a certificate incorporating in the patent the substitute claim.

(F) INTERVENING RIGHTS.—Any substitute claim determined to be patentable and incorporated into a patent following an expedited IPR examination 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 the substitute claim, or who made substantial preparation therefor, prior to issuance of a certificate under subparagraph (E).

35 U.S.C. 317

- (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)~~ 315(f) 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.

35 U.S.C. 318

- (a) FINAL WRITTEN DECISION.—~~If~~ Except as provided in section 316A(c)(5), 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)~~ section 316A.
- (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.

35 U.S.C. 321

(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 reissue patent (as the case may be).

(d) PERSONS THAT MAY PETITION.—

(1) DEFINITION.—In this subsection, the term ‘charged with infringement’ means a real and substantial controversy regarding infringement of a patent exists such that the petitioner would have standing to bring a declaratory judgment action in Federal court.

(2) NECESSARY CONDITIONS.—A person may not file with the Office a petition to institute a post-grant review of the patent unless the person, or a real party in interest or privy of the person, demonstrates—

(A) a reasonable possibility of being—

(i) sued for infringement of the patent; or

(ii) charged with infringement under the patent; or

(B) a competitive harm related to the validity of the patent.

35 U.S.C. 324

(a) THRESHOLD.—

(1) LIKELIHOOD OF PREVAILING.—Subject to paragraph (2), the ~~The~~ Director may not authorize a post-grant review to be instituted unless the Director determines that the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that it is more likely than not that at least one of the claims challenged in the petition is unpatentable.

(2) PREVIOUS INSTITUTION.—The Director may not authorize a post-grant review to be instituted on a claim challenged in a petition if the Director has previously instituted an inter partes or post-grant review with respect to that claim.

(b) ADDITIONAL GROUNDS.—The determination required under subsection (a) may also be satisfied by a showing that the petition raises a novel or unsettled legal question that is important to other patents or patent applications.

- (c) TIMING.—The Director shall determine whether to institute a post-grant review under this chapter pursuant to a petition filed under section 321 within 3 months after—
- (1) receiving a preliminary response to the petition under section 323; or
 - (2) if no such preliminary response is filed, the last date on which such response may be filed.
- (d) NOTICE.—The Director shall notify the petitioner and patent owner, in writing, of the Director’s determination under subsection (a) or (b), 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.
- ~~(e) NO APPEAL.—The determination by the Director whether to institute a post-grant review under this section shall be final and nonappealable.~~
- (e) NO APPEAL.—A determination by the Director not to institute a post-grant review under this section shall be final and nonappealable.
- (f) INTERLOCUTORY APPEAL.—
- (1) RIGHT OF APPEAL.—A determination by the Director to institute a post-grant review under this section may be appealed to the United States Court of Appeals for the Federal Circuit.
 - (2) TIMING.—A party shall file a notice of interlocutory appeal under paragraph (1) not later than 7 days after the date on which the Director enters the institution decision.
 - (3) LIMITATION.—An interlocutory appeal filed under paragraph (1) may challenge the institution decision on any basis except for the determination made under section 324(a)(1).
 - (4) EFFECT ON PROCEEDINGS.—An interlocutory appeal filed under paragraph (1) shall not stay proceedings in the post-grant review unless the Director or the United States Court of Appeals for the Federal Circuit so orders.
 - (5) DECISION.—An interlocutory appeal filed under paragraph (1) may be granted at the discretion of the United States Court of Appeals for the Federal Circuit, which may include consideration of whether—
 - (A) the institution decision appears to be in error and mere institution presents a risk of immediate, irreparable injury to the patent owner;
 - (B) the institution decision presents an unsettled and fundamental issue of law, important both to the specific proceeding and generally, that is likely to evade end-of-the-proceeding review; or
 - (C) the institution decision is manifestly erroneous.

35 U.S.C. 325

(a) INFRINGER’S CIVIL ACTION.—

- (1) POST-GRANT REVIEW BARRED BY CIVIL ACTION.—A post-grant review may not be instituted under this chapter 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 post-grant 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) PRELIMINARY INJUNCTIONS.—If a civil action alleging infringement of a patent is filed within 3 months after the date on which the patent is granted, the court may not stay its consideration of the patent owner’s motion for a preliminary injunction against infringement of the patent on the basis that a petition for post-grant review has been filed under this chapter or that such a post-grant review has been instituted under this chapter.

(c) FEDERAL COURT VALIDITY DETERMINATIONS.—

(1) INSTITUTION BARRED.—A post-grant review of a patent claim may not be instituted if, 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 (19 U.S.C. 1337), a court has entered a final judgment—

(A) that decides the validity of the patent claim with respect to section 102 or 103; and

(B) from which an appeal under section 1295 of title 28 may be taken, or from which an appeal under section 1295 of title 28 was previously available but is no longer available.

(2) STAY OF PROCEEDINGS.—

(A) IN GENERAL.—If, 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 (19 U.S.C. 1337), a court has entered a final judgment that decides the validity of a patent claim with respect to section 102 or 103 and from which an appeal under section 1295 of title 28 may be taken, the Patent Trial and Appeal Board shall stay any ongoing post-grant review of that patent claim pending a final decision of the court or Commission, as applicable.

(B) TERMINATION.—If the validity of a patent claim described in subparagraph (A) is finally upheld by a court or the International Trade Commission, as applicable, the Patent Trial and Appeal Board shall terminate the post-grant review.

~~(c)-(d)~~ (d) JOINDER.—If more than 1 petition for a post-grant review under this chapter is properly filed against the same patent and the Director determines that more than 1 of these petitions warrants the institution of a post-grant review under section 324, the Director may consolidate such reviews into a single post-grant review.

~~(d)-(e)~~ (e) MULTIPLE PROCEEDINGS.—Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of any post- grant review under this chapter, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in

which the post-grant review or other proceeding or matter may proceed, including providing for the stay, transfer, consolidation, or termination of any such matter or proceeding. In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

~~(e)~~ (f) ESTOPPEL.—

(1) PROCEEDINGS BEFORE THE OFFICE.—~~The petitioner in~~ A person petitioning for a post-grant review of a claim in a patent under this chapter that results in a final written decision under section 328(a), or the real party in interest or privy of the petitioner, may not petition for a subsequent post-grant review before the Office with respect to that patent 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 post-grant review in the initial petition, unless, after the filing of the initial petition, the petitioner, or the real party in interest or privy of the petitioner, is charged with infringement of additional claims of the patent.

(2) CIVIL ACTIONS AND OTHER PROCEEDINGS.—The petitioner in a post-grant review of a claim in a patent under this chapter that results in a final written decision under section 328(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 post-grant review.

~~(f)~~ (g) REISSUE PATENTS.—A post-grant review may not be instituted under this chapter if the petition requests cancellation of a claim in a reissue patent that is identical to or narrower than a claim in the original patent from which the reissue patent was issued, and the time limitations in section 321(c) would bar filing a petition for a post-grant review for such original patent.

(h) REAL PARTY IN INTEREST.—For purposes of this chapter, a person that directly or through an affiliate, subsidiary, or proxy, makes a financial contribution to the preparation for, or conduct during, a post-grant review on behalf of the petitioner shall be considered a real party in interest of the petitioner.

35 U.S.C. 326

(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 subsections (a) and (b) of section 324;
- (3) establishing procedures for the submission of supplemental information after the petition is filed;

- (4) establishing and governing a post-grant 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 ~~— evidence directly related to factual assertions advanced by either party in the proceeding;~~
 - (A) the deposition of witnesses submitting affidavits or declarations;
 - (B) evidence identifying the petitioner's real parties in interest; and
 - (C) 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 323 after a post-grant 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)~~ section 326A to cancel a challenged claim or propose a reasonable number of substitute claims, including the standard for how substitute claims should be construed, and ensuring that any information submitted by the patent owner in support of any amendment entered under ~~subsection (d)~~ section 326A 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 any post-grant review be issued not later than 1 year after the date on which the Director notices the institution of a proceeding 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 325(e)~~ 325(d); ~~and~~
- (12) providing the petitioner with at least 1 opportunity to file written comments within a time period established by the Director[.]; ~~and~~
- (13) providing that for all purposes under this chapter—
 - (A) each challenged claim of a patent shall be construed as the claim would be construed under section 282(b) in an action to invalidate a patent, including by construing each challenged claim of the patent in accordance with—
 - (i) the ordinary and customary meaning of the claim as understood by a person having ordinary skill in the art to which the claimed invention pertains;
 - and
 - (ii) the prosecution history pertaining to the patent; and
 - (B) if a court has previously construed a challenged claim of a patent or a challenged claim term in a civil action to which the patent owner was a party, the Office shall consider that claim construction.

(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 post-grant review instituted under this chapter.

~~(d) AMENDMENT OF THE PATENT.—~~

~~(1) IN GENERAL.—During a post-grant 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 327, or upon the request of the patent owner for good cause shown.~~

~~(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)-(d)~~ EVIDENTIARY STANDARDS.—

(1) PRESUMPTION OF VALIDITY.—The presumption of validity under section 282(a) shall apply to a previously issued claim that is challenged during a proceeding under this chapter.

(2) BURDEN OF PROOF.—In a post-grant review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence of a previously issued claim by clear and convincing evidence.

35 U.S.C. § 326A

(a) ACTIONS PERMITTED.—During a post-grant review instituted under this chapter, the patent owner may move to take one or more of the following actions with respect to any challenged patent claim being reviewed:

(1) Cancel the claim.

(2) Propose a reasonable number of substitute claims whose patentability will be adjudicated by the Patent Trial and Appeal Board in accordance with subsection (c).

(3) Propose a reasonable number of substitute claims to be examined in an expedited PGR reexamination in accordance with subsection (d).

(b) SCOPE OF CLAIMS.—An amendment to a patent under this section may not enlarge the scope of the claims of the patent or introduce new matter.

(c) AMENDMENT PRACTICE BEFORE THE PATENT TRIAL AND APPEAL BOARD.—

(1) PATENT OWNER'S INITIAL MOTION.—For each challenged claim for which the patent owner seeks to propose a reasonable number of substitute claims, the patent owner shall be required to make a prima facie showing that each substitute claim—

(A) responds to each ground of unpatentability on which the post-grant review was instituted;

(B) meets the written description requirement under section 112(a); and

(C) meets the requirement under subsection (b) of this section.

(2) NEW EVIDENCE.—

(A) PETITIONER.—The petitioner may respond to the patent owner’s initial motion under paragraph (1) by presenting new evidence.

(B) PATENT OWNER.—The patent owner shall have not less than 1 opportunity to respond to any new evidence presented under subparagraph (A).

(3) EXPEDITED PATENTABILITY REPORT.—

(A) IN GENERAL.—Upon the filing of a motion under paragraph (1), the Patent Trial and Appeal Board, in its discretion, may order an expedited patentability report from a patent examiner on a substitute claim.

(B) CONTENTS OF REPORT.—In ordering an expedited patentability report, the Patent Trial and Appeal Board may—

(i) order examination of any ground of patentability that is assessed by a patent examiner under chapter 12; and

(ii) request a non-binding recommendation as to the patentability of a substitute claim.

(C) RIGHT OF REPLY.—Any party to the post-grant review may file supplemental briefing, including new evidence, addressing the expedited patentability report.

(D) TIMING.—The production of the expedited patentability report shall be expedited.

(E) GOOD CAUSE.—The ordering of a patentability report shall constitute good cause, for purposes of section 326(a)(11), to extend the 1-year period for the post-grant review.

(4) ADJUDICATION OF PATENTABILITY.—

(A) NO REBUTTAL.—A patent owner shall be entitled to a substitute claim if the prima facie showing required under paragraph (1) is not rebutted.

(B) ADDITIONAL EVIDENCE.—If additional evidence of record is presented, the patent owner shall be entitled to a substitute claim unless a preponderance of that evidence proves that the patent owner is not so entitled.

(5) PATENT TRIAL AND APPEAL BOARD’S DISCRETION TO ORDER EXPEDITED PGR

REEXAMINATION.—Upon issuing a final written decision with respect to each challenged claim, the Patent Trial and Appeal Board may order an expedited PGR reexamination to be conducted under section (d)(2) to consider a substitute claim in lieu of issuing a final written decision on that claim.

(6) AMENDMENTS TO ADVANCE SETTLEMENT.—The Patent Trial and Appeal Board may consider additional motions to amend upon the joint request of the petitioner and the patent owner to materially advance the settlement of a proceeding under section 327 if the patent owner makes the prima facie showing required under paragraph (1).

(d) AMENDMENT PRACTICE BEFORE A PATENT EXAMINER.—

(1) MOTION TO CONVERT TO EXPEDITED PGR EXAMINATION.—

(A) IN GENERAL.—If the Director determines to institute a post-grant review on a challenged claim under section 324, a patent owner may, before any further substantive briefing on the patentability of an instituted claim, move to

terminate the post-grant review in favor of an expedited PGR reexamination under paragraph (2) of this subsection.

- (B) CONTENTS OF MOTION.—A patent owner shall be required to show good cause for why an expedited PGR reexamination would further the goals of the patent system, including consideration of whether there are substantial—
- (i) investments in research directly related to the claimed invention;
 - (ii) secondary indicia of non-obviousness, such as commercial success, long-felt but unsolved needs, or failures of persons skilled in the art to develop the claimed invention; or
 - (iii) changes in case law governing relevant substantive patentability requirements since the patent was issued.

- (C) NEW EVIDENCE ALLOWED.—The opening motion and opposition briefs under this paragraph may include new evidence, and further rebuttal evidence may be allowed at the discretion of the Patent Trial and Appeal Board.

(2) CONDUCT OF EXPEDITED PGR EXAMINATION.—

- (A) IN GENERAL.—If the Patent Trial and Appeal Board grants a motion filed under paragraph (1), the patent owner shall cancel each instituted claim and submit a reasonable number of substitute claims for consideration by the patent examiner in an expedited PGR examination under this paragraph.

- (B) TIMING.—A patent examiner shall complete an expedited PGR examination, excluding any time for appeals, within 18 months.

- (C) PROCEDURES.—Consideration of the substitute claims in an expedited PGR examination shall follow the procedures established for initial examination under sections 132 and 133, subject to subsection (b) of this section and modified as necessary to ensure that the procedures are expedited.

(D) APPEAL.—

- (i) PATENT EXAMINER DECISION.—If the final decision of a patent examiner in an expedited PGR examination is adverse to the patentability of a substitute claim, the patent owner may appeal the decision to the Patent Trial and Appeal Board under section 134(c).

- (ii) PATENT TRIAL AND APPEAL BOARD DECISION.—If the final decision in an appeal of an expedited PGR reexamination to the Patent Trial and Appeal Board under section 134(c) is adverse to the patentability of a substitute claim, the patent owner may appeal the decision to the United States Court of Appeals for the Federal Circuit in accordance with sections 141 through 144.

- (E) CERTIFICATE.—If the patent examiner determines in an expedited PGR examination that a substitute claim is patentable, and the time for appeal has expired or any appeal proceeding has terminated, the Director shall issue and publish a certificate incorporating in the patent the substitute claim.

- (F) INTERVENING RIGHTS.—Any substitute claim determined to be patentable and incorporated into a patent following an expedited PGR examination 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 the substitute claim, or who made substantial preparation therefor, prior to issuance of a certificate under subparagraph (E).

35 U.S.C. 327

- (a) IN GENERAL.—A post-grant 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 post-grant review is terminated with respect to a petitioner under this section, no estoppel under ~~section 325(e)~~ 325(f) 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 post-grant review. If no petitioner remains in the post-grant review, the Office may terminate the post-grant review or proceed to a final written decision under section 328(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 a post-grant 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 post-grant 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.

35 U.S.C. 328

- (a) FINAL WRITTEN DECISION.—~~If Except as provided in section 326A(c)(5), if~~ a post-grant 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 326(d)~~ section 326A.
- (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 a post-grant 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 post-grant review.