

Patent Laws and Regulations

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.

(Amended Nov. 14, 1975, Public Law 94-131, sec. 4, 89 Stat. 690; Dec. 12, 1980, Public Law 96-517, sec. 3, 94 Stat. 3018; Aug. 27, 1982, Public Law 97-247, sec. 3(g), 96 Stat. 319.)

(Subsection (c) amended Dec. 10, 1991, Public Law 102-204, sec. 5, 105 Stat. 1640.)

(Subsection (e) added Dec. 10, 1991, Public Law 102-204, sec. 4, 105 Stat. 1637.)

*Patent Laws and Regulations***PART II—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS****CHAPTER 10—PATENTABILITY OF INVENTIONS**

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35 U.S.C. 100 Definitions.

When used in this title unless the context otherwise indicates ---

- (a) The term “invention” means invention or discovery.
- (b) The term “process” means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.
- (c) The terms “United States” and “this country” mean the United States of America, its territories and possessions.
- (d) The word “patentee” includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

35 U.S.C. 101 Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless —

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
- (c) he has abandoned the invention, or
- (d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by applicant for patent, or
- (f) he did not himself invent the subject matter sought to be patented, or
- (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention,

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but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

(Amended July 28, 1972, Public Law 92-358, sec. 2, 86 Stat. 501; Nov. 14, 1975, Public Law 94-131, sec. 3, 89 Stat. 691.)

35 U.S.C. 103 Conditions for patentability; non-obvious subject matter.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b)(1) Notwithstanding subsection (a), and upon timely election by the applicant for patent to proceed under this subsection, a biotechnological process using or resulting in a composition of matter that is novel under section 102 and nonobvious under subsection (a) of this section shall be considered nonobvious if--

- (A) claims to the process and the composition of matter are contained in either the same application for patent or in separate applications having the same effective filing date; and
 - (B) the composition of matter, and the process at the time it was invented, were owned by the same person or subject to an obligation of assignment to the same person.
- (2) A patent issued on a process under paragraph (1)--
- (A) shall also contain the claims to the composition of matter used in or made by that process, or
 - (B) shall, if such composition of matter is claimed in another patent, be set to expire on the same date as such other patent, notwithstanding section 154.
- (3) For purposes of paragraph (1), the term 'biotechnological process' means--
- (A) a process of genetically altering or otherwise inducing a single- or multi-celled organism to--
 - (i) express an exogenous nucleotide sequence,
 - (ii) inhibit, eliminate, augment, or alter expression of an endogenous nucleotide sequence, or
 - (iii) express a specific physiological characteristic not naturally associated with said organism;
 - (B) cell fusion procedures yielding a cell line that expresses a specific protein, such as a monoclonal antibody; and
 - (C) a method of using a product produced by a process defined by subparagraph (A) or (B), or a combination of subparagraphs (A) and (B).

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(Second paragraph added Nov. 8, 1984, Public Law 98-622, sec. 103, 98 Stat. 3384.)

35 U.S.C. 104 Invention made abroad.

(a) IN GENERAL.—

(1) PROCEEDINGS.—In proceedings in the Patent and Trademark Office, in the

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courts, and before any other competent authority, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country other than a NAFTA country or a WTO member country, except as provided in sections 119 and 365 of this title.

- (2) RIGHTS.—If an invention was made by a person, civil or military—
- (A) while domiciled in the United States, and serving in any other country in connection with operations by or on behalf of the United States,
 - (B) while domiciled in a NAFTA country and serving in another country in connection with operations by or on behalf of that NAFTA country, or
 - (C) while domiciled in a WTO member country and serving in another country in connection with operations by or on behalf of that WTO member country,

that person shall be entitled to the same rights of priority in the United States with respect to such invention as if such invention had been made in the United States, that NAFTA country, or that WTO member country, as the case may be.

- (3) USE OF INFORMATION.—To the extent that any information in a NAFTA country or a WTO member country concerning knowledge, use, or other activity relevant to proving or disproving a date of invention has not been made available for use in a proceeding in the Patent and Trademark Office, a court, or any other competent authority to the same extent as such information could be made available in the United States, the Commissioner, court, or such other authority shall draw appropriate inferences, or take other action permitted by statute, rule, or regulation, in favor of the party that requested the information in the proceeding.

- (b) DEFINITIONS.—As used in this section—

- (1) The term “NAFTA country” has the meaning given that term in section 2(4) of the North American Free Trade Agreement Implementation Act; and
- (2) The term “WTO member country” has the meaning given that term in section 2(10) of the Uruguay Round Agreements Act.

(Amended Jan 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 14, 1975, Public Law 94-131, sec. 6, 89 Stat. 691; Dec. 8, 1993, Public Law 103-182, sec. 331, 107 Stat. 2057 (as to NAFTA country); amended Dec. 8, 1994, Public Law 103-465, sec. 531, 108 Stat. 4809, effective Jan 1, 1996 as to WTO member country.)

35 U.S.C. 105 Inventions in outer space.

(a) Any invention made, used, or sold in outer space on a space object or component thereof under the jurisdiction or control of the United States shall be considered to be made, used or sold within the United States for the purposes of this title, except with respect to any space object or component thereof that is specifically identified and otherwise provided for by an international agreement to which the United States is a party, or with respect to any space object or component thereof that is carried on the registry of a foreign state in accordance with the Convention on Registration of Objects Launched into Outer Space.

(b) Any invention made, used, or sold in outer space on a space object or component thereof that is carried on the registry of a foreign state in accordance with the Convention on Registration of Objects Launched into Outer Space, shall be considered to be made, used, or sold within the United States for the purposes of this title if specifically so agreed in an international agreement between the United States and the state of registry.

(Added November 15, 1990, Public Law 101-580, sec. 1, 104 Stat. 2863; Dec. 8, 1993, Public Law 103-182, Stat 331, 107 Stat. 2057.)

*Patent Laws and Regulations***CHAPTER 11—APPLICATION FOR PATENT**

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35 U.S.C. 111 Application.**(a) IN GENERAL.—**

- (1) **WRITTEN APPLICATION.**—An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Commissioner.
- (2) **CONTENTS.**—Such application shall include—
 - (A) a specification as prescribed by section 112 of this title;
 - (B) a drawing as prescribed by section 113 of this title; and
 - (C) an oath by the applicant as prescribed by section 115 of this title.
- (3) **FEE AND OATH.**—The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Commissioner.
- (4) **FAILURE TO SUBMIT.**—Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Commissioner that the delay in submitting the fee and oath was unavoidable or unintentional. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

(b) PROVISIONAL APPLICATION.—

- (1) **AUTHORIZATION.**—A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include—
 - (A) a specification as prescribed by the first paragraph of section 112 of this title; and
 - (B) a drawing as prescribed by section 113 of this title.
- (2) **CLAIM.**—A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.
- (3) **FEE.**—(A) The application must be accompanied by the fee required by law.
 (B) The fee may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including