

## CHAPTER 30—PRIOR ART CITATIONS TO OFFICE AND REEXAMINATION OF PATENTS

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### 35 U.S.C. 301      Citation of prior art.

Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential.

*(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3015.)*

### 35 U.S.C. 302      Request for reexamination.

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 of this title. The request must be in writing and must be accompanied by payment of a reexamination fee established by the Commissioner of Patents pursuant to the provisions of section 41 of this title. 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 Commissioner promptly will send a copy of the request to the owner of record of the patent.

*(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3015.)*

### 35 U.S.C. 303      Determination of issue by Commissioner.

(a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Commissioner 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 Commissioner 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 of this title.

(b) A record of the Commissioner'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 Commissioner 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 Commissioner may refund a portion of the reexamination fee required under section 302 of this title.

*(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3015.)*

### 35 U.S.C. 304      Reexamination order by Commissioner.

If, in a determination made under the provisions of subsection 303(a) of this title, the Commissioner finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the

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date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed.

*(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3016.)*

**35 U.S.C. 305      Conduct of reexamination proceedings.**

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

*(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3016; amended Nov. 8, 1984, Public Law 98-622, sec. 204(c), 98 Stat. 3388.)*

**35 U.S.C. 306      Appeal.**

The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent.

*(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3016.)*

**35 U.S.C. 307      Certificate of patentability, unpatentability, and claim cancellation.**

(a) In a reexamination proceeding under this chapter, when the time for appeal has expired or any appeal proceeding has terminated, the Commissioner will issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent any proposed amended or new claim determined to be patentable.

(b) Any proposed amended or new claim determined to be patentable and incorporated into a patent following a reexamination proceeding will have the same effect as that specified in section 252 of this title for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation for the same, prior to issuance of a certificate under the provisions of subsection (a) of this section.

*(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3016; amended Dec. 8, 1994, Public Law 103-465, sec. 533, 108 Stat. 4809, effective Jan. 1, 1996.)*

**PART IV—PATENT COOPERATION TREATY****CHAPTER 35—DEFINITIONS**

Sec.

351 Definitions.

**35 U.S.C. 351 Definitions.**

When used in this part unless the context otherwise indicates—

- (a) The term “treaty” means the Patent Cooperation Treaty done at Washington, on June 19, 1970.
- (b) The term “Regulations,” when capitalized, means the Regulations under the treaty, done at Washington on the same date as the treaty. The term “regulations,” when not capitalized, means the regulations established by the Commissioner under this title.
- (c) The term “international application” means an application filed under the treaty.
- (d) The term “international application originating in the United States” means an international application filed in the Patent and Trademark Office when it is acting as a Receiving Office under the treaty, irrespective of whether or not the United States has been designated in that international application.
- (e) The term “international application designating the United States” means an international application specifying the United States as a country in which a patent is sought, regardless where such international application is filed.
- (f) The term “Receiving Office” means a national patent office or intergovernmental organization which receives and processes international applications as prescribed by the treaty and the Regulations.
- (g) The terms “International Searching Authority” and “International Preliminary Examining Authority” mean a national patent office or intergovernmental organization as appointed under the treaty which processes international applications as prescribed by the treaty and the Regulations.
- (h) The term “International Bureau” means the inter- national intergovernmental organization which is recognized as the coordinating body under the treaty and the Regulations.
- (i) Terms and expressions not defined in this part are to be taken in the sense indicated by the treaty and the Regulations.

*(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 685; amended Nov. 6, 1986, Public Law 99-616, sec.2 (a)(b)(c)(1)(2)(3), effective July 1, 1987.)*

*Patent Laws and Regulations***CHAPTER 36—INTERNATIONAL STAGE**

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**35 U.S.C. 361 Receiving Office.**

(a) The Patent and Trademark Office shall act as a Receiving Office for international applications filed by nationals or residents of the United States. In accordance with any agreement made between the United States and another country, the Patent and Trademark Office may also act as a Receiving Office for international applications filed by residents or nationals of such country who are entitled to file international applications.

(b) The Patent and Trademark Office shall perform all acts connected with the discharge of duties required of a Receiving Office, including the collection of international fees and their transmittal to the International Bureau.

(c) International applications filed in the Patent and Trademark Office shall be in the English language.

(d) The international fee, and the transmittal and search fees prescribed under section 376(a) of this part, shall either be paid on filing of an international application or within such later time as may be fixed by the Commissioner.

*(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 686; amended Nov. 8, 1984, Public Law 98-622, sec. 401(a), 98 Stat. 3391; Nov. 6, 1986, Public Law 99-616, sec. 2 (d), effective July 1, 1987.)*

**35 U.S.C. 362 International Searching Authority and International Preliminary Examining Authority.**

(a) The Patent and Trademark Office may act as an International Searching Authority and International Preliminary Examining Authority with respect to international applications in accordance with the terms and conditions of an agreement which may be concluded with the International Bureau, and may discharge all duties required of such Authorities, including the collection of handling fees and their transmittal to the International Bureau.

(b) The handling fee, preliminary examination fee, and any additional fees due for international preliminary examination shall be paid within such time as may be fixed by the Commissioner.

*(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 686; amended Nov. 6, 1986, Public Law 99-616, sec. 4, effective July 1, 1987.)*

**35 U.S.C. 363 International application designating the United States: Effect.**

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title.

*(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 686.)*

*Patent Laws and Regulations***35 U.S.C. 364      International stage: Procedure.**

(a) International applications shall be processed by the Patent and Trademark Office when acting as a Receiving Office, International Searching Authority, or International Preliminary Examining Authority, in accordance with the applicable provisions of the treaty, the Regulations, and this title.

(b) An applicant's failure to act within prescribed time limits in connection with requirements pertaining to a pending international application may be excused upon a showing satisfactory to the Commissioner of unavoidable delay, to the extent not precluded by the treaty and the Regulations, and provided the conditions imposed by the treaty and the Regulations regarding the excuse of such failure to act are complied with.

*(Subsection (a) amended Nov. 6, 1986, Public Law 99-616, sec. 5, effective July 1, 1987.)*

*(Subsection (b) added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 686.)*

**35 U.S.C. 365      Right of priority; benefit of the filing date of a prior application.**

(a) In accordance with the conditions and requirements of subsections (a) through (d) of section 119 of this title, a national application shall be entitled to the right of priority based on a prior filed international application which designated at least one country other than the United States.

(b) In accordance with the conditions and requirements of section 119(a) of this title and the treaty and the Regulations, an international application designating the United States shall be entitled to the right of priority based on a prior foreign application, or a prior international application designating at least one country other than the United States.

(c) In accordance with the conditions and requirements of section 120 of this title, an international application designating the United States shall be entitled to the benefit of the filing date of a prior national application or a prior international application designating the United States, and a national application shall be entitled to the benefit of the filing date of a prior international application designating the United States. If any claim for the benefit of an earlier filing date is based on a prior international application which designated but did not originate in the United States, the Commissioner may require the filing in the Patent and Trademark Office of a certified copy of such application together with a translation thereof into the English language, if it was filed in another language.

*(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 686; amended Dec. 8, 1994, Public Law 103-465, sec. 532, 108 Stat. 4809, effective June 8, 1995.)*

**35 U.S.C. 366      Withdrawn international application.**

Subject to section 367 of this part, if an international application designating the United States is withdrawn or considered withdrawn, either generally or as to the United States, under the conditions of the treaty and the Regulations, before the applicant has complied with the applicable requirements prescribed by section 371(c) of this part, the designation of the United States shall have no effect after the date of withdrawal and shall be considered as not having been made, unless a claim for benefit of a prior filing date under section 365(c) of this section was made in a national application, or an international application designating the United States, filed before the date of such withdrawal. However, such withdrawn international application may serve as the basis for a claim of priority under section 365 (a) and (b) of this part, if it designated a country other than the United States.

*(Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 687; Amended Nov. 8, 1984, Public Law 98-622, sec. 401(b), 98 Stat. 3391.)*

**35 U.S.C. 367      Actions of other authorities: Review.**

(a) Where a Receiving Office other than the Patent and Trademark Office has refused to accord an international filing date to an international application designating the United States or where it has held such application to be withdrawn either generally or as to the United States, the applicant may request review of the matter by the Commissioner, on compliance with the