 KeyCite citing references available

Code of Federal Regulations
Title 37. Patents, Trademarks, and Copyrights
Chapter I. United States Patent and Trademark Office, Department of Commerce (Refs & Annos)
Subchapter A. General
Patents
Part 1. Rules of Practice in Patent Cases (Refs & Annos)
Subpart B. National Processing Provisions
the Application

37 C.F.R. § 1.56

§ 1.56 Duty to disclose information material to patentability.

Effective: September 16, 2012

[Currentness](#)

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)–(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) Prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or

being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
- (2) It refutes, or is inconsistent with, a position the applicant takes in:
 - (i) Opposing an argument of unpatentability relied on by the Office, or
 - (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) Each inventor named in the application;
- (2) Each attorney or agent who prepares or prosecutes the application; and
- (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, the applicant, an assignee, or anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

(e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

Credits

[42 FR 5593, Jan. 28, 1977 as amended at 47 FR 21751, May 19, 1982; 48 FR 2710, Jan. 20, 1983; 49 FR 554, Jan. 4, 1984; 50 FR 5171, Feb. 6, 1985; 53 FR 47808, Nov. 28, 1988; 57 FR 2034, Jan. 17, 1992; 65 FR 54666, Sept. 8, 2000; 77 FR 48818, Aug. 14, 2012]

SOURCE: 24 FR 10332, Dec. 22, 1959; 60 FR 14518, March 17, 1995; 65 FR 14871, March 20, 2000; 65 FR 33455, May 24, 2000; 65 FR 50103, Aug. 16, 2000; 65 FR 56793, Sept. 20, 2000; 65 FR 70490, Nov. 24, 2000; 80 FR 17952, April 2, 2015, unless otherwise noted.


AUTHORITY: 35 U.S.C. 2(b)(2), unless otherwise noted.

Notes of Decisions (1309)

Current through November 12, 2021, 86 FR 62891

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 KeyCite citing references available

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Title 35. Patents ([Refs & Annos](#))

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Chapter 10. Patentability of Inventions ([Refs & Annos](#))

35 U.S.C.A. § 100

§ 100. Definitions

Effective: May 13, 2015

[Currentness](#)

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.

- (e) The term “third-party requester” means a person requesting ex parte reexamination under [section 302](#) who is not the patent owner.

- (f) The term “inventor” means the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.

- (g) The terms “joint inventor” and “coinventor” mean any 1 of the individuals who invented or discovered the subject matter of a joint invention.

(h) The term “joint research agreement” means a written contract, grant, or cooperative agreement entered into by 2 or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

(i)(1) The term “effective filing date” for a claimed invention in a patent or application for patent means--

(A) if subparagraph (B) does not apply, the actual filing date of the patent or the application for the patent containing a claim to the invention; or

(B) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority under [section 119](#), [365\(a\)](#), [365\(b\)](#), [386\(a\)](#), or [386\(b\)](#) or to the benefit of an earlier filing date under [section 120](#), [121](#), [365\(c\)](#), or [386\(c\)](#).

(2) The effective filing date for a claimed invention in an application for reissue or reissued patent shall be determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought.

(j) The term “claimed invention” means the subject matter defined by a claim in a patent or an application for a patent.

CREDIT(S)


(July 19, 1952, c. 950, 66 Stat. 797; [Pub.L. 106-113](#), Div. B, § 1000(a)(9) [Title IV, § 4603], Nov. 29, 1999, 113 Stat. 1536, 1501A-567; [Pub.L. 112-29](#), § 3(a), Sept. 16, 2011, 125 Stat. 285; [Pub.L. 112-211](#), Title I, § 102(1), Dec. 18, 2012, 126 Stat. 1531.)

[Notes of Decisions \(41\)](#)

35 U.S.C.A. § 100, 35 USCA § 100
Current through PL 117-55.

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Chapter 10. Patentability of Inventions ([Refs & Annos](#))

35 U.S.C.A. § 101

§ 101. Inventions patentable

[Currentness](#)

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.

CREDIT(S)


(July 19, 1952, c. 950, 66 Stat. 797.)

[Notes of Decisions \(2227\)](#)

35 U.S.C.A. § 101, 35 USCA § 101
Current through PL 117-55.

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Chapter 10. Patentability of Inventions ([Refs & Annos](#))

35 U.S.C.A. § 102

§ 102. Conditions for patentability; novelty

Effective: May 13, 2015

[Currentness](#)

(a) Novelty; Prior Art.--A person shall be entitled to a patent unless--

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under [section 151](#), or in an application for patent published or deemed published under [section 122\(b\)](#), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) Exceptions.--

(1) Disclosures made 1 year or less before the effective filing date of the claimed invention.--A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if--

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(2) Disclosures appearing in applications and patents.--A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if--

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

(c) Common Ownership Under Joint Research Agreements.--Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if--

(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;

(2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(d) Patents and Published Applications Effective as Prior Art.--For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application--

(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or

(2) if the patent or application for patent is entitled to claim a right of priority under [section 119](#), [365\(a\)](#), [365\(b\)](#), [386\(a\)](#), or [386\(b\)](#), or to claim the benefit of an earlier filing date under [section 120](#), [121](#), [365\(c\)](#), or [386\(c\)](#), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

CREDIT(S)


(July 19, 1952, c. 950, 66 Stat. 797; [Pub.L. 92-358](#), § 2, July 28, 1972, 86 Stat. 502; [Pub.L. 94-131](#), § 5, Nov. 14, 1975, 89 Stat. 691; [Pub.L. 106-113](#), Div. B, § 1000(a)(9) [Title IV, §§ 4505, 4806], Nov. 29, 1999, 113 Stat. 1536, 1501A-565, 1501A-590; [Pub.L. 107-273](#), Div. C, Title III, § 13205(1), Nov. 2, 2002, 116 Stat. 1902; [Pub.L. 112-29](#), § 3(b)(1), Sept. 16, 2011, 125 Stat. 285; [Pub.L. 112-211](#), Title I, § 102(2), Dec. 18, 2012, 126 Stat. 1531.)

[Notes of Decisions \(2750\)](#)

35 U.S.C.A. § 102, 35 USCA § 102
Current through PL 117-55.

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Chapter 10. Patentability of Inventions ([Refs & Annos](#))

35 U.S.C.A. § 103

§ 103. Conditions for patentability; non-obvious subject matter

[Currentness](#)

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in [section 102](#), if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

CREDIT(S)


(July 19, 1952, c. 950, 66 Stat. 798; [Pub.L. 98-622, Title I, § 103](#), Nov. 8, 1984, 98 Stat. 3384; [Pub.L. 104-41, § 1](#), Nov. 1, 1995, 109 Stat. 351; [Pub.L. 106-113, Div. B, § 1000\(a\)\(9\)](#) [Title IV, § 4807(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-591; [Pub.L. 108-453, § 2](#), Dec. 10, 2004, 118 Stat. 3596; [Pub.L. 112-29, §§ 3\(c\), 20\(j\)\(1\)](#), Sept. 16, 2011, 125 Stat. 287, 335.)

[Notes of Decisions \(3060\)](#)

35 U.S.C.A. § 103, 35 USCA § 103
Current through PL 117-55.

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Part II. Patentability of Inventions and Grant of Patents ([Refs & Annos](#))

Chapter 11. Application for Patent ([Refs & Annos](#))

35 U.S.C.A. § 112

§ 112. Specification

Effective: September 16, 2012

[Currentness](#)

(a) In General.--The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

(b) Conclusion.--The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

(c) Form.--A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

(d) Reference in Dependent Forms.--Subject to subsection (e), a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

(e) Reference in Multiple Dependent Form.--A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

(f) Element in Claim for a Combination.--An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

CREDIT(S)

§ 112. Specification, 35 USCA § 112


(July 19, 1952, c. 950, 66 Stat. 798; [Pub.L. 89-83](#), § 9, July 24, 1965, 79 Stat. 261; [Pub.L. 94-131](#), § 7, Nov. 14, 1975, 89 Stat. 691; [Pub.L. 112-29](#), § 4(c), Sept. 16, 2011, 125 Stat. 296.)

[Notes of Decisions \(3808\)](#)


35 U.S.C.A. § 112, 35 USCA § 112
Current through PL 117-55.

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 KeyCite cautionary citing references available

Unconstitutional or Preempted Prior Version Held Unconstitutional by *Florida Prepaid Postsecondary Educ. Expense Bd. v. College Sav. Bank*, U.S.N.J., June 23, 1999

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United States Code Annotated

Title 35. Patents ([Refs & Annos](#))

Part III. Patents and Protection of Patent Rights

Chapter 28. Infringement of Patents ([Refs & Annos](#))

35 U.S.C.A. § 271

§ 271. Infringement of patent

Effective: March 23, 2010

[Currentness](#)

(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.

(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.

(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, and 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 designee of the

patentee, is that in which the sale will occur before the expiration of the term of the patent.

CREDIT(S)

(July 19, 1952, c. 950, 66 Stat. 811; Pub.L. 98-417, Title II, § 202, Sept. 24, 1984, 98 Stat. 1603; Pub.L. 98-622, Title I, § 101(a), Nov. 8, 1984, 98 Stat. 3383; Pub.L. 100-418, Title IX, § 9003, Aug. 23, 1988, 102 Stat. 1563; Pub.L. 100-670, Title II, § 201(i), Nov. 16, 1988, 102 Stat. 3988; Pub.L. 100-703, Title II, § 201, Nov. 19, 1988, 102 Stat. 4676; Pub.L. 102-560, § 2(a)(1), Oct. 28, 1992, 106 Stat. 4230; Pub.L. 103-465, Title V, § 533(a), Dec. 8, 1994, 108 Stat. 4988; Pub.L. 108-173, Title XI, § 1101(d), Dec. 8, 2003, 117 Stat. 2457; Pub.L. 111-148, Title VII, § 7002(c)(1), Mar. 23, 2010, 124 Stat. 815.)

VALIDITY


<For validity of the Patent and Plant Variety Protection Remedy Clarification Act, Pub.L. 102-560, which added subsec. (h) to this section, see [Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank](#), U.S.N.J.1999, 527 U.S. 627, 119 S.Ct. 2199, 144 L.Ed. 2d 575.>

Notes of Decisions (3308)

35 U.S.C.A. § 271, 35 USCA § 271
Current through PL 117-55.

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United States Code Annotated

Title 35. Patents ([Refs & Annos](#))

Part III. Patents and Protection of Patent Rights

Chapter 29. Remedies for Infringement of Patent, and Other Actions ([Refs & Annos](#))

35 U.S.C.A. § 282

§ 282. Presumption of validity; defenses

Effective: September 16, 2012

[Currentness](#)

(a) In General.--A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.

(b) Defenses.--The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement or unenforceability.

(2) Invalidity of the patent or any claim in suit on any ground specified in part II as a condition for patentability.

(3) Invalidity of the patent or any claim in suit for failure to comply with--

(A) any requirement of [section 112](#), except that the failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable; or

(B) any requirement of [section 251](#).

(4) Any other fact or act made a defense by this title.

(c) Notice of Actions; Actions During Extension of Patent Term.--In an action involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Federal Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires. Invalidity of the extension of a patent term or any portion thereof under [section 154\(b\)](#) or [156](#) because of the material failure--

(1) by the applicant for the extension, or

(2) by the Director,

to comply with the requirements of such section shall be a defense in any action involving the infringement of a patent during the period of the extension of its term and shall be pleaded. A due diligence determination under [section 156\(d\)\(2\)](#) is not subject to review in such an action.

CREDIT(S)


(July 19, 1952, c. 950, 66 Stat. 812; [Pub.L. 89-83](#), § 10, July 24, 1965, 79 Stat. 261; [Pub.L. 94-131](#), § 10, Nov. 14, 1975, 89 Stat. 692; [Pub.L. 97-164, Title I, § 161\(7\)](#), Apr. 2, 1982, 96 Stat. 49; [Pub.L. 98-417, Title II, § 203](#), Sept. 24, 1984, 98 Stat. 1603; [Pub.L. 104-41](#), § 2, Nov. 1, 1995, 109 Stat. 352; [Pub.L. 106-113](#), Div. B, § 1000(a)(9) [Title IV, §§ 4402(b)(1), 4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-560, 1501A-582; [Pub.L. 107-273](#), Div. C, Title III, § 13206(b)(1)(B), (4), Nov. 2, 2002, 116 Stat. 1906; [Pub.L. 112-29](#), §§ 15(a), 20(g), (j)(1), Sept. 16, 2011, 125 Stat. 328, 334, 335.)

[Notes of Decisions \(2463\)](#)

35 U.S.C.A. § 282, 35 USCA § 282
Current through PL 117-55.

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United States Code Annotated

Title 35. Patents ([Refs & Annos](#))

Part III. Patents and Protection of Patent Rights

Chapter 29. Remedies for Infringement of Patent, and Other Actions ([Refs & Annos](#))

35 U.S.C.A. § 283

§ 283. Injunction

[Currentness](#)

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.

CREDIT(S)


(July 19, 1952, c. 950, 66 Stat. 812.)

[Notes of Decisions \(1610\)](#)

35 U.S.C.A. § 283, 35 USCA § 283
Current through PL 117-55.

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35 U.S.C.A. § 284

§ 284. Damages

Effective: September 16, 2012

[Currentness](#)

Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed. Increased damages under this paragraph shall not apply to provisional rights under [section 154\(d\)](#).

The court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances.

CREDIT(S)


(July 19, 1952, c. 950, 66 Stat. 813; [Pub.L. 106-113](#), Div. B, § 1000(a)(9) [Title IV, § 4507(9)], Nov. 29, 1999, 113 Stat. 1536, 1501A-566; [Pub.L. 112-29](#), § 20(j)(1), Sept. 16, 2011, 125 Stat. 335.)

[Notes of Decisions \(1879\)](#)

35 U.S.C.A. § 284, 35 USCA § 284
Current through PL 117-55.

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Chapter 29. Remedies for Infringement of Patent, and Other Actions ([Refs & Annos](#))

35 U.S.C.A. § 285

§ 285. Attorney fees

[Currentness](#)

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

CREDIT(S)


(July 19, 1952, c. 950, 66 Stat. 813.)

[Notes of Decisions \(794\)](#)

35 U.S.C.A. § 285, 35 USCA § 285
Current through PL 117-55.

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35 U.S.C.A. § 286

§ 286. Time limitation on damages

[Currentness](#)

Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.

In the case of claims against the United States Government for use of a patented invention, the period before bringing suit, up to six years, between the date of receipt of a written claim for compensation by the department or agency of the Government having authority to settle such claim, and the date of mailing by the Government of a notice to the claimant that his claim has been denied shall not be counted as part of the period referred to in the preceding paragraph.

CREDIT(S)

(July 19, 1952, c. 950, 66 Stat. 813.)


[Notes of Decisions \(363\)](#)

35 U.S.C.A. § 286, 35 USCA § 286

Current through PL 117-55.

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Part III. Patents and Protection of Patent Rights

Chapter 29. Remedies for Infringement of Patent, and Other Actions ([Refs & Annos](#))

35 U.S.C.A. § 287

§ 287. Limitation on damages and other remedies; marking and notice

Effective: March 16, 2013

[Currentness](#)

(a) Patentees, and persons making, offering for sale, or selling within the United States any patented article for or under them, or importing any patented article into the United States, may give notice to the public that the same is patented, either by fixing thereon the word “patent” or the abbreviation “pat.,” together with the number of the patent, or by fixing thereon the word “patent” or the abbreviation “pat.” together with an address of a posting on the Internet, accessible to the public without charge for accessing the address, that associates the patented article with the number of the patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.

(b)(1) An infringer under [section 271\(g\)](#) shall be subject to all the provisions of this title relating to damages and injunctions except to the extent those remedies are modified by this subsection or section 9006 of the Process Patent Amendments Act of 1988. The modifications of remedies provided in this subsection shall not be available to any person who--

(A) practiced the patented process;

(B) owns or controls, or is owned or controlled by, the person who practiced the patented process; or

(C) had knowledge before the infringement that a patented process was used to make the product the importation, use, offer for sale, or sale of which constitutes the infringement.

(2) No remedies for infringement under [section 271\(g\)](#) shall be available with respect to any product in the possession of, or

in transit to, the person subject to liability under such section before that person had notice of infringement with respect to that product. The person subject to liability shall bear the burden of proving any such possession or transit.

(3)(A) In making a determination with respect to the remedy in an action brought for infringement under [section 271\(g\)](#), the court shall consider--

- (i)** the good faith demonstrated by the defendant with respect to a request for disclosure,
- (ii)** the good faith demonstrated by the plaintiff with respect to a request for disclosure, and
- (iii)** the need to restore the exclusive rights secured by the patent.

(B) For purposes of subparagraph (A), the following are evidence of good faith:

- (i)** a request for disclosure made by the defendant;
- (ii)** a response within a reasonable time by the person receiving the request for disclosure; and
- (iii)** the submission of the response by the defendant to the manufacturer, or if the manufacturer is not known, to the supplier, of the product to be purchased by the defendant, together with a request for a written statement that the process claimed in any patent disclosed in the response is not used to produce such product.

The failure to perform any acts described in the preceding sentence is evidence of absence of good faith unless there are mitigating circumstances. Mitigating circumstances include the case in which, due to the nature of the product, the number of sources for the product, or like commercial circumstances, a request for disclosure is not necessary or practicable to avoid infringement.

(4)(A) For purposes of this subsection, a “request for disclosure” means a written request made to a person then engaged in the manufacture of a product to identify all process patents owned by or licensed to that person, as of the time of the request, that the person then reasonably believes could be asserted to be infringed under [section 271\(g\)](#) if that product were imported into, or sold, offered for sale, or used in, the United States by an unauthorized person. A request for disclosure is further limited to a request--

(i) which is made by a person regularly engaged in the United States in the sale of the same type of products as those manufactured by the person to whom the request is directed, or which includes facts showing that the person making the request plans to engage in the sale of such products in the United States;

(ii) which is made by such person before the person's first importation, use, offer for sale, or sale of units of the product produced by an infringing process and before the person had notice of infringement with respect to the product; and

(iii) which includes a representation by the person making the request that such person will promptly submit the patents identified pursuant to the request to the manufacturer, or if the manufacturer is not known, to the supplier, of the product to be purchased by the person making the request, and will request from that manufacturer or supplier a written statement that none of the processes claimed in those patents is used in the manufacture of the product.

(B) In the case of a request for disclosure received by a person to whom a patent is licensed, that person shall either identify the patent or promptly notify the licensor of the request for disclosure.

(C) A person who has marked, in the manner prescribed by subsection (a), the number of the process patent on all products made by the patented process which have been offered for sale or sold by that person in the United States, or imported by the person into the United States, before a request for disclosure is received is not required to respond to the request for disclosure. For purposes of the preceding sentence, the term "all products" does not include products made before the effective date of the Process Patent Amendments Act of 1988.

(5)(A) For purposes of this subsection, notice of infringement means actual knowledge, or receipt by a person of a written notification, or a combination thereof, of information sufficient to persuade a reasonable person that it is likely that a product was made by a process patented in the United States.

(B) A written notification from the patent holder charging a person with infringement shall specify the patented process alleged to have been used and the reasons for a good faith belief that such process was used. The patent holder shall include in the notification such information as is reasonably necessary to explain fairly the patent holder's belief, except that the patent holder is not required to disclose any trade secret information.

(C) A person who receives a written notification described in subparagraph (B) or a written response to a request for disclosure described in paragraph (4) shall be deemed to have notice of infringement with respect to any patent referred to in such written notification or response unless that person, absent mitigating circumstances--

(i) promptly transmits the written notification or response to the manufacturer or, if the manufacturer is not known, to the supplier, of the product purchased or to be purchased by that person; and

(ii) receives a written statement from the manufacturer or supplier which on its face sets forth a well grounded factual basis for a belief that the identified patents are not infringed.

(D) For purposes of this subsection, a person who obtains a product made by a process patented in the United States in a quantity which is abnormally large in relation to the volume of business of such person or an efficient inventory level shall be rebuttably presumed to have actual knowledge that the product was made by such patented process.

(6) A person who receives a response to a request for disclosure under this subsection shall pay to the person to whom the request was made a reasonable fee to cover actual costs incurred in complying with the request, which may not exceed the cost of a commercially available automated patent search of the matter involved, but in no case more than \$500.

(c)(1) With respect to a medical practitioner's performance of a medical activity that constitutes an infringement under section 271(a) or (b), the provisions of sections 281, 283, 284, and 285 shall not apply against the medical practitioner or against a related health care entity with respect to such medical activity.

(2) For the purposes of this subsection:

(A) the term "medical activity" means the performance of a medical or surgical procedure on a body, but shall not include (i) the use of a patented machine, manufacture, or composition of matter in violation of such patent, (ii) the practice of a patented use of a composition of matter in violation of such patent, or (iii) the practice of a process in violation of a biotechnology patent.

(B) the term "medical practitioner" means any natural person who is licensed by a State to provide the medical activity described in subsection (c)(1) or who is acting under the direction of such person in the performance of the medical activity.

(C) the term "related health care entity" shall mean an entity with which a medical practitioner has a professional affiliation under which the medical practitioner performs the medical activity, including but not limited to a nursing home, hospital, university, medical school, health maintenance organization, group medical practice, or a medical clinic.

(D) the term "professional affiliation" shall mean staff privileges, medical staff membership, employment or contractual relationship, partnership or ownership interest, academic appointment, or other affiliation under which a medical practitioner provides the medical activity on behalf of, or in association with, the health care entity.

(E) the term "body" shall mean a human body, organ or cadaver, or a nonhuman animal used in medical research or instruction directly relating to the treatment of humans.

(F) the term “patented use of a composition of matter” does not include a claim for a method of performing a medical or surgical procedure on a body that recites the use of a composition of matter where the use of that composition of matter does not directly contribute to achievement of the objective of the claimed method.

(G) the term “State” shall mean any State or territory of the United States, the District of Columbia, and the Commonwealth of Puerto Rico.

(3) This subsection does not apply to the activities of any person, or employee or agent of such person (regardless of whether such person is a tax exempt organization under [section 501\(c\) of the Internal Revenue Code](#)), who is engaged in the commercial development, manufacture, sale, importation, or distribution of a machine, manufacture, or composition of matter or the provision of pharmacy or clinical laboratory services (other than clinical laboratory services provided in a physician’s office), where such activities are:

(A) directly related to the commercial development, manufacture, sale, importation, or distribution of a machine, manufacture, or composition of matter or the provision of pharmacy or clinical laboratory services (other than clinical laboratory services provided in a physician’s office), and

(B) regulated under the Federal Food, Drug, and Cosmetic Act, the Public Health Service Act, or the Clinical Laboratories Improvement Act.


(4) This subsection shall not apply to any patent issued based on an application which has an effective filing date before September 30, 1996.

CREDIT(S)

(July 19, 1952, c. 950, 66 Stat. 813; [Pub.L. 100-418, Title IX, § 9004\(a\)](#), Aug. 23, 1988, 102 Stat. 1564; [Pub.L. 103-465, Title V, § 533\(b\)\(5\)](#), Dec. 8, 1994, 108 Stat. 4989; [Pub.L. 104-208, Div. A, Title I, § 101\(a\)](#) [Title VI, § 616], Sept. 30, 1996, 110 Stat. 3009-67; [Pub.L. 106-113, Div. B, § 1000\(a\)\(9\)](#) [Title IV, § 4803], Nov. 29, 1999, 113 Stat. 1536, 1501A-589; [Pub.L. 112-29, §§ 3\(g\)\(2\), 16\(a\)\(1\), 20\(i\)\(4\), \(j\)\(1\), \(2\)\(K\)](#), Sept. 16, 2011, 125 Stat. 288, 328, 335.)

[Notes of Decisions \(322\)](#)

35 U.S.C.A. § 287, 35 USCA § 287
Current through PL 117-55.

 KeyCite citing references available

United States Code Annotated

Title 28. Judiciary and Judicial Procedure ([Refs & Annos](#))

Part IV. Jurisdiction and Venue ([Refs & Annos](#))

Chapter 87. District Courts; Venue ([Refs & Annos](#))

28 U.S.C.A. § 1400

§ 1400. Patents and copyrights, mask works, and designs

Effective: August 5, 1999

[Currentness](#)

(a) Civil actions, suits, or proceedings arising under any Act of Congress relating to copyrights or exclusive rights in mask works or designs may be instituted in the district in which the defendant or his agent resides or may be found.

(b) Any civil action for patent infringement may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.

CREDIT(S)

(June 25, 1948, c. 646, 62 Stat. 936; [Pub.L. 100-702, Title X, § 1020\(a\)\(5\)](#), Nov. 19, 1988, 102 Stat. 4671; [Pub.L. 105-304, Title V, § 503\(c\)\(1\), \(2\)](#), Oct. 28, 1998, 112 Stat. 2917; [Pub.L. 106-44, § 2\(a\)](#), Aug. 5, 1999, 113 Stat. 223.)

[Notes of Decisions \(618\)](#)

28 U.S.C.A. § 1400, 28 USCA § 1400
Current through PL 117-55.

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