



(f) UNREASONABLE ASSERTION OF DEFENSE.—If the defense under this section is pleaded by a person who is found to infringe the patent and who subsequently fails to demonstrate a reasonable basis for asserting the defense, the court shall find the case exceptional for the purpose of awarding attorney fees under section 285.

(g) INVALIDITY.—A patent shall not be deemed to be invalid under section 102 or 103 solely because a defense is raised or established under this section.

(Added Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4302(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A–555; amended Pub. L. 112–29, §5(a), Sept. 16, 2011, 125 Stat. 297.)

AMENDMENTS

2011—Pub. L. 112–29 amended section generally. Prior to amendment, section related to defense to infringement based on earlier inventor.

EFFECTIVE DATE OF 2011 AMENDMENT

Pub. L. 112–29, §5(c), Sept. 16, 2011, 125 Stat. 299, provided that: “The amendments made by this section [amending this section] shall apply to any patent issued on or after the date of the enactment of this Act [Sept. 16, 2011].”

EFFECTIVE DATE

Pub. L. 106–113, div. B, §1000(a)(9) [title IV, subtitle C, §4303], Nov. 29, 1999, 113 Stat. 1536, 1501A–557, provided that: “This subtitle [enacting this section and provisions set out as a note under section 1 of this title] and the amendments made by this subtitle shall take effect on the date of the enactment of this Act [Nov. 29, 1999], but shall not apply to any action for infringement that is pending on such date of enactment or with respect to any subject matter for which an adjudication of infringement, including a consent judgment, has been made before such date of enactment.”

CHAPTER 29—REMEDIES FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

281.	Remedy for infringement of patent.
282.	Presumption of validity; defenses.
283.	Injunction.
284.	Damages.
285.	Attorney fees.
286.	Time limitation on damages.
287.	Limitation on damages and other remedies; marking and notice.
288.	Action for infringement of a patent containing an invalid claim.
289.	Additional remedy for infringement of design patent.
290.	Notice of patent suits.
291.	Interfering patents.
292.	False marking.
293.	Nonresident patentee, service and notice. ¹
294.	Voluntary arbitration.
295.	Presumption: Product made by patented process.
296.	Liability of States, instrumentalities of States, and State officials for infringement of patents.
297.	Improper and deceptive invention promotion.
298.	Advice of counsel.
299.	Joinder of parties.

AMENDMENT OF ANALYSIS

Pub. L. 112–29, §3(h)(2), (n), Sept. 16, 2011, 125 Stat. 289, 293, provided that, effective upon

the expiration of the 18-month period beginning on Sept. 16, 2011, and applicable to certain applications for patent and any patents issuing thereon, item 291 of this analysis is amended to read “Derived patents.”. See 2011 Amendment notes below.

AMENDMENTS

2011—Pub. L. 112–29, §19(d)(2), Sept. 16, 2011, 125 Stat. 333, added item 299.

Pub. L. 112–29, §17(b), Sept. 16, 2011, 125 Stat. 329, added item 298.

Pub. L. 112–29, §3(h)(2), Sept. 16, 2011, 125 Stat. 289, amended item 291 generally, substituting “Derived patents” for “Interfering patents”.

1999—Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4102(b)], Nov. 29, 1999, 113 Stat. 1536, 1501A–554, added item 297.

1992—Pub. L. 102–560, §2(b), Oct. 28, 1992, 106 Stat. 4230, added item 296.

1988—Pub. L. 100–418, title IX, §§9004(b), 9005(b), Aug. 23, 1988, 102 Stat. 1566, inserted “and other remedies” in item 287 and added item 295.

1982—Pub. L. 97–247, §17(b)(2), Aug. 27, 1982, 96 Stat. 323, added item 294.

§ 281. Remedy for infringement of patent

A patentee shall have remedy by civil action for infringement of his patent.

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

HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §§67 and 70, part (R.S. 4919; R.S. 4921, amended (1) Mar. 3, 1897, ch. 391, §6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, §8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, §1, 60 Stat. 778).

The corresponding two sections of existing law are divided among sections 281, 283, 284, 285, 286 and 289 with some changes in language. Section 281 serves as an introduction or preamble to the following sections, the modern term civil action is used, there would be, of course, a right to a jury trial when no injunction is sought.

§ 282. Presumption of validity; defenses

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. Notwithstanding the preceding sentence, if a claim to a composition of matter is held invalid and that claim was the basis of a determination of nonobviousness under section 103(b)(1), the process shall no longer be considered nonobvious solely on the basis of section 103(b)(1). The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.

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 of this title 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

¹ So in original. Does not conform to section catchline.

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.

In actions 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 of this title 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.

(July 19, 1952, ch. 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. 102–572, title IX, §902(b)(1), Oct. 29, 1992, 106 Stat. 4516; 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), Sept. 16, 2011, 125 Stat. 328, 334, 335.)

AMENDMENT OF SECTION

Pub. L. 112–29, §20(g), (j), (l), Sept. 16, 2011, 125 Stat. 334, 335, provided that, effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, this section is amended:

- (1) in the first undesignated paragraph—
 - (A) by striking “A patent” and inserting “(a) IN GENERAL.—A patent”; and
 - (B) by striking the third sentence;
- (2) in the second undesignated paragraph—
 - (A) by striking “The following” and inserting “(b) DEFENSES.—The following”;
 - (B) in paragraph (1), by striking “unenforceability,” and inserting “unenforceability.”; and
 - (C) in paragraph (2), by striking “patentability,” and inserting “patentability.”;
- (3) in the third undesignated paragraph—

(A) by striking “In actions involving the validity or infringement of a patent” and inserting “(c) NOTICE OF ACTIONS; ACTIONS DURING EXTENSION OF PATENT TERM.—In an action involving the validity or infringement of a patent”; and

(B) by striking “Claims Court” and inserting “Court of Federal Claims”; and

(4) by striking “of this title” each place that term appears.

See 2011 Amendment notes below.

HISTORICAL AND REVISION NOTES

Derived from Title 35, U.S.C., 1946 ed., §69 (R.S. 4920, amended (1) Mar. 3, 1897, ch. 391, §2, 29 Stat. 692, (2) Aug. 5, 1939, ch. 450, §1, 53 Stat. 1212).

The first paragraph declares the existing presumption of validity of patents.

The five defenses named in R.S. 4920 are omitted and replaced by a broader paragraph specifying defenses in general terms.

The third paragraph, relating to notice of prior patents, publications and uses, is based on part of the last paragraph of R.S. 4920 which was superseded by the Federal Rules of Civil Procedure but which is reinstated with modifications.

AMENDMENTS

2011—Pub. L. 112–29, §20(g)(1), (2)(A), (C), (3), (j), designated first to third pars. as subsecs. (a) to (c), respectively, inserted headings, in subsec. (a), struck out third sentence which read “Notwithstanding the preceding sentence, if a claim to a composition of matter is held invalid and that claim was the basis of a determination of nonobviousness under section 103(b)(1), the process shall no longer be considered nonobvious solely on the basis of section 103(b)(1).”, in par. (2) of subsec. (b), struck out “of this title” after “II” and substituted “patentability.” for “patentability.”, and in introductory provisions of subsec. (c), struck out “of this title” after “156” and substituted “In an action involving the validity or infringement of a patent” for “In actions involving the validity or infringement of a patent” and “Court of Federal Claims” for “Claims Court”.

Pub. L. 112–29, §20(g)(2)(B), which directed substitution of “unenforceability.” for “unenforceability,” in par. (1) of former second par. which was designated subsec. (b), was executed by making the substitution for “unenforceability.”, to reflect the probable intent of Congress.

Pub. L. 112–29, §15(a), amended second par. by substituting “(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.”

for “(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title.”.

2002—Third par. Pub. L. 107–273, §13206(b)(4), made technical correction to directory language of Pub. L. 106–113, §1000(a)(9) [title IV, §4402(b)(1)]. See 1999 Amendment note below.

Pub. L. 107–273, §13206(b)(1)(B), made technical correction to directory language of Pub. L. 106–113, §1000(a)(9) [title IV, §4732(a)(10)(A)]. See 1999 Amendment note below.

1999—Third par. Pub. L. 106–113, §1000(a)(9) [title IV, §4732(a)(10)(A)], as amended by Pub. L. 107–273, §13206(b)(1)(B), substituted “(2) by the Director,” for “(2) by the Commissioner.”.

Pub. L. 106–113, §1000(a)(9) [title IV, §4402(b)(1)], as amended by Pub. L. 107–273, §13206(b)(4), substituted “154(b) or 156 of this title” for “156 of this title”.

1995—First par. Pub. L. 104–41 inserted after second sentence “Notwithstanding the preceding sentence, if a

claim to a composition of matter is held invalid and that claim was the basis of a determination of non-obviousness under section 103(b)(1), the process shall no longer be considered nonobvious solely on the basis of section 103(b)(1)."

1992—Third par. Pub. L. 102-572 substituted "United States Court of Federal Claims" for "United States Claims Court".

1984—Pub. L. 98-417 inserted provision at end that the invalidity of the extension of a patent term or any portion thereof under section 156 of this title because of the material failure by the applicant for the extension, or by the Commissioner, 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, and that a due diligence determination under section 156(d)(2) is not subject to review in such an action.

1982—Third par. Pub. L. 97-164 substituted "Claims Court" for "Court of Claims".

1975—First par. Pub. L. 94-131 made presumption of validity applicable to claim of a patent in multiple dependent form and multiple dependent claims and substituted "asserting such invalidity" for "asserting it".

1965—Pub. L. 89-83 required each claim of a patent (whether in independent or dependent form) to be presumed valid independently of the validity of other claims and required dependent claims to be presumed valid even though dependent upon an invalid claim.

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 15(a) of Pub. L. 112-29 effective on Sept. 16, 2011, and applicable to proceedings commenced on or after that date, see section 15(c) of Pub. L. 112-29, set out as a note under section 119 of this title.

Amendment by section 20(g), (j) of Pub. L. 112-29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112-29, set out as a note under section 2 of this title.

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by section 1000(a)(9) [title IV, §4402(b)(1)] of Pub. L. 106-113 effective on date that is 6 months after Nov. 29, 1999, and, except for design patent application filed under chapter 16 of this title, applicable to any application filed on or after such date, see section 1000(a)(9) [title IV, §4405(a)] of Pub. L. 106-113, set out as a note under section 154 of this title.

Amendment by section 1000(a)(9) [title IV, §4732(a)(10)(A)] of Pub. L. 106-113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106-113, set out as a note under section 1 of this title.

EFFECTIVE DATE OF 1992 AMENDMENT

Amendment by Pub. L. 102-572 effective Oct. 29, 1992, see section 911 of Pub. L. 102-572, set out as a note under section 171 of Title 28, Judiciary and Judicial Procedure.

EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-164 effective Oct. 1, 1982, see section 402 of Pub. L. 97-164, set out as a note under section 171 of Title 28, Judiciary and Judicial Procedure.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 94-131 effective Jan. 24, 1978, and applicable on and after that date to patent applications filed in the United States and to international applications, where applicable, see section 11 of Pub. L. 94-131, set out as an Effective Date note under section 351 of this title.

EFFECTIVE DATE OF 1965 AMENDMENT

Amendment by Pub. L. 89-83 effective 3 months after July 24, 1965, see section 7(a) of Pub. L. 89-83, set out as a note under section 41 of this title.

§ 283. Injunction

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.

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

HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §70, part (R.S. 4921, amended (1) Mar. 3, 1897, ch. 391, §6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, §8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, §1, 60 Stat. 778).

This section is the same as the provision which opens R.S. 4921 with minor changes in language.

§ 284. Damages

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) of this title.

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

(July 19, 1952, ch. 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), Sept. 16, 2011, 125 Stat. 335.)

AMENDMENT OF SECTION

Pub. L. 112-29, §20(j), (l), Sept. 16, 2011, 125 Stat. 335, provided that, effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, this section is amended by striking "of this title" each place that term appears. See 2011 Amendment note below.

HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., §§67 and 70, part (R.S. 4919; R.S. 4921, amended (1) Mar. 3, 1897, ch. 391, §6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, §8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, §1, 60 Stat. 778).

This section consolidates the provisions relating to damages in R.S. 4919 and 4921, with some changes in language.

AMENDMENTS

2011—Second par. Pub. L. 112-29 struck out "of this title" after "154(d)".

1999—Second par. Pub. L. 106-113 inserted at end "Increased damages under this paragraph shall not apply to provisional rights under section 154(d) of this title."

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by Pub. L. 112-29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112-29, set out as a note under section 2 of this title.