

106TH CONGRESS  
2D SESSION

# H. R. 4870

To make technical corrections in patent, copyright, and trademark laws.

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IN THE HOUSE OF REPRESENTATIVES

JULY 18, 2000

Mr. COBLE (for himself and Mr. BERMAN) introduced the following bill; which  
was referred to the Committee on the Judiciary

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## A BILL

To make technical corrections in patent, copyright, and  
trademark laws.

1 *Be it enacted by the Senate and House of Representa-*  
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the “Intellectual Property  
5 Technical Amendments Act of 2000”.

6 **SEC. 2. OFFICERS AND EMPLOYEES.**

7 (a) RENAMING OF OFFICERS.—(1) Title 35, United  
8 States Code, is amended—

9 (A) by striking “Director” each place it appears  
10 and inserting “Commissioner”; and

1 (B) by striking “Director’s” each place it ap-  
2 pears and inserting “Commissioner’s”.

3 (2) The Act of July 5, 1946 (commonly referred to  
4 as the “Trademark Act of 1946”; 15 U.S.C. 1051 et seq.)  
5 is amended by striking “Director” each place it appears  
6 and inserting “Commissioner”.

7 (3) Title 35, United States Code, is amended by  
8 striking “Commissioner for Patents” each place it appears  
9 and inserting “Assistant Commissioner for Patents”.

10 (4) Title 35, United States Code, is amended by  
11 striking “Commissioner for Trademarks” each place it ap-  
12 pears and inserting “Assistant Commissioner for Trade-  
13 marks”.

14 (5) Section 5314 of title 5, United States Code, is  
15 amended by striking

16 “Under Secretary of Commerce for Intellectual  
17 Property and Director of the United States Patent  
18 and Trademark Office.”

19 and inserting

20 “Under Secretary of Commerce for Intellectual  
21 Property and Commissioner of the United States  
22 Patent and Trademark Office.”

23 (b) REFERENCES.—Any reference in any other Fed-  
24 eral law, Executive order, rule, regulation, or delegation

1 of authority, or any document of or pertaining to the Pat-  
2 ent and Trademark Office—

3 (1) to the Director of the United States Patent  
4 and Trademark Office or to the Commissioner of  
5 Patents and Trademarks is deemed to refer to the  
6 Under Secretary of Commerce for Intellectual Prop-  
7 erty and Commissioner of the United States Patent  
8 and Trademark Office;

9 (2) to the Commissioner for Patents is deemed  
10 to refer to the Assistant Commissioner for Patents;  
11 and

12 (3) to the Commissioner for Trademarks is  
13 deemed to refer to the Assistant Commissioner for  
14 Trademarks.

15 **SEC. 3. ADJUSTMENT OF TRADEMARK FEES.**

16 Section 4203 of the Intellectual Property and Com-  
17 munications Omnibus Reform Act of 1999, as enacted by  
18 section 1000(a)(9) of Public Law 106–113, is amended  
19 by striking “Director” and inserting “Commissioner”.

20 **SEC. 4. OPTIONAL INTER PARTES REEXAMINATION PROCE-**  
21 **DURE ACT OF 1999; TECHNICAL AMEND-**  
22 **MENTS.**

23 (a) OPTIONAL INTER PARTES REEXAMINATION PRO-  
24 CEDURES.—Title 35, United States Code, is amended as  
25 follows:

1 (1) Section 311 is amended—

2 (A) in subsection (a), by striking “person”  
3 and inserting “third-party requester”; and

4 (B) in subsection (c), by striking “Unless  
5 the requesting person is the owner of the pat-  
6 ent, the” and inserting “The”.

7 (2) Section 312 is amended—

8 (A) in subsection (a), by striking the last  
9 sentence; and

10 (B) by striking “if any”.

11 (3) Section 314(b)(1) is amended—

12 (A) by striking “(1) This” and all that fol-  
13 lows through “(2)” and inserting “(1)”;

14 (B) by striking “the third-party requester  
15 shall receive a copy” and inserting “the Office  
16 shall send to the third-party requester a copy”;  
17 and

18 (C) by redesignating paragraph (3) as  
19 paragraph (2).

20 (4) Section 317(a) is amended by striking “pat-  
21 ent owner nor the third-party requester, if any, nor  
22 privies of either” and inserting “third-party re-  
23 quester nor its privies”.

24 (b) CONFORMING AMENDMENTS.—Subsections (a),  
25 (b), and (c) of section 134 of title 35, United States Code,

1 are each amended by striking “administrative patent  
2 judge” each place it appears and inserting “primary exam-  
3 iner”.

4 (c) CLERICAL AMENDMENTS.—

5 (1) Section 4604(a) of the Intellectual Property  
6 and Communications Omnibus Reform Act of 1999,  
7 is amended by striking “Part 3” and inserting “Part  
8 III”.

9 (2) Section 4605(b) of that Act is amended by  
10 striking “title 25” and inserting “title 35”.

11 (d) EFFECTIVE DATE.—The amendments made by  
12 sections 4605(c) and 4605(e) of the Intellectual Property  
13 and Communications Omnibus Reform Act, as enacted by  
14 section 1000(a)(9) of Public Law 106–113, shall apply to  
15 any reexamination filed in the United States Patent and  
16 Trademark Office on or after the date of the enactment  
17 of Public Law 106–113.

18 **SEC. 5. PATENT AND TRADEMARK EFFICIENCY ACT AMEND-**

19 **MENTS.**

20 (a) DEPUTY DIRECTOR.—

21 (1) Section 5315 of title 5, United States Code,  
22 is amended by striking “Deputy Under Secretary of  
23 Commerce for Intellectual Property and Deputy Di-  
24 rector of the United States Patent and Trademark  
25 Office.”.

1           (2) Section 17(b) of the Act of July 5, 1946  
2           (commonly referred to as the “Trademark Act of  
3           1946”) (15 U.S.C. 1067(b)), is amended by insert-  
4           ing “the Deputy Commissioner,” after “Commis-  
5           sioner,”.

6           (3) Section 6(a) of title 35, United States Code,  
7           is amended by inserting “the Deputy Commis-  
8           sioner,” after “Commissioner,”.

9           (b) PUBLIC ADVISORY COMMITTEES.—Section 5 of  
10          title 35, United States Code, is amended by adding at the  
11          end the following new subsection:

12          “(j) INAPPLICABILITY OF PATENT PROHIBITION.—  
13          Section 4 shall not apply to voting members of the Advi-  
14          sory Committees.”.

15          (c) CHIEF FINANCIAL OFFICER.—Section 901(b)(2)  
16          of title 31, United States Code, is amended by adding at  
17          the end the following new subparagraph:

18                  “(I) The United States Patent and Trade-  
19                  mark Office.”.

20          (d) MISCELLANEOUS.—Section 153 of title 35,  
21          United States Code, is amended by striking “and attested  
22          by an officer of the Patent and Trademark Office des-  
23          ignated by the Director,”.

1 **SEC. 6. DOMESTIC PUBLICATION OF FOREIGN FILED PAT-**  
2 **ENT APPLICATIONS ACT OF 1999 AMEND-**  
3 **MENTS.**

4 Section 154(d)(4)(A) of title 35, United States Code,  
5 is amended—

6 (1) by striking “on which the Patent and  
7 Trademark Office receives a copy of the” and insert-  
8 ing “of”; and

9 (2) by striking “international application” the  
10 last place it appears and inserting “publication”.

11 **SEC. 7. DOMESTIC PUBLICATION OF PATENT APPLICA-**  
12 **TIONS PUBLISHED ABROAD.**

13 Subtitle E of the Intellectual Property and Commu-  
14 nications Omnibus Reform Act of 1999, as enacted by sec-  
15 tion 1000(a)(9) of Public Law 106–113, is amended as  
16 follows:

17 (1) Section 4505 is amended to read as follows:

18 **“SEC. 4505. PRIOR ART EFFECT OF PUBLISHED APPLICA-**  
19 **TIONS.**

20 “Section 102(e) of title 35, United States Code, is  
21 amended to read as follows:

22 ““(e) the invention was described in (1) an applica-  
23 tion for patent, published under section 122(b), by another  
24 filed in the United States before the invention by the ap-  
25 plicant for patent or (2) a patent granted on an applica-  
26 tion for patent by another filed in the United States before

1 the invention by the applicant for patent, except that an  
2 international application filed under the treaty defined in  
3 section 351(a) shall have the effects for the purposes of  
4 this subsection of an application filed in the United States  
5 if and only if the international application designated the  
6 United States and was published under Article 21(2) of  
7 such treaty in the English language; or’ ”.

8 (2) Section 4507 is amended—

9 (A) in paragraph (1), by striking “Section  
10 11” and inserting “Section 10”;

11 (B) in paragraph (2), by striking “Section  
12 12” and inserting “Section 11”.

13 (C) in paragraph (3), by striking “Section  
14 13” and inserting “Section 12”;

15 (D) in paragraph (4), by striking “12 and  
16 13” and inserting “11 and 12”;

17 (E) in section 374 of title 35, United  
18 States Code, as amended by paragraph (10), by  
19 striking “confer the same rights and shall have  
20 the same effect under this title as an applica-  
21 tion for patent published” and inserting “be  
22 deemed a publication”; and

23 (F) by adding at the end the following:



1           “(12) The item relating to section 374 in the  
2           table of contents for chapter 37 of title 35, United  
3           States Code, is amended to read as follows:

          “374. Publication of international application.”.

4           (3) Section 4508 is amended to read as follows:

5   **“SEC. 4508. EFFECTIVE DATE.**

6           “Except as otherwise provided in this section, sec-  
7           tions 4502 through 4507, and the amendments made by  
8           such sections, shall take effect on November 29, 2000, and  
9           shall apply only to applications (including international  
10          applications designating the United States) filed on or  
11          after that date. The amendments made by sections 4504  
12          and 4505 shall additionally apply to any pending applica-  
13          tion filed before November 29, 2000, if such pending ap-  
14          plication is published pursuant to a request of the appli-  
15          cant under such procedures as may be established by the  
16          Director. If an application is filed on or after November  
17          29, 2000, or is published pursuant to a request from the  
18          applicant, and the application claims the benefit of one  
19          or more prior-filed applications under section 119(e), 120,  
20          or 365(e) of title 35, United States Code, then the provi-  
21          sions of section 4505 shall apply to the prior-filed applica-  
22          tion in determining the filing date in the United States  
23          of the application.”.

1 **SEC. 8. MISCELLANEOUS CLERICAL AMENDMENTS.**

2 (a) AMENDMENTS TO TITLE 35.—The following pro-  
3 visions of title 35, United States Code, are amended:

4 (1) Section 2(b) is amended in paragraphs  
5 (2)(B) and (4)(B), by striking “, United States  
6 Code”.

7 (2) Section 3 is amended—

8 (A) in subsection (b)(2)—

9 (i) in the first sentence of subpara-  
10 graph (B) by striking “United States  
11 Code,”;

12 (ii) in the second sentence of subpara-  
13 graph (B)—

14 (I) by striking “United States  
15 Code,”; and

16 (II) by striking “, United States  
17 Code.” and inserting a period; and

18 (iii) in subparagraph (C), by striking  
19 “, United States Code”; and

20 (B) in subsection (c)—

21 (i) in the subsection caption, by strik-  
22 ing “, UNITED STATES CODE”; and

23 (ii) by striking “United States Code,”.

24 (3) Section 5 is amended in subsections (e) and  
25 (g), by striking “, United States Code” each place  
26 it appears.

1 (4) The table of chapters for part I is amended  
 2 in the item relating to chapter 3, by striking “**be-**  
 3 **fore**” and inserting “**Before**”.

4 (5) The item relating to section 21 in the table  
 5 of contents for chapter 2 is amended to read as fol-  
 6 lows:

“21. Filing date and day for taking action.”.

7 (6) The item relating to chapter 12 in the table  
 8 of chapters for part II is amended to read as fol-  
 9 lows:

“12. Examination of Application ..... 131”.

10 (7) The item relating to section 116 in the table  
 11 of contents for chapter 11 is amended to read as fol-  
 12 lows:

“116. Inventors.”.

13 (8) Section 156 is amended—

14 (A) in subsection (b)(3)(B), by striking  
 15 “paragraphs” and inserting “paragraph”;

16 (B) in subsection (d)(2)(B)(i), by striking  
 17 “below the office” and inserting “below the Of-  
 18 fice”; and

19 (C) in subsection (g)(6)(B)(iii), by striking  
 20 “submittted” and inserting “submitted”.

21 (9) The item relating to section 183 in the table  
 22 of contents for chapter 17 is amended by striking  
 23 “of” and inserting “to”.

1           (10) Section 185 is amended by striking the  
2 second period at the end of the section.

3           (11) Section 202(c)(4) is amended by striking  
4 “rights;” and inserting “rights,”.

5           (12) Section 203 is amended—

6           (A) in paragraph (2)—

7                 (i) by striking “(2)” and inserting  
8 “(b)”;

9                 (ii) by striking the quotation marks  
10 and comma before “as appropriate”.

11           (B) in the first paragraph—

12                 (i) by striking “(a)”, “(b)”, “(c)”,  
13 and (d)” and inserting “(1)”, “(2)”, “(3)”,  
14 and (4)”, respectively; and

15                 (ii) by striking “(1.” and inserting  
16 “(a)”.

17           (13) Section 210 is amended—

18           (A) in subsection (a)—

19                 (i) in paragraph (11), by striking  
20 “5901” and inserting “5908”; and

21                 (ii) in paragraph (20) by striking  
22 “178(j)” and inserting “178j”; and

23           (B) in subsection (c)—

24                 (i) by striking “paragraph 202(c)(4)”  
25 and inserting “section 202(c)(4)”; and

1 (ii) by striking “title..” and inserting  
2 “title.”.

3 (14) The item relating to chapter 29 in the  
4 table of chapters for part III is amended by insert-  
5 ing a comma after “**Patent**”.

6 (15) The item relating to section 256 in the  
7 table of contents for chapter 25 is amended to read  
8 as follows:

“256. Correction of named inventor.”.

9 (16) Section 294(c) is amended in the second  
10 sentence by striking “court to” and inserting “court  
11 of”.

12 (17)(A) The item relating to section 374 in the  
13 table of contents for chapter 37 is amended to read  
14 as follows:

“374. Publication of international application.”.

15 (B) The amendment made by subparagraph (A)  
16 shall take effect on November 29, 2000.

17 (18) Section 371(b) is amended by adding at  
18 the end a period.

19 (19) Section 371(d) is amended by adding at  
20 the end a period.

21 (20) Paragraphs (1), (2), and (3) of section  
22 376(a) are each amended by striking the semicolon  
23 and inserting a period.

24 (b) OTHER AMENDMENTS.—

1           (1) Section 4732(a) of the Intellectual Property  
2           and Communications Omnibus Reform Act of 1999  
3           is amended—

4                   (A) in paragraph (9)(A)(ii), by inserting  
5                   “in subsection (b),” after “(ii)”; and

6                   (B) in paragraph (10)(A), by inserting  
7                   after “title 35, United States Code,” the fol-  
8                   lowing: “other than sections 1 through 6 (as  
9                   amended by chapter 1 of this subtitle),”.

10           (2) Section 4802(1) of that Act is amended by  
11           inserting “to” before “citizens”.

12           (3) Section 4804 of that Act is amended—

13                   (A) in subsection (b), by striking “11(a)”  
14                   and inserting “10(a)”; and

15                   (B) in subsection (c), by striking “13” and  
16                   inserting “12”.

17           (4) Section 4402(b)(1) of that Act is amended  
18           by striking “in the fourth paragraph”.

19 **SEC. 9. TECHNICAL CORRECTIONS IN TRADEMARK LAW.**

20           (a) AWARD OF DAMAGES.—Section 35(a) of the Act  
21           of July 5, 1946 (commonly referred to as the “Trademark  
22           Act of 1946”) (15 U.S.C. 1117(a)), is amended by strik-  
23           ing “a violation under section 43(a), (c), or (d),” and in-  
24           serting “a violation under section 43(a) or (d),”.

1 (b) CLERICAL AMENDMENTS.—The Trademark Act  
2 of 1946 is further amended as follows:

3 (1) Section 1(d)(1) is amended in the first sen-  
4 tence by striking “specifying the date of the appli-  
5 cant’s first use” and all that follows through the end  
6 of the sentence and inserting “specifying the date of  
7 the applicant’s first use of the mark in commerce  
8 and those goods or services specified in the notice of  
9 allowance on or in connection with which the mark  
10 is used in commerce.”.

11 (2) Section 23(c) is amended by striking the  
12 second comma after “numeral”.

13 (3) Section 33(b)(8) is amended by aligning the  
14 text with paragraph (7).

15 (4) Sections 34(d)(11) and 35(b) are each  
16 amended by striking “of 1954” and inserting “of  
17 1986”.

○