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107TH CONGRESS, 1st Session } HOUSE OF REPRESENTATIVES { REPORT 107–18

INTELLECTUAL PROPERTY AND HIGH TECHNOLOGY TECHNICAL AMENDMENTS ACT OF 2001

MARCH 12, 2001.—Committed to the Committee of the Whole House on the State of the Union and ordered to be printed

Mr. SENSENBRENNER, from the Committee on the Judiciary, submitted the following

R E P O R T

[To accompany S. 320]

[Including cost estimate of the Congressional Budget Office]

The Committee on the Judiciary, to whom was referred the bill (S. 320) to make technical corrections in patent, copyright, and trademark laws, having considered the same, report favorably thereon with an amendment and recommend that the bill as amended do pass.

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The amendment is as follows:

Strike all after the enacting clause and insert the following:

SECTION 1. SHORT TITLE.

This Act may be cited as the "Intellectual Property and High Technology Technical Amendments Act of 2001".

89–006

SEC. 2. OFFICERS AND EMPLOYEES.

(a) RENAMING OF OFFICERS.—(1)(A) Except as provided in subparagraph (B), title 35, United States Code, other than section 210(d), is amended—

(i) by striking "Director" each place it appears and inserting "Commissioner"; and

(ii) by striking "Director's" each place it appears and inserting "Commissioner's".

(B) Section 3(b)(5) of title 35, United States Code, is amended by striking "Director" the first place it appears and inserting "Commissioner".

(C) Section 3(a) of title 35, United States Code, is amended in the subsection heading, by striking "DIRECTOR" and inserting "COMMISSIONER".

(D) Section 3(b)(1) of title 35, United States Code, is amended in the paragraph heading, by striking "DIRECTOR" and inserting "COMMISSIONER".

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

(3)(A) Title 35, United States Code, other than subsection (f) of section 3, is amended by striking "Commissioner for Patents" each place it appears and inserting "Assistant Commissioner for Patents".

(B) Title 35, United States Code, other than subsection (f) of section 3, is amended by striking "Commissioner for Trademarks" each place it appears and inserting "Assistant Commissioner for Trademarks".

(C) Section 3(b)(2) of title 35, United States Code, is amended—

(i) in the paragraph heading, by striking "COMMISSIONERS" and inserting "ASSISTANT COMMISSIONERS";

(ii) in subparagraph (A), in the last sentence—

(I) by striking "a Commissioner" and inserting "an Assistant Commissioner"; and

(II) by striking "the Commissioner" and inserting "the Assistant Commissioner";

(iii) in subparagraph (B)—

(I) by striking "Commissioners" each place it appears and inserting "Assistant Commissioners";

(II) by striking "Commissioners'" each place it appears and inserting "Assistant Commissioners'"; and

(iv) in subparagraph (C), by striking "Commissioners" and inserting "Assistant Commissioners".

(D) Section 3(f) of title 35, United States Code, is amended in subparagraphs (A) and (B) of paragraph (2)—

(i) by striking "the Commissioner" each place it appears and inserting "the Assistant Commissioner"; and

(ii) by striking "a Commissioner" each place it appears and inserting "an Assistant Commissioner".

(E) Section 13 of title 35, United States Code, is amended—

(i) by striking "Commissioner of" each place it appears and inserting "Assistant Commissioner for"; and

(ii) by striking "Commissioners" and inserting "Assistant Commissioners".

(F) Chapter 17 of title 35, United States Code, is amended by striking "Commissioner of Patents" each place it appears and inserting "Assistant Commissioner for Patents".

(G) Section 297 of title 35, United States Code, is amended by striking "Commissioner of Patents" each place it appears and inserting "Commissioner".

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

"Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office."

and inserting

"Under Secretary of Commerce for Intellectual Property and Commissioner of the United States Patent and Trademark Office.".

(5) Section 5315 of title 5, United States Code, is amended by striking

"Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office."

and inserting

"Deputy Under Secretary of Commerce for Intellectual Property and Deputy Commissioner of the United States Patent and Trademark Office.".

(6)(A) Sections 303 and 304 of title 35, United States Code, are each amended in the section headings by striking "**Director**" and inserting "**Commissioner**".

(B) The items relating to sections 303 and 304 in the table of sections for chapter 30 of title 35, United States Code, are each amended by striking "Director" and inserting "Commissioner".

(7)(A) Sections 312 and 313 of title 35, United States Code, are each amended in the section headings by striking "**Director**" and inserting "**Commissioner**".

(B) The items relating to sections 312 and 313 in the table of sections for chapter 31 of title 35, United States Code, are each amended by striking "Director" and inserting "Commissioner".

(8) Section 17(b) of the Trademark Act of 1946 (15 U.S.C. 1067) is amended by striking "Commissioner for Patents, the Commissioner for Trademarks" and inserting "Assistant Commissioner for Patents, the Assistant Commissioner for Trademarks".

(b) ADDITIONAL CLERICAL AMENDMENTS.—

(1) The following provisions of law are amended by striking "Director" each place it appears and inserting "Commissioner".

(A) Section 9(p)(1)(B) of the Small Business Act (15 U.S.C. 638(p)(1)(B).

(B) Section 19 of the Tennessee Valley Authority Act of 1933 (16 U.S.C. 831r).

(C) Section 182(b)(2)(A) of the Trade Act of 1974 (19 U.S.C. 2242(b)(2)(A)).

(D) Section 302(b)(2)(D) of the Trade Act of 1974 (19 U.S.C. 2412(b)(2)(D)).

(E) Section 702(d) of the Federal Food, Drug, and Cosmetic Act (21 U.S.C. 372(d)).

(F) Section 1295(a)(4)(B) of title 28, United States Code.

(G) Section 1744 of title 28, United States Code.

(H) Section 151 of the Atomic Energy Act of 1954 (42 U.S.C. 2181).

(I) Section 152 of the Atomic Energy Act of 1954 (42 U.S.C. 2182).

(J) Section 305 of the National Aeronautics and Space Act of 1958 (42 U.S.C. 2457).

(K) Section 12(a) of the Solar Heating and Cooling Demonstration Act of 1974 (42 U.S.C. 5510(a)), the last place such term appears.

(L) Section 10(i) of the Trading with the enemy Act (50 U.S.C. App. 10(i)).

(M) Sections 4203, 4506, 4606, and 4804(d)(2) of the Intellectual Property and Communications Omnibus Reform Act of 1999, as enacted by section 1000(a)(9) of Public Law 106–113.

(2) The item relating to section 1744 in the table of sections for chapter 115 of title 28, United States Code, is amended by striking "generally" and inserting ", generally".

(c) REFERENCES.—Any reference in any other Federal law, Executive order, rule, regulation, or delegation of authority, or any document of or pertaining to the Patent and Trademark Office—

(1) to the Director of the United States Patent and Trademark Office or to the Commissioner of Patents and Trademarks is deemed to refer to the Under Secretary of Commerce for Intellectual Property and Commissioner of the United States Patent and Trademark Office;

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

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

SEC. 3. CLARIFICATION OF REEXAMINATION PROCEDURE ACT OF 1999; TECHNICAL AMENDMENTS.

(a) OPTIONAL INTER PARTES REEXAMINATION PROCEDURES.—Title 35, United States Code, is amended as follows:

(1) Section 311 is amended—

(A) in subsection (a), by striking "person" and inserting "third-party requester"; and

(B) in subsection (c), by striking "Unless the requesting person is the owner of the patent, the" and inserting "The".

(2) Section 312 is amended—

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

(B) in subsection (b), by striking ", if any".

(3) Section 314(b)(1) is amended—

(A) by striking "(1) This" and all that follows through "(2)" and inserting "(1)";

(B) by striking "the third-party requester shall receive a copy" and inserting "the Office shall send to the third-party requester a copy"; and

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

(4) Section 315(c) is amended by striking "United States Code,".

(5) Section 317 is amended—

(A) in subsection (a), by striking "patent owner nor the third-party requester, if any, nor privies of either" and inserting "third-party requester nor its privies"; and

(B) in subsection (b), by striking "United States Code,".

(b) CONFORMING AMENDMENTS.—

(1) APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES.—Subsections (a), (b), and (c) of section 134 of title 35, United States Code, are each amended by striking "administrative patent judge" each place it appears and inserting "primary examiner".

(2) PROCEEDING ON APPEAL.—Section 143 of title 35, United States Code, is amended by amending the third sentence to read as follows: "In an ex parte case or any reexamination case, the Commissioner shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Commissioner and the parties in the appeal.".

(c) CLERICAL AMENDMENTS.—

(1) Section 4604(a) of the Intellectual Property and Communications Omnibus Reform Act of 1999, as enacted by section 1000(a)(9) of Public Law 106–113, is amended by striking "Part 3" and inserting "Part III".

(2) Section 4604(b) of that Act is amended by striking "title 25" and inserting "title 35".

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

SEC. 4. PATENT AND TRADEMARK EFFICIENCY ACT AMENDMENTS.

(a) DEPUTY COMMISSIONER.—

(1) Section 17(b) of the Act of July 5, 1946 (commonly referred to as the "Trademark Act of 1946") (15 U.S.C. 1067(b)), is amended by inserting "the Deputy Commissioner," after "Commissioner,".

(2) Section 6(a) of title 35, United States Code, is amended by inserting "the Deputy Commissioner," after "Commissioner,".

(b) PUBLIC ADVISORY COMMITTEES.—Section 5 of title 35, United States Code, is amended—

(1) in subsection (i), by inserting ", privileged," after "personnel"; and

(2) by adding at the end the following new subsection:

"(j) INAPPLICABILITY OF PATENT PROHIBITION.—Section 4 shall not apply to voting members of the Advisory Committees.".

(c) MISCELLANEOUS.—Section 153 of title 35, United States Code, is amended by striking "and attested by an officer of the Patent and Trademark Office designated by the Commissioner,".

SEC. 5. DOMESTIC PUBLICATION OF FOREIGN FILED PATENT APPLICATIONS ACT OF 1999 AMENDMENTS.

Section 154(d)(4)(A) of title 35, United States Code, as in effect on November 29, 2000, is amended—

(1) by striking "on which the Patent and Trademark Office receives a copy of the" and inserting "of"; and

(2) by striking "international application" the last place it appears and inserting "publication".

SEC. 6. DOMESTIC PUBLICATION OF PATENT APPLICATIONS PUBLISHED ABROAD.

Subtitle E of title IV of the Intellectual Property and Communications Omnibus Reform Act of 1999, as enacted by section 1000(a)(9) of Public Law 106–113, is amended as follows:

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

"SEC. 4505. PRIOR ART EFFECT OF PUBLISHED APPLICATIONS.

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

"'(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or'.".

(2) Section 4507 is amended—

(A) in paragraph (1), by striking "Section 11" and inserting "Section 10";

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

(C) in paragraph (3), by striking "Section 13" and inserting "Section 12";

(D) in paragraph (4), by striking "12 and 13" and inserting "11 and 12";

(E) in section 374 of title 35, United States Code, as amended by paragraph (10), by striking "confer the same rights and shall have the same effect under this title as an application for patent published" and inserting "be deemed a publication"; and

(F) by adding at the end the following:

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

"'374. Publication of international application.'".

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

"SEC. 4508. EFFECTIVE DATE.

"Except as otherwise provided in this section, sections 4502 through 4507, and the amendments made by such sections, shall be effective as of November 29, 2000, and shall apply only to applications (including international applications designating the United States) filed on or after that date. The amendments made by sections 4504 and 4505 shall additionally apply to any pending application filed before November 29, 2000, if such pending application is published pursuant to a request of the applicant under such procedures as may be established by the Commissioner. If an application is filed on or after November 29, 2000, or is published pursuant to a request from the applicant, and the application claims the benefit of one or more prior-filed applications under section 119(e), 120, or 365(c) of title 35, United States Code, then the amendment made by section 4505 shall apply to the prior-filed application in determining the filing date in the United States of the application.".

SEC. 7. MISCELLANEOUS CLERICAL AMENDMENTS.

(a) AMENDMENTS TO TITLE 35.—The following provisions of title 35, United States Code, are amended:

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

(2) Section 3 is amended—

(A) in subsection (a)(2)(B), by striking "United States Code,";

(B) in subsection (b)(2)—

(i) in the first sentence of subparagraph (A), by striking ", United States Code";

(ii) in the first sentence of subparagraph (B)—

(I) by striking "United States Code,"; and

(II) by striking ", United States Code";

(iii) in the second sentence of subparagraph (B)—

(I) by striking "United States Code,"; and

(II) by striking ", United States Code." and inserting a period;

(iv) in the last sentence of subparagraph (B), by striking ", United States Code"; and

(v) in subparagraph (C), by striking ", United States Code"; and

(C) in subsection (c)—

(i) in the subsection caption, by striking ", UNITED STATES CODE"; and

(ii) by striking "United States Code,".

(3) Section 5 is amended in subsections (e) and (g), by striking ", United States Code" each place it appears.

(4) The table of chapters for part I is amended in the item relating to chapter 3, by striking "**before**" and inserting "**Before**".

(5) The item relating to section 21 in the table of contents for chapter 2 is amended to read as follows:

"21. Filing date and day for taking action.".

(6) The item relating to chapter 12 in the table of chapters for part II is amended to read as follows:

"12. Examination of Application ..... 131".

(7) The item relating to section 116 in the table of contents for chapter 11 is amended to read as follows:

"116. Inventors.".

(8) Section 154(b)(4) is amended by striking ", United States Code,".

(9) Section 156 is amended—

(A) in subsection (b)(3)(B), by striking "paragraphs" and inserting "paragraph";

(B) in subsection (d)(2)(B)(i), by striking "below the office" and inserting "below the Office"; and

(C) in subsection (g)(6)(B)(iii), by striking "submittted" and inserting "submitted".

(10) The item relating to section 183 in the table of contents for chapter 17 is amended by striking "of" and inserting "to".

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

(12) Section 201(a) is amended—

(A) by striking "United States Code,"; and

(B) by striking "5, United States Code." and inserting "5.".

(13) Section 202 is amended—

(A) in subsection (b)(4), by striking "last paragraph of section 203(2)" and inserting "section 203(b)"; and

(B) in subsection (c)—

(i) in paragraph (4), by striking "rights;" and inserting "rights,"; and

(ii) in paragraph (5), by striking "of the United States Code".

(14) Section 203 is amended—

(A) in paragraph (2)—

(i) by striking "(2)" and inserting "(b)";

(ii) by striking the quotation marks and comma before "as appropriate"; and

(iii) by striking "paragraphs (a) and (c)" and inserting "paragraphs (1) and (3) of subsection (a)"; and

(B) in the first paragraph—

(i) by striking "(a)", "(b)", "(c)", and "(d)" and inserting "(1)", "(2)", "(3)", and "(4)", respectively; and

(ii) by striking "(1." and inserting "(a)".

(15) Section 209 is amended in subsections (d)(2) and (f), by striking "of the United States Code".

(16) Section 210 is amended—

(A) in subsection (a)—

(i) in paragraph (11), by striking "5901" and inserting "5908"; and

(ii) in paragraph (20) by striking "178(j)" and inserting "178j"; and

(B) in subsection (c)—

(i) by striking "paragraph 202(c)(4)" and inserting "section 202(c)(4)"; and

(ii) by striking "title.." and inserting "title.".

(17) The item relating to chapter 29 in the table of chapters for part III is amended by inserting a comma after "**Patent**".

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

"256. Correction of named inventor.".

(19) Section 294 is amended—

(A) in subsection (b), by striking "United States Code,"; and

(B) in subsection (c), in the second sentence by striking "court to" and inserting "court of".

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

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

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

(b) OTHER AMENDMENTS.—

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

(A) in paragraph (9)(A)(ii), by inserting "in subsection (b)," after "(ii)"; and

(B) in paragraph (10)(A), by inserting after "title 35, United States Code," the following: "other than sections 1 through 6 (as amended by chapter 1 of this subtitle),".

(2) Section 4802(1) of that Act is amended by inserting "to" before "citizens".

(3) Section 4804 of that Act is amended—

(A) in subsection (b), by striking "11(a)" and inserting "10(a)"; and

(B) in subsection (c), by striking "13" and inserting "12".

(4) Section 4402(b)(1) of that Act is amended by striking "in the fourth paragraph".

SEC. 8. TECHNICAL CORRECTIONS IN TRADEMARK LAW.

(a) AWARD OF DAMAGES.—Section 35(a) of the Act of July 5, 1946 (commonly referred to as the "Trademark Act of 1946") (15 U.S.C. 1117(a)), is amended by striking "a violation under section 43(a), (c), or (d)," and inserting "a violation under section 43(a) or (d),".

(b) ADDITIONAL TECHNICAL AMENDMENTS.—The Trademark Act of 1946 is further amended as follows:

(1) Section 1(d)(1) (15 U.S.C. 1051(d)(1)) is amended in the first sentence by striking "specifying the date of the applicant's first use" and all that follows through the end of the sentence and inserting "specifying the date of the applicant's first use of the mark in commerce and those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce.".

(2) Section 1(e) (15 U.S.C. 1051(e)) is amended to read as follows:

"(e) If the applicant is not domiciled in the United States the applicant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Commissioner.".

(3) Section 8(f) (15 U.S.C. 1058(f)) is amended to read as follows:

"(f) If the registrant is not domiciled in the United States, the registrant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Commissioner.".

(4) Section 9(c) (15 U.S.C. 1059(c)) is amended to read as follows:

"(c) If the registrant is not domiciled in the United States the registrant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Commissioner.".

(5) Subsections (a) and (b) of section 10 (15 U.S.C. 1060(a) and (b)) are amended to read as follows:

"(a)(1) A registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. Notwithstanding the preceding sentence, no application to register a mark under section 1(b) shall be assignable prior to the filing of an amendment under section 1(c) to bring the application into conformity with section 1(a) or the filing of the verified statement of use under section 1(d), except for

an assignment to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing.

"(2) In any assignment authorized by this section, it shall not be necessary to include the good will of the business connected with the use of and symbolized by any other mark used in the business or by the name or style under which the business is conducted.

"(3) Assignments shall be by instruments in writing duly executed. Acknowledgment shall be prima facie evidence of the execution of an assignment, and when the prescribed information reporting the assignment is recorded in the United States Patent and Trademark Office, the record shall be prima facie evidence of execution.

"(4) An assignment shall be void against any subsequent purchaser for valuable consideration without notice, unless the prescribed information reporting the assignment is recorded in the United States Patent and Trademark Office within 3 months after the date of the assignment or prior to the subsequent purchase.

"(5) The United States Patent and Trademark Office shall maintain a record of information on assignments, in such form as may be prescribed by the Commissioner.

"(b) An assignee not domiciled in the United States may designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the assignee does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served upon the Commissioner.".

(6) Section 23(c) (15 U.S.C. 1091(c)) is amended by striking the second comma after "numeral".

(7) Section 33(b)(8) (15 U.S.C. 1115(b)(8)) is amended by aligning the text with paragraph (7).

(8) Section 34(d)(1)(A) (15 U.S.C. 1116(d)(1)(A)) is amended by striking "section 110" and all that follows through "(36 U.S.C. 380)" and inserting "section 220506 of title 36, United States Code,".

(9) Section 34(d)(1)(B)(ii) (15 U.S.C. 1116(d)(1)(B)(ii)) is amended by striking "section 110" and all that follows through "(36 U.S.C. 380)" and inserting "section 220506 of title 36, United States Code".

(10) Section 34(d)(11) is amended by striking "6621 of the Internal Revenue Code of 1954" and inserting "6621(a)(2) of the Internal Revenue Code of 1986".

(11) Section 35(b) (15 U.S.C. 1117(b)) is amended—

(A) by striking "section 110" and all that follows through "(36 U.S.C. 380)" and inserting "section 220506 of title 36, United States Code,"; and

(B) by striking "6621 of the Internal Revenue Code of 1954" and inserting "6621(a)(2) of the Internal Revenue Code of 1986".

(12) Section 44(e) (15 U.S.C. 1126(e)) is amended by striking "a certification" and inserting "a true copy, a photocopy, a certification,".

SEC. 9. PATENT AND TRADEMARK FEE CLERICAL AMENDMENT.

The Patent and Trademark Fee Fairness Act of 1999 (113 Stat. 1537–546 et seq.), as enacted by section 1000(a)(9) of Public Law 106–113, is amended in section 4203, by striking "111(a)" and inserting "1113(a)".

SEC. 10. COPYRIGHT RELATED CORRECTIONS TO 1999 OMNIBUS REFORM ACT.

Title I of the Intellectual Property and Communications Omnibus Reform Act of 1999, as enacted by section 1000(a)(9) of Public Law 106–113, is amended as follows:

(1) Section 1007 is amended—

(A) in paragraph (2), by striking "paragraph (2)" and inserting "paragraph (2)(A)"; and

(B) in paragraph (3), by striking "1005(e)" and inserting "1005(d)".

(2) Section 1006(b) is amended by striking "119(b)(1)(B)(iii)" and inserting "119(b)(1)(B)(ii)".

(3)(A) Section 1006(a) is amended—

(i) in paragraph (1), by adding "and" after the semicolon;

(ii) by striking paragraph (2); and

(iii) by redesignating paragraph (3) as paragraph (2).

(B) Section 1011(b)(2)(A) is amended to read as follows:

"(A) in paragraph (1), by striking 'primary transmission made by a superstation and embodying a performance or display of a work' and insert-

ing 'performance or display of a work embodied in a primary transmission made by a superstation or by the Public Broadcasting Service satellite feed';".

SEC. 11. AMENDMENTS TO TITLE 17, UNITED STATES CODE.

Title 17, United States Code, is amended as follows:

(1) Section 119(a)(6) is amended by striking "of performance" and inserting "of a performance".

(2)(A) The section heading for section 122 is amended by striking "**rights; secondary**" and inserting "**rights: Secondary**".

(B) The item relating to section 122 in the table of contents for chapter 1 is amended to read as follows:

"122. Limitations on exclusive rights: Secondary transmissions by satellite carriers within local markets.".

(3)(A) The section heading for section 121 is amended by striking "**reproduction**" and inserting "**Reproduction**".

(B) The item relating to section 121 in the table of contents for chapter 1 is amended by striking "reproduction" and inserting "Reproduction".

(4)(A) Section 106 is amended by striking "107 through 121" and inserting "107 through 122".

(B) Section 501(a) is amended by striking "106 through 121" and inserting "106 through 122".

(C) Section 511(a) is amended by striking "106 through 121" and inserting "106 through 122".

(5) Section 101 is amended—

(A) by moving the definition of "computer program" so that it appears after the definition of "compilation"; and

(B) by moving the definition of "registration" so that it appears after the definition of "publicly".

(6) Section 110(4)(B) is amended in the matter preceding clause (i) by striking "conditions;" and inserting "conditions:".

(7) Section 118(b)(1) is amended in the second sentence by striking "to it".

(8) Section 119(b)(1)(A) is amended—

(A) by striking "transmitted" and inserting "retransmitted"; and

(B) by striking "transmissions" and inserting "retransmissions".

(9) Section 203(a)(2) is amended—

(A) in subparagraph (A)—

(i) by striking "(A) the" and inserting "(A) The"; and

(ii) by striking the semicolon at the end and inserting a period;

(B) in subparagraph (B)—

(i) by striking "(B) the" and inserting "(B) The"; and

(ii) by striking the semicolon at the end and inserting a period; and

(C) in subparagraph (C), by striking "(C) the" and inserting "(C) The".

(10) Section 304(c)(2) is amended—

(A) in subparagraph (A)—

(i) by striking "(A) the" and inserting "(A) The"; and

(ii) by striking the semicolon at the end and inserting a period;

(B) in subparagraph (B)—

(i) by striking "(B) the" and inserting "(B) The"; and

(ii) by striking the semicolon at the end and inserting a period; and

(C) in subparagraph (C), by striking "(C) the" and inserting "(C) The".

(11) The item relating to section 903 in the table of contents for chapter 9 is amended by striking "licensure" and inserting "licensing".

SEC. 12. OTHER COPYRIGHT RELATED TECHNICAL AMENDMENTS.

(a) AMENDMENT TO TITLE 18.—Section 2319(e)(2) of title 18, United States Code, is amended by striking "107 through 120" and inserting "107 through 122".

(b) STANDARD REFERENCE DATA.—(1) Section 105(f) of Public Law 94–553 is amended by striking "section 290(e) of title 15" and inserting "section 6 of the Standard Reference Data Act (15 U.S.C. 290e)".

(2) Section 6(a) of the Standard Reference Data Act (15 U.S.C. 290e) is amended by striking "Notwithstanding" and all that follows through "United States Code," and inserting "Notwithstanding the limitations under section 105 of title 17, United States Code,".

PURPOSE AND SUMMARY

The purpose of S. 320, the "Intellectual Property and High Technology Technical Amendments Act of 2001," is to remedy miscella-

neous technical and clerical drafting errors in the U.S. Code and the Intellectual Property and Communications Omnibus Reform Act (IPCORA), and to clarify provisions in title IV of IPCORA, the "American Inventor's Protection Act" (AIPA).[1] This bill makes these remedial changes in four primary areas: patent law, trademark law, copyright law, and the organization of the U.S. Patent and Trademark Office (PTO).

Each provision was carefully scrutinized to ensure that it will not substantially change existing law, especially the AIPA, which contains carefully negotiated agreements developed by Members of Congress, high-technology companies, the patent and trademark bar, unions, and the independent inventor community.

BACKGROUND AND NEED FOR THE LEGISLATION

In the mid-1990's, Congress investigated several proposals aimed at modernizing the Federal patent and trademark laws, harmonizing our laws with those of other developed nations, and transforming the U.S. Patent and Trademark Office into a more efficient agency. Several of these proposals passed as part of the AIPA.

The bill makes certain technical and clarifying changes in the law to facilitate the implementation of the changes contained in the AIPA; in addition, the bill helps to empower inventors and other users of the PTO. These changes included in S. 320 fall within the following areas:

- *PTO* modernization. The bill establishes a Chief Financial Officer within the agency, changes the titles of certain key officers of the agency, clarifies the authority of the Public Advisory Committee, and makes other minor changes to PTO administrative operations.
- *Inter Partes Patent Reexamination.* The bill amends the statutory provisions for the optional inter partes reexamination that is an alternative to litigation while not altering its substantive procedures.
- *Early Publication of Patent Applications.* The bill amends the statutory procedures for the early publication of foreign-filed patents so as to conform with the procedures for accepting and processing international applications.
- *Trademark Law.* The bill provides for technical and clerical amendments to the Trademark Act.[2]

S. 320 is entirely consistent with Congress' efforts and goals to craft patent and trademark law reform through the AIPA.

The United States Copyright Office periodically forwards to Congress recommendations for technical corrections to title 17, the Copyright Act. S. 320 implements many of those recommendations. S.320 corrects errors in references, spelling, and punctuation; conforms the table of contents with section headings; restores the definitions in chapter 1 to alphabetical order; deletes an expired paragraph; and creates continuity in the grammatical style used throughout title 17. These are necessary amendments which clarify U.S. Copyright law.

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[1] Intellectual Property and Communications Omnibus Reform Act of 1999, S. 1948, P.L. No. 106–113 (Nov. 1999).

[2] The Trademark Act of 1946, July 5, 1946, 15 U.S.C. 1501 *et seq.*

On February 14, 2001, the Senate passed S. 320 by a recorded vote of 98–0. That same day, Representative Coble, Chairman of the Subcommittee on Courts, the Internet and Intellectual Property, and the Subcommittee Ranking Member, Mr. Berman, introduced two related technical corrections bills in the House: H.R. 614, the "Copyright Technical Corrections Act of 2001," and H.R.615, the "Intellectual Property Technical Amendments Act of 2001." In the 106th Congress, the House passed virtually identical technical corrections bills under suspension of the rules: H.R. 4870, the "Intellectual Property Technical Amendments Act of 2000," and, H.R. 5106, the "Copyright Technical Corrections Act of 2000." The Senate failed to pass these bills during the final days of the 106th Congress.

Review of S.320 revealed the need to correct typos that exist in the Senate-passed text. S. 320, as amended by the Committee on the Judiciary, makes additional technical and clerical changes.

COMMITTEE CONSIDERATION

On March 8, 2001, the Committee met in open session and ordered favorably reported the bill S. 320, with an amendment in the Nature of a Substitute, by voice vote, a quorum being present.

COMMITTEE OVERSIGHT FINDINGS

In compliance with clause 3(c)(1) of rule XIII of the Rules of the House of Representatives, the Committee reports that the findings and recommendations of the Committee, based on oversight activities under clause 2(b)(1) of rule X of the Rules of the House of Representatives, are incorporated in the descriptive portions of this report.

PERFORMANCE GOALS AND OBJECTIVES

S. 320 does not authorize funding; therefore, clase 3(c) of rule XIII of the Rules of the House of Representatives is inapplicable.

NEW BUDGET AND TAX EXPENDITURES

Clause 3(c)(2) of House rule XIII is inapplicable because this legislation does not provide new budgetary authority or increased tax expenditures.

CONGRESSIONAL BUDGET OFFICE COST ESTIMATE

In compliance with clause 3(c)(3) of rule XIII of the Rules of the House of Representatives, the Committee sets forth, with respect to the bill, S. 320, the following estimate and comparison prepared by the Director of the Congressional Budget Office under section 402 of the Congressional Budget Act of 1974:

U.S. CONGRESS,
CONGRESSIONAL BUDGET OFFICE,
Washington, DC, March 12, 2001.

Hon. F. JAMES SENSENBRENNER, Jr., *Chairman,*
Committee on the Judiciary,
House of Representatives, Washington, DC.

DEAR MR. CHAIRMAN: The Congressional Budget Office has prepared the enclosed cost estimate for S. 320, the Intellectual Property and High Technology Technical Amendments Act of 2001.

If you wish further details on this estimate, we will be pleased to provide them. The CBO staff contact is Ken Johnson.

Sincerely,

DAN L. CRIPPEN, *Director.*

Enclosure.

S. 320—Intellectual Property and High Technology Technical Amendments Act of 2001.

S. 320 contains a number of minor corrections to current patent and trademark law. The act also would make technical changes to several sections of law related to copyrights.

CBO estimates that enacting S. 320 would have no significant impact on the federal budget because its provisions are all technical in nature. Because the act would not affect direct spending or receipts, pay-as-you-go procedures would not apply.

S. 320 contains no intergovernmental or private-sector mandates as defined in the Unfunded Mandates Reform Act and would impose no costs on state, local, or tribal governments.

The CBO staff contact for this estimate is Ken Johnson. This estimate was approved by Robert A. Sunshine, Assistant Director for Budget Analysis.

CONSTITUTIONAL AUTHORITY STATEMENT

Pursuant to clause 3(d)(1) of the rule XIII of the Rules of the House of Representatives, the Committee finds the authority for this legislation in Article I, section 8, clause 8, of the Constitution.

SECTION-BY-SECTION ANALYSIS AND DISCUSSION

SEC. 1. SHORT TITLE.

The act may be cited as the "Intellectual Property and High Technology Technical Amendments Act of 2001."

SEC. 2. OFFICERS AND EMPLOYEES.

The AIPA changed the titles of key officers of the PTO. Briefly, the head of the agency was given the title of Director (formerly "Commissioner"). The chief officer for the patent operations was given the title of Managing Director for Patents (formerly "Assistant Commissioner for Patents"). The chief officer for trademark operations was given the title of Managing Director for Trademarks (formerly "Assistant Commissioner for Trademarks"). After review, the PTO has requested that these officer titles revert to their traditional names because the new titles may cause confusion, are contrary to our international efforts, and may upset case law on a va-

riety of subjects. This section merely renames the titles of the PTO officers appropriately throughout the United States Code and revises such references throughout Federal law, Executive order, rule, regulation, and other specified documents.

SEC. 3. CLARIFICATION OF REEXAMINATION PROCEDURE ACT OF 1999; TECHNICAL AMENDMENTS.

Reexamination is an administrative proceeding in which a patent may be reviewed in light of new evidence affecting its patentability ("prior art").[3] Traditionally, reexamination operated only between the patent owner and the PTO *(ex parte)*. As part of the AIPA, a new *inter partes* reexamination procedure was established to allow a third party also to challenge the validity of a patent or its claims through the introduction of new evidence. While this *inter partes* procedure is considered beneficial because it provides cost savings over court litigation, some critics were concerned it would be abused. As a result, reexamination through the *inter partes* mechanism was designed with certain limitations (e.g., estoppel provisions) which do not apply in *ex parte* reexamination under the Patent Act.

Section 3 of the bill merely clarifies the Patent Act's *inter partes* reexamination section by stipulating that it will apply to the proper parties and operate as envisioned. For example, the term "third-party requester" is inserted in lieu of "persons," since only a third party may invoke this *inter partes* reexamination. This is logical because a patent owner has more rights under ex parte reexamination and would not choose to use the *inter partes* procedures even if available.

The bill, under paragraph (c), specifies that the effective date of these reexamination procedures shall apply to any reexamination on or after the date of the act's enactment.

SEC. 4. PATENT AND TRADEMARK EFFICIENCY ACT AMENDMENTS.

The AIPA contained a title (the "Patent and Trademark Efficiency Act") to modernize the PTO by transforming it into a more autonomous and efficient agency. The first section of the bill clarifies the status and authority of the Deputy Director of the PTO under this reorganization.

The amendments made by the succeeding two paragraphs also conform the membership of the Trademark Trial and Appeal Board and the Board of Patent Appeals and Interferences to include the Deputy Director, as under current statute.

Subsection (b) amends section 5, chapter 1, of title 35. The employees of the PTO are currently prohibited from having an ownership interest in patents.[4] Members of the newly-established Public Advisory Committee are currently considered employees of the Office. Currently, those individuals who possess the most thorough understanding of the patent system (for example, independent inventors) are prohibited from participating on the Public Advisory Committee. This subsection eases this restriction on those serving on the Public Advisory Committee in light of the goals of the AIPA.

[3] 35 U.S.C. § 301 *et seq.*
[4] 35 U.S.C. § 4.

Section (c) eliminates the need for a signature to be attested on a patent grant. This amendment removes one step of the agency's bureaucracy and allows the PTO to issue patents more expeditiously.

SEC. 5. DOMESTIC PUBLICATION OF FOREIGN FILED PATENT APPLICATIONS ACT OF 1999 AMENDMENTS.

The AIPA established the early publication of patent applications in the U.S. patent system for the first time along with certain conditions and new rights for inventors. One such right is a corresponding provisional right (e.g., a reasonable royalty) in patent infringement cases. These provisions will take effect 1 year after the AIPA's date of enactment. This section of the bill is technical in nature and clarifies the text regarding the statutory requirement for the effective date of international applications which may qualify for the provisional rights based on early publication.

SEC. 6. DOMESTIC PUBLICATION OF PATENT APPLICATIONS PUBLISHED ABROAD.

The AIPA established the early publication of patent applications, as described above. One consequence of early publication is its effect on the standard of novelty for a patent application. This section and the following paragraphs establish certain safeguards regarding the interplay of the early publication of patent applications and the review of novelty during the patent examination process. It is an especially important safeguard in light of the fact that the U.S. is a signatory of the Patent Cooperation Treaty, an international convention allowing for the multi-national application of patents in several languages.

Subsection 1 contains a safeguard that the PTO will only rely on information published in English in patent applications as it makes the essential determination of novelty during the examination of a patent application. This limits the evidence from foreign applications that may be considered "prior art" and could affect patentability. This is an important safeguard for independent inventors and small American businesses who do not have access to expensive translation services and the foreign patent offices.

Subsection 2 makes a series of technical and clerical amendments, including changes to section 4507 of IPCORA. The following section, subsection 3, clarifies the effective date of the new safeguard and ensures that it takes effect along with the other early publication provisions later this year. The AIPA established the early publication of certain patent applications starting on November 29, 2000. The effective date language relating to section 102(e) of the patent code relates to when the amended version of the statute creates "prior art" by virtue of the publication of a patent specification. All currently pending applications for patent and all issued U.S. patents, whenever filed, will be subject to any prior art created by virtue of amended section 102(e) since the AIPA does nothing to alter the controlling U.S. Supreme Court precedent holding that a patent specification publication is constructively deemed prior art from its U.S. filing date.[5]

[5] See Alexander Milburn v. Davis-Bournonville Co., 270 U.S. 390 (1926).

SEC. 7. MISCELLANEOUS CLERICAL AMENDMENTS.

The section contains a series of highly technical clerical amendments developed by the Office of Legislative Counsel upon its own initiative. These changes to the Patent Act are self-evident, and range from aligning paragraphs, deleting quotation marks, correcting the fonts of headings, and the like.

SEC. 8. TECHNICAL CORRECTIONS IN TRADEMARK LAW.

The first paragraph clarifies the statutory text of the Trademark Act as it relates to damages. In 1999, the "Anti-Cybersquatting Consumer Protection Act"[6] established certain damages for willful violation of § 43(c) of the Trademark Act.[7] The present language entitles a plaintiff to damages, but it reads awkwardly. This bill makes a technical correction to the text and thereby removes the redundant text, without altering the substance of available trademark infringement remedies.

The second paragraph provides for additional technical amendments, including four strictly clerical changes, such as the deletion of a comma and the realignment of a paragraph. The bill also makes additional changes to the Trademark Act regarding the designation of persons involved with the filing procedures for receiving notice and process correspondence relating to the trademark registration.

SEC. 9. PATENT AND TRADEMARK FEE CLERICAL AMENDMENT.

Section 9 corrects a clerical error pertaining to the section of the law cited relating to the adjustment of trademark fees and the consumer price index. The change to the cited reference does not make a substantive change in trademark law.

SEC. 10. COPYRIGHT RELATED CORRECTIONS TO 1999 OMNIBUS REFORM ACT.

This section makes amendments to Title I of IPCORA.

Paragraph (1)(A) amends section 1007(2) by striking "paragraph (2)" and inserting "paragraph (2)(A)".

Paragraph (1)(B) amends section 1007(3) by striking "1005(e)" and inserting "1005(d)". In section 1007(3), the amendment instructions require paragraph 12 to be added to subsection 119(a) "as amended by section 1005(e)". The reference to section 1005(e) is wrong. Section 1005(d) amended subsection 119(a), whereas section 1005(e) amended subsection 119(d). Section 1005(d) amended subsection 119(a) by adding paragraph 11. Section 1005(e) amended subsection 119(d) by rewriting its paragraph 11. This amendment corrects this.

Paragraph (2) amends section 1006(b) by striking "119(b)(1)(B)(iii)" and inserting "119(b)(1)(B)(ii)". Section 1006(b) amended section 119(b)(1)(B)(iii) by inserting "or the Public Broadcasting Service satellite feed" after "network station". Section 119(b)(1)(B)(ii), not (iii), should have been amended. Section 119(b)(1)(B)(iii) contains no reference to "network station". Section

[6] H.R.3194, P. L. 106–113 (Nov. 29, 1999).
[7] 15 U.S.C. § 1125(c).

119(b)(1)(B)(ii) does contain that reference, and it is clear that section 1006(b) was intended to amend section 119(b)(1)(B)(ii).

Paragraphs (3)(A) and (3)(B) amend section 1006(a)(2) by repealing it, redesignating the paragraphs and changing the language in section 1011(b). The amendment in section 1006(b)(2) amends section 119(a)(1) by inserting new wording so that the text will read as follows, with the new wording italicized: "primary transmission made by a superstation *or by the Public Broadcasting Service satellite feed* and embodying a performance or display of a work".

The amendment in section 1011(b)(2)(A) subsequently amends the same language but does not take the first amendment into account. It directs that section 119(a)(1) be amended to delete "primary transmission made by a superstation and embodying a performance or display of a work" (ignoring the fact that *"or by the Public Broadcasting Service satellite feed"* has been inserted into the middle of that phrase). In lieu of that phrase, it inserts "performance or display of a work embodied in a primary transmission made by a superstation" (but without taking into account the addition of *"or by the Public Broadcasting Service satellite feed"*). As a result, it is unclear what is to be done with the phrase *"or by the Public Broadcasting Service satellite feed"*. Although the intent is clear, the language of sections 1006(a)(2) and 1011(b)(2)(A) does not necessarily accomplish the intended result. These paragraphs clarify the ambiguity and achieve the intended result.

SEC. 11. AMENDMENTS TO TITLE 17, UNITED STATES CODE.

This section makes amendments to title 17, United States Code.

Paragraph (1) amends section 119(a)(6) by striking "of performance" and inserting "of a performance". Section 1011(b)(2) of IPCORA amended section 119(a)(6) so that "performance or display of a work embodied in" is inserted after "by a satellite carrier of". The word "a" is missing between these two phrases. This section inserts it before "performance" so that the language will read "by a satellite carrier of a performance or display of a work embodied in".

Paragraph (2)(A) amends the section heading for section 122 by striking "rights; secondary" and inserting "rights: Secondary". Section 1002(a) of IPCORA added section 122 to title 17. The title of section 122 has editorial errors. To make it consistent with the style used throughout title 17, the title is changed to substitute a colon in lieu of the semicolon and "secondary" is capitalized. Paragraph (2)(B) amends the item relating to section 122 in the table of contents for chapter 1 to make it consistent with the change made by paragraph (2)(A).

Paragraph (3)(A) amends the section heading for section 121 by striking "reproduction" and inserting "Reproduction". Paragraph 3(B) amends the item relating to section 121 in the table of contents for chapter 1 by striking "reproduction" and inserting "Reproduction". This makes the heading for section 121 and the table of contents for chapter 1 conform to the editorial style used for the rest of the headings for title 17 by capitalizing "reproduction".

Paragraphs (4)(A), (4)(B), and (4)(C) amend cross references to the limitations on exclusive rights in copyright to include section 122. Throughout title 17, such references to "121" are changed to "122". Paragraph 4(A) amends section 106 by striking "107 through

121" and inserting "107 through 122". Paragraph (4)(B) amends section 501(a) by striking "106 through 121" and inserting "106 through 122". Paragraph (4)(C) amends section 511(a) by striking "106 through 121" and inserting "106 through 122".

Paragraph (5)(A) amends section 101 by moving the definition of "computer program" so that it appears after the definition of "compilation". Paragraph (5)(B) amends section 101 by moving the definition of "registration" so that it appears after the definition of "publicly". This amendment ensures that the definitions appear in alphabetical order.

Paragraph (6) amends section 110(4)(B) in the matter preceding clause (i) by striking "conditions;" and inserting "conditions:". A colon is the proper punctuation when a phrase that introduces multiple subparts is worded to include "the following".

Paragraph (7) amends section 118(b)(1) in the second sentence by striking "to it". This section was amended by the Copyright Royalty Tribunal Reform Act of 1993 to substitute "Librarian of Congress" for references to the "Copyright Royalty Tribunal" (CRT). As originally enacted by the Copyright Act of 1976, the second sentence in subsection(b) used the pronoun "it" to refer to the CRT. As amended in 1993, the sentence now states, "The Librarian of Congress shall proceed on the basis of the proposals submitted *to it*. . . ." This amendment corrects that reference.

Paragraphs (8)(A) and (B) amend section 119(b)(1)(A). Paragraph (A) strikes "transmitted" and inserts "retransmitted". Paragraph (B) strikes "transmissions" and inserts "retransmissions". These paragraphs correct two drafting errors in section 119(b)(1)(A) when it was enacted by the Satellite Home Viewer Act of 1988.

Paragraphs (9)(A), (B) and (C) amend section 203(a)(2). Paragraph (9)(A)(i) amends subparagraph (A) by striking "(A) the" and inserts "(A) The". Paragraph (9)(A)(ii) amends subparagraph (A) by striking the semicolon at the end and inserting a period. Paragraph (9)(B)(i) amends subparagraph (B) by striking "(B) the" and inserting "(B) The". Paragraph (9)(B)(ii) amends subparagraph (B) by striking the semicolon at the end and inserting a period. Paragraph (9)(C) amends subparagraph (C) by striking "(C) the" and inserting "(C) The".

Paragraphs (10)(A), (B) and (C) amend section 304(c)(2). Paragraph (10)(A)(i) amends subparagraph (A) by striking "(A) the" and inserting "(A) The". Paragraph (10)(A)(ii) amends subparagraph (A) by striking the semicolon at the end and inserting a period. Paragraph (10)(B)(i) amends subparagraph (B) by striking "(B) the" and inserting "(B) The". Paragraph (10)(B)(ii) amends subparagraph (B) by striking the semicolon at the end and inserting a period. Paragraph (10)(C) amends subparagraph (C) by striking "(C) the" and inserting "(C) The". The addition of subparagraph (C) to sections 203(a)(2) and 304(c)(2) resulted in inconsistent punctuation and this amendment makes the punctuation in sections 203(a)(2) and 304(c)(2) internally consistent.

Paragraph (11) amends the item relating to section 903 in the table of contents for chapter 9 by striking "licensure" and inserting "licensing". As originally enacted in 1984, the table of contents for chapter 9 and the text each had a different heading for section 903. The heading in the text was the same as it is now, which is "Ownership, transfer, licensing, and recordation". The heading in the

table of contents was, "Ownership and transfer.". In 1997, a technical amendment changed the heading in the table of sections to its present form, which is, "Ownership, transfer, licensure, and recordation.". The 1997 amendment did not change the heading in the text to make it the same. This amendment makes both the table of contents and the heading in the text the same.

Paragraph (12) amends section 109 by striking subsection (e). Section 803 of the Computer Software Rental Amendments Act of 1990 amended section 109 of title 17 by adding subsection (e). According to section 804(c) the amendments made by section 803 shall not apply to public performances or displays that occur on or after October 1, 1995. Therefore, section 109 is expired.

SEC. 12. OTHER COPYRIGHT RELATED TECHNICAL AMENDMENTS.

This section makes other technical and conforming amendments. Paragraph (a) amends title 18, section 2319(e)(2) by striking "107 through 120" and inserting "107 through 122". Paragraph (b)(1) and (2) correct an incorrect reference to an uncodified title. It is incorrect to directly cite to an uncodified title.

CHANGES IN EXISTING LAW MADE BY THE BILL, AS REPORTED

In compliance with clause 3(e) of rule XIII of the Rules of the House of Representatives, changes in existing law made by the bill, as reported, are shown as follows (existing law proposed to be omitted is enclosed in black brackets, new matter is printed in italics, existing law in which no change is proposed is shown in roman):

TITLE 35, UNITED STATES CODE

* * * * * * *

PART I—UNITED STATES PATENT AND TRADEMARK OFFICE

Chap.		Sec.
1.	**Establishment, Officers and Employees, Functions**	**1**
	* * * * * * *	
3.	**Practice [before] *Before* Patent and Trademark Office**	**31**
	* * * * * * *	

CHAPTER 1—ESTABLISHMENT, OFFICERS AND EMPLOYEES, FUNCTIONS

* * * * * * *

§ 2. Powers and duties

(a) * * *

(b) SPECIFIC POWERS.—The Office—

(1) * * *

(2) may establish regulations, not inconsistent with law, which—

(A) shall govern the conduct of proceedings in the Office;

(B) shall be made in accordance with section 553 of title 5[, United States Code];

* * * * * * *

(4)(A) * * *

(B) may enter into and perform such purchases and contracts for printing services, including the process of composition, platemaking, presswork, silk screen processes, binding, microform, and the products of such processes, as it considers necessary to carry out the functions of the Office, without regard to sections 501 through 517 and 1101 through 1123 of title 44[, United States Code];

* * * * * * *

(6) may, when the [Director] *Commissioner* determines that it is practicable, efficient, and cost-effective to do so, use, with the consent of the United States and the agency, instrumentality, Patent and Trademark Office, or international organization concerned, the services, records, facilities, or personnel of any State or local government agency or instrumentality or foreign patent and trademark office or international organization to perform functions on its behalf;

* * * * * * *

(c) CLARIFICATION OF SPECIFIC POWERS.—(1) * * *

* * * * * * *

(4) In exercising the [Director's] *Commissioner's* powers under paragraphs (3) and (4)(A) of subsection (b), the [Director] *Commissioner* shall consult with the Administrator of General Services.

(5) In exercising the [Director's] *Commissioner's* powers and duties under this section, the [Director] *Commissioner* shall consult with the Register of Copyrights on all copyright and related matters.

* * * * * * *

§ 3. Officers and employees

(a) UNDER SECRETARY AND [DIRECTOR] *COMMISSIONER*.—

(1) IN GENERAL.—The powers and duties of the United States Patent and Trademark Office shall be vested in an Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office (in this title referred to as the "[Director] *Commissioner*"), who shall be a citizen of the United States and who shall be appointed by the President, by and with the advice and consent of the Senate. The [Director] *Commissioner* shall be a person who has a professional background and experience in patent or trademark law.

(2) DUTIES.—

(A) IN GENERAL.—The [Director] *Commissioner* shall be responsible for providing policy direction and management supervision for the Office and for the issuance of patents and the registration of trademarks. The [Director] *Commissioner* shall perform these duties in a fair, impartial, and equitable manner.

(B) CONSULTING WITH THE PUBLIC ADVISORY COMMITTEES.—The [Director] *Commissioner* shall consult with the Patent Public Advisory Committee established in section 5 on a regular basis on matters relating to the patent operations of the Office, shall consult with the Trademark Public Advisory Committee established in section 5 on a regular basis on matters relating to the trademark operations of the Office, and shall consult with the respective Public Advisory Committee before submitting budgetary proposals to the Office of Management and Budget or changing or proposing to change patent or trademark user fees or patent or trademark regulations which are subject to the requirement to provide notice and opportunity for public comment under section 553 of title 5, [United States Code,] as the case may be.

(3) OATH.—The [Director] *Commissioner* shall, before taking office, take an oath to discharge faithfully the duties of the Office.

(4) REMOVAL.—The [Director] *Commissioner* may be removed from office by the President. The President shall provide notification of any such removal to both Houses of Congress.

(b) OFFICERS AND EMPLOYEES OF THE OFFICE.—

(1) DEPUTY UNDER SECRETARY AND DEPUTY [DIRECTOR] *COMMISSIONER*.—The Secretary of Commerce, upon nomination by the [Director] *Commissioner*, shall appoint a Deputy Under Secretary of Commerce for Intellectual Property and Deputy [Director] *Commissioner* of the United States Patent and Trademark Office who shall be vested with the authority to act in the capacity of the [Director] *Commissioner* in the event of the absence or incapacity of the [Director] *Commissioner*. The Deputy [Director] *Commissioner* shall be a citizen of the United States who has a professional background and experience in patent or trademark law.

(2) [COMMISSIONERS] *ASSISTANT COMMISSIONERS*.—

(A) APPOINTMENT AND DUTIES.—The Secretary of Commerce shall appoint a [Commissioner for Patents] *Assistant Commissioner for Patents* and a [Commissioner for Trademarks] *Assistant Commissioner for Trademarks*, without regard to chapter 33, 51, or 53 of title 5[, United States Code]. The [Commissioner for Patents] *Assistant Commissioner for Patents* shall be a citizen of the United States with demonstrated management ability and professional background and experience in patent law and serve for a term of 5 years. The [Commissioner for Trademarks] *Assistant Commissioner for Trademarks* shall be a citizen of the United States with demonstrated management ability and professional background and experience in trademark law and serve for a term of 5 years. The [Commissioner for Patents] *Assistant Commissioner for Patents* and the [Commissioner for Trademarks] *Assistant Commissioner for Trademarks* shall serve as the chief operating officers for the operations of the Office relating to patents and trademarks, respectively, and shall be responsible for the management and direction of all aspects of

the activities of the Office that affect the administration of patent and trademark operations, respectively. The Secretary may reappoint [a] *an Assistant* Commissioner to subsequent terms of 5 years as long as the performance of the *Assistant* Commissioner as set forth in the performance agreement in subparagraph (B) is satisfactory.

(B) SALARY AND PERFORMANCE AGREEMENT.—The *Assistant* Commissioners shall be paid an annual rate of basic pay not to exceed the maximum rate of basic pay for the Senior Executive Service established under section 5382 of title 5, [United States Code,] including any applicable locality-based comparability payment that may be authorized under section 5304(h)(2)(C) of title 5[, United States Code]. The compensation of the *Assistant* Commissioners shall be considered, for purposes of section 207(c)(2)(A) of title 18, [United States Code,] to be the equivalent of that described under clause (ii) of section 207(c)(2)(A) of title 18[, United States Code]. In addition, the *Assistant* Commissioners may receive a bonus in an amount of up to, but not in excess of, 50 percent of the *Assistant* Commissioners' annual rate of basic pay, based upon an evaluation by the Secretary of Commerce, acting through the [Director] *Commissioner*, of the *Assistant* Commissioners' performance as defined in an annual performance agreement between the *Assistant* Commissioners and the Secretary. The annual performance agreements shall incorporate measurable organization and individual goals in key operational areas as delineated in an annual performance plan agreed to by the *Assistant* Commissioners and the Secretary. Payment of a bonus under this subparagraph may be made to the *Assistant* Commissioners only to the extent that such payment does not cause the *Assistant* Commissioners' total aggregate compensation in a calendar year to equal or exceed the amount of the salary of the Vice President under section 104 of title 3[, United States Code].

(C) REMOVAL.—The *Assistant* Commissioners may be removed from office by the Secretary for misconduct or nonsatisfactory performance under the performance agreement described in subparagraph (B), without regard to the provisions of title 5[, United States Code]. The Secretary shall provide notification of any such removal to both Houses of Congress.

(3) OTHER OFFICERS AND EMPLOYEES.—The [Director] *Commissioner* shall—

(A) appoint such officers, employees (including attorneys), and agents of the Office as the [Director] *Commissioner* considers necessary to carry out the functions of the Office; and

(B) define the title, authority, and duties of such officers and employees and delegate to them such of the powers vested in the Office as the [Director] *Commissioner* may determine.

The Office shall not be subject to any administratively or statutorily imposed limitation on positions or personnel, and no

positions or personnel of the Office shall be taken into account for purposes of applying any such limitation.

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(5) NATIONAL SECURITY POSITIONS.—The [Director] *Commissioner*, in consultation with the Director of the Office of Personnel Management, shall maintain a program for identifying national security positions and providing for appropriate security clearances, in order to maintain the secrecy of certain inventions, as described in section 181, and to prevent disclosure of sensitive and strategic information in the interest of national security.

(c) CONTINUED APPLICABILITY OF TITLE 5[, UNITED STATES CODE].—Officers and employees of the Office shall be subject to the provisions of title 5, [United States Code,] relating to Federal employees.

* * * * * * *

(e) CARRYOVER OF PERSONNEL.—

(1) * * *

(2) OTHER PERSONNEL.—Any individual who, on the day before the effective date of the Patent and Trademark Office Efficiency Act, is an officer or employee of the Department of Commerce (other than an officer or employee under paragraph (1)) shall be transferred to the Office, as necessary to carry out the purposes of this Act, if—

(A) * * *

* * * * * * *

(C) such transfer would be in the interest of the Office, as determined by the Secretary of Commerce in consultation with the [Director] *Commissioner*.

Any transfer under this paragraph shall be effective as of the same effective date as referred to in paragraph (1), and shall be made without a break in service.

(f) TRANSITION PROVISIONS.—

(1) INTERIM APPOINTMENT OF [DIRECTOR] *COMMISSIONER*.—On or after the effective date of the Patent and Trademark Office Efficiency Act, the President shall appoint an individual to serve as the [Director] *Commissioner* until the date on which a [Director] *Commissioner* qualifies under subsection (a). The President shall not make more than one such appointment under this subsection.

(2) CONTINUATION IN OFFICE OF CERTAIN OFFICERS.—(A) The individual serving as the Assistant Commissioner for Patents on the day before the effective date of the Patent and Trademark Office Efficiency Act may serve as the *Assistant* Commissioner for Patents until the date on which [a] *an Assistant* Commissioner for Patents is appointed under subsection (b).

(B) The individual serving as the Assistant Commissioner for Trademarks on the day before the effective date of the Patent and Trademark Office Efficiency Act may serve as the *Assistant* Commissioner for Trademarks until the date on which

[a] *an Assistant* Commissioner for Trademarks is appointed under subsection (b).

* * * * * * *

§ 5. Patent and Trademark Office Public Advisory Committees

(a) * * *

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(d) DUTIES.—Each Advisory Committee shall—

(1) review the policies, goals, performance, budget, and user fees of the United States Patent and Trademark Office with respect to patents, in the case of the Patent Public Advisory Committee, and with respect to Trademarks, in the case of the Trademark Public Advisory Committee, and advise the [Director] *Commissioner* on these matters;

* * * * * * *

(e) COMPENSATION.—Each member of each Advisory Committee shall be compensated for each day (including travel time) during which such member is attending meetings or conferences of that Advisory Committee or otherwise engaged in the business of that Advisory Committee, at the rate which is the daily equivalent of the annual rate of basic pay in effect for level III of the Executive Schedule under section 5314 of title 5[, United States Code]. While away from such member's home or regular place of business such member shall be allowed travel expenses, including per diem in lieu of subsistence, as authorized by section 5703 of title 5[, United States Code].

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(g) APPLICABILITY OF CERTAIN ETHICS LAWS.—Members of each Advisory Committee shall be special Government employees within the meaning of section 202 of title 18[, United States Code].

* * * * * * *

(i) OPEN MEETINGS.—The meetings of each Advisory Committee shall be open to the public, except that each Advisory Committee may by majority vote meet in executive session when considering personnel*, priviledged,* or other confidential information.

(j) INAPPLICABILITY OF PATENT PROHIBITION.—Section 4 shall not apply to voting members of the Advisory Committees.

§ 6. Board of Patent Appeals and Interferences

(a) ESTABLISHMENT AND COMPOSITION.—There shall be in the United States Patent and Trademark Office a Board of Patent Appeals and Interferences. The [Director] *Commissioner*, *the Deputy Commissioner,* the [Commissioner for Patents] *Assistant Commissioner for Patents*, the [Commissioner for Trademarks] *Assistant Commissioner for Trademarks*, and the administrative patent judges shall constitute the Board. The administrative patent judges shall be persons of competent legal knowledge and scientific ability who are appointed by the [Director] *Commissioner*.

(b) DUTIES.—The Board of Patent Appeals and Interferences shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents and shall determine pri-

ority and patentability of invention in interferences declared under section 135(a). Each appeal and interference shall be heard by at least three members of the Board, who shall be designated by the [Director] *Commissioner*. Only the Board of Patent Appeals and Interferences may grant rehearings.

§ 7. Library

The [Director] *Commissioner* shall maintain a library of scientific and other works and periodicals, both foreign and domestic, in the Patent and Trademark Office to aid the officers in the discharge of their duties.

§ 8. Classification of patents

The [Director] *Commissioner* may revise and maintain the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patent are filed.

§ 9. Certified copies of records

The [Director] *Commissioner* may furnish certified copies of specifications and drawings of patents issued by the Patent and Trademark Office, and of other records available either to the public or to the person applying therefor.

§ 10. Publications

(a) The [Director] *Commissioner* may publish in printed, typewritten, or electronic form, the following:

* * * * * * *

(b) The [Director] *Commissioner* may exchange any of the publications specified in items 3, 4, 5, and 6 of subsection (a) of this section for publications desirable for the use of the Patent and Trademark Office.

§ 11. Exchange of copies of patents with foreign countries

The [Director] *Commissioner* may exchange copies of specifications and drawings of United States patents for those of foreign countries. The [Director] *Commissioner* shall not enter into an agreement to provide such copies of specifications and drawings of United States patents and applications to a foreign country, other than a NAFTA country or a WTO member country, without the express authorization of the Secretary of Commerce. For purposes of this section, the terms "NAFTA country" and "WTO member country" have the meanings given those terms in section 104(b).

§ 12. Copies of patents for public libraries

The [Director] *Commissioner* may supply printed copies of specifications and drawings of patents to public libraries in the United States which shall maintain such copies for the use of the public, at the rate for each year's issue established for this purpose in section 41(d) of this title.

§ 13. Annual report to Congress

The [Director] *Commissioner* shall report to the Congress, not later than 180 days after the end of each fiscal year, the moneys received and expended by the Office, the purposes for which the moneys were spent, the quality and quantity of the work of the Office, the nature of training provided to examiners, the evaluation of the [Commissioner of] *Assistant Commissioner for* Patents and the [Commissioner of] *Assistant Commissioner for* Trademarks by the Secretary of Commerce, the compensation of the *Assistant* Commissioners, and other information relating to the Office.

CHAPTER 2—PROCEEDINGS IN THE PATENT AND TRADEMARK OFFICE

Sec.
[21. Day for taking action falling on Saturday, Sunday, or holiday.]
21. Filing date and day for taking action.

* * * * * * *

§ 21. Filing date and day for taking action

(a) The [Director] *Commissioner* may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the [Director] *Commissioner*.

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§ 22. Printing of papers filed

The [Director] *Commissioner* may require papers filed in the Patent and Trademark Office to be printed, typewritten, or on an electronic medium.

§ 23. Testimony in Patent and Trademark Office cases

The [Director] *Commissioner* may establish rules for taking affidavits and depositions required in cases in the Patent and Trademark Office. Any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where he resides, may take such affidavits and depositions.

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§ 25. Declaration in lieu of oath

(a) The [Director] *Commissioner* may by rule prescribe that any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration in such form as the [Director] *Commissioner* may prescribe, such declaration to be in lieu of the oath otherwise required.

(b) Whenever such written declaration is used, the document must warn the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001).

§ 26. Effect of defective execution

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be executed in a specified manner may be provisionally accepted by the [Director] *Commissioner* despite a defective execution, provided a properly executed document is submitted within such time as may be prescribed.

CHAPTER 3—PRACTICE BEFORE PATENT AND TRADEMARK OFFICE

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§ 32. Suspension or exclusion from practice

The [Director] *Commissioner* may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent and Trademark Office, any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 2(b)(2)(D) of this title, or who shall, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The [Director] *Commissioner* shall have the discretion to designate any attorney who is an officer or employee of the United States Patent and Trademark Office to conduct the hearing required by this section. The United States District Court for the District of Columbia, under such conditions and upon such proceedings as it by its rules determines, may review the action of the [Director] *Commissioner* upon the petition of the person so refused recognition or so suspended or excluded.

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CHAPTER 4—PATENT FEES; FUNDING; SEARCH SYSTEMS

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§ 41. Patent fees; patent and trademark search systems

(a) The [Director] *Commissioner* shall charge the following fees:

(1) * * *

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(8) For petitions for 1-month extensions of time to take actions required by the [Director] *Commissioner* in an application—

(A) * * *

* * * * * * *

For the purpose of computing fees, a multiple dependent claim referred to in section 112 of this title or any claim depending therefrom shall be considered as separate dependent claims in accordance with the number of claims to which reference is made. Errors

in payment of the additional fees may be rectified in accordance with regulations of the [Director] *Commissioner*.

(b) The [Director] *Commissioner* shall charge the following fees for maintaining in force all patents based on applications filed on or after December 12, 1980:

(1) * * *

* * * * * * *

Unless payment of the applicable maintenance fee is received in the Patent and Trademark Office on or before the date the fee is due or within a grace period of 6 months thereafter, the patent will expire as of the end of such grace period. The [Director] *Commissioner* may require the payment of a surcharge as a condition of accepting within such 6-month grace period the payment of an applicable maintenance fee. No fee may be established for maintaining a design or plant patent in force.

(c)(1) The [Director] *Commissioner* may accept the payment of any maintenance fee required by subsection (b) of this section which is made within twenty-four months after the six-month grace period if the delay is shown to the satisfaction of the [Director] *Commissioner* to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the [Director] *Commissioner* to have been unavoidable. The [Director] *Commissioner* may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-month grace period. If the [Director] *Commissioner* accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.

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(d) The [Director] *Commissioner* shall establish fees for all other processing, services, or materials relating to patents not specified in this section to recover the estimated average cost to the Office of such processing, services, or materials, except that the [Director] *Commissioner* shall charge the following fees for the following services:

(1) * * *

* * * * * * *

(e) The [Director] *Commissioner* may waive the payment of any fee for any service or material related to patents in connection with an occasional or incidental request made by a department or agency of the Government, or any officer thereof. The [Director] *Commissioner* may provide any applicant issued a notice under section 132 of this title with a copy of the specifications and drawings for all patents referred to in that notice without charge.

(f) The fees established in subsections (a) and (b) of this section may be adjusted by the [Director] *Commissioner* on October 1, 1992, and every year thereafter, to reflect any fluctuations occurring during the previous 12 months in the Consumer Price Index, as determined by the Secretary of Labor. Changes of less than 1 per centum may be ignored.

(g) No fee established by the [Director] *Commissioner* under this section shall take effect until at least 30 days after notice of

the fee has been published in the Federal Register and in the Official Gazette of the Patent and Trademark Office.

(h)(1) Fees charged under subsection (a) or (b) shall be reduced by 50 percent with respect to their application to any small business concern as defined under section 3 of the Small Business Act, and to any independent inventor or nonprofit organization as defined in regulations issued by the [Director] *Commissioner*.

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(i)(1) The [Director] *Commissioner* shall maintain, for use by the public, paper, microform, or electronic collections of United States patents, foreign patent documents, and United States trademark registrations arranged to permit search for and retrieval of information. The [Director] *Commissioner* may not impose fees directly for the use of such collections, or for the use of the public patent or trademark search rooms or libraries.

(2) The [Director] *Commissioner* shall provide for the full deployment of the automated search systems of the Patent and Trademark Office so that such systems are available for use by the public, and shall assure full access by the public to, and dissemination of, patent and trademark information, using a variety of automated methods, including electronic bulletin boards and remote access by users to mass storage and retrieval systems.

(3) The [Director] *Commissioner* may establish reasonable fees for access by the public to the automated search systems of the Patent and Trademark Office. If such fees are established, a limited amount of free access shall be made available to users of the systems for purposes of education and training. The [Director] *Commissioner* may waive the payment by an individual of fees authorized by this subsection upon a showing of need or hardship, and if such a waiver is in the public interest.

(4) The [Director] *Commissioner* shall submit to the Congress an annual report on the automated search systems of the Patent and Trademark Office and the access by the public to such systems. The [Director] *Commissioner* shall also publish such report in the Federal Register. The [Director] *Commissioner* shall provide an opportunity for the submission of comments by interested persons on each such report.

§ 42. Patent and Trademark Office funding

(a) All fees for services performed by or materials furnished by the Patent and Trademark Office will be payable to the [Director] *Commissioner*.

(b) All fees paid to the [Director] *Commissioner* and all appropriations for defraying the costs of the activities of the Patent and Trademark Office will be credited to the Patent and Trademark Office Appropriation Account in the Treasury of the United States.

(c) To the extent and in the amounts provided in advance in appropriations Acts, fees authorized in this title or any other Act to be charged or established by the [Director] *Commissioner* shall be collected by and shall be available to the [Director] *Commissioner* to carry out the activities of the Patent and Trademark Office. All fees available to the [Director] *Commissioner* under section 31 of the Trademark Act of 1946 shall be used only for the processing of trademark registrations and for other activities, services, and materials relating to trademarks and to cover a propor-

tionate share of the administrative costs of the Patent and Trademark Office.

(d) The [Director] *Commissioner* may refund any fee paid by mistake or any amount paid in excess of that required.

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PART II—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

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Chap.		Sec.
10.	**Patentability of Inventions**	**100**
*	*	*
[12.	**Examination of Applications**	**131]**
12.	***Examination of Application***	***131***

* * * * * * *

CHAPTER 10—PATENTABILITY OF INVENTIONS

* * * * * * *

§ 104. Invention made abroad

(a) IN GENERAL.—

(1) * * *

* * * * * * *

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

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CHAPTER 11—APPLICATION FOR PATENT

Sec.
111. Application.

* * * * * * *

[116. Joint inventors.]
116. Inventors.

* * * * * * *

§ 111. Application

(a) IN GENERAL.—

(1) WRITTEN APPLICATION.—An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the [Director] *Commissioner*.

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(3) FEE AND OATH.—The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the [Director] *Commissioner*.

(4) FAILURE TO SUBMIT.—Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the [Director] *Commissioner* that the delay in submitting the fee and oath was unavoidable or unintentional. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

(b) PROVISIONAL APPLICATION.—

(1) AUTHORIZATION.—A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the [Director] *Commissioner*. Such application shall include—

(A) * * *

* * * * * * *

(3) FEE.—(A) The application must be accompanied by the fee required by law.

(B) The fee may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the [Director] *Commissioner*.

(C) Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the [Director] *Commissioner* that the delay in submitting the fee was unavoidable or unintentional.

* * * * * * *

(5) ABANDONMENT.—Notwithstanding the absence of a claim, upon timely request and as prescribed by the [Director] *Commissioner*, a provisional application may be treated as an application filed under subsection (a). Subject to section 119(e)(3) of this title, if no such request is made, the provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival after such 12-month period.

(6) OTHER BASIS FOR PROVISIONAL APPLICATION.—Subject to all the conditions in this subsection and section 119(e) of this title, and as prescribed by the [Director] *Commissioner*, an application for patent filed under subsection (a) may be treated as a provisional application for patent.

* * * * * * *

§ 113. Drawings

The applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented. When the nature of such subject matter admits of illustration by a drawing and the applicant has not furnished such a drawing, the [Di-

rector] *Commissioner* may require its submission within a time period of not less than two months from the sending of a notice thereof. Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.

§ 114. Models, specimens

The [Director] *Commissioner* may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the [Director] *Commissioner* may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

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§ 116. Inventors

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The [Director] *Commissioner*, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever through error a person is named in an application for patent as the inventor, or through error an inventor is not named in an application, and such error arose without any deceptive intention on his part, the [Director] *Commissioner* may permit the application to be amended accordingly, under such terms as he prescribes.

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§ 118. Filing by other than inventor

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the [Director] *Commissioner* may grant a patent to such inventor upon such notice to him as the [Director] *Commissioner*

deems sufficient, and on compliance with such regulations as he prescribes.

§ 119. Benefit of earlier filing date; right of priority

(a) * * *

(b) No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent and Trademark Office before the patent is granted, or at such time during the pendency of the application as required by the [Director] *Commissioner* not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The [Director] *Commissioner* may require a translation of the papers filed if not in the English language and such other information as he deems necessary.

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§ 121. Divisional applications

If two or more independent and distinct inventions are claimed in one application, the [Director] *Commissioner* may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the [Director] *Commissioner* may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the [Director] *Commissioner* to require the application to be restricted to one invention.

§ 122. Confidential status of applications

Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the [Director] *Commissioner*.

CHAPTER 12—EXAMINATION OF APPLICATION

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§ 131. Examination of application

The [Director] *Commissioner* shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the [Director] *Commissioner* shall issue a patent therefor.

§ 132. Notice of rejection; reexamination

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the [Director] *Commissioner* shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

(b) The [Director] *Commissioner* shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The [Director] *Commissioner* may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title.

§ 133. Time for prosecuting application

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the [Director] *Commissioner* in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the [Director] *Commissioner* that such delay was unavoidable.

§ 134. Appeal to the Board of Patent Appeals and Interferences

(a) PATENT APPLICANT.—An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the [administrative patent judge] *primary examiner* to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

(b) PATENT OWNER.—A patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the [administrative patent judge] *primary examiner* to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

(c) THIRD-PARTY.—A third-party requester in an inter partes proceeding may appeal to the Board of Patent Appeals and Interferences from the final decision of the [administrative patent judge] *primary examiner* favorable to the patentability of any original or proposed amended or new claim of a patent, having once paid the fee for such appeal. The third-party requester may not appeal the decision of the Board of Patent Appeals and Interferences.

§ 135. Interferences

(a) Whenever an application is made for a patent which, in the opinion of the [Director] *Commissioner*, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the [Director] *Commissioner* shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability. Any final decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent and Trademark Office of the claims involved, and the [Director] *Commissioner* may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved in the patent, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation by the Patent and Trademark Office.

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(c) Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent and Trademark Office before the termination of the interference as between the said parties to the agreement or understanding. If any party filing the same so requests, the copy shall be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person on a showing of good cause. Failure to file the copy of such agreement or understanding shall render permanently unenforceable such agreement or understanding and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved. The [Director] *Commissioner* may, however, on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six-month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

The [Director] *Commissioner* shall give notice to the parties or their attorneys of record, a reasonable time prior to said termination, of the filing requirement of this section. If the [Director] *Commissioner* gives such notice at a later time, irrespective of the right to file such agreement or understanding within the six-month period on a showing of good cause, the parties may file such agreement or understanding within sixty days of the receipt of such notice.

Any discretionary action of the [Director] *Commissioner* under this subsection shall be reviewable under section 10 of the Administrative Procedure Act.

(d) Parties to a patent interference, within such time as may be specified by the [Director] *Commissioner* by regulation, may determine such contest or any aspect thereof by arbitration. Such arbitration shall be governed by the provisions of title 9 to the extent such title is not inconsistent with this section. The parties shall

give notice of any arbitration award to the [Director] *Commissioner*, and such award shall, as between the parties to the arbitration, be dispositive of the issues to which it relates. The arbitration award shall be unenforceable until such notice is given. Nothing in this subsection shall preclude the [Director] *Commissioner* from determining patentability of the invention involved in the interference.

CHAPTER 13—REVIEW OF PATENT AND TRADEMARK OFFICE DECISIONS

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§ 141. Appeal to Court of Appeals for the Federal Circuit

An applicant dissatisfied with the decision in an appeal to the Board of Patent Appeals and Interferences under section 134 of this title may appeal the decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal the applicant waives his or her right to proceed under section 145 of this title. A patent owner in any reexamination proceeding dissatisfied with the final decision in an appeal to the Board of Patent Appeals and Interferences under section 134 may appeal the decision only to the United States Court of Appeals for the Federal Circuit. A party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences on the interference may appeal the decision to the United States Court of Appeals for the Federal Circuit, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal in accordance with section 142 of this title, files notice with the [Director] *Commissioner* that the party elects to have all further proceedings conducted as provided in section 146 of this title. If the appellant does not, within thirty days after the filing of such notice by the adverse party, file a civil action under section 146, the decision appealed from shall govern the further proceedings in the case.

§ 142. Notice of appeal

When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the [Director] *Commissioner*, within such time after the date of the decision from which the appeal is taken as the [Director] *Commissioner* prescribes, but in no case less than 60 days after that date.

§ 143. Proceedings on appeal

With respect to an appeal described in section 142 of this title, the [Director] *Commissioner* shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the [Director] *Commissioner* forward the original or certified copies of such documents during pendency of the appeal. [In any reexamination case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal.] *In an ex parte case or any reexamination case, the Commissioner shall submit to the court in writing the grounds for the*

decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Commissioner and the parties in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the [Director] *Commissioner* and the parties in the appeal.

§ 144. Decision on appeal

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the [Director] *Commissioner* its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

§ 145. Civil action to obtain patent

An applicant dissatisfied with the decision of the Board of Patent Appeals and Interferences in an appeal under section 134(a) of this title may, unless appeal has been taken to the United States Court of Appeals for the Federal Circuit, have remedy by civil action against the [Director] *Commissioner* in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the [Director] *Commissioner* appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Patent Appeals and Interferences, as the facts in the case may appear and such adjudication shall authorize the [Director] *Commissioner* to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

§ 146. Civil action in case of interference

Any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences on the interference, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the [Director] *Commissioner* appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Appeals for the Federal Circuit, and such appeal is pending or has been decided. In such suits the record in the Patent and Trademark Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction

and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The [Director] *Commissioner* shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the [Director] *Commissioner* to issue such patent on the filing in the Patent and Trademark Office of a certified copy of the judgment and on compliance with the requirements of law.

CHAPTER 14—ISSUE OF PATENT

* * * * * * *

§ 151. Issue of patent

If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.

Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof and, if not paid, the patent shall lapse at the termination of this three-month period. In calculating the amount of a remaining balance, charges for a page or less may be disregarded.

If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be accepted by the [Director] *Commissioner* as though no abandonment or lapse had ever occurred.

* * * * * * *

§ 153. How issued

Patents shall be issued in the name of the United States of America, under the seal of the Patent and Trademark Office, and shall be signed by the [Director] *Commissioner* or have his signature placed thereon [and attested by an officer of the Patent and Trademark Office designated by the Director,] and shall be recorded in the Patent and Trademark Office.

§ 154. Contents and term of patent

(a) * * *

* * * * * * *

(b) ADJUSTMENT OF PATENT TERM.—

(1) * * *

* * * * * * *

(2) LIMITATIONS.—

(A) * * *

* * * * * * *

(C) REDUCTION OF PERIOD OF ADJUSTMENT.—

(i) * * *

* * * * * * *

(iii) The [Director] *Commissioner* shall prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

(3) PROCEDURES FOR PATENT TERM ADJUSTMENT DETERMINATION.—

(A) The [Director] *Commissioner* shall prescribe regulations establishing procedures for the application for and determination of patent term adjustments under this subsection.

(B) Under the procedures established under subparagraph (A), the [Director] *Commissioner* shall—

(i) make a determination of the period of any patent term adjustment under this subsection, and shall transmit a notice of that determination with the written notice of allowance of the application under section 151; and

(ii) provide the applicant one opportunity to request reconsideration of any patent term adjustment determination made by the [Director] *Commissioner*.

(C) The [Director] *Commissioner* shall reinstate all or part of the cumulative period of time of an adjustment under paragraph (2)(C) if the applicant, prior to the issuance of the patent, makes a showing that, in spite of all due care, the applicant was unable to respond within the 3-month period, but in no case shall more than three additional months for each such response beyond the original 3-month period be reinstated.

(D) The [Director] *Commissioner* shall proceed to grant the patent after completion of the [Director's] *Commissioner's* determination of a patent term adjustment under the procedures established under this subsection, notwithstanding any appeal taken by the applicant of such determination.

(4) APPEAL OF PATENT TERM ADJUSTMENT DETERMINATION.—

(A) An applicant dissatisfied with a determination made by the [Director] *Commissioner* under paragraph (3) shall have remedy by a civil action against the [Director] *Commissioner* filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent. Chapter 7 of title 5[, United States Code,] shall apply to such action. Any final judgment resulting in a change to the period of adjustment of the patent term shall be served on the [Director] *Commissioner*, and the [Director] *Commissioner* shall thereafter alter the term of the patent to reflect such change.

* * * * * * *

(d) PROVISIONAL RIGHTS.—

(1) * * *

* * * * * * *

(4) REQUIREMENTS FOR INTERNATIONAL APPLICATIONS.—

(A) EFFECTIVE DATE.—The right under paragraph (1) to obtain a reasonable royalty based upon the publication under the treaty defined in section 351(a) of an international application designating the United States shall commence on the date [on which the Patent and Trademark Office receives a copy of the] *of* publication under the treaty of the international application, or, if the publication under the treaty of the international application is in a language other than English, on the date on which the Patent and Trademark Office receives a translation of the [international application] *publication* in the English language.

* * * * * * *

§ 155. Patent term extension

Notwithstanding the provisions of section 154, the term of a patent which encompasses within its scope a composition of matter or a process for using such composition shall be extended if such composition or process has been subjected to a regulatory review by the Federal Food and Drug Administration pursuant to the Federal Food, Drug, and Cosmetic Act leading to the publication of regulation permitting the interstate distribution and sale of such composition or process and for which there has thereafter been a stay of regulation of approval imposed pursuant to section 409 of the Federal Food, Drug, and Cosmetic Act which stay was in effect on January 1, 1981, by a length of time to be measured from the date such stay of regulation of approval was imposed until such proceedings are finally resolved and commercial marketing permitted. The patentee, his heirs, successors or assigns shall notify the [Director] *Commissioner* within ninety days of the date of enactment of this section or the date the stay of regulation of approval has been removed, whichever is later, of the number of the patent to be extended and the date the stay was imposed and the date commercial marketing was permitted. On receipt of such notice, the [Director] *Commissioner* shall promptly issue to the owner of record of the patent a certificate of extension, under seal, stating the fact and length of the extension and identifying the composition of matter or process for using such composition to which such extension is applicable. Such certificate shall be recorded in the official file of each patent extended and such certificate shall be considered as part of the original patent, and an appropriate notice shall be published in the Official Gazette of the Patent and Trademark Office.

§ 155A. Patent term restoration

(a) * * *

* * * * * * *

(c) The patentee of any patent described in subsection (a) of this section shall, within ninety days after the date of enactment of this section, notify the [Director] *Commissioner* of the number

of any patent so extended. On receipt of such notice, the [Director] *Commissioner* shall confirm such extension by placing a notice thereof in the official file of such patent and publishing an appropriate notice of such extension in the Official Gazette of the Patent and Trademark Office.

§ 156. Extension of patent term

(a) * * *

* * * * * * *

(b) Except as provided in subsection (d)(5)(F), the rights derived from any patent the term of which is extended under this section shall during the period during which the term of the patent is extended—

(1) * * *

* * * * * * *

(3) in the case of a patent which claims a method of manufacturing a product, be limited to the method of manufacturing as used to make—

(A) the approved product, or

(B) the product if it has been subject to a regulatory review period described in [paragraphs] *paragraph* (1), (4), or (5) of subsection (g).

As used in this subsection, the term "product" includes an approved product.

* * * * * * *

(d)(1) To obtain an extension of the term of a patent under this section, the owner of record of the patent or its agent shall submit an application to the [Director] *Commissioner*. Except as provided in paragraph (5), such an application may only be submitted within the sixty-day period beginning on the date the product received permission under the provision of law under which the applicable regulatory review period occurred for commercial marketing or use. The application shall contain—

(A) * * *

* * * * * * *

(C) information to enable the [Director] *Commissioner* to determine under subsections (a) and (b) the eligibility of a patent for extension and the rights that will be derived from the extension and information to enable the [Director] *Commissioner* and the Secretary of Health and Human Services or the Secretary of Agriculture to determine the period of the extension under subsection (g);

* * * * * * *

(E) such patent or other information as the [Director] *Commissioner* may require.

(2)(A) Within 60 days of the submittal of an application for extension of the term of a patent under paragraph (1), the [Director] *Commissioner* shall notify—

(i) * * *

* * * * * * *

of the extension application and shall submit to the Secretary who is so notified a copy of the application. Not later than 30 days after

the receipt of an application from the [Director] *Commissioner*, the Secretary receiving the application shall review the dates contained in the application pursuant to paragraph (1)(C) and determine the applicable regulatory review period, shall notify the [Director] *Commissioner* of the determination, and shall publish in the Federal Register a notice of such determination.

(B)(i) If a petition is submitted to the Secretary making the determination under subparagraph (A), not later than 180 days after the publication of the determination under subparagraph (A), upon which it may reasonably be determined that the applicant did not act with due diligence during the applicable regulatory review period, the Secretary making the determination shall, in accordance with regulations promulgated by such Secretary, determine if the applicant acted with due diligence during the applicable regulatory review period. The Secretary making the determination shall make such determination not later than 90 days after the receipt of such a petition. For a drug product, device, or additive subject to the Federal Food, Drug, and Cosmetic Act or the Public Health Service Act, the Secretary may not delegate the authority to make the determination prescribed by this clause to an office below the Office of the [Director] *Commissioner* of Food and Drugs. For a product subject to the Virus-Serum-Toxin Act, the Secretary of Agriculture may not delegate the authority to make the determination prescribed by this clause to an office below the [office] *Office* of the Assistant Secretary for Marketing and Inspection Services.

(ii) The Secretary making a determination under clause (i) shall notify the [Director] *Commissioner* of the determination and shall publish in the Federal Register a notice of such determination together with the factual and legal basis for such determination. Any interested person may request, within the 60-day period beginning on the publication of a determination, the Secretary making the determination to hold an informal hearing on the determination. If such a request is made within such period, such Secretary shall hold such hearing not later than 30 days after the date of the request, or at the request of the person making the request, not later than 60 days after such date. The Secretary who is holding the hearing shall provide notice of the hearing to the owner of the patent involved and to any interested person and provide the owner and any interested person an opportunity to participate in the hearing. Within 30 days after the completion of the hearing, such Secretary shall affirm or revise the determination which was the subject of the hearing and shall notify the [Director] *Commissioner* of any revision of the determination and shall publish any such revision in the Federal Register.

* * * * * * *

(4) An application for the extension of the term of a patent is subject to the disclosure requirements prescribed by the [Director] *Commissioner*.

(5)(A) If the owner of record of the patent or its agent reasonably expects that the applicable regulatory review period described in paragraph (1)(B)(ii), (2)(B)(ii), (3)(B)(ii), (4)(B)(ii), or (5)(B)(ii) of subsection (g) that began for a product that is the subject of such patent may extend beyond the expiration of the patent term in effect, the owner or its agent may submit an application to the [Director] *Commissioner* for an interim extension during the period

beginning 6 months, and ending 15 days, before such term is due to expire. The application shall contain—

(i) * * *

* * * * * * *

(iii) information to enable the [Director] *Commissioner* to determine under subsection (a)(1), (2), and (3) the eligibility of a patent for extension;

* * * * * * *

(v) such patent or other information as the [Director] *Commissioner* may require.

(B) If the [Director] *Commissioner* determines that, except for permission to market or use the product commercially, the patent would be eligible for an extension of the patent term under this section, the [Director] *Commissioner* shall publish in the Federal Register a notice of such determination, including the identity of the product under regulatory review, and shall issue to the applicant a certificate of interim extension for a period of not more than 1 year.

* * * * * * *

(E) Any interim extension granted under this paragraph shall terminate at the end of the 60-day period beginning on the date on which the product involved receives permission for commercial marketing or use, except that, if within that 60-day period the applicant notifies the [Director] *Commissioner* of such permission and submits any additional information under paragraph (1) of this subsection not previously contained in the application for interim extension, the patent shall be further extended, in accordance with the provisions of this section—

(i) * * *

* * * * * * *

(e)(1) A determination that a patent is eligible for extension may be made by the [Director] *Commissioner* solely on the basis of the representations contained in the application for the extension. If the [Director] *Commissioner* determines that a patent is eligible for extension under subsection (a) and that the requirements of paragraphs (1) through (4) of subsection (d) have been complied with, the [Director] *Commissioner* shall issue to the applicant for the extension of the term of the patent a certificate of extension, under seal, for the period prescribed by subsection (c). Such certificate shall be recorded in the official file of the patent and shall be considered as part of the original patent.

(2) If the term of a patent for which an application has been submitted under subsection (d)(1) would expire before a certificate of extension is issued or denied under paragraph (1) respecting the application, the [Director] *Commissioner* shall extend, until such determination is made, the term of the patent for periods of up to one year if he determines that the patent is eligible for extension.

* * * * * * *

(g) For purposes of this section, the term "regulatory review period" has the following meanings:

(1) * * *

* * * * * * *

(6) A period determined under any of the preceding paragraphs is subject to the following limitations:

(A) * * *

(B) If the patent involved was issued before the date of the enactment of this section and—

(i) * * *

* * * * * * *

(iii) no clinical investigation described in paragraph (3) was begun or product development protocol described in such paragraph was [submittted] *submitted*,

before such date for the approved product the period of extension determined on the basis of the regulatory review period determined under any such paragraph may not exceed five years.

(h) The [Director] *Commissioner* may establish such fees as the [Director] *Commissioner* determines appropriate to cover the costs to the Office of receiving and acting upon applications under this section.

§ 157. Statutory invention registration

(a) Notwithstanding any other provision of this title, the [Director] *Commissioner* is authorized to publish a statutory invention registration containing the specification and drawings of a regularly filed application for a patent without examination if the applicant—

(1) meets the requirements of section 112 of this title;

(2) has complied with the requirements for printing, as set forth in regulations of the [Director] *Commissioner*;

(3) waives the right to receive a patent on the invention within such period as may be prescribed by the [Director] *Commissioner*; and

(4) pays application, publication, and other processing fees established by the [Director] *Commissioner*.

If an interference is declared with respect to such an application, a statutory invention registration may not be published unless the issue of priority of invention is finally determined in favor of the applicant.

* * * * * * *

(c) A statutory invention registration published pursuant to this section shall have all of the attributes specified for patents in this title except those specified in section 183 and sections 271 through 289 of this title. A statutory invention registration shall not have any of the attributes specified for patents in any other provision of law other than this title. A statutory invention registration published pursuant to this section shall give appropriate notice to the public, pursuant to regulations which the [Director] *Commissioner* shall issue, of the preceding provisions of this subsection. The invention with respect to which a statutory invention certificate is published is not a patented invention for purposes of section 292 of this title.

(d) The [Director] *Commissioner* shall report to the Congress annually on the use of statutory invention registrations. Such report shall include an assessment of the degree to which agencies

of the Federal Government are making use of the statutory invention registration system, the degree to which it aids the management of federally developed technology, and an assessment of the cost savings to the Federal Government of the use of such procedures.

CHAPTER 15—PLANT PATENTS

* * * * * * *

§ 164. Assistance of Department of Agriculture

The President may by Executive order direct the Secretary of Agriculture, in accordance with the requests of the [Director] *Commissioner*, for the purpose of carrying into effect the provisions of this title with respect to plants (1) to furnish available information of the Department of Agriculture, (2) to conduct through the appropriate bureau or division of the Department research upon special problems, or (3) to detail to the [Director] *Commissioner* officers and employees of the Department.

* * * * * * *

CHAPTER 17—SECRECY OF CERTAIN INVENTIONS AND FILING APPLICATIONS IN FOREIGN COUNTRY

Sec.
181. Secrecy of certain inventions and withholding of patent.
* * * * * * *
183. Right [of] *to* compensation.
* * * * * * *

§ 181. Secrecy of certain inventions and withholding of patent

Whenever publication or disclosure by the publication of an application or by the grant of a patent on an invention in which the Government has a property interest might, in the opinion of the head of the interested Government agency, be detrimental to the national security, the [Commissioner of Patents] *Assistant Commissioner for Patents* upon being so notified shall order that the invention be kept secret and shall withhold the publication of the application or the grant of a patent therefor under the conditions set forth hereinafter.

Whenever the publication or disclosure of an invention by the publication of an application or by the granting of a patent, in which the Government does not have a property interest, might, in the opinion of the [Commissioner of Patents] *Assistant Commissioner for Patents*, be detrimental to the national security, he shall make the application for patent in which such invention is disclosed available for inspection to the Atomic Energy Commission, the Secretary of Defense, and the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States.

Each individual to whom the application is disclosed shall sign a dated acknowledgment thereof, which acknowledgment shall be entered in the file of the application. If, in the opinion of the Atomic Energy Commission, the Secretary of a Defense Department, or the chief officer of another department or agency so designated, the

publication or disclosure of the invention by the publication of the application or by the granting of a patent therefor would be detrimental to the national security, the Atomic Energy Commission, the Secretary of a Defense Department, or such other chief officer shall notify the [Commissioner of Patents] *Assistant Commissioner for Patents* and the [Commissioner of Patents] *Assistant Commissioner for Patents* shall order that the invention be kept secret and shall withhold the publication of the application or the grant of a patent for such period as the national interest requires, and notify the applicant thereof. Upon proper showing by the head of the department or agency who caused the secrecy order to be issued that the examination of the application might jeopardize the national interest, the [Commissioner of Patents] *Assistant Commissioner for Patents* shall thereupon maintain the application in a sealed condition and notify the applicant thereof. The owner of an application which has been placed under a secrecy order shall have a right to appeal from the order to the Secretary of Commerce under rules prescribed by him.

An invention shall not be ordered kept secret and the publication of an application or the grant of a patent withheld for a period of more than one year. The [Commissioner of Patents] *Assistant Commissioner for Patents* shall renew the order at the end thereof, or at the end of any renewal period, for additional periods of one year upon notification by the head of the department or the chief officer of the agency who caused the order to be issued that an affirmative determination has been made that the national interest continues so to require. An order in effect, or issued, during a time when the United States is at war, shall remain in effect for the duration of hostilities and one year following cessation of hostilities. An order in effect, or issued, during a national emergency declared by the President shall remain in effect for the duration of the national emergency and six months thereafter. The [Commissioner of Patents] *Assistant Commissioner for Patents* may rescind any order upon notification by the heads of the departments and the chief officers of the agencies who caused the order to be issued that the publication or disclosure of the invention is no longer deemed detrimental to the national security.

§ 182. Abandonment of invention for unauthorized disclosure

The invention disclosed in an application for patent subject to an order made pursuant to section 181 of this title may be held abandoned upon its being established by the [Commissioner of Patents] *Assistant Commissioner for Patents* that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent of the [Commissioner of Patents] *Assistant Commissioner for Patents*. The abandonment shall be held to have occurred as of the time of violation. The consent of the [Commissioner of Patents] *Assistant Commissioner for Patents* shall not be given without the concurrence of the heads of the departments and the chief officers of the agencies who caused the order to be issued. A holding of abandonment shall constitute forfeiture by the applicant, his successors, as-

signs, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention.

* * * * * * *

§ 184. Filing of application in foreign country

Except when authorized by a license obtained from the [Commissioner of Patents] *Assistant Commissioner for Patents* a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the [Commissioner of Patents] *Assistant Commissioner for Patents* pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been filed abroad through error and without deceptive intent and the application does not disclose an invention within the scope of section 181 of this title.

The term "application" when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

The scope of a license shall permit subsequent modifications, amendments, and supplements containing additional subject matter if the application upon which the request for the license is based is not, or was not, required to be made available for inspection under section 181 of this title and if such modifications, amendments, and supplements do not change the general nature of the invention in a manner which would require such application to be made available for inspection under such section 181. In any case in which a license is not, or was not, required in order to file an application in any foreign country, such subsequent modifications, amendments, and supplements may be made, without a license, to the application filed in the foreign country if the United States application was not required to be made available for inspection under section 181 and if such modifications, amendments, and supplements do not, or did not, change the general nature of the invention in a manner which would require the United States application to have been made available for inspection under such section 181.

§ 185. Patent barred for filing without license

Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184 of this title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid, unless the failure to procure such li-

cense was through error and without deceptive intent, and the patent does not disclose subject matter within the scope of section 181 of this title.[.]

* * * * * * *

CHAPTER 18—PATENT RIGHTS IN INVENTIONS MADE WITH FEDERAL ASSISTANCE

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§ 201. Definitions

As used in this chapter—

(a) The term "Federal agency" means any executive agency as defined in section 105 of title 5, [United States Code,] and the military departments as defined by section 102 of title [5, United States Code] *5*.

* * * * * * *

§ 202. Disposition of rights

(a) * * *

(b)(1) * * *

* * * * * * *

(4) If the contractor believes that a determination is contrary to the policies and objectives of this chapter or constitutes an abuse of discretion by the agency, the determination shall be subject to the [last paragraph of section 203(2)] *section 203(b)*.

(c) Each funding agreement with a small business firm or nonprofit organization shall contain appropriate provisions to effectuate the following:

(1) * * *

* * * * * * *

(4) With respect to any invention in which the contractor elects rights, the Federal agency shall have a nonexclusive, nontransferrable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States any subject invention throughout the world: *Provided*, That the funding agreement may provide for such additional [rights;] *rights,* including the right to assign or have assigned foreign patent rights in the subject invention, as are determined by the agency as necessary for meeting the obligations of the United States under any treaty, international agreement, arrangement of cooperation, memorandum of understanding, or similar arrangement, including military agreement relating to weapons development and production.

(5) The right of the Federal agency to require periodic reporting on the utilization or efforts at obtaining utilization that are being made by the contractor or his licensees or assignees: *Provided*, That any such information as well as any information on utilization or efforts at obtaining utilization obtained as part of a proceeding under section 203 of this chapter shall be treated by the Federal agency as commercial and financial information obtained from a person and privileged and confiden-

tial and not subject to disclosure under section 552 of title 5 [of the United States Code].

* * * * * * *

§ 203. March-in rights

[(1.] *(a)* With respect to any subject invention in which a small business firm or nonprofit organization has acquired title under this chapter, the Federal agency under whose funding agreement the subject invention was made shall have the right, in accordance with such procedures as are provided in regulations promulgated hereunder to require the contractor, an assignee or exclusive licensee of a subject invention to grant a nonexclusive, partially exclusive, or exclusive license in any field of use to a responsible applicant or applicants, upon terms that are reasonable under the circumstances, and if the contractor, assignee, or exclusive licensee refuses such request, to grant such a license itself, if the Federal agency determines that such—

[(a)] *(1)* action is necessary because the contractor or assignee has not taken, or is not expected to take within a reasonable time, effective steps to achieve practical application of the subject invention in such field of use;

[(b)] *(2)* action is necessary to alleviate health or safety needs which are not reasonably satisfied by the contractor, assignee, or their licensees;

[(c)] *(3)* action is necessary to meet requirements for public use specified by Federal regulations and such requirements are not reasonably satisfied by the contractor, assignee, or licensees; or

[(d)] *(4)* action is necessary because the agreement required by section 204 has not been obtained or waived or because a licensee of the exclusive right to use or sell any subject invention in the United States is in breach of its agreement obtained pursuant to section 204.

[(2)] *(b)* A determination pursuant to this section or section 202(b)(4) shall not be subject to the Contract Disputes Act (41 U.S.C. § 601 et seq.). An administrative appeals procedure shall be established by regulations promulgated in accordance with section 206. Additionally, any contractor, inventor, assignee, or exclusive licensee adversely affected by a determination under this section may, at any time within sixty days after the determination is issued, file a petition in the United States Court of Federal Claims, which shall have jurisdiction to determine the appeal on the record and to affirm, reverse, remand or modify, [",] as appropriate, the determination of the Federal agency. In cases described in paragraphs [(a) and (c)] *(1) and (3) of subsection (a)*, the agency's determination shall be held in abeyance pending the exhaustion of appeals or petitions filed under the preceding sentence.

* * * * * * *

§ 209. Licensing federally owned inventions

(a) * * *

* * * * * * *

(d) TERMS AND CONDITIONS.—Any licenses granted under section 207(a)(2) shall contain such terms and conditions as the granting agency considers appropriate, and shall include provisions—

(1) * * *

(2) requiring periodic reporting on utilization of the invention, and utilization efforts, by the licensee, but only to the extent necessary to enable the Federal agency to determine whether the terms of the license are being complied with, except that any such report shall be treated by the Federal agency as commercial and financial information obtained from a person and privileged and confidential and not subject to disclosure under section 552 of title 5 [of the United States Code]; and

* * * * * * *

(f) PLAN.—No Federal agency shall grant any license under a patent or patent application on a federally owned invention unless the person requesting the license has supplied the agency with a plan for development or marketing of the invention, except that any such plan shall be treated by the Federal agency as commercial and financial information obtained from a person and privileged and confidential and not subject to disclosure under section 552 of title 5 [of the United States Code].

* * * * * * *

(f) Any grant of a license shall contain such terms and conditions as the Federal agency determines appropriate for the protection of the interests of the Federal Government and the public, including provisions for the following:

(1) periodic reporting on the utilization or efforts at obtaining utilization that are being made by the licensee with particular reference to the plan submitted: *Provided*, That any such information may be treated by the Federal agency as commercial and financial information obtained from a person and privileged and confidential and not subject to disclosure under section 552 of title 5 [of the United States Code];

* * * * * * *

§ 210. Precedence of chapter

(a) This chapter shall take precedence over any other Act which would require a disposition of rights in subject inventions of small business firms or nonprofit organizations contractors in a manner that is inconsistent with this chapter, including but not necessarily limited to the following:

(1) * * *

* * * * * * *

(11) section 9 of the Federal Nonnuclear Energy Research and Development Act of 1974 (42 U.S.C. [5901] *5908*; 88 Stat. 1878);

* * * * * * *

(20) section 12 of the Native Latex Commercialization and Economic Development Act of 1978 (7 U.S.C. [178(j)] *178j*; 92 Stat. 2533); and

* * * * * * *

(c) Nothing in this chapter is intended to limit the authority of agencies to agree to the disposition of rights in inventions made in the performance of work under funding agreements with persons other than nonprofit organizations or small business firms in accordance with the Statement of Government Patent Policy issued on February 18, 1983, agency regulations, or other applicable regulations or to otherwise limit the authority of agencies to allow such persons to retain ownership of inventions except that all funding agreements, including those with other than small business firms and nonprofit organizations, shall include the requirements established in [paragraph] *section* 202(c)(4) and section 203 of this title.[.] Any disposition of rights in inventions made in accordance with the Statement or implementing regulations, including any disposition occurring before enactment of this section, are hereby authorized.

* * * * * * *

PART III—PATENTS AND PROTECTION OF PATENT RIGHTS

Chap.		Sec.
25.	**Amendment and Correction of Patents**	**251**
*	*	*
29.	**Remedies for Infringement of Patent, and Other Actions**	**281**
*	*	*

CHAPTER 25—AMENDMENT AND CORRECTION OF PATENTS

Sec.
251. Reissue of defective patents.

* * * * * * *

[256. Misjoinder of inventor.]
256. Correction of named inventor.

§ 251. Reissue of defective patents

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the [Director] *Commissioner* shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The [Director] *Commissioner* may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

* * * * * * *

§ 254. Certificate of correction of Patent and Trademark Office mistake

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the [Director] *Commissioner* may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The [Director] *Commissioner* may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

§ 255. Certificate of correction of applicant's mistake

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the [Director] *Commissioner* may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

§ 256. Correction of named inventor

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the [Director] *Commissioner* may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issued a certificate correcting such error.

The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the [Director] *Commissioner* shall issue a certificate accordingly.

* * * * * * *

CHAPTER 27—GOVERNMENT INTERESTS IN PATENTS

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§ 267. Time for taking action in Government applications

Notwithstanding the provisions of sections 133 and 151 of this title, the [Director] *Commissioner* may extend the time for taking any action to three years, when an application has become the property of the United States and the head of the appropriate department or agency of the Government has certified to the [Director] *Commissioner* that the invention disclosed therein is important to the armament or defense of the United States.

* * * * * * *

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

* * * * * * *

§ 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) * * *

* * * * * * *

(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] *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. A due dili-

gence determination under section 156(d)(2) is not subject to review in such an action.

* * * * * * *

§ 290. Notice of patent suits

The clerks of the courts of the United States, within one month after the filing of an action under this title shall give notice thereof in writing to the [Director] *Commissioner*, setting forth so far as known the names and addresses of the parties, name of the inventor, and the designating number of the patent upon which the action has been brought. If any other patent is subsequently included in the action he shall give like notice thereof. Within one month after the decision is rendered or a judgment issued the clerk of the court shall give notice thereof to the [Director] *Commissioner*. The [Director] *Commissioner* shall, on receipt of such notices, enter the same in the file of such patent.

* * * * * * *

§ 294. Voluntary arbitration

(a) * * *

(b) Arbitration of such disputes, awards by arbitrators and confirmation of awards shall be governed by title 9, [United States Code,] to the extent such title is not inconsistent with this section. In any such arbitration proceeding, the defenses provided for under section 282 of this title shall be considered by the arbitrator if raised by any party to the proceeding.

(c) An award by an arbitrator shall be final and binding between the parties to the arbitration but shall have no force or effect on any other person. The parties to an arbitration may agree that in the event a patent which is the subject matter of an award is subsequently determined to be invalid or unenforceable in a judgment rendered by a court [to] *of* competent jurisdiction from which no appeal can or has been taken, such award may be modified by any court of competent jurisdiction upon application by any party to the arbitration. Any such modification shall govern the rights and obligations between such parties from the date of such modification.

(d) When an award is made by an arbitrator, the patentee, his assignee or licensee shall give notice thereof in writing to the [Director] *Commissioner*. There shall be a separate notice prepared for each patent involved in such proceeding. Such notice shall set forth the names and addresses of the parties, the name of the inventor, and the name of the patent owner, shall designate the number of the patent, and shall contain a copy of the award. If an award is modified by a court, the party requesting such modification shall give notice of such modification to the [Director] *Commissioner*. The [Director] *Commissioner* shall, upon receipt of either notice, enter the same in the record of the prosecution of such patent. If the required notice is not filed with the [Director] *Commissioner*, any party to the proceeding may provide such notice to the [Director] *Commissioner*.

(e) The award shall be unenforceable until the notice required by subsection (d) is received by the [Director] *Commissioner*.

* * * * * * *

§ 297. Improper and deceptive invention promotion

(a) * * *

(b) CIVIL ACTION.—(1) * * *

(2) Notwithstanding paragraph (1), in a case where the customer sustains the burden of proof, and the court finds, that the invention promoter intentionally misrepresented or omitted a material fact to such customer, or willfully failed to disclose such information as required under subsection (a), with the purpose of deceiving that customer, the court may increase damages to not more than three times the amount awarded, taking into account past complaints made against the invention promoter that resulted in regulatory sanctions or other corrective actions based on those records compiled by the Commissioner [of Patents] under subsection (d).

* * * * * * *

(d) RECORDS OF COMPLAINTS.—

(1) RELEASE OF COMPLAINTS.—The Commissioner [of Patents] shall make all complaints received by the Patent and Trademark Office involving invention promoters publicly available, together with any response of the invention promoters. The Commissioner [of Patents] shall notify the invention promoter of a complaint and provide a reasonable opportunity to reply prior to making such complaint publicly available.

(2) REQUEST FOR COMPLAINTS.—The Commissioner [of Patents] may request complaints relating to invention promotion services from any Federal or State agency and include such complaints in the records maintained under paragraph (1), together with any response of the invention promoters.

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

Sec.
301. Citation of prior art.
* * * * * * *
303. Determination of issue by [Director] *Commissioner*.
304. Reexamination order by [Director] *Commissioner*.
* * * * * * *

§ 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 [Director] *Commissioner* 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 [Director] *Commissioner* promptly will send a copy of the request to the owner of record of the patent.

§ 303. Determination of issue by [Director] *Commissioner*

(a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the [Director] *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 [Director] *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 [Director's] *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 [Director] *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 [Director] *Commissioner* may refund a portion of the reexamination fee required under section 302 of this title.

§ 304. Reexamination order by [Director] *Commissioner*

If, in a determination made under the provisions of subsection 303(a) of this title, the [Director] *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 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.

* * * * * * *

§ 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 [Director] *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.

CHAPTER 31—OPTIONAL INTER PARTES REEXAMINATION PROCEDURES

Sec.
311. Request for inter partes reexamination.
312. Determination of issue by [Director] *Commissioner*.
313. Inter partes reexamination order by [Director] *Commissioner*.

* * * * * * *

§ 311. Request for inter partes reexamination

(a) IN GENERAL.—Any [person] *third-party requester* at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

(b) REQUIREMENTS.—The request shall—

(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the [Director] *Commissioner* under section 41; and

(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

(c) COPY.—[Unless the requesting person is the owner of the patent, the Director] *The Commissioner* promptly shall send a copy of the request to the owner of record of the patent.

§ 312. Determination of issue by [Director] *Commissioner*

(a) REEXAMINATION.—Not later than 3 months after the filing of a request for inter partes reexamination under section 311, the [Director] *Commissioner* shall 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 the Director's initiative, and at any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications.]

(b) RECORD.—A record of the [Director's] *Commissioner's* determination under subsection (a) shall be placed in the official file of the patent, and a copy shall be promptly given or mailed to the owner of record of the patent and to the third-party requester[, if any].

(c) FINAL DECISION.—A determination by the [Director] *Commissioner* under subsection (a) shall be final and non-appealable. Upon a determination that no substantial new question of patentability has been raised, the [Director] *Commissioner* may refund a portion of the inter partes reexamination fee required under section 311.

§ 313. Inter partes reexamination order by [Director] *Commissioner*

If, in a determination made under section 312(a), the [Director] *Commissioner* finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for inter partes reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the inter partes reexamination conducted in accordance with section 314.

§ 314. Conduct of inter partes reexamination proceedings

(a) * * *

(b) RESPONSE.—(1) [This subsection shall apply to any inter partes reexamination proceeding in which the order for inter partes reexamination is based upon a request by a third-party requester.]

[(2)] With the exception of the inter partes reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party. In addition, [the third-party requester shall receive a copy] *the Office shall send to the third-party requester a copy* of any communication sent by the Office to the patent owner concerning the patent subject to the inter partes reexamination proceeding.

[(3)] *(2)* Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

(c) SPECIAL DISPATCH.—Unless otherwise provided by the [Director] *Commissioner* for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

§ 315. Appeal

(a) * * *

* * * * * * *

(c) CIVIL ACTION.—A third-party requester whose request for an inter partes reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, [United States Code,] the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the inter partes reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

§ 316. Certificate of patentability, unpatentability, and claim cancellation

(a) IN GENERAL.—In an inter partes reexamination proceeding under this chapter, when the time for appeal has expired or any appeal proceeding has terminated, the [Director] *Commissioner* shall 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.

* * * * * * *

§ 317. Inter partes reexamination prohibited

(a) ORDER FOR REEXAMINATION.—Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the [patent owner nor the third-party requester, if any, nor privies of either] *third-party requester nor its privies*, may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the [Director] *Commissioner*.

(b) FINAL DECISION.—Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, [United States Code,] that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

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PART IV—PATENT COOPERATION TREATY

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CHAPTER 36—INTERNATIONAL STAGE

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§ 361. Receiving Office

(a) * * *

* * * * * * *

(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 [Director] *Commissioner*.

§ 362. International Searching Authority and International Preliminary Examining Authority

(a) * * *

(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 [Director] *Commissioner*.

* * * * * * *

§ 364. International stage: Procedure

(a) * * *

(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 [Director] *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.

§ 365. Right of priority; benefit of the filing date of a prior application

(a) * * *

* * * * * * *

(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 [Director] *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.

* * * * * * *

§ 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 [Director] *Commissioner*, on compliance with the requirements of and within the time limits specified by the treaty and the Regulations. Such review may result in a determination that such application be considered as pending in the national stage.

* * * * * * *

CHAPTER 37—NATIONAL STAGE

Sec.
371. National stage: Commencement.

* * * * * * *

[374. Publication of international application: Effect.]
374. Publication of international application.

* * * * * * *

§ 371. National stage: Commencement

(a) * * *

(b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22(1) or (2), or under article 39(1)(a) of the treaty.

* * * * * * *

(d) The requirements with respect to the national fee referred to in subsection (c)(1), the translation referred to in subsection (c)(2), and the oath or declaration referred to in subsection (c)(4) of this section shall be complied with by the date of the commencement of the national stage or by such later time as may be fixed by the [Director] *Commissioner*. The copy of the international application referred to in subsection (c)(2) shall be submitted by the date of the commencement of the national stage. Failure to comply with these requirements shall be regarded as abandonment of the application by the parties thereof, unless it be shown to the satisfaction of the [Director] *Commissioner* that such failure to comply was unavoidable. The payment of a surcharge may be required as a condition of accepting the national fee referred to in subsection (c)(1) or the oath or declaration referred to in subsection (c)(4) of this section if these requirements are not met by the date of the commencement of the national stage. The requirements of subsection (c)(3) of this section shall be complied with by the date of the commencement of the national stage, and failure to do so shall be regarded as a cancellation of the amendments to the claims in the international application made under article 19 of the treaty. The requirement of subsection (c)(5) shall be complied with at such time as may be fixed by the [Director] *Commissioner* and failure to do so shall be regarded as cancellation of the amendments made under article 34(2)(b) of the treaty.

* * * * * * *

§ 372. National stage: Requirements and procedure

(a) * * *

(b) In case of international applications designating but not originating in, the United States—

(1) the [Director] *Commissioner* may cause to be reexamined questions relating to form and contents of the application in accordance with the requirements of the treaty and the Regulations;

(2) the [Director] *Commissioner* may cause the question of unity of invention to be reexamined under section 121 of this title, within the scope of the requirements of the treaty and the Regulations; and

(3) the [Director] *Commissioner* may require a verification of the translation of the international application or any other document pertaining to the application if the application or other document was filed in a language other than English.

* * * * * * *

§ 375. Patent issued on international application: Effect

(a) A patent may be issued by the [Director] *Commissioner* based on an international application designating the United States, in accordance with the provisions of this title. Subject to section 102(e) of this title, such patent shall have the force and effect of a patent issued on a national application filed under the provisions of chapter 11 of this title.

* * * * * * *

§ 376. Fees

(a) The required payment of the international fee and the handling fee, which amounts are specified in the Regulations, shall be paid in United States currency. The Patent and Trademark Office shall charge a national fee as provided in section 41(a), and may also charge the following fees:

(1) A transmittal fee (see section 361(d))[;].

(2) A search fee (see section 361(d))[;].

(3) A supplemental search fee (to be paid when required)[;].

(4) A preliminary examination fee and any additional fees (see section 362(b)).

(5) Such other fees as established by the [Director] *Commissioner*.

(b) The amounts of fees specified in subsection (a) of this section, except the international fee and the handling fee, shall be prescribed by the [Director] *Commissioner*. He may refund any sum paid by mistake or in excess of the fees so specified, or if required under the treaty and the Regulations. The [Director] *Commissioner* may also refund any part of the search fee, the national fee, the preliminary examination fee, and any additional fees, where he determines such refund to be warranted.

ACT OF JULY 5, 1946

[Commonly referred to as the "Trademark Act of 1946".]

AN ACT To provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes.

* * * * * * *

TITLE I—THE PRINCIPAL REGISTER

SECTION 1. (a)(1) The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the [Director] *Com-*

missioner, and such number of specimens or facsimiles of the mark as used as may be required by the [Director] *Commissioner*.

* * * * * * *

(4) The applicant shall comply with such rules or regulations as may be prescribed by the [Director] *Commissioner*. The [Director] *Commissioner* shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

(b)(1) A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the [Director] *Commissioner*.

* * * * * * *

(4) The applicant shall comply with such rules or regulations as may be prescribed by the [Director] *Commissioner*. The [Director] *Commissioner* shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

* * * * * * *

(d)(1) Within six months after the date on which the notice of allowance with respect to a mark is issued under section 13(b)(2) to an applicant under subsection (b) of this section, the applicant shall file in the Patent and Trademark Office, together with such number of specimens or facsimiles of the mark as used in commerce as may be required by the [Director] *Commissioner* and payment of the prescribed fee, a verified statement that the mark is in use in commerce and [specifying the date of the applicant's first use of the mark in commerce and,, those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce.] *specifying the date of the applicant's first use of the mark in commerce and those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce.* Subject to examination and acceptance of the statement of use, the mark shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued for those goods or services recited in the statement of use for which the mark is entitled to registration, and notice of registration shall be published in the Official Gazette of the Patent and Trademark Office. Such examination may include an examination of the factors set forth in subsections (a) through (e) of section 2. The notice of registration shall specify the goods or services for which the mark is registered.

(2) The [Director] *Commissioner* shall extend, for one additional 6-month period, the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the [Director] *Commissioner* may, upon a showing of good cause by the applicant, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months, pursuant to written request of the applicant made before the expiration of the last extension granted under this paragraph. Any re-

quest for an extension under this paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce and specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce. Any request for an extension under this paragraph shall be accompanied by payment of the prescribed fee. The [Director] *Commissioner* shall issue regulations setting forth guidelines for determining what constitutes good cause for purposes of this paragraph.

(3) The [Director] *Commissioner* shall notify any applicant who files a statement of use of the acceptance or refusal thereof and, if the statement of use is refused, the reasons for the refusal. An applicant may amend the statement of use.

(4) The failure to timely file a verified statement of use under paragraph (1) or an extension request under paragraph (2) shall result in abandonment of the application, unless it can be shown to the satisfaction of the [Director] *Commissioner* that the delay in responding was unintentional, in which case the time for filing may be extended, but for a period not to exceed the period specified in paragraphs (1) and (2) for filing a statement of use.

[(e) If the applicant is not domiciled in the United State he shall designate by a written document filed in the Patent and Trademark Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with him or mailing to him a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, such notice or process may be served upon the Director.]

(e) If the applicant is not domiciled in the United States the applicant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Commissioner.

MARKS REGISTRABLE ON THE PRINCIPAL REGISTER

SEC. 2. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) * * *

* * * * * * *

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade

name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: *Provided,* That if the [Director] *Commissioner* determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this Act; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the [Director] *Commissioner* when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the [Director] *Commissioner* shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

* * * * * * *

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The [Director] *Commissioner* may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act.

A mark which when used would cause dilution under section 43(c) may be refused registration only pursuant to a proceeding brought under section 13. A registration for a mark which when used would cause dilution under section 43(c) may be canceled pursuant to a proceeding brought under either section 14 or section 24.

* * * * * * *

SEC. 6. (a) The [Director] *Commissioner* may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered.

(b) No disclaimer, including those made under subsection (e) of section 7 of this Act, shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive of his goods or services.

CERTIFICATES

SEC. 7. (a) Certificates of registration of marks registered upon the principal register shall be issued in the name of the United States of America, under the seal of the Patent and Trademark Office, and shall be signed by the [Director] *Commissioner* or have his signature placed thereon, and a record thereof shall be kept in the Patent Office. The registration shall reproduce the mark, and state that the mark is registered on the principal register under this Act, the date of the first use of the mark, the date of the first use of the mark in commerce, the particular goods or services for which it is registered, the number and date of the registration, the term thereof, the date on which the application for registration was received in the Patent and Trademark Office, and any conditions and limitations that may be imposed in the registration.

* * * * * * *

(d) A certificate of registration of a mark may be issued to the assignee of the applicant, but the assignment must first be recorded in the Patent and Trademark Office. In case of change of ownership the [Director] *Commissioner* shall, at the request of the owner and upon a proper showing and the payment of the prescribed fee, issue to such assignee a new certificate of registration of the said mark in the name of such assignee, and for the unexpired part of the original period.

(e) Upon application of the registrant the [Director] *Commissioner* may permit any registration to be surrendered for cancelation, and upon cancelation appropriate entry shall be made in the records of the Patent and Trademark Office. Upon application of the registrant and payment of the prescribed fee, the [Director] *Commissioner* for good cause may permit any registration to be amended or to be disclaimed in part: *Provided,* That the amendment or disclaimer does not alter materially the character of the mark. Appropriate entry shall be made in the records of the Patent and Trademark Office and upon the certificate of registration or, if said certificate is lost or destroyed, upon a certified copy thereof.

(f) Copies of any records, books, papers, or drawings belonging to the Patent and Trademark Office relating to marks, and, copies of registrations, when authenticated by the seal of the Patent and Trademark Office and certified by the [Director] *Commissioner*, or in his name by an employee of the Office duly designated by the [Director] *Commissioner*, shall be evidence in all cases wherein the originals would be evidence; and any person making application therefore and paying the prescribed fee shall have such copies.

(g) Whenever a material mistake in a registration, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office a certificate stating the fact and nature of such mistake shall be issued without charge and re-

corded and a printed copy thereof shall be attached to each printed copy of the registration and such corrected registration shall thereafter have the same effect as if the same had been originally issued in such corrected form, or in the discretion of the [Director] *Commissioner* a new certificate of registration may be issued without charge. All certificates of correction heretofore issued in accordance with the rules of the Patent and Trademark Office and the registrations to which they are attached shall have the same force and effect as if such certificates and their issue had been specifically authorized by statute.

(h) Whenever a mistake has been made in a registration and a showing has been made that such mistake occurred in good faith through the fault of the applicant, the [Director] *Commissioner* is authorized to issue a certificate of correction or, in his discretion, a new certificate upon the payment of the prescribed fee: *Provided,* That the correction does not involve such changes in the registration as to require republication of the mark.

DURATION

SEC. 8. (a) Each registration shall remain in force for 10 years, except that the registration of any mark shall be canceled by the [Director] *Commissioner* for failure to comply with the provisions of subsection (b) of this section, upon the expiration of the following time periods, as applicable:

(1) * * *

* * * * * * *

(b) During the 1-year period immediately preceding the end of the applicable time period set forth in subsection (a), the owner of the registration shall pay the prescribed fee and file in the Patent and Trademark Office—

(1) an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce and such number of specimens or facsimiles showing current use of the mark as may be required by the [Director] *Commissioner*; or

(2) an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is not in use in commerce and showing that any such nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark.

(c)(1) The owner of the registration may make the submissions required under this section within a grace period of 6 months after the end of the applicable time period set forth in subsection (a). Such submission is required to be accompanied by a surcharge prescribed by the [Director] *Commissioner*.

(2) If any submission filed under this section is deficient, the deficiency may be corrected after the statutory time period and within the time prescribed after notification of the deficiency. Such submission is required to be accompanied by a surcharge prescribed by the [Director] *Commissioner*.

(d) Special notice of the requirement for affidavits under this section shall be attached to each certificate of registration and notice of publication under section 12(c).

(e) The [Director] *Commissioner* shall notify any owner who files 1 of the affidavits required by this section of the Commissioner's acceptance or refusal thereof and, in the case of a refusal, the reasons therefor.

[(f) If the registrant is not domiciled in the United States, the registrant shall designate by a written document filed in the Patent and Trademark Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, such notice or process may be served upon the Director.]

(f) If the registrant is not domiciled in the United States, the registrant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Commissioner.

RENEWAL OF REGISTRATION

SEC. 9. (a) Subject to the provisions of section 8, each registration may be renewed for periods of 10 years at the end of each successive 10-year period following the date of registration upon payment of the prescribed fee and the filing of a written application, in such form as may be prescribed by the [Director] *Commissioner*. Such application may be made at any time within 1 year before the end of each successive 10-year period for which the registration was issued or renewed, or it may be made within a grace period of 6 months after the end of each successive 10-year period, upon payment of a fee and surcharge prescribed therefor. If any application filed under this section is deficient, the deficiency may be corrected within the time prescribed after notification of the deficiency, upon payment of a surcharge prescribed therefor.

(b) If the [Director] *Commissioner* refuses to renew the registration, the [Director] *Commissioner* shall notify the registrant of the Commissioner's refusal and the reasons therefor.

[(c) If the registrant is not domiciled in the United States, the registrant shall designate by a written document filed in the Patent and Trademark Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated

cannot be found at the address given in the last designation, such notice or process may be served upon the Director.]

(c) If the registrant is not domiciled in the United States the registrant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Commissioner.

ASSIGNMENT

SEC. 10. [(a) A registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. Notwithstanding the preceding sentence, no application to register a mark under section 1(b) shall be assignable prior to the filing of an amendment under section 1(c) to bring the application into conformity with section 1(a) or the filing of the verified statement of use under section 1(d), except for an assignment to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing. In any assignment authorized by this section, it shall not be necessary to include the good will of the business connected with the use of and symbolized by any other mark used in the business or by the name or style under which the business is conducted. Assignments shall be by instruments in writing duly executed. Acknowledgment shall be prima facie evidence of the execution of an assignment, and when the prescribed information reporting the assignment is recorded in the Patent and Trademark Office, the record shall be prima facie evidence of execution. An assignment shall be void against any subsequent purchaser for valuable consideration without notice, unless the prescribed information reporting the assignment is recorded in the Patent and Trademark Office within 3 months after the date of the subsequent purchase or prior to the subsequent purchase. The Patent and Trademark Office shall maintain a record of information on assignments, in such form as may be prescribed by the Director.

[(b) An assignee not domiciled in the United States shall designate by a written document filed in the Patent and Trademark Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, such notice or process may be served upon the Director.]

(a)(1) A registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. Notwithstanding the preceding sentence, no application to register a mark under section 1(b) shall be assignable prior to the filing of an amendment under section 1(c) to bring the application into conformity with section 1(a) or the filing of the verified statement of use under section 1(d), except for an assignment to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing.

(2) In any assignment authorized by this section, it shall not be necessary to include the good will of the business connected with the use of and symbolized by any other mark used in the business or by the name or style under which the business is conducted.

(3) Assignments shall be by instruments in writing duly executed. Acknowledgment shall be prima facie evidence of the execution of an assignment, and when the prescribed information reporting the assignment is recorded in the United States Patent and Trademark Office, the record shall be prima facie evidence of execution.

(4) An assignment shall be void against any subsequent purchaser for valuable consideration without notice, unless the prescribed information reporting the assignment is recorded in the United States Patent and Trademark Office within 3 months after the date of the assignment or prior to the subsequent purchase.

(5) The United States Patent and Trademark Office shall maintain a record of information on assignments, in such form as may be prescribed by the Commissioner.

(b) An assignee not domiciled in the United States may designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the assignee does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served upon the Commissioner.

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PUBLICATION

SEC. 12. (a) Upon the filing of an application for registration and payment of the prescribed fee, the ⟦Director⟧ *Commissioner* shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and, if on such examination it shall appear that the applicant is entitled to registration, or would be entitled to registration upon the acceptance of the statement of use required by section 1(d) of this Act, the ⟦Director⟧ *Commissioner* shall cause the mark to be

published in the Official Gazette of the Patent and Trademark Office: *Provided,* That in the case of an applicant claiming concurrent use, or in the case of an application to be placed in an interference as provided for in section 16 of this Act, the mark, if otherwise registrable, may be published subject to the determination of the rights of the parties to such proceedings.

(b) If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reasons therefor. The applicant shall have a period of six months in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of six months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the [Director] *Commissioner* that the delay in responding was unintentional, whereupon such time may be extended.

(c) A registrant of a mark registered under the provisions of the Act of March 3, 1881, or the Act of February 20, 1905, may, at any time prior to the expiration of the registration thereof, upon the payment of the prescribed fee file with the [Director] *Commissioner* an affidavit setting forth those goods stated in the registration on which said mark is in use in commerce and that the registrant claims the benefits of this Act for said mark. The [Director] *Commissioner* shall publish notice thereof with a reproduction of said mark in the Official Gazette, and notify the registrant of such publication and of the requirement for the affidavit of use or nonuse as provided for in subsection (b) of section 8 of this Act. Marks published under this subsection shall not be subject to the provisions of section 13 of this Act.

OPPOSITION

SEC. 13. (a) Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 43(c), may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the [Director] *Commissioner* for good cause when requested prior to the expiration of an extension. The [Director] *Commissioner* shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the [Director] *Commissioner*.

* * * * * * *

SEC. 15. Except on a ground for which application to cancel may be filed at any time under paragraphs (3) and (5) of section 14 of this Act, and except to the extent, if any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of registra-

tion under this Act of such registered mark, the right of the registrant to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable: *Provided*, That—

(1) * * *

* * * * * * *

(3) an affidavit is filed with the [Director] *Commissioner* within one year after the expiration of any such five-year period setting forth those goods or services stated in the registration on or in connection with which such mark has been in continuous use for such five consecutive years and is still in use in commerce, and the other matters specified in paragraphs (1) and (2) of this section; and

(4) no incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered.

Subject to the conditions above specified in this section, the incontestable right with reference to a mark registered under this Act shall apply to a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, upon the filing of the required affidavit with the [Director] *Commissioner* within one year after the expiration of any period of five consecutive years after the date of publication of a mark under the provisions of subsection (c) of section 12 of this Act.

The [Director] *Commissioner* shall notify any registrant who files the above-prescribed affidavit of the filing thereof.

INTERFERENCE

SEC. 16. Upon petition showing extraordinary circumstances, the [Director] *Commissioner* may declare that an interference exists when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive. No interference shall be declared between an application and the registration of a mark the right to the use of which has become incontestable.

SEC. 17. (a) In every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the [Director] *Commissioner* shall give notice to all parties and shall direct a Trademark Trial and Appeal Board to determine and decide the respective rights of registration.

(b) The Trademark Trial and Appeal Board shall include the [Director] *Commissioner*, *the Deputy Commissioner,* the [Commissioner for Patents, the Commissioner for Trademarks] *Assistant Commissioner for Patents, the Assistant Commissioner for Trademarks*, and administrative trademark judges who are appointed by the [Director] *Commissioner*.

SEC. 18. In such proceedings the [Director] *Commissioner* may refuse to register the opposed mark, may cancel the registration,

in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark, may refuse to register any or all of several interfering marks, or may register the mark or marks for the person or persons entitled thereto, as the rights of the parties hereunder may be established in the proceedings; *Provided,* That in the case of the registration of any mark based on concurrent use, the [Director] *Commissioner* shall determine and fix the conditions and limitations provided for in subsection (d) of section 2 of this Act. However, no final judgment shall be entered in favor of an applicant under section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).

* * * * * * *

SEC. 21. (a)(1) An applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section 8, or an applicant for renewal, who is dissatisfied with the decision of the [Director] *Commissioner* or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit thereby waiving his right to proceed under subsection (b) of this section: *Provided,* That such appeal shall be dismissed if any adverse party to the proceeding, other than the [Director] *Commissioner*, shall, within twenty days after the appellant has filed notice of appeal according to paragraph (2) of this subsection, files notice with the [Director] *Commissioner* that he elects to have all further proceedings conducted as provided in subsection (b) of this section. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under subsection (b) of this section, in default of which the decision appealed from shall govern the further proceedings in the case.

(2) When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the [Director] *Commissioner*, within such time after the date of the decision from which the appeal is taken as the [Director] *Commissioner* prescribes, but in no case less than 60 days after that date.

(3) The [Director] *Commissioner* shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the [Director] *Commissioner* forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the [Director] *Commissioner* shall submit to that court a brief explaining the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal give notice of the time and place of the hearing to the [Director] *Commissioner* and the parties in the appeal.

(4) The United States Court of Appeals for the Federal Circuit shall review the decision from which the appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue its mandate and opinion to the [Di-

rector] *Commissioner*, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case. However, no final judgment shall be entered in favor of an applicant under section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).

(b)(1) Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the [Director] *Commissioner* or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the [Director] *Commissioner* appoints or as provided in subsection (a) of this section. The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be canceled, or such other matter as the issues in the proceeding require, as the facts in the case may appear. Such adjudication shall authorize the [Director] *Commissioner* to take any necessary action, upon compliance with the requirements of law. However, no final judgment shall be entered in favor of an applicant under section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).

(2) The [Director] *Commissioner* shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.

(3) In any case where there is no adverse party, a copy of the complaint shall be served on the [Director] *Commissioner*, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not. In suits brought hereunder, the record in the Patent and Trademark Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of any party to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit.

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TITLE II—THE SUPPLEMENTAL REGISTER

SEC. 23. (a) In addition to the principal register, the [Director] *Commissioner* shall keep a continuation of the register provided in paragraph (b) of section 1 of the Act of March 19, 1920, entitled "An Act to give effect to certain provisions of the convention for the protection of trademarks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes", to be called the supplemental register. All marks capable of distinguishing applicant's goods or services and not registrable on the principal register herein provided, except those declared to be unregistrable under subsections (a), (b),

(c), (d), and (e)(3) of section 2 of this Act, which are in lawful use in commerce by the owner thereof, on or in connection with any goods or services may be registered on the supplemental register upon the payment of the prescribed fee and compliance with the provisions of subsections (a) and (e) of section 1 so far as they are applicable. Nothing in this section shall prevent the registration on the supplemental register of a mark, capable of distinguishing the applicant's goods or services and not registrable on the principal register under this Act, that is declared to be unregistrable under section 2(e)(3), if such mark has been in lawful use in commerce by the owner thereof, on or in connection with any goods or services, since before the date of the enactment of the North American Free Trade Agreement Implementation Act.

(b) Upon the filing of an application for registration on the supplemental register and payment of the prescribed fee the [Director] *Commissioner* shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and if on such examination it shall appear that the applicant is entitled to registration, the registration shall be granted. If the applicant is found not entitled to registration the provisions of subsection (b) of section 12 of this Act shall apply.

(c) For the purposes of registration on the supplemental register, a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral,[,] device, any matter that as a whole is not functional, or any combination of any of the foregoing, but such mark must be capable of distinguishing the applicant's goods or services.

CANCELATION

SEC. 24. Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that he is or will be damaged by the registration of a mark on this register, including as a result of dilution under section 43(c), he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the [Director] *Commissioner* to cancel such registration. The [Director] *Commissioner* shall refer such application to the Trademark Trial and Appeal Board, which shall give notice thereof to the registrant. If it is found after a hearing before the Board which that the registrant is not entitled to registration, or that the mark has been abandoned, the registration shall be canceled by the [Director] *Commissioner*. However, no final judgment shall be entered in favor of an applicant under section (1)(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).

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TITLE IV—CLASSIFICATION

SEC. 30. The [Director] *Commissioner* may establish a classification of goods and services, for convenience of Patent and Trademark Office administration, but not to limit or extend the applicant's or registrant's rights. The applicant may apply to register a

mark for any or all of the goods or services on or in connection with which he or she is using or has a bona fide intention to use the mark in commerce: *Provided,* That if the [Director] *Commissioner* by regulation permits the filing of an application for the registration of a mark for goods or services which fall within a plurality of classes, a fee equaling the sum of the fees for filing an application in each class shall be paid, and the [Director] *Commissioner* may issue a single certificate of registration for such mark.

TITLE V—FEES AND CHARGES

SEC. 31. (a) The [Director] *Commissioner* shall establish fees for the filing and processing of an application for the registration of a trademark or other mark and for all other services performed by and materials furnished by the Patent and Trademark Office related to trademarks and other marks. Fees established under this subsection may be adjusted by the [Director] *Commissioner* once each year to reflect, in the aggregate, any fluctuations during the preceding 12 months in the Consumer Price Index, as determined by the Secretary of Labor. Changes of less than 1 percent may be ignored. No fee established under this section shall take effect until at least 30 days after notice of the fee has been published in the Federal Register and in the Official Gazette of the Patent and Trademark Office.

(b) The [Director] *Commissioner* may waive the payment of any fee for any service or material related to trademarks or other marks in connection with an occasional request made by a department or agency of the Government, or any officer thereof. The Indian Arts and Crafts Board will not be charged any fee to register Government trademarks of genuineness and quality for Indian products or for products of particular Indian tribes and groups.

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TITLE VI—REMEDIES

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SEC. 33. (a) * * *

(b) To extent that the right to use the registered mark has become incontestable under section 15, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce. Such conclusive evidence shall relate to the exclusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under the provisions of section 15, or in the renewal application filed under the provisions of section 9 if the goods or services specified in the renewal are fewer in number, subject to any conditions or limitations in the registration or in such affidavit or renewal application. Such conclusive evidence of the right to use the registered mark shall be subject to proof of infringement as defined in section 32, and shall be subject to the following defenses or defects:

(1) * * *

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(8) That the mark is functional; or

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SEC. 34. (a) * * *

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(c) It shall be the duty of the clerks of such courts within one month after the filing of any action, suit, or proceeding involving a mark registered under the provisions of this Act to give notice thereof in writing to the [Director] *Commissioner* setting forth in order so far as known the names and addresses of the litigants and the designating number or numbers of the registration or registrations upon which the action, suit, or proceeding has been brought, and in the event any other registration be subsequently included in the action, suit, or proceeding by amendment, answer, or other pleading, the clerk shall give like notice thereof to the [Director] *Commissioner*, and within one month after the judgment is entered or an appeal is taken the clerk of the court shall give notice thereof to the [Director] *Commissioner*, and it shall be the duty of the [Director] *Commissioner* on receipt of such notice forthwith to endorse the same upon the file wrapper of the said registration or registrations and to incorporate the same as a part of the contents of said file wrapper.

(d)(1)(A) In the case of a civil action arising under section 32(1)(a) of this Act (15 U.S.C. 1114) or [section 110 of the Act entitled. "An Act to incorporate the United States Olympic Association", approved September 21, 1950 (36 U.S.C. 380)] *section 220506 of title 36, United States Code,* with respect to a violation that consists of using a counterfeit mark in connection with the sale, offering for sale, or distribution of goods or services, the court may, upon ex parte application, grant an order under subsection (a) of this section pursuant to this subsection providing for the seizure of goods and counterfeit marks involved in such violation and the means of making such marks, and records documenting the manufacture, sale, or receipt of things involved in such violation.

(B) As used in this subsection the term "counterfeit mark" means—

(i) * * *

(ii) a spurious designation that is identical with, or substantially indistinguishable from, a designation as to which the remedies of this Act are made available by reason of [section 110 of the Act entitled "An Act to incorporate the United States Olympic Association", approved September 21, 1950 (36 U.S.C. 380)] *section 220506 of title 36, United States Code*;

but such term does not include any mark or designation used on or in connection with goods or services of which the manufacture or producer was, at the time of the manufacture or production in question authorized to use the mark or designation for the type of goods or services so manufactured or produced, by the holder of the right to use such mark or designation.

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(11) A person who suffers damage by reason of a wrongful seizure under this subsection has a cause of action against the applicant for the order under which such seizure was made, and shall be entitled to recover such relief as may be appropriate, including

damages for lost profits, cost of materials, loss of good will, and punitive damages in instances where the seizure was sought in bad faith, and, unless the court finds extenuating circumstances, to recover a reasonable attorney's fee. The court in its discretion may award prejudgment interest on relief recovered under this paragraph, at an annual interest rate established under section [6621 of the Internal Revenue Code of 1954] *6621(a)(2) of the Internal Revenue Code of 1986*, commencing on the date of service of the claimant's pleadings setting forth the claim under this paragraph and ending on the date such recovery is granted, or for such shorter time as the court deems appropriate.

SEC. 35. (a) When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, [a violation under section 43(a), (c), or (d),] *a violation under section 43(a) or (d),* or a willful violation under section 43(c), shall have been established in any civil action arising under this Act, the plaintiff shall be entitled, subject to the provisions of sections 29 and 32, and subject to the principles of equity, to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action. The court shall assess such profits and damages or cause the same to be assessed under its direction. In assessing profits the plaintiff shall be required to prove defendant's sales only, defendant must prove all elements of cost or deduction claimed. In assessing damages the court may enter judgment, according to the circumstances of the case, for any sum above the amount found as actual damages, not exceeding three times such amount. If the court shall find that the amount of the recovery based on profits is either inadequate or excessive the court may in its discretion enter judgment for such sum as the court shall find to be just, according to the circumstances of the case. Such sum in either of the above circumstances shall constitute compensation and not a penalty. The court in exceptional cases may award reasonable attorney fees to the prevailing party.

(b) In assessing damages under subsection (a), the court shall, unless the court finds extenuating circumstances, enter judgment for three times such profits or damages, whichever is greater, together with a reasonable attorney's fee in the case of any violation of section 32(1)(a) of this Act (15 U.S.C. 1114(1)(a)) or [section 110 of the Act entitled "An Act to incorporate the United States Olympic Association", approved September 21, 1950 (36 U.S.C. 380)] *section 220506 of title 36, United States Code,* that consists of intentionally using a mark or designation, knowing such mark or designation is a counterfeit mark (as defined in section 34(d) of this Act (15 U.S.C. 1116(d)), in connection with the sale, offering for sale, or distribution of goods or services. In such cases, the court may in its discretion award prejudgment interest on such amount at an annual interest rate established under such [6621 of the Internal Revenue Code of 1954] *6621(a)(2) of the Internal Revenue Code of 1986*, commencing on the date of the service of the claimant's pleadings setting forth the claim for such entry and ending on the date such entry is made, or for such shorter time as the court deems appropriate.

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SEC. 37. In any action involving a registered mark the court may determine the right to registration, order the cancelation of

registrations, in whole or in part, restore canceled registrations, and otherwise rectify the register with respect to the registrations of any party to the action. Decrees and orders shall be certified by the court to the [Director] *Commissioner*, who shall make appropriate entry upon the records of the Patent and Trademark Office, and shall be controlled thereby.

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SEC. 41. The [Director] *Commissioner* shall make rules and regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office under this Act.

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TITLE VIX—INTERNATIONAL CONVENTIONS

SEC. 44. (a) The [Director] *Commissioner* shall keep a register of all marks communicated to him by the international bureaus provided for by the conventions for the protection of industrial property, trademarks, trade and commercial names, and the repression of unfair competition to which the United States is or may become a party, and upon the payment of the fees required by such conventions and the fees required in this Act may place the marks so communicated upon such register. This register shall show a facsimile of the mark or trade or commercial name; the name, citizenship, and address of the registrant; the number, date, and place of the first registration of the mark, including the date on which application for such registration was filed and granted and the term of such registration; a list of goods or services to which the mark is applied as shown by the registration in the country of origin, and such other data as may be useful concerning the mark. This register shall be a continuation of the register provided in section 1(a) of the Act of March 19, 1920.

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(e) A mark duly registered in the country of origin of the foreign applicant may be registered on the principal register if eligible, otherwise on the supplemental register herein provided. Such applicant shall submit, within such time period as may be prescribed by the [Director, a certification] *Commissioner, a true copy, a photocopy, a certification,* or a certified copy of the registration in the country of origin of the applicant. The application must state the applicant's bona fide intention to use the mark in commerce, but use in commerce shall not be required prior to registration.

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TITLE X—CONSTRUCTION AND DEFINITIONS

SEC. 45. In the construction of this Act, unless the contrary is plainly apparent from the context—

The United States includes and embraces all territory which is under its jurisdiction and control.

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The term "[Director] *Commissioner*" means the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office.

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TITLE XI—REPEAL OF PREVIOUS ACTS

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SEC. 47. (a) * * *

(b) In any case in which an appeal is pending before the United States Court of Customs and Patent Appeals or any United States Circuit Court of Appeals or the United States Court of Appeals for the District of Columbia or the United States Supreme Court at the effective date of this Act, the court, if it be of the opinion that the provisions of this Act are applicable to the subject matter of the appeal, may apply such provision or may remand the case to the [Director] *Commissioner* or to the district court for the taking of additional evidence or a new trial or for reconsideration of the decision on the record as made, as the appellate court may deem proper.

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TITLE 5, UNITED STATES CODE

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CHAPTER 53—PAY RATES AND SYSTEMS

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SUBCHAPTER II—EXECUTIVE SCHEDULE PAY RATES

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§ 5314. Positions at level III

Level III of the Executive Schedule applies to the following positions, for which the annual rate of basic pay shall be the rate determined with respect to such level under chapter 11 of title 2, as adjusted by section 5318 of this title:

Solicitor General of the United States.

* * * * * * *

[Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.]

Under Secretary of Commerce for Intellectual Property and Commissioner of the United States Patent and Trademark Office.

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§ 5315. Positions at level IV

Level IV of the Executive Schedule applies to the following positions, for which the annual rate of basic pay shall be the rate determined with respect to such level under chapter 11 of title 2, as adjusted by section 5318 of this title:

Deputy Administrator of General Services.

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[Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office.]

Deputy Under Secretary of Commerce for Intellectual Property and Deputy Commissioner of the United States Patent and Trademark Office.

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SECTION 9 OF THE SMALL BUSINESS ACT

SEC. 9. (a) * * *

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(p) STTR POLICY DIRECTIVE.—

(1) ISSUANCE.—The Administrator shall issue a policy directive for the general conduct of the STTR programs within the Federal Government. Such policy directive shall be issued after consultation with—

(A) the heads of each of the Federal agencies required by subsection (n) to establish an STTR program;

(B) the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office; and

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SECTION 19 OF THE TENNESSEE VALLEY AUTHORITY ACT OF 1933

SEC. 19. The Corporation, as an instrumentality and agency of the Government of the United States for the purpose of executing its constitutional powers, shall have access to the United States Patent and Trademark Office for the purpose of studying, ascertaining, and copying all methods, formula, and scientific information (not including access to pending applications for patents) necessary to enable the Corporation to use and employ the most efficacious and economical process for the production of fixed nitrogen, or any essential ingredient of fertilizer, or any method of improving and cheapening the production of hydroelectric power, and any owner of a patent whose patent rights may have been thus in any way copied, used, infringed, or employed by the exercise of this authority by the Corporation shall have as the exclusive remedy a cause of action against the Corporation to be instituted and prosecuted on the equity side of the appropriate district court of the United States, for the recovery of reasonable compensation for such infringement. The Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office shall furnish to the Corporation, at its request and without payment of fees, copies of documents on file in his office: *Provided,* That the benefits of this section shall not apply

to any art, machine, method of manufacture, or composition of matter, discovered or invented by such employee during the time of his employment or service with the Corporation or with the Government of the United States.

TRADE ACT OF 1974

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TITLE I—NEGOTIATING AND OTHER AUTHORITY

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CHAPTER 8—IDENTIFICATION OF MARKET BARRIERS AND CERTAIN UNFAIR TRADE ACTIONS

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SEC. 182. IDENTIFICATION OF COUNTRIES THAT DENY ADEQUATE PROTECTION, OR MARKET ACCESS, FOR INTELLECTUAL PROPERTY RIGHTS.

(a) * * *

(b) SPECIAL RULES FOR IDENTIFICATIONS.—

(1) * * *

(2) In identifying priority foreign countries under subsection (a)(2), the Trade Representative shall—

(A) consult with the Register of Copyrights, the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office, other appropriate officers of the Federal Government, and

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TITLE III—RELIEF FROM UNFAIR TRADE PRACTICES

CHAPTER 1—ENFORCEMENT OF UNITED STATES RIGHTS UNDER TRADE AGREEMENTS AND RESPONSE TO CERTAIN FOREIGN TRADE PRACTICES

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SEC. 302. INITIATION OF INVESTIGATIONS.

(a) * * *

(b) INITIATION OF INVESTIGATION BY MEANS OTHER THAN PETITION.—

(1) * * *

(2)(A) * * *

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(D) The Trade Representative shall, from time to time, consult with the Register of Copyrights, the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office, and

other appropriate officers of the Federal Government, during any investigation initiated under this chapter by reason of subparagraph (A).

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SECTION 702 OF THE FEDERAL FOOD, DRUG AND COSMETIC ACT

EXAMINATIONS AND INVESTIGATIONS

SEC. 702. (a) * * *

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(d) The Secretary is authorized and directed, upon request from the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office, to furnish full and complete information with respect to such questions relating to drugs as the [Director] *Commissioner* may submit concerning any patent application. The Secretary is further authorized, upon receipt of any such request, to conduct or cause to be conducted, such research as may be required.

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TITLE 28, UNITED STATES CODE

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PART IV—JURISDICTION AND VENUE

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CHAPTER 83—COURTS OF APPEALS

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§ 1295. Jurisdiction of the United States Court of Appeals for the Federal Circuit

(a) The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction—

(1) * * *

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(4) of an appeal from a decision of—

(A) * * *

(B) the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office or the Trademark Trial and Appeal Board with respect to applications for registration of marks and other proceedings as provided in

section 21 of the Trademark Act of 1946 (15 U.S.C. 1071); or

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PART V—PROCEDURE

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CHAPTER 115—EVIDENCE; DOCUMENTARY

Sec.
1731. Treason.

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1744. Copies of United States Patent and Trademark Office documents [generally], *generally*.

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§ 1744. Copies of United States Patent and Trademark Office documents, generally

Copies of letters patent or of any records, books, papers, or drawings belonging to the United States Patent and Trademark Office and relating to patents, authenticated under the seal of the United States Patent and Trademark Office and certified by the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office, or by another officer of the United States Patent and Trademark Office authorized to do so by the [Director] *Commissioner*, shall be admissible in evidence with the same effect as the originals.

Any person making application and paying the required fee may obtain such certified copies.

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ATOMIC ENERGY ACT OF 1954

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TITLE I—ATOMIC ENERGY

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CHAPTER 13. PATENTS AND INVENTIONS

SEC. 151. INVENTIONS RELATING TO ATOMIC WEAPONS, AND FILING OF REPORTS.—

a. * * *

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c. Any person who has made or hereafter makes any invention or discovery useful in the production or utilization of special nuclear material or atomic energy, shall file with the Commission a report containing a complete description thereof unless such invention or discovery is described in an application for a patent filed

with the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office by such person within the time required for the filing of such report. The report covering any such invention or discovery shall be filed on or before the one hundred and eightieth day after such person first discovers or first has reason to believe that such invention or discovery is useful in such production or utilization.

d. The Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office shall notify the Commission of all applications for patents heretofore or hereafter filed which, in his opinion, disclose inventions or discoveries required to be reported under subsection 151 c., and shall provide the Commission access to all such applications.

* * * * * * *

SEC. 152. INVENTIONS MADE OR CONCEIVED DURING COMMISSION CONTRACTS.—Any invention or discovery, useful in the production or utilization of special nuclear material or atomic energy, made or conceived in the course of or under any contract, subcontract, or arrangement entered into with or for the benefit of the Commission, regardless of whether the contract, subcontract, or arrangement involved the expenditure of funds by the Commission, shall be vested in, and be the property of, the Commission, except that the Commission may waive its claim to any such invention or discovery under such circumstances as the Commission may deem appropriate, consistent with the policy of this section. No patent for any invention or discovery, useful in the production or utilization of special nuclear material or atomic energy, shall be issued unless the applicant files with the application, or within thirty days after request therefor by the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office (unless the Commission advises the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office that its rights have been determined and that accordingly no statement is necessary) a statement under oath setting forth the full facts surrounding the making or conception of the invention or discovery described in the application and whether the invention or discovery was made or conceived in the course of or under any contract, subcontract, or arrangement entered into with or for the benefit of the Commission, regardless of whether the contract, subcontract, or arrangement involved the expenditure of funds by the Commission. The Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office shall as soon as the application is otherwise in condition for allowance forward copies of the application and the statement to the Commission.

The Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office may proceed with the application and issue the patent to the applicant (if the invention or discovery is otherwise patentable) unless the Commission, within 90 days after receipt of copies of the application and statement, directs the Under Secretary of Commerce for Intellectual Property and [Director] *Com-*

missioner of the United States Patent and Trademark Office to issue the patent to the Commission (if the invention or discovery is otherwise patentable) to be held by the Commission as the agent of and on behalf of the United States.

If the Commission files such a direction with the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office, and if the applicant's statement claims, and the applicant still believes, that the invention or discovery was not made or conceived in the course of or under any contract, subcontract or arrangement entered into with or for the benefit of the Commission entitling the Commission to the title to the application or the patent the applicant may, within 30 days after notification of the filing of such a direction, request a hearing before the Board of Patent Appeals and Interferences. The Board shall have the power to hear and determine whether the Commission was entitled to the direction filed with the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office. The Board shall follow the rules and procedures established for interference cases and an appeal may be taken by either the applicant or the Commission from the final order of the Board to the United States Court of Appeals for the Federal Circuit in accordance with the procedures governing the appeals from the Board of Patent Appeals and Interferences.

If the statement filed by the applicant should thereafter be found to contain false material statements any notification by the Commission that it has no objections to the issuance of a patent to the applicant shall not be deemed in any respect to constitute a waiver of the provisions of this section or of any applicable civil or criminal statute, and the Commission may have the title to the patent transferred to the Commission on the records of the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office in accordance with the provisions of this section. A determination of rights by the Commission pursuant to a contractual provision or other arrangement prior to the request of the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office for the statement, shall be final in the absence of false material statements or nondisclosure of material facts by the applicant.

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SECTION 305 OF THE NATIONAL AERONAUTICS AND SPACE ACT OF 1958

PROPERTY RIGHTS IN INVENTIONS

SEC. 305. (a) * * *

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(c) No patent may be issued to any applicant other than the Administrator for any invention which appears to the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office (here-

after in this section referred to as the "[Director] *Commissioner*") to have significant utility in the conduct of aeronautical and space activities unless the applicant files with the [Director] *Commissioner*, with the application or within thirty days after request therefor by the [Director] *Commissioner*, a written statement executed under oath setting forth the full facts concerning the circumstances under which such invention was made and stating the relationship (if any) of such invention to the performance of any work under any contract of the Administration. Copies of each such statement and the application to which it relates shall be transmitted forthwith by the [Director] *Commissioner* to the Administrator.

(d) Upon any application as to which any such statement has been transmitted to the Administrator, the [Director] *Commissioner* may, if the invention is patentable, issue a patent to the applicant unless the Administrator, within ninety days after receipt of such application and statement, requests that such patent be issued to him on behalf of the United States. If, within such time, the Administrator files such a request with the [Director] *Commissioner*, the [Director] *Commissioner* shall transmit notice thereof to the applicant, and shall issue such patent to the Administrator unless the applicant within thirty days after receipt of such notice requests a hearing before the Board of Patent Appeals and Interferences on the question whether the Administrator is entitled under this section to receive such patent. The Board may hear and determine, in accordance with rules and procedures established for interference cases, the question so presented, and its determination shall be subject to appeal by the applicant or by the Administrator to the United States Court of Appeals for the Federal Circuit in accordance with procedures governing appeals from decisions of the Board of Patent Appeals and Interferences in other proceedings.

(e) Whenever any patent has been issued to any applicant in conformity with subsection (d), and the Administrator thereafter has reason to believe that the statement filed by the applicant in connection therewith contained any false representation of any material fact, the Administrator within five years after the date of issuance of such patent may file with the [Director] *Commissioner* a request for the transfer to the Administrator of title to such patent on the records of the [Director] *Commissioner*. Notice of any such request shall be transmitted by the [Director] *Commissioner* to the owner of record of such patent, and title, to such patent shall be so transferred to the Administrator unless within thirty days after receipt of such notice such owner of record requests a hearing before the Board of Patent Appeals and Interferences on the question whether any such false representation was contained in such statement. Such question shall be heard and determined, and determination thereof shall be subject to review, in the manner prescribed by subsection (d) for questions arising thereunder. No request made by the Administrator under this subsection for the transfer of title to any patent, and no prosecution for the violation of any criminal statute, shall be barred by any failure of the Administrator to make a request under subsection (d) for the issuance of such patent to him, or by any notice previously given by the Ad-

ministrator stating that he had no objection to the issuance of such patent to the applicant therefore.

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SECTION 12 OF THE SOLAR HEATING AND COOLING DEMONSTRATION ACT OF 1974

DISSEMINATION OF INFORMATION AND OTHER ACTIONS TO PROMOTE PRACTICAL USE OF SOLAR HEATING AND COOLING TECHNOLOGIES

SEC. 12. (a) The Secretary shall take all possible steps to assure that full and complete information with respect to the demonstrations and other activities conducted under this Act is made available to Federal, State, and local authorities, the building industry and related segments of the economy, the scientific and technical community, and the public at large, both during and after the close of the programs under this Act, with the objective of promoting and facilitating to the maximum extent feasible the early and widespread practical use of solar energy for the heating and cooling of buildings throughout the United States. In accordance with regulations prescribed under section 16 such information shall be disseminated on a coordinated basis by the Secretary, the Administrator, the Director of the National Bureau of Standards, the Director, the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office, and other appropriate Federal offices and agencies.

* * * * * * *

SECTION 10 OF THE TRADING WITH THE ENEMY ACT

SEC. 10. That nothing contained in this Act shall be held to make unlawful any of the following Acts:

(a) * * *

* * * * * * *

(i) Whenever the publication of an invention by the granting of a patent may, in the opinion of the President, be detrimental to the public safety or defense, or may assist the enemy or endanger the successful prosecution of the war, he may order that the invention be kept secret and withhold the grant of a patent until the end of the war: *Provided,* That the invention disclosed in the application for said patent may be held abandoned upon it being established before or by the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office that, in violation of said order, said invention has been published or that an application for a patent therefor has been filed in any other country, by the inventor or his assigns or legal representatives, without the consent or approval of the commissioner or under a license of the President.

When an application whose patent is withheld as herein provided and who faithfully obeys the order of the President above re-

ferred to shall tender his invention to the Government of the United States for its use, he shall, if he ultimately receives a patent, have the right to sue for compensation in the United States Claims Court, such right to compensation to begin from the date of the use of the invention by the Government.

INTELLECTUAL PROPERTY AND COMMUNICATIONS OMNIBUS REFORM ACT OF 1999

* * * * * * *

TITLE I—SATELLITE HOME VIEWER IMPROVEMENT

* * * * * * *

SEC. 1006. PUBLIC BROADCASTING SERVICE SATELLITE FEED.

(a) SECONDARY TRANSMISSIONS.—Section 119(a)(1) of title 17, United States Code, is amended—

(1) by striking the paragraph heading and inserting "(1) SUPERSTATIONS AND PBS SATELLITE FEED.—"; *and*

[(2) by inserting "or by the Public Broadcasting Service satellite feed" after "superstation"; and**]**

[(3)**]** *(2)* by adding at the end the following: "In the case of the Public Broadcasting Service satellite feed, the statutory license shall be effective until January 1, 2002.".

(b) ROYALTY FEES.—Section **[**119(b)(1)(B)(iii)**]** *119(b)(1)(B)(ii)* of title 17, United States Code, is amended by inserting "or the Public Broadcasting Service satellite feed" after "network station".

* * * * * * *

SEC. 1007. APPLICATION OF FEDERAL COMMUNICATIONS COMMISSION REGULATIONS.

Section 119(a) of title 17, United States Code, is amended—

(1) * * *

(2) in paragraph **[**(2)**]** *(2)(A)*, by inserting "with regard to secondary transmissions the satellite carrier is in compliance with the rules, regulations, or authorizations of the Federal Communications Commission governing the carriage of television broadcast station signals," after "satellite carrier to the public for private home viewing,"; and

(3) by adding at the end of such subsection (as amended by section **[**1005(e)**]** *1005(d)* of this Act) the following new paragraph:

"(12) STATUTORY LICENSE CONTINGENT ON COMPLIANCE WITH FCC RULES AND REMEDIAL STEPS.—Notwithstanding any other provision of this section, the willful or repeated secondary transmission to the public by a satellite carrier of a primary transmission embodying a performance or display of a work made by a broadcast station licensed by the Federal Communications Commission is actionable as an act of infringement under section 501, and is fully subject to the remedies provided by sections 502 through 506 and 509, if, at the time of such transmission, the satellite carrier is not in compliance

with the rules, regulations, and authorizations of the Federal Communications Commission concerning the carriage of television broadcast station signals.".

* * * * * * *

SEC. 1011. TECHNICAL AMENDMENTS.

(a) * * *

(b) TECHNICAL AMENDMENTS RELATING TO PERFORMANCE OR DISPLAYS OF WORKS.—

(1) * * *

(2) Section 119(a) of title 17, United States Code, is amended—

[(A) in paragraph (1), by striking "primary transmission made by a superstation and embodying a performance or display of a work" and inserting "performance or display of a work embodied in a primary transmission made by a superstation";]

(A) in paragraph (1), by striking "primary transmission made by a superstation and embodying a performance or display of a work" and inserting "performance or display of a work embodied in a primary transmission made by a superstation or by the Public Broadcasting Service satellite feed";

* * * * * * *

TITLE IV—INVENTOR PROTECTION

* * * * * * *

Subtitle B—Patent and Trademark Fee Fairness

* * * * * * *

SEC. 4203. ADJUSTMENT OF TRADEMARK FEES.

Notwithstanding the second sentence of section 31(a) of the Trademark Act of 1946 (15 U.S.C. [111(a)] *1113(a)*), the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office is authorized in fiscal year 2000 to adjust trademark fees without regard to fluctuations in the Consumer Price Index during the preceding 12 months.

* * * * * * *

Subtitle D—Patent Term Guarantee

* * * * * * *

SEC. 4402. PATENT TERM GUARANTEE AUTHORITY.

(a) * * *

(b) CONFORMING AMENDMENTS.—

(1) Section 282 of title 35, United States Code, is amended [in the fourth paragraph] by striking "156 of this title" and inserting "154(b) or 156 of this title".

* * * * * * *

Subtitle E—Domestic Publication of Patent Applications Published Abroad

* * * * * * *

[SEC. 4505. PRIOR ART EFFECT OF PUBLISHED APPLICATIONS.

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

["(e) The invention was described in—

["(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

["(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a); or".]

SEC. 4505. PRIOR ART EFFECT OF PUBLISHED APPLICATIONS.

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

"(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or".

SEC. 4506. COST RECOVERY FOR PUBLICATION.

The Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office shall recover the cost of early publication required by the amendment made by section 4502 by charging a separate publication fee after notice of allowance is given under section 151 of title 35, United States Code.

SEC. 4507. CONFORMING AMENDMENTS.

The following provisions of title 35, United States Code, are amended:

(1) Section [11] *10* is amended in paragraph 1 of subsection (a) by inserting "and published applications for patents" after "Patents".

(2) Section [12] *11* is amended—

(A) * * *

* * * * * * *

(3) Section [13] *12* is amended—

(A) * * *

* * * * * * *

(4) The items relating to sections [12 and 13] *11 and 12* in the table of sections for chapter 1 are each amended by inserting "and applications" after "patents".

* * * * * * *

(10) Section 374 is amended to read as follows:

"§ 374. Publication of international application

"The publication under the treaty defined in section 351(a) of this title, of an international application designating the United States shall [confer the same rights and shall have the same effect under this title as an application for patent published] *be deemed a publication* under section 122(b), except as provided in sections 102(e) and 154(d) of this title.".

* * * * * * *

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

"374. Publication of international application.".

* * * * * * *

[SEC. 4508. EFFECTIVE DATE.

[Sections 4502 through 4507, and the amendments made by such sections, shall take effect on the date that is 1 year after the date of the enactment of this Act and shall apply to all applications filed under section 111 of title 35, United States Code, on or after that date, and all applications complying with section 371 of title 35, United States Code, that resulted from international applications filed on or after that date. The amendments made by sections 4504 and 4505 shall apply to any such application voluntarily published by the applicant under procedures established under this subtitle that is pending on the date that is 1 year after the date of the enactment of this Act. The amendment made by section 4504 shall also apply to international applications designating the United States that are filed on or after the date that is 1 year after the date of the enactment of this Act.]

SEC. 4508. EFFECTIVE DATE.

Except as otherwise provided in this section, sections 4502 through 4507, and the amendments made by such sections, shall be effective as of November 29, 2000, and shall apply only to applications (including international applications designating the United States) filed on or after that date. The amendments made by sections 4504 and 4505 shall additionally apply to any pending application filed before November 29, 2000, if such pending application

is published pursuant to a request of the applicant under such procedures as may be established by the Commissioner. If an application is filed on or after November 29, 2000, or is published pursuant to a request from the applicant, and the application claims the benefit of one or more prior-filed applications under section 119(e), 120, or 365(c) of title 35, United States Code, then the amendment made by section 4505 shall apply to the prior-filed application in determining the filing date in the United States of the application.

* * * * * * *

Subtitle F—Optional Inter Partes Reexamination Procedure

* * * * * * *

SEC. 4604. OPTIONAL INTER PARTES REEXAMINATION PROCEDURES.

(a) IN GENERAL.—[Part 3] *Part III* of title 35, United States Code, is amended by adding after chapter 30 the following new chapter:

* * * * * * *

(b) CONFORMING AMENDMENT.—The table of chapters for part III of [title 25] *title 35*, United States Code, is amended by striking the item relating to chapter 30 and inserting the following:

* * * * * * *

SEC. 4606. REPORT TO CONGRESS.

Not later than 5 years after the date of the enactment of this Act, the Under Secretary of Commerce for Intellectual Property and [Director] *Commissioner* of the United States Patent and Trademark Office shall submit to the Congress a report evaluating whether the inter partes reexamination proceedings established under the amendments made by this subtitle are inequitable to any of the parties in interest and, if so, the report shall contain recommendations for changes to the amendments made by this subtitle to remove such inequity.

* * * * * * *

Subtitle G—Patent and Trademark Office

* * * * * * *

CHAPTER 2—EFFECTIVE DATE; TECHNICAL AMENDMENTS

* * * * * * *

SEC. 4732. TECHNICAL AND CONFORMING AMENDMENTS.

(a) AMENDMENTS TO TITLE 35, UNITED STATES CODE.—

(1) * * *

* * * * * * *

(9)(A) Section 303 of title 35, United States Code, is amended—

(i) in the section heading by striking "**Commissioner**" and inserting "**Director**"; and

(ii) *in subsection (b),* by striking "Commissioner's" and inserting "Director's".

* * * * * * *

(10)(A) Except as provided in subparagraph (B), title 35, United States Code, *other than sections 1 through 6 (as amended by chapter 1 of this subtitle),* is amended by striking "Commissioner" each place it appears and inserting "Director".

* * * * * * *

Subtitle H—Miscellaneous Patent Provisions

* * * * * * *

SEC. 4802. INTERNATIONAL APPLICATIONS.

Section 119 of title 35, United States Code, is amended as follows:

(1) In subsection (a), insert "or in a WTO member country," after "or *to* citizens of the United States,".

* * * * * * *

SEC. 4804. ELECTRONIC FILING AND PUBLICATIONS.

(a) * * *

(b) PUBLICATIONS.—Section **[**11(a)**]** *10(a)* of title 35, United States Code, is amended by amending the matter preceding paragraph 1 to read as follows:

* * * * * * *

(c) COPIES OF PATENTS FOR PUBLIC LIBRARIES.—Section **[**13**]** *12* of title 35, United States Code, is amended by striking "printed copies of specifications and drawings of patents" and inserting "copies of specifications and drawings of patents in printed or electronic form".

* * * * * * *

(d) MAINTENANCE OF COLLECTIONS.—

(1) * * *

(2) CONTINUATION OF MAINTENANCE.—The Under Secretary of Commerce for Intellectual Property and **[**Director**]** *Commissioner* of the United States Patent and Trademark Office shall not, pursuant to the amendment made by paragraph (1), cease to maintain, for use by the public, paper or microform collections of United States patents, foreign patent documents, and United States trademark registrations, except pursuant to notice and opportunity for public comment and except that the **[**Director**]** *Commissioner* shall first submit a report to the Committees on the Judiciary of the Senate and the House of Representatives detailing such plan, including a description of the mechanisms in place to ensure the integrity of such collections and the data contained therein, as well as to ensure prompt public access to the most current available in-

formation, and certifying that the implementation of such plan will not negatively impact the public.

TITLE 17, UNITED STATES CODE

* * * * * * *

CHAPTER 1—SUBJECT MATTER AND SCOPE OF COPYRIGHT

Sec.
101. Definitions.

* * * * * * *

121. Limitations on exclusive rights: [reproduction] *Reproduction* for blind or other people with disabilities.
[122. Limitations on exclusive rights; secondary transmissions by satellite carriers within local market.]
122. Limitations on exclusive rights: Secondary transmissions by satellite carriers within local markets.

§ 101. Definitions

Except as otherwise provided in this title, as used in this title, the following terms and their variant forms mean the following:

An "anonymous work" is a work on the copies or phonorecords of which no natural person is identified as author.

* * * * * * *

A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term "compilation" includes collective works.

A "computer program" is a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result.

* * * * * * *

To perform or display a work "publicly" means—

(1) * * *

* * * * * * *

"Registration", for purposes of sections 205(c)(2), 405, 406, 410(d), 411, 412, and 506(e), means a registration of a claim in the original or the renewed and extended term of copyright.

* * * * * * *

§ 106. Exclusive rights in copyrighted works

Subject to sections 107 through [121] *122*, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

(1) * * *

* * * * * * *

§ 110. Limitations on exclusive rights: Exemption of certain performances and displays

Notwithstanding the provisions of section 106, the following are not infringements of copyright:

(1) * * *

* * * * * * *

(4) performance of a nondramatic literary or musical work otherwise than in a transmission to the public, without any purpose of direct or indirect commercial advantage and without payment of any fee or other compensation for the performance to any of its performers, promoters, or organizers, if—

(A) * * *

(B) the proceeds, after deducting the reasonable costs of producing the performance, are used exclusively for educational, religious, or charitable purposes and not for private financial gain, except where the copyright owner has served notice of objection to the performance under the following conditions**[**;**]***:*

(i) * * *

* * * * * * *

§ 118. Scope of exclusive rights: Use of certain works in connection with noncommercial broadcasting

(a) * * *

(b) Notwithstanding any provision of the antitrust laws, any owners of copyright in published nondramatic musical works and published pictorial, graphic, and sculptural works and any public broadcasting entities, respectively, may negotiate and agree upon the terms and rates of royalty payments and the proportionate division of fees paid among various copyright owners, and may designate common agents to negotiate, agree to, pay, or receive payments.

(1) Any owner of copyright in a work specified in this subsection or any public broadcasting entity may submit to the Librarian of Congress proposed licenses covering such activities with respect to such works. The Librarian of Congress shall proceed on the basis of the proposals submitted **[**to it**]** as well as any other relevant information. The Librarian of Congress shall permit any interested party to submit information relevant to such proceedings.

* * * * * * *

§ 119. Limitations on exclusive rights: Secondary transmissions of superstations and network stations for private home viewing

(a) SECONDARY TRANSMISSIONS BY SATELLITE CARRIERS.—

(1) * * *

* * * * * * *

(6) DISCRIMINATION BY A SATELLITE CARRIER.—Notwithstanding the provisions of paragraph (1), the willful or repeated secondary transmission to the public by a satellite carrier **[**of performance**]** *of a performance* or display of a work

embodied in a primary transmission made by a superstation or a network station is actionable as an act of infringement under section 501, and is fully subject to the remedies provided by sections 502 through 506 and 509, if the satellite carrier unlawfully discriminates against a distributor.

* * * * * * *

(b) STATUTORY LICENSE FOR SECONDARY TRANSMISSIONS FOR PRIVATE HOME VIEWING.—

(1) DEPOSITS WITH THE REGISTER OF COPYRIGHTS.—A satellite carrier whose secondary transmissions are subject to statutory licensing under subsection (a) shall, on a semiannual basis, deposit with the Register of Copyrights, in accordance with requirements that the Register shall prescribe by regulation—

(A) a statement of account, covering the preceding 6-month period, specifying the names and locations of all superstations and network stations whose signals were [transmitted] *retransmitted*, at any time during that period, to subscribers for private home viewing as described in subsections (a)(1) and (a)(2), the total number of subscribers that received such [transmissions] *retransmissions*, and such other data as the Register of Copyrights may from time to time prescribe by regulation; and

* * * * * * *

§ 121. Limitations on exclusive rights: [reproduction] *Reproduction* for blind or other people with disabilities

(a) * * *

* * * * * * *

§ 122. Limitations on exclusive [rights; secondary] *rights: Secondary* transmissions by satellite carriers within local markets

(a) * * *

* * * * * * *

CHAPTER 2—COPYRIGHT OWNERSHIP AND TRANSFER

* * * * * * *

§ 203. Termination of transfers and licenses granted by the author

(a) CONDITIONS FOR TERMINATION.—In the case of any work other than a work made for hire, the exclusive or nonexclusive grant of a transfer or license of copyright or of any right under a copyright, executed by the author on or after January 1, 1978, otherwise than by will, is subject to termination under the following conditions:

(1) * * *

(2) Where an author is dead, his or her termination interest is owned, and may be exercised, as follows:

(A) [the] *The* widow or widower owns the author's entire termination interest unless there are any surviving children or grandchildren of the author, in which case the

widow or widower owns one-half of the author's interest[;].

(B) [the] *The* author's surviving children, and the surviving children of any dead child of the author, own the author's entire termination interest unless there is a widow or widower, in which case the ownership of one-half of the author's interest is divided among them[;].

(C) [the] *The* rights of the author's children and grandchildren are in all cases divided among them and exercised on a per stirpes basis according to the number of such author's children represented; the share of the children of a dead child in a termination interest can be exercised only by the action of a majority of them.

* * * * * * *

CHAPTER 3—DURATION OF COPYRIGHT

* * * * * * *

§ 304. Duration of copyright: Subsisting copyrights

(a) * * *

* * * * * * *

(c) TERMINATION OF TRANSFERS AND LICENSES COVERING EXTENDED RENEWAL TERM.—In the case of any copyright subsisting in either its first or renewal term on January 1, 1978, other than a copyright in a work made for hire, the exclusive or nonexclusive grant of a transfer or license of the renewal copyright or any right under it, executed before January 1, 1978, by any of the persons designated by subsection (a)(1)(C) of this section, otherwise than by will, is subject to termination under the following conditions:

(1) * * *

(2) Where an author is dead, his or her termination interest is owned, and may be exercised, as follows:

(A) [the] *The* widow or widower owns the author's entire termination interest unless there are any surviving children or grandchildren of the author, in which case the widow or widower owns one-half of the author's interest[;].

(B) [the] *The* author's surviving children, and the surviving children of any dead child of the author, own the author's entire termination interest unless there is a widow or widower, in which case the ownership of one-half of the author's interest is divided among them[;].

(C) [the] *The* rights of the author's children and grandchildren are in all cases divided among them and exercised on a per stirpes basis according to the number of such author's children represented; the share of the children of a dead child in a termination interest can be exercised only by the action of a majority of them.

* * * * * * *

CHAPTER 5—COPYRIGHT INFRINGEMENT AND REMEDIES

* * * * * * *

§ 501. Infringement of copyright

(a) Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through [121] *122* or of the author as provided in section 106A(a), or who imports copies or phonorecords into the United States in violation of section 602, is an infringer of the copyright or right of the author, as the case may be. For purposes of this chapter (other than section 506), any reference to copyright shall be deemed to include the rights conferred by section 106A(a). As used in this subsection, the term "anyone" includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her 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.

* * * * * * *

§ 511. Liability of States, instrumentalities of States, and State officials for infringement of copyright

(a) IN GENERAL.—Any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity, shall not be immune, under the Eleventh Amendment of the Constitution of the United States or under any other doctrine of sovereign immunity, from suit in Federal court by any person, including any governmental or nongovernmental entity, for a violation of any of the exclusive rights of a copyright owner provided by sections 106 through [121] *122*, for importing copies of phonorecords in violation of section 602, or for any other violation under this title.

* * * * * * *

CHAPTER 9—PROTECTION OF SEMICONDUCTOR CHIP PRODUCTS

Sec.
901. Definitions.

* * * * * * *

903. Ownership, transfer, [licensure] *licensing*, and recordation.

* * * * * * *

SECTION 2319 OF TITLE 18, UNITED STATES CODE

§ 2319. Criminal infringement of a copyright

(a) * * *

* * * * * * *

(e) As used in this section—

(1) * * *

(2) the terms "reproduction" and "distribution" refer to the exclusive rights of a copyright owner under clauses (1) and (3) respectively of section 106 (relating to exclusive rights in copy-

righted works), as limited by sections 107 through [120] *122*, of title 17.

SECTION 105 OF THE DESIGN PROTECTION ACT

SEC. 105. (a) * * *

* * * * * * *

(f) Subsection (a) of [section 290(e) of title 15] *section 6 of the Standard Reference Data Act (15 U.S.C. 290e)* is amended by deleting the phrase "section 8" and inserting in lieu thereof the phrase "section 105".

SECTION 6 OF THE STANDARD REFERENCE DATA ACT

SEC. 6. (a) [Notwithstanding the limitations contained in section 105 of title 17 of the United States Code,] *Notwithstanding the limitations under section 105 of title 17, United States Code,* the Secretary may secure copyright and renewal thereof on behalf of the United States as author or proprietor in all or any part of any standard reference data which he prepares or makes available under this Act, and may authorize the reproduction and publication thereof by others.

* * * * * * *

BUSINESS MEETING

THURSDAY, MARCH 8, 2001

HOUSE OF REPRESENTATIVES,
COMMITTEE ON THE JUDICIARY,
Washington, DC.

The committee met, pursuant to notice, at 10 a.m., in Room 2141, Rayburn House Office Building, Hon. F. James Sensenbrenner (chairman of the committee) presiding.

Pursuant to notice, I now call up the bill S.320, a bill to make technical corrections in the patent, copyright, and trademark laws, for purposes of markup, and move its favorable recommendation to the House.

[S.320 follows:]

107TH CONGRESS
1ST SESSION

S. 320

AN ACT

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 and High Technology Technical Amendments Act of
6 2001".

1 **SEC. 2. OFFICERS AND EMPLOYEES.**

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

4 (A) by striking "Director" each place it appears
5 and inserting "Commissioner"; and

6 (B) by striking "Director's" each place it ap-
7 pears and inserting "Commissioner's".

8 (2) The Act of July 5, 1946 (commonly referred to
9 as the "Trademark Act of 1946"; 15 U.S.C. 1051 et seq.)
10 is amended by striking "Director" each place it appears
11 and inserting "Commissioner".

12 (3)(A) Title 35, United States Code, is amended by
13 striking "Commissioner for Patents" each place it appears
14 and inserting "Assistant Commissioner for Patents".

15 (B) Section 3(b)(2) of title 35, United States Code,
16 is amended—

17 (i) in the paragraph heading, by striking "COM-
18 MISSIONERS" and inserting "ASSISTANT COMMIS-
19 SIONERS";

20 (ii) in subparagraph (A), in the last sentence—

21 (I) by striking "a Commissioner" and in-
22 serting "an Assistant Commissioner"; and

23 (II) by striking "the Commissioner" and
24 inserting "the Assistant Commissioner";

25 (iii) in subparagraph (B)—

(I) by striking "Commissioners" each place it appears and inserting "Assistant Commissioners";

(II) by striking "Commissioners'" each place it appears and inserting "Assistant Commissioners'"; and

(iv) in subparagraph (C), by striking "Commissioners" and inserting "Assistant Commissioners".

(C) Section 3(f) of title 35, United States Code, is amended in paragraphs (2) and (3), by striking "the Commissioner" each place it appears and inserting "the Assistant Commissioner".

(D) Section 13 of title 35, United States Code, is amended—

(i) by striking "Commissioner of" each place it appears and inserting "Assistant Commissioner for"; and

(ii) by striking "Commissioners" and inserting "Assistant Commissioners".

(E) Chapter 17 of title 35, United States Code, is amended by striking "Commissioner of Patents" each place it appears and inserting "Assistant Commissioner for Patents".

1 (F) Section 297 of title 35, United States Code, is
2 amended by striking "Commissioner of Patents" each
3 place it appears and inserting "Commissioner".
4 (4) Title 35, United States Code, is amended by
5 striking "Commissioner for Trademarks" each place it ap-
6 pears and inserting "Assistant Commissioner for Trade-
7 marks".
8 (5) Section 5314 of title 5, United States Code, is
9 amended by striking
10 "Under Secretary of Commerce for Intellectual
11 Property and Director of the United States Patent
12 and Trademark Office."
13 and inserting
14 "Under Secretary of Commerce for Intellectual
15 Property and Commissioner of the United States
16 Patent and Trademark Office.".
17 (6)(A) Section 303 of title 35, United States Code,
18 is amended—
19 (i) in the section heading by striking "**Direc-**
20 **tor** " and inserting "**Commissioner**"; and
21 (ii) by striking "Director's" and inserting
22 "Commissioner's".
23 (B) The item relating to section 303 in the table of
24 sections for chapter 30 of title 35, United States Code,

1 is amended by striking "Director" and inserting "Com-
2 missioner".
3 (b) ADDITIONAL CLERICAL AMENDMENTS.—
4 (1) The following provisions of law are amended
5 by striking "Director" each place it appears and in-
6 serting "Commissioner".
7 (A) Section 9(p)(1)(B) of the Small Busi-
8 ness Act (15 U.S.C. 638(p)(1)(B).
9 (B) Section 19 of the Tennessee Valley
10 Authority Act of 1933 (16 U.S.C. 831r).
11 (C) Section 182(b)(2)(A) of the Trade Act
12 of 1974 (19 U.S.C. 2242(b)(2)(A)).
13 (D) Section 302(b)(2)(D) of the Trade Act
14 of 1974 (19 U.S.C. 2412(b)(2)(D)).
15 (E) Section 702(d) of the Federal Food,
16 Drug, and Cosmetic Act (21 U.S.C. 372(d)).
17 (F) Section 1295(a)(4)(B) of title 28,
18 United States Code.
19 (G) Section 1744 of title 28, United States
20 Code.
21 (H) Section 151 of the Atomic Energy Act
22 of 1954 (42 U.S.C. 2181).
23 (I) Section 152 of the Atomic Energy Act
24 of 1954 (42 U.S.C. 2182).

(J) Section 305 of the National Aeronautics and Space Act of 1958 (42 U.S.C. 2457).

(K) Section 12(a) of the Solar Heating and Cooling Demonstration Act of 1974 (42 U.S.C. 5510(a)).

(L) Section 10(i) of the Trading with the enemy Act (50 U.S.C. App. 10(i)).

(M) Section 4203 of the Intellectual Property and Communications Omnibus Reform Act of 1999, as enacted by section 1000(a)(9) of Public Law 106–113.

(2) The item relating to section 1744 in the table of sections for chapter 115 of title 28, United States Code, is amended by striking "generally" and inserting ", generally".

(c) REFERENCES.—Any reference in any other Federal law, Executive order, rule, regulation, or delegation of authority, or any document of or pertaining to the Patent and Trademark Office—

(1) to the Director of the United States Patent and Trademark Office or to the Commissioner of Patents and Trademarks is deemed to refer to the Under Secretary of Commerce for Intellectual Prop-

1 erty and Commissioner of the United States Patent
2 and Trademark Office;
3 (2) to the Commissioner for Patents is deemed
4 to refer to the Assistant Commissioner for Patents;
5 and
6 (3) to the Commissioner for Trademarks is
7 deemed to refer to the Assistant Commissioner for
8 Trademarks.

9 **SEC. 3. CLARIFICATION OF REEXAMINATION PROCEDURE**
10 **ACT OF 1999; TECHNICAL AMENDMENTS.**

11 (a) OPTIONAL INTER PARTES REEXAMINATION PRO-
12 CEDURES.—Title 35, United States Code, is amended as
13 follows:
14 (1) Section 311 is amended—
15 (A) in subsection (a), by striking "person"
16 and inserting "third-party requester"; and
17 (B) in subsection (c), by striking "Unless
18 the requesting person is the owner of the pat-
19 ent, the" and inserting "The".
20 (2) Section 312 is amended—
21 (A) in subsection (a), by striking the last
22 sentence; and
23 (B) by striking ", if any".
24 (3) Section 314(b)(1) is amended—

(A) by striking "(1) This" and all that follows through "(2)" and inserting "(1)";

(B) by striking "the third-party requester shall receive a copy" and inserting "the Office shall send to the third-party requester a copy"; and

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

(4) Section 315(c) is amended by striking "United States Code,".

(5) Section 317 is amended—

(A) in subsection (a), by striking "patent owner nor the third-party requester, if any, nor privies of either" and inserting "third-party requester nor its privies"; and

(B) in subsection (b), by striking "United States Code,".

(b) CONFORMING AMENDMENTS.—

(1) APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES.—Subsections (a), (b), and (c) of section 134 of title 35, United States Code, are each amended by striking "administrative patent judge" each place it appears and inserting "primary examiner".

1 (2) PROCEEDING ON APPEAL.—Section 143 of
2 title 35, United States Code, is amended by amend-
3 ing the third sentence to read as follows: "In an ex
4 parte case or any reexamination case, the Commis-
5 sioner shall submit to the court in writing the
6 grounds for the decision of the Patent and Trade-
7 mark Office, addressing all the issues involved in the
8 appeal. The court shall, before hearing an appeal,
9 give notice of the time and place of the hearing to
10 the Commissioner and the parties in the appeal.".
11 (c) CLERICAL AMENDMENTS.—
12 (1) Section 4604(a) of the Intellectual Property
13 and Communications Omnibus Reform Act of 1999,
14 is amended by striking "Part 3" and inserting "Part
15 III".
16 (2) Section 4604(b) of that Act is amended by
17 striking "title 25" and inserting "title 35".
18 (d) EFFECTIVE DATE.—The amendments made by
19 sections 4605(c) and 4605(e) of the Intellectual Property
20 and Communications Omnibus Reform Act, as enacted by
21 section 1000(a)(9) of Public Law 106–113, shall apply to
22 any reexamination filed in the United States Patent and
23 Trademark Office on or after the date of the enactment
24 of Public Law 106–113.

SEC. 4. PATENT AND TRADEMARK EFFICIENCY ACT AMENDMENTS.

(a) DEPUTY COMMISSIONER.—

(1) Section 17(b) of the Act of July 5, 1946 (commonly referred to as the "Trademark Act of 1946") (15 U.S.C. 1067(b)), is amended by inserting "the Deputy Commissioner," after "Commissioner,".

(2) Section 6(a) of title 35, United States Code, is amended by inserting "the Deputy Commissioner," after "Commissioner,".

(b) PUBLIC ADVISORY COMMITTEES.—Section 5 of title 35, United States Code, is amended—

(1) in subsection (i), by inserting ", privileged," after "personnel"; and

(2) by adding at the end the following new subsection:

"(j) INAPPLICABILITY OF PATENT PROHIBITION.—Section 4 shall not apply to voting members of the Advisory Committees.".

(c) MISCELLANEOUS.—Section 153 of title 35, United States Code, is amended by striking "and attested by an officer of the Patent and Trademark Office designated by the Commissioner,".

SEC. 5. DOMESTIC PUBLICATION OF FOREIGN FILED PATENT APPLICATIONS ACT OF 1999 AMENDMENTS.

Section 154(d)(4)(A) of title 35, United States Code, as in effect on November 29, 2000, is amended—

(1) by striking "on which the Patent and Trademark Office receives a copy of the" and inserting "of"; and

(2) by striking "international application" the last place it appears and inserting "publication".

SEC. 6. DOMESTIC PUBLICATION OF PATENT APPLICATIONS PUBLISHED ABROAD.

Subtitle E of title IV of the Intellectual Property and Communications Omnibus Reform Act of 1999, as enacted by section 1000(a)(9) of Public Law 106–113, is amended as follows:

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

"SEC. 4505. PRIOR ART EFFECT OF PUBLISHED APPLICATIONS.

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

"'(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application 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 Commissioner. If an application is filed on or after No-
17 vember 29, 2000, or is published pursuant to a request
18 from the applicant, and the application claims the benefit
19 of one or more prior-filed applications under section
20 119(e), 120, or 365(c) of title 35, United States Code,
21 then the amendment made by section 4505 shall apply to
22 the prior-filed application in determining the filing date
23 in the United States of the application.".

1 **SEC. 7. 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 (a)(2)(B), by striking
9 "United States Code,";

10 (B) in subsection (b)(2)—

11 (i) in the first sentence of subpara-
12 graph (A), by striking ", United States
13 Code";

14 (ii) in the first sentence of subpara-
15 graph (B)—

16 (I) by striking "United States
17 Code,"; and

18 (II) by striking ", United States
19 Code";

20 (iii) in the second sentence of sub-
21 paragraph (B)—

22 (I) by striking "United States
23 Code,"; and

24 (II) by striking ", United States
25 Code." and inserting a period;

1 (iv) in the last sentence of subpara-
2 graph (B), by striking ", United States
3 Code"; and
4 (v) in subparagraph (C), by striking
5 ", United States Code"; and
6 (C) in subsection (c)—
7 (i) in the subsection caption, by strik-
8 ing ", UNITED STATES CODE"; and
9 (ii) by striking "United States Code,".
10 (3) Section 5 is amended in subsections (e) and
11 (g), by striking ", United States Code" each place
12 it appears.
13 (4) The table of chapters for part I is amended
14 in the item relating to chapter 3, by striking "**be-**
15 **fore**" and inserting "**Before**".
16 (5) The item relating to section 21 in the table
17 of contents for chapter 2 is amended to read as fol-
18 lows:

"21. Filing date and day for taking action.".

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

"12. Examination of Application ..... 131".

(7) The item relating to section 116 in the table of contents for chapter 11 is amended to read as follows:

"116. Inventors.".

(8) Section 154(b)(4) is amended by striking ", United States Code,".

(9) Section 156 is amended—

(A) in subsection (b)(3)(B), by striking "paragraphs" and inserting "paragraph";

(B) in subsection (d)(2)(B)(i), by striking "below the office" and inserting "below the Office"; and

(C) in subsection (g)(6)(B)(iii), by striking "submittted" and inserting "submitted".

(10) The item relating to section 183 in the table of contents for chapter 17 is amended by striking "of" and inserting "to".

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

(12) Section 201(a) is amended—

(A) by striking "United States Code,"; and

(B) by striking "5, United States Code." and inserting "5.".

(13) Section 202 is amended—

1 (A) in subsection (b)(4), by striking "last
2 paragraph of section 203(2)" and inserting
3 "section 203(b)"; and
4 (B) in subsection (c)—
5 (i) in paragraph (4) by striking
6 "rights;" and inserting "rights,"; and
7 (ii) in paragraph (5) by striking "of
8 the United States Code".
9 (14) Section 203 is amended—
10 (A) in paragraph (2)—
11 (i) by striking "(2)" and inserting
12 "(b)";
13 (ii) by striking the quotation marks
14 and comma before "as appropriate"; and
15 (iii) by striking "paragraphs (a) and
16 (c)" and inserting "paragraphs (1) and (3)
17 of subsection (a)"; and
18 (B) in the first paragraph—
19 (i) by striking "(a)", "(b)", "(c)",
20 and (d)" and inserting "(1)", "(2)", "(3)",
21 and (4)", respectively; and
22 (ii) by striking "(1." and inserting
23 "(a)".
24 (15) Section 209 is amended in subsections (a)
25 and (f)(1), by striking "of the United States Code".

1 (16) Section 210 is amended—

2 (A) in subsection (a)—

3 (i) in paragraph (11), by striking

4 "5901" and inserting "5908"; and

5 (ii) in paragraph (20) by striking

6 "178(j)" and inserting "178j"; and

7 (B) in subsection (c)—

8 (i) by striking "paragraph 202(c)(4)"

9 and inserting "section 202(c)(4)"; and

10 (ii) by striking "title.." and inserting

11 "title.".

12 (17) The item relating to chapter 29 in the

13 table of chapters for part III is amended by insert-

14 ing a comma after "**Patent**".

15 (18) The item relating to section 256 in the

16 table of contents for chapter 25 is amended to read

17 as follows:

"256. Correction of named inventor.".

18 (19) Section 294 is amended—

19 (A) in subsection (b), by striking "United

20 States Code,"; and

21 (B) in subsection (c), in the second sen-

22 tence by striking "court to" and inserting

23 "court of".

1 (20)(A) The item relating to section 374 in the
2 table of contents for chapter 37 is amended to read
3 as follows:

"374. Publication of international application.".

4 (B) The amendment made by subparagraph (A)
5 shall take effect on November 29, 2000.
6 (21) Section 371(b) is amended by adding at
7 the end a period.
8 (22) Section 371(d) is amended by adding at
9 the end a period.
10 (23) Paragraphs (1), (2), and (3) of section
11 376(a) are each amended by striking the semicolon
12 and inserting a period.
13 (b) OTHER AMENDMENTS.—
14 (1) Section 4732(a) of the Intellectual Property
15 and Communications Omnibus Reform Act of 1999
16 is amended—
17 (A) in paragraph (9)(A)(ii), by inserting
18 "in subsection (b)," after "(ii)"; and
19 (B) in paragraph (10)(A), by inserting
20 after "title 35, United States Code," the fol-
21 lowing: "other than sections 1 through 6 (as
22 amended by chapter 1 of this subtitle),".
23 (2) Section 4802(1) of that Act is amended by
24 inserting "to" before "citizens".
25 (3) Section 4804 of that Act is amended—

(A) in subsection (b), by striking "11(a)" and inserting "10(a)"; and

(B) in subsection (c), by striking "13" and inserting "12".

(4) Section 4402(b)(1) of that Act is amended by striking "in the fourth paragraph".

SEC. 8. TECHNICAL CORRECTIONS IN TRADEMARK LAW.

(a) AWARD OF DAMAGES.—Section 35(a) of the Act of July 5, 1946 (commonly referred to as the "Trademark Act of 1946") (15 U.S.C. 1117(a)), is amended by striking "a violation under section 43(a), (c), or (d)," and inserting "a violation under section 43(a) or (d),".

(b) ADDITIONAL TECHNICAL AMENDMENTS.—The Trademark Act of 1946 is further amended as follows:

(1) Section 1(d)(1) (15 U.S.C. 1051(d)(1)) is amended in the first sentence by striking "specifying the date of the applicant's first use" and all that follows through the end of the sentence and inserting "specifying the date of the applicant's first use of the mark in commerce and those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce.".

(2) Section 1(e) (15 U.S.C. 1051(e)) is amended to read as follows:

1 "(e) If the applicant is not domiciled in the United
2 States the applicant may designate, by a document filed
3 in the United States Patent and Trademark Office, the
4 name and address of a person resident in the United
5 States on whom may be served notices or process in pro-
6 ceedings affecting the mark. Such notices or process may
7 be served upon the person so designated by leaving with
8 that person or mailing to that person a copy thereof at
9 the address specified in the last designation so filed. If
10 the person so designated cannot be found at the address
11 given in the last designation, or if the registrant does not
12 designate by a document filed in the United States Patent
13 and Trademark Office the name and address of a person
14 resident in the United States on whom may be served no-
15 tices or process in proceedings affecting the mark, such
16 notices or process may be served on the Commissioner.";
17 (3) Section 8(f) (15 U.S.C. 1058(f)) is amend-
18 ed to read as follows:
19 "(f) If the registrant is not domiciled in the United
20 States, the registrant may designate, by a document filed
21 in the United States Patent and Trademark Office, the
22 name and address of a person resident in the United
23 States on whom may be served notices or process in pro-
24 ceedings affecting the mark. Such notices or process may
25 be served upon the person so designated by leaving with

1 that person or mailing to that person a copy thereof at
2 the address specified in the last designation so filed. If
3 the person so designated cannot be found at the address
4 given in the last designation, or if the registrant does not
5 designate by a document filed in the United States Patent
6 and Trademark Office the name and address of a person
7 resident in the United States on whom may be served no-
8 tices or process in proceedings affecting the mark, such
9 notices or process may be served on the Commissioner.";
10 (4) Section 9(c) (15 U.S.C. 1059(c)) is amend-
11 ed to read as follows:
12 "(c) If the registrant is not domiciled in the United
13 States the registrant may designate, by a document filed
14 in the United States Patent and Trademark Office, the
15 name and address of a person resident in the United
16 States on whom may be served notices or process in pro-
17 ceedings affecting the mark. Such notices or process may
18 be served upon the person so designated by leaving with
19 that person or mailing to that person a copy thereof at
20 the address specified in the last designation so filed. If
21 the person so designated cannot be found at the address
22 given in the last designation, or if the registrant does not
23 designate by a document filed in the United States Patent
24 and Trademark Office the name and address of a person
25 resident in the United States on whom may be served no-

1 tices or process in proceedings affecting the mark, such
2 notices or process may be served on the Commissioner.";
3 (5) Subsections (a) and (b) of section 10 (15
4 U.S.C. 1060(a) and (b)) are amended to read as fol-
5 lows:
6 "(a)(1) A registered mark or a mark for which an
7 application to register has been filed shall be assignable
8 with the good will of the business in which the mark is
9 used, or with that part of the good will of the business
10 connected with the use of and symbolized by the mark.
11 Notwithstanding the preceding sentence, no application to
12 register a mark under section 1(b) shall be assignable
13 prior to the filing of an amendment under section 1(c)
14 to bring the application into conformity with section 1(a)
15 or the filing of the verified statement of use under section
16 1(d), except for an assignment to a successor to the busi-
17 ness of the applicant, or portion thereof, to which the
18 mark pertains, if that business is ongoing and existing.
19 "(2) In any assignment authorized by this section,
20 it shall not be necessary to include the good will of the
21 business connected with the use of and symbolized by any
22 other mark used in the business or by the name or style
23 under which the business is conducted.
24 "(3) Assignments shall be by instruments in writing
25 duly executed. Acknowledgment shall be prima facie evi-

1 dence of the execution of an assignment, and when the
2 prescribed information reporting the assignment is re-
3 corded in the United States Patent and Trademark Office,
4 the record shall be prima facie evidence of execution.

5 "(4) An assignment shall be void against any subse-
6 quent purchaser for valuable consideration without notice,
7 unless the prescribed information reporting the assign-
8 ment is recorded in the United States Patent and Trade-
9 mark Office within 3 months after the date of the assign-
10 ment or prior to the subsequent purchase.

11 "(5) The United States Patent and Trademark Office
12 shall maintain a record of information on assignments, in
13 such form as may be prescribed by the Commissioner.

14 "(b) An assignee not domiciled in the United States
15 may designate by a document filed in the United States
16 Patent and Trademark Office the name and address of
17 a person resident in the United States on whom may be
18 served notices or process in proceedings affecting the
19 mark. Such notices or process may be served upon the
20 person so designated by leaving with that person or mail-
21 ing to that person a copy thereof at the address specified
22 in the last designation so filed. If the person so designated
23 cannot be found at the address given in the last designa-
24 tion, or if the assignee does not designate by a document
25 filed in the United States Patent and Trademark Office

1 the name and address of a person resident in the United
2 States on whom may be served notices or process in pro-
3 ceedings affecting the mark, such notices or process may
4 be served upon the Commissioner.";

5 (7) Section 23(c) (15 U.S.C. 1091(c)) is
6 amended by striking the second comma after "nu-
7 meral".

8 (8) Section 33(b)(8) (15 U.S.C. 1115(b)(8)) is
9 amended by aligning the text with paragraph (7).

10 (9) Section 34(d)(1)(A) (15 U.S.C.
11 1116(d)(1)(A)) is amended by striking "section
12 110" and all that follows through "(36 U.S.C. 380)"
13 and inserting "section 220506 of title 36, United
14 States Code,".

15 (10) Section 34(d)(1)(B)(ii) (15 U.S.C.
16 1116(d)(1)(B)(ii)) is amended by striking "section
17 110" and all that follows through "(36 U.S.C. 380)"
18 and inserting "section 220506 of title 36, United
19 States Code".

20 (11) Section 34(d)(11) is amended by striking
21 "6621 of the Internal Revenue Code of 1954" and
22 inserting "6621(a)(2) of the Internal Revenue Code
23 of 1986".

24 (12) Section 35(b) (15 U.S.C. 1117(b)) is
25 amended—

(A) by striking "section 110" and all that follows through "(36 U.S.C. 380)" and inserting "section 220506 of title 36, United States Code,"; and

(B) by striking "6621 of the Internal Revenue Code of 1954" and inserting "6621(a)(2) of the Internal Revenue Code of 1986".

(13) Section 44(e) (15 U.S.C. 1126(e)) is amended by striking "a certification" and inserting "a true copy, a photocopy, a certification,".

SEC. 9. PATENT AND TRADEMARK FEE CLERICAL AMENDMENT.

The Patent and Trademark Fee Fairness Act of 1999 (113 Stat. 1537–546 et seq.), as enacted by section 1000(a)(9) of Public Law 106–113, is amended in section 4203, by striking "111(a)" and inserting "1113(a)".

SEC. 10. COPYRIGHT RELATED CORRECTIONS TO 1999 OMNIBUS REFORM ACT.

Title I of the Intellectual Property and Communications Omnibus Reform Act of 1999, as enacted by section 1000(a)(9) of Public Law 106–113, is amended as follows:

(1) Section 1007 is amended—

(A) in paragraph (2), by striking "paragraph (2)" and inserting "paragraph (2)(A)"; and

(B) in paragraph (3), by striking "1005(e)" and inserting "1005(d)".

(2) Section 1006(b) is amended by striking "119(b)(1)(B)(iii)" and inserting "119(b)(1)(B)(ii)".

(3)(A) Section 1006(a) is amended—

(i) in paragraph (1), by adding "and" after the semicolon;

(ii) by striking paragraph (2); and

(iii) by redesignating paragraph (3) as paragraph (2).

(B) Section 1011(b)(2)(A) is amended to read as follows:

"(A) in paragraph (1), by striking 'primary transmission made by a superstation and embodying a performance or display of a work' and inserting 'performance or display of a work embodied in a primary transmission made by a superstation or by the Public Broadcasting Service satellite feed';".

SEC. 11. AMENDMENTS TO TITLE 17, UNITED STATES CODE.

Title 17, United States Code, is amended as follows:

(1) Section 119(a)(6) is amended by striking "of performance" and inserting "of a performance".

(2)(A) The section heading for section 122 is amended by striking "**rights; secondary**" and inserting "**rights: Secondary**".

(B) The item relating to section 122 in the table of contents for chapter 1 is amended to read as follows:

"122. Limitations on exclusive rights: Secondary transmissions by satellite carriers within local markets.".

(3)(A) The section heading for section 121 is amended by striking "**reproduction**" and inserting "**Reproduction**".

(B) The item relating to section 121 in the table of contents for chapter 1 is amended by striking "reproduction" and inserting "Reproduction".

(4)(A) Section 106 is amended by striking "107 through 121" and inserting "107 through 122".

(B) Section 501(a) is amended by striking "106 through 121" and inserting "106 through 122".

(C) Section 511(a) is amended by striking "106 through 121" and inserting "106 through 122".

(5) Section 101 is amended—

(A) by moving the definition of "computer program" so that it appears after the definition of "compilation"; and

(B) by moving the definition of "registration" so that it appears after the definition of "publicly".

(6) Section 110(4)(B) is amended in the matter preceding clause (i) by striking "conditions;" and inserting "conditions:".

(7) Section 118(b)(1) is amended in the second sentence by striking "to it".

(8) Section 119(b)(1)(A) is amended—

(A) by striking "transmitted" and inserting "retransmitted"; and

(B) by striking "transmissions" and inserting "retransmissions".

(9) Section 203(a)(2) is amended—

(A) in subparagraph (A)—

(i) by striking "(A) the" and inserting "(A) The"; and

(ii) by striking the semicolon at the end and inserting a period;

(B) in subparagraph (B)—

(i) by striking "(B) the" and inserting "(B) The"; and

(ii) by striking the semicolon at the end and inserting a period; and

(C) in subparagraph (C), by striking "(C) the" and inserting "(C) The".

(10) Section 304(c)(2) is amended—

(A) in subparagraph (A)—

(i) by striking "(A) the" and inserting "(A) The"; and

(ii) by striking the semicolon at the end and inserting a period;

(B) in subparagraph (B)—

(i) by striking "(B) the" and inserting "(B) The"; and

(ii) by striking the semicolon at the end and inserting a period; and

(C) in subparagraph (C), by striking "(C) the" and inserting "(C) The".

(11) The item relating to section 903 in the table of contents for chapter 9 is amended by striking "licensure" and inserting "licensing".

SEC. 12. OTHER COPYRIGHT RELATED TECHNICAL AMENDMENTS.

(a) AMENDMENT TO TITLE 18.—Section 2319(e)(2) of title 18, United States Code, is amended by striking "107 through 120" and inserting "107 through 122".

(b) STANDARD REFERENCE DATA.—(1) Section 105(f) of Public Law 94–553 is amended by striking "sec-

1 tion 290(e) of title 15" and inserting "section 6 of the
2 Standard Reference Data Act (15 U.S.C. 290e)".
3 (2) Section 6(a) of the Standard Reference Data Act
4 (15 U.S.C. 290e) is amended by striking "Notwith-
5 standing" and all that follows through "United States
6 Code," and inserting "Notwithstanding the limitations
7 under section 105 of title 17, United States Code,".

Passed the Senate February 14, 2001.

Attest:

Secretary.

Chairman SENSENBRENNER. Without objection, the bill will be considered as read and open for amendment at any time, and I recognize myself for 5 minutes.

On February 14th, the Senate passed S.320, the Intellectual Property and High Technology Technical Amendments Act of 2001 by a recorded vote of 98 to nothing. It is nice to know they have done something.

The same day, our distinguished colleague from North Carolina, Mr. Coble, introduced, along with Ranking Member Berman, two related technical corrections bills, H.R. 614 and H.R. 615, which are nearly identical to two bills passed in the 106th Congress. Both of those were discharged from the Subcommittee on Courts and Intellectual Property, passed by this committee by voice vote, and by the House under suspension of the rules.

The Senate was not able to pass these bills during the final days of the 106th, and the bill before us is virtually identical to both bills passed in the 106th Congress, and the bills introduced in the 107th Congress, and I now recognize Mr. Conyers.

Mr. CONYERS. I would say that we're in support of this measure again. I think that our ranking member of the subcommittee, Mr. Berman, has examined it, and we are in complete support of the measure.

I return any time.

Chairman SENSENBRENNER. I thank the gentleman from Michigan.

I now recognize the gentleman from North Carolina, for purpose of offering a substitute.

Mr. COBLE. I thank the chairman. Mr. Chairman, I have an amendment at the desk.

Chairman SENSENBRENNER. The clerk will report the amendment.

The CLERK. Amendment to the amend—amendment in the nature of the substitute to S.320 of the——

Mr. COBLE. Mr. Chairman, I ask unanimous consent that the amendment be considered as read.

Chairman SENSENBRENNER. Without objection, and the gentleman is recognized for 5 minutes.

[The amendment in the nature of a substitute to S.320 offered by Mr. Coble follows:]

AMENDMENT IN THE NATURE OF A SUBSTITUTE

TO S. 320

OFFERED BY Mr. Coble

Strike all after the enacting clause and insert the following:

1 **SECTION 1. SHORT TITLE.**

2 This Act may be cited as the "Intellectual Property
3 and High Technology Technical Amendments Act of
4 2001".

5 **SEC. 2. OFFICERS AND EMPLOYEES.**

6 (a) RENAMING OF OFFICERS.—(1)(A) Except as pro-
7 vided in subparagraph (B), title 35, United States Code,
8 is amended—

9 (i) by striking "Director" each place it appears
10 and inserting "Commissioner"; and

11 (ii) by striking "Director's" each place it ap-
12 pears and inserting "Commissioner's".

13 (B) Section 3(b)(5) of title 35, United States Code,
14 is amended by striking "Director" the first place it ap-
15 pears and inserting "Commissioner".

16 (C) Section 3(a) of title 35, United States Code, is
17 amended in the subsection heading, by striking "DIREC-
18 TOR" and inserting "COMMISSIONER".

1 (D) Section 3(b)(1) of title 35, United States Code,
2 is amended in the paragraph heading, by striking "DIREC-
3 TOR" and inserting "COMMISSIONER".
4 (2) The Act of July 5, 1946 (commonly referred to
5 as the "Trademark Act of 1946"; 15 U.S.C. 1051 et seq.)
6 is amended by striking "Director" each place it appears
7 and inserting "Commissioner".
8 (3)(A) Title 35, United States Code, other than sub-
9 section (f) of section 3, is amended by striking "Commis-
10 sioner for Patents" each place it appears and inserting
11 "Assistant Commissioner for Patents".
12 (B) Title 35, United States Code, other than sub-
13 section (f) of section 3, is amended by striking "Commis-
14 sioner for Trademarks" each place it appears and insert-
15 ing "Assistant Commissioner for Trademarks".
16 (C) Section 3(b)(2) of title 35, United States Code,
17 is amended—
18 (i) in the paragraph heading, by striking "COM-
19 MISSIONERS" and inserting "ASSISTANT COMMIS-
20 SIONERS";
21 (ii) in subparagraph (A), in the last sentence—
22 (I) by striking "a Commissioner" and in-
23 serting "an Assistant Commissioner"; and
24 (II) by striking "the Commissioner" and
25 inserting "the Assistant Commissioner";

1 (iii) in subparagraph (B)—

2 (I) by striking "Commissioners" each place

3 it appears and inserting "Assistant Commis-

4 sioners";

5 (II) by striking "Commissioners'" each

6 place it appears and inserting "Assistant Com-

7 missioners'"; and

8 (iv) in subparagraph (C), by striking "Commis-

9 sioners" and inserting "Assistant Commissioners".

10 (D) Section 3(f) of title 35, United States Code, is

11 amended in subparagraphs (A) and (B) of paragraph

12 (2)—

13 (i) by striking "the Commissioner" each place

14 it appears and inserting "the Assistant Commis-

15 sioner"; and

16 (ii) by striking "a Commissioner" each place it

17 appears and inserting "an Assistant Commissioner".

18 (E) Section 13 of title 35, United States Code, is

19 amended—

20 (i) by striking "Commissioner of" each place it

21 appears and inserting "Assistant Commissioner for";

22 and

23 (ii) by striking "Commissioners" and inserting

24 "Assistant Commissioners".

1 (F) Chapter 17 of title 35, United States Code, is
2 amended by striking "Commissioner of Patents" each
3 place it appears and inserting "Assistant Commissioner
4 for Patents".
5 (G) Section 297 of title 35, United States Code, is
6 amended by striking "Commissioner of Patents" each
7 place it appears and inserting "Commissioner".
8 (4) Section 5314 of title 5, United States Code, is
9 amended by striking
10 "Under Secretary of Commerce for Intellectual
11 Property and Director of the United States Patent
12 and Trademark Office."
13 and inserting
14 "Under Secretary of Commerce for Intellectual
15 Property and Commissioner of the United States
16 Patent and Trademark Office.".
17 (5) Section 5315 of title 5, United States Code, is
18 amended by striking
19 "Deputy Under Secretary of Commerce for In-
20 tellectual Property and Deputy Director of the
21 United States Patent and Trademark Office."
22 and inserting
23 "Deputy Under Secretary of Commerce for In-
24 tellectual Property and Deputy Commissioner of the
25 United States Patent and Trademark Office.".

1 (6)(A) Sections 303 and 304 of title 35, United
2 States Code, are each amended in the section headings
3 by striking "**Director**" and inserting "**Commis-**
4 **sioner**".
5 (B) The items relating to sections 303 and 304 in
6 the table of sections for chapter 30 of title 35, United
7 States Code, are each amended by striking "Director" and
8 inserting "Commissioner".
9 (7)(A) Sections 312 and 313 of title 35, United
10 States Code, are each amended in the section headings
11 by striking "**Director**" and inserting "**Commis-**
12 **sioner**".
13 (B) The items relating to sections 312 and 313 in
14 the table of sections for chapter 31 of title 35, United
15 States Code, are each amended by striking "Director" and
16 inserting "Commissioner".
17 (8) Section 17(b) of the Trademark Act of 1946 (15
18 U.S.C. 1067) is amended by striking "Commissioner for
19 Patents, the Commissioner for Trademarks" and inserting
20 "Assistant Commissioner for Patents, the Assistant Com-
21 missioner for Trademarks".
22 (b) ADDITIONAL CLERICAL AMENDMENTS.—
23 (1) The following provisions of law are amended
24 by striking "Director" each place it appears and in-
25 serting "Commissioner".

1 (A) Section 9(p)(1)(B) of the Small Busi-
2 ness Act (15 U.S.C. 638(p)(1)(B).
3 (B) Section 19 of the Tennessee Valley
4 Authority Act of 1933 (16 U.S.C. 831r).
5 (C) Section 182(b)(2)(A) of the Trade Act
6 of 1974 (19 U.S.C. 2242(b)(2)(A)).
7 (D) Section 302(b)(2)(D) of the Trade Act
8 of 1974 (19 U.S.C. 2412(b)(2)(D)).
9 (E) Section 702(d) of the Federal Food,
10 Drug, and Cosmetic Act (21 U.S.C. 372(d)).
11 (F) Section 1295(a)(4)(B) of title 28,
12 United States Code.
13 (G) Section 1744 of title 28, United States
14 Code.
15 (H) Section 151 of the Atomic Energy Act
16 of 1954 (42 U.S.C. 2181).
17 (I) Section 152 of the Atomic Energy Act
18 of 1954 (42 U.S.C. 2182).
19 (J) Section 305 of the National Aero-
20 nautics and Space Act of 1958 (42 U.S.C.
21 2457).
22 (K) Section 12(a) of the Solar Heating
23 and Cooling Demonstration Act of 1974 (42
24 U.S.C. 5510(a)).

1 (L) Section 10(i) of the Trading with the
2 enemy Act (50 U.S.C. App. 10(i)).
3 (M) Sections 4506, 4606, and 4804(d)(2)
4 of the Intellectual Property and Communica-
5 tions Omnibus Reform Act of 1999, as enacted
6 by section 1000(a)(9) of Public Law 106–113.
7 (2) The item relating to section 1744 in the
8 table of sections for chapter 115 of title 28, United
9 States Code, is amended by striking "generally" and
10 inserting ", generally".
11 (c) REFERENCES.—Any reference in any other Fed-
12 eral law, Executive order, rule, regulation, or delegation
13 of authority, or any document of or pertaining to the Pat-
14 ent and Trademark Office—
15 (1) to the Director of the United States Patent
16 and Trademark Office or to the Commissioner of
17 Patents and Trademarks is deemed to refer to the
18 Under Secretary of Commerce for Intellectual Prop-
19 erty and Commissioner of the United States Patent
20 and Trademark Office;
21 (2) to the Commissioner for Patents is deemed
22 to refer to the Assistant Commissioner for Patents;
23 and

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

SEC. 3. CLARIFICATION OF REEXAMINATION PROCEDURE ACT OF 1999; TECHNICAL AMENDMENTS.

(a) OPTIONAL INTER PARTES REEXAMINATION PROCEDURES.—Title 35, United States Code, is amended as follows:

(1) Section 311 is amended—

(A) in subsection (a), by striking "person" and inserting "third-party requester"; and

(B) in subsection (c), by striking "Unless the requesting person is the owner of the patent, the" and inserting "The".

(2) Section 312 is amended—

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

(B) by striking ", if any".

(3) Section 314(b)(1) is amended—

(A) by striking "(1) This" and all that follows through "(2)" and inserting "(1)";

(B) by striking "the third-party requester shall receive a copy" and inserting "the Office shall send to the third-party requester a copy"; and

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

(4) Section 315(c) is amended by striking "United States Code,".

(5) Section 317 is amended—

(A) in subsection (a), by striking "patent owner nor the third-party requester, if any, nor privies of either" and inserting "third-party requester nor its privies"; and

(B) in subsection (b), by striking "United States Code,".

(b) CONFORMING AMENDMENTS.—

(1) APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES.—Subsections (a), (b), and (c) of section 134 of title 35, United States Code, are each amended by striking "administrative patent judge" each place it appears and inserting "primary examiner".

(2) PROCEEDING ON APPEAL.—Section 143 of title 35, United States Code, is amended by amending the third sentence to read as follows: "In an ex parte case or any reexamination case, the Commissioner shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the

1 appeal. The court shall, before hearing an appeal,
2 give notice of the time and place of the hearing to
3 the Commissioner and the parties in the appeal.".
4 (c) CLERICAL AMENDMENTS.—
5 (1) Section 4604(a) of the Intellectual Property
6 and Communications Omnibus Reform Act of 1999,
7 as enacted by section 1000(a)(9) of Public Law
8 106–113, is amended by striking "Part 3" and in-
9 serting "Part III".
10 (2) Section 4604(b) of that Act is amended by
11 striking "title 25" and inserting "title 35".
12 (d) EFFECTIVE DATE.—The amendments made by
13 sections 4605(c) and 4605(e) of the Intellectual Property
14 and Communications Omnibus Reform Act, as enacted by
15 section 1000(a)(9) of Public Law 106–113, shall apply to
16 any reexamination filed in the United States Patent and
17 Trademark Office on or after the date of the enactment
18 of Public Law 106–113.
19 **SEC. 4. PATENT AND TRADEMARK EFFICIENCY ACT AMEND-**
20 **MENTS.**
21 (a) DEPUTY COMMISSIONER.—
22 (1) Section 17(b) of the Act of July 5, 1946
23 (commonly referred to as the "Trademark Act of
24 1946") (15 U.S.C. 1067(b)), is amended by insert-

1 ing "the Deputy Commissioner," after "Commis-
2 sioner,".
3 (2) Section 6(a) of title 35, United States Code,
4 is amended by inserting "the Deputy Commis-
5 sioner," after "Commissioner,".
6 (b) PUBLIC ADVISORY COMMITTEES.—Section 5 of
7 title 35, United States Code, is amended—
8 (1) in subsection (i), by inserting ", privileged,"
9 after "personnel"; and
10 (2) by adding at the end the following new sub-
11 section:
12 "(j) INAPPLICABILITY OF PATENT PROHIBITION.—
13 Section 4 shall not apply to voting members of the Advi-
14 sory Committees.".
15 (c) MISCELLANEOUS.—Section 153 of title 35,
16 United States Code, is amended by striking "and attested
17 by an officer of the Patent and Trademark Office des-
18 ignated by the Commissioner,".
19 **SEC. 5. DOMESTIC PUBLICATION OF FOREIGN FILED PAT-**
20 **ENT APPLICATIONS ACT OF 1999 AMEND-**
21 **MENTS.**
22 Section 154(d)(4)(A) of title 35, United States Code,
23 as in effect on November 29, 2000, is amended—

1 (1) by striking "on which the Patent and
2 Trademark Office receives a copy of the" and insert-
3 ing "of"; and
4 (2) by striking "international application" the
5 last place it appears and inserting "publication".

6 **SEC. 6. DOMESTIC PUBLICATION OF PATENT APPLICA-**
7 **TIONS PUBLISHED ABROAD.**

8 Subtitle E of title IV of the Intellectual Property and
9 Communications Omnibus Reform Act of 1999, as enacted
10 by section 1000(a)(9) of Public Law 106–113, is amended
11 as follows:
12 (1) Section 4505 is amended to read as follows:

13 **"SEC. 4505. PRIOR ART EFFECT OF PUBLISHED APPLICA-**
14 **TIONS.**

15 "Section 102(e) of title 35, United States Code, is
16 amended to read as follows:
17 "'(e) the invention was described in (1) an applica-
18 tion for patent, published under section 122(b), by another
19 filed in the United States before the invention by the ap-
20 plicant for patent or (2) a patent granted on an applica-
21 tion for patent by another filed in the United States before
22 the invention by the applicant for patent, except that an
23 international application filed under the treaty defined in
24 section 351(a) shall have the effects for the purposes of
25 this subsection of an application filed in the United States

1 only if the international application designated the United
2 States and was published under Article 21(2) of such trea-
3 ty in the English language; or' ".

4 (2) Section 4507 is amended—

5 (A) in paragraph (1), by striking "Section
6 11" and inserting "Section 10";

7 (B) in paragraph (2), by striking "Section
8 12" and inserting "Section 11".

9 (C) in paragraph (3), by striking "Section
10 13" and inserting "Section 12";

11 (D) in paragraph (4), by striking "12 and
12 13" and inserting "11 and 12";

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

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

20 "(12) The item relating to section 374 in the
21 table of contents for chapter 37 of title 35, United
22 States Code, is amended to read as follows:

"374. Publication of international application. ".

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

1 **"SEC. 4508. EFFECTIVE DATE.**

2 "Except as otherwise provided in this section, sec-
3 tions 4502 through 4507, and the amendments made by
4 such sections, shall be effective as of November 29, 2000,
5 and shall apply only to applications (including inter-
6 national applications designating the United States) filed
7 on or after that date. The amendments made by sections
8 4504 and 4505 shall additionally apply to any pending ap-
9 plication filed before November 29, 2000, if such pending
10 application is published pursuant to a request of the appli-
11 cant under such procedures as may be established by the
12 Commissioner. If an application is filed on or after No-
13 vember 29, 2000, or is published pursuant to a request
14 from the applicant, and the application claims the benefit
15 of one or more prior-filed applications under section
16 119(e), 120, or 365(c) of title 35, United States Code,
17 then the amendment made by section 4505 shall apply to
18 the prior-filed application in determining the filing date
19 in the United States of the application.".

20 **SEC. 7. MISCELLANEOUS CLERICAL AMENDMENTS.**

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

23 (1) Section 2(b) is amended in paragraphs
24 (2)(B) and (4)(B), by striking ", United States
25 Code".

26 (2) Section 3 is amended—

1 (A) in subsection (a)(2)(B), by striking
2 "United States Code,";
3 (B) in subsection (b)(2)—
4 (i) in the first sentence of subpara-
5 graph (A), by striking ", United States
6 Code";
7 (ii) in the first sentence of subpara-
8 graph (B)—
9 (I) by striking "United States
10 Code,"; and
11 (II) by striking ", United States
12 Code";
13 (iii) in the second sentence of sub-
14 paragraph (B)—
15 (I) by striking "United States
16 Code,"; and
17 (II) by striking ", United States
18 Code." and inserting a period;
19 (iv) in the last sentence of subpara-
20 graph (B), by striking ", United States
21 Code"; and
22 (v) in subparagraph (C), by striking
23 ", United States Code"; and
24 (C) in subsection (c)—

(i) in the subsection caption, by striking ", UNITED STATES CODE"; and

(ii) by striking "United States Code,".

(3) Section 5 is amended in subsections (e) and (g), by striking ", United States Code" each place it appears.

(4) The table of chapters for part I is amended in the item relating to chapter 3, by striking "**before**" and inserting "**Before**".

(5) The item relating to section 21 in the table of contents for chapter 2 is amended to read as follows:

"21. Filing date and day for taking action.".

(6) The item relating to chapter 12 in the table of chapters for part II is amended to read as follows:

"12. Examination of Application ..... 131".

(7) The item relating to section 116 in the table of contents for chapter 11 is amended to read as follows:

"116. Inventors.".

(8) Section 154(b)(4) is amended by striking ", United States Code,".

(9) Section 156 is amended—

(A) in subsection (b)(3)(B), by striking "paragraphs" and inserting "paragraph";

(B) in subsection (d)(2)(B)(i), by striking "below the office" and inserting "below the Office"; and

(C) in subsection (g)(6)(B)(iii), by striking "submittted" and inserting "submitted".

(10) The item relating to section 183 in the table of contents for chapter 17 is amended by striking "of" and inserting "to".

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

(12) Section 201(a) is amended—

(A) by striking "United States Code,"; and

(B) by striking "5, United States Code." and inserting "5.".

(13) Section 202 is amended—

(A) in subsection (b)(4), by striking "last paragraph of section 203(2)" and inserting "section 203(b)"; and

(B) in subsection (c)—

(i) in paragraph (4), by striking "rights;" and inserting "rights,"; and

(ii) in paragraph (5), by striking "of the United States Code".

(14) Section 203 is amended—

(A) in paragraph (2)—

1 (i) by striking "(2)" and inserting
2 "(b)";
3 (ii) by striking the quotation marks
4 and comma before "as appropriate"; and
5 (iii) by striking "paragraphs (a) and
6 (c)" and inserting "paragraphs (1) and (3)
7 of subsection (a)"; and
8 (B) in the first paragraph—
9 (i) by striking "(a)", "(b)", "(c)",
10 and (d)" and inserting "(1)", "(2)", "(3)",
11 and (4)", respectively; and
12 (ii) by striking "(1." and inserting
13 "(a)".
14 (15) Section 209 is amended in subsections (a)
15 and (f)(1), by striking "of the United States Code".
16 (16) Section 210 is amended—
17 (A) in subsection (a)—
18 (i) in paragraph (11), by striking
19 "5901" and inserting "5908"; and
20 (ii) in paragraph (20) by striking
21 "178(j)" and inserting "178j"; and
22 (B) in subsection (c)—
23 (i) by striking "paragraph 202(c)(4)"
24 and inserting "section 202(c)(4)"; and

(ii) by striking "title.." and inserting "title.".

(17) The item relating to chapter 29 in the table of chapters for part III is amended by inserting a comma after "**Patent**".

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

"256. Correction of named inventor.".

(19) Section 294 is amended—

(A) in subsection (b), by striking "United States Code,"; and

(B) in subsection (c), in the second sentence by striking "court to" and inserting "court of".

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

"374. Publication of international application.".

(B) The amendment made by subparagraph (A) shall be effective as of November 29, 2000.

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

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

1 (23) Paragraphs (1), (2), and (3) of section
2 376(a) are each amended by striking the semicolon
3 and inserting a period.
4 (b) OTHER AMENDMENTS.—
5 (1) Section 4732(a) of the Intellectual Property
6 and Communications Omnibus Reform Act of 1999
7 is amended—
8 (A) in paragraph (9)(A)(ii), by inserting
9 "in subsection (b)," after "(ii)"; and
10 (B) in paragraph (10)(A), by inserting
11 after "title 35, United States Code," the fol-
12 lowing: "other than sections 1 through 6 (as
13 amended by chapter 1 of this subtitle),".
14 (2) Section 4802(1) of that Act is amended by
15 inserting "to" before "citizens".
16 (3) Section 4804 of that Act is amended—
17 (A) in subsection (b), by striking "11(a)"
18 and inserting "10(a)"; and
19 (B) in subsection (c), by striking "13" and
20 inserting "12".
21 (4) Section 4402(b)(1) of that Act is amended
22 by striking "in the fourth paragraph".
23 **SEC. 8. TECHNICAL CORRECTIONS IN TRADEMARK LAW.**
24 (a) AWARD OF DAMAGES.—Section 35(a) of the Act
25 of July 5, 1946 (commonly referred to as the "Trademark

1 Act of 1946") (15 U.S.C. 1117(a)), is amended by strik-
2 ing "a violation under section 43(a), (c), or (d)," and in-
3 serting "a violation under section 43(a) or (d),".
4 (b) ADDITIONAL TECHNICAL AMENDMENTS.—The
5 Trademark Act of 1946 is further amended as follows:
6 (1) Section 1(d)(1) (15 U.S.C. 1051(d)(1)) is
7 amended in the first sentence by striking "specifying
8 the date of the applicant's first use" and all that fol-
9 lows through the end of the sentence and inserting
10 "specifying the date of the applicant's first use of
11 the mark in commerce and those goods or services
12 specified in the notice of allowance on or in connec-
13 tion with which the mark is used in commerce.".
14 (2) Section 1(e) (15 U.S.C. 1051(e)) is amend-
15 ed to read as follows:
16 "(e) If the applicant is not domiciled in the United
17 States the applicant may designate, by a document filed
18 in the United States Patent and Trademark Office, the
19 name and address of a person resident in the United
20 States on whom may be served notices or process in pro-
21 ceedings affecting the mark. Such notices or process may
22 be served upon the person so designated by leaving with
23 that person or mailing to that person a copy thereof at
24 the address specified in the last designation so filed. If
25 the person so designated cannot be found at the address

1 given in the last designation, or if the registrant does not
2 designate by a document filed in the United States Patent
3 and Trademark Office the name and address of a person
4 resident in the United States on whom may be served no-
5 tices or process in proceedings affecting the mark, such
6 notices or process may be served on the Commissioner.".
7 (3) Section 8(f) (15 U.S.C. 1058(f)) is amend-
8 ed to read as follows:
9 "(f) If the registrant is not domiciled in the United
10 States, the registrant may designate, by a document filed
11 in the United States Patent and Trademark Office, the
12 name and address of a person resident in the United
13 States on whom may be served notices or process in pro-
14 ceedings affecting the mark. Such notices or process may
15 be served upon the person so designated by leaving with
16 that person or mailing to that person a copy thereof at
17 the address specified in the last designation so filed. If
18 the person so designated cannot be found at the address
19 given in the last designation, or if the registrant does not
20 designate by a document filed in the United States Patent
21 and Trademark Office the name and address of a person
22 resident in the United States on whom may be served no-
23 tices or process in proceedings affecting the mark, such
24 notices or process may be served on the Commissioner.".

1 (4) Section 9(c) (15 U.S.C. 1059(c)) is amend-
2 ed to read as follows:
3 "(c) If the registrant is not domiciled in the United
4 States the registrant may designate, by a document filed
5 in the United States Patent and Trademark Office, the
6 name and address of a person resident in the United
7 States on whom may be served notices or process in pro-
8 ceedings affecting the mark. Such notices or process may
9 be served upon the person so designated by leaving with
10 that person or mailing to that person a copy thereof at
11 the address specified in the last designation so filed. If
12 the person so designated cannot be found at the address
13 given in the last designation, or if the registrant does not
14 designate by a document filed in the United States Patent
15 and Trademark Office the name and address of a person
16 resident in the United States on whom may be served no-
17 tices or process in proceedings affecting the mark, such
18 notices or process may be served on the Commissioner.".
19 (5) Subsections (a) and (b) of section 10 (15
20 U.S.C. 1060(a) and (b)) are amended to read as fol-
21 lows:
22 "(a)(1) A registered mark or a mark for which an
23 application to register has been filed shall be assignable
24 with the good will of the business in which the mark is
25 used, or with that part of the good will of the business

1 connected with the use of and symbolized by the mark.
2 Notwithstanding the preceding sentence, no application to
3 register a mark under section 1(b) shall be assignable
4 prior to the filing of an amendment under section 1(c)
5 to bring the application into conformity with section 1(a)
6 or the filing of the verified statement of use under section
7 1(d), except for an assignment to a successor to the busi-
8 ness of the applicant, or portion thereof, to which the
9 mark pertains, if that business is ongoing and existing.
10 "(2) In any assignment authorized by this section,
11 it shall not be necessary to include the good will of the
12 business connected with the use of and symbolized by any
13 other mark used in the business or by the name or style
14 under which the business is conducted.
15 "(3) Assignments shall be by instruments in writing
16 duly executed. Acknowledgment shall be prima facie evi-
17 dence of the execution of an assignment, and when the
18 prescribed information reporting the assignment is re-
19 corded in the United States Patent and Trademark Office,
20 the record shall be prima facie evidence of execution.
21 "(4) An assignment shall be void against any subse-
22 quent purchaser for valuable consideration without notice,
23 unless the prescribed information reporting the assign-
24 ment is recorded in the United States Patent and Trade-

1 mark Office within 3 months after the date of the assign-
2 ment or prior to the subsequent purchase.
3 "(5) The United States Patent and Trademark Office
4 shall maintain a record of information on assignments, in
5 such form as may be prescribed by the Commissioner.
6 "(b) An assignee not domiciled in the United States
7 may designate by a document filed in the United States
8 Patent and Trademark Office the name and address of
9 a person resident in the United States on whom may be
10 served notices or process in proceedings affecting the
11 mark. Such notices or process may be served upon the
12 person so designated by leaving with that person or mail-
13 ing to that person a copy thereof at the address specified
14 in the last designation so filed. If the person so designated
15 cannot be found at the address given in the last designa-
16 tion, or if the assignee does not designate by a document
17 filed in the United States Patent and Trademark Office
18 the name and address of a person resident in the United
19 States on whom may be served notices or process in pro-
20 ceedings affecting the mark, such notices or process may
21 be served upon the Commissioner.".
22 (6) Section 23(c) (15 U.S.C. 1091(c)) is
23 amended by striking the second comma after "nu-
24 meral".

1 (7) Section 33(b)(8) (15 U.S.C. 1115(b)(8)) is
2 amended by aligning the text with paragraph (7).
3 (8) Section 34(d)(1)(A) (15 U.S.C.
4 1116(d)(1)(A)) is amended by striking "section
5 110" and all that follows through "(36 U.S.C. 380)"
6 and inserting "section 220506 of title 36, United
7 States Code,".
8 (9) Section 34(d)(1)(B)(ii) (15 U.S.C.
9 1116(d)(1)(B)(ii)) is amended by striking "section
10 110" and all that follows through "(36 U.S.C. 380)"
11 and inserting "section 220506 of title 36, United
12 States Code".
13 (10) Section 34(d)(11) is amended by striking
14 "6621 of the Internal Revenue Code of 1954" and
15 inserting "6621(a)(2) of the Internal Revenue Code
16 of 1986".
17 (11) Section 35(b) (15 U.S.C. 1117(b)) is
18 amended—
19 (A) by striking "section 110" and all that
20 follows through "(36 U.S.C. 380)" and insert-
21 ing "section 220506 of title 36, United States
22 Code,"; and
23 (B) by striking "6621 of the Internal Rev-
24 enue Code of 1954" and inserting "6621(a)(2)
25 of the Internal Revenue Code of 1986".

(12) Section 44(e) (15 U.S.C. 1126(e)) is amended by striking "a certification" and inserting "a true copy, a photocopy, a certification,".

SEC. 9. PATENT AND TRADEMARK FEE CLERICAL AMENDMENT.

The Patent and Trademark Fee Fairness Act of 1999 (113 Stat. 1537–546 et seq.), as enacted by section 1000(a)(9) of Public Law 106–113, is amended in section 4203, by striking "111(a)" and inserting "1113(a)".

SEC. 10. COPYRIGHT RELATED CORRECTIONS TO 1999 OMNIBUS REFORM ACT.

Title I of the Intellectual Property and Communications Omnibus Reform Act of 1999, as enacted by section 1000(a)(9) of Public Law 106–113, is amended as follows:

(1) Section 1007 is amended—

(A) in paragraph (2), by striking "paragraph (2)" and inserting "paragraph (2)(A)"; and

(B) in paragraph (3), by striking "1005(e)" and inserting "1005(d)".

(2) Section 1006(b) is amended by striking "119(b)(1)(B)(iii)" and inserting "119(b)(1)(B)(ii)".

(3)(A) Section 1006(a) is amended—

(i) in paragraph (1), by adding "and" after the semicolon;

(ii) by striking paragraph (2); and

(iii) by redesignating paragraph (3) as paragraph (2).

(B) Section 1011(b)(2)(A) is amended to read as follows:

"(A) in paragraph (1), by striking 'primary transmission made by a superstation and embodying a performance or display of a work' and inserting 'performance or display of a work embodied in a primary transmission made by a superstation or by the Public Broadcasting Service satellite feed';".

SEC. 11. AMENDMENTS TO TITLE 17, UNITED STATES CODE.

Title 17, United States Code, is amended as follows:

(1) Section 119(a)(6) is amended by striking "of performance" and inserting "of a performance".

(2)(A) The section heading for section 122 is amended by striking "**rights; secondary**" and inserting "**rights: Secondary**".

(B) The item relating to section 122 in the table of contents for chapter 1 is amended to read as follows:

"122. Limitations on exclusive rights: Secondary transmissions by satellite carriers within local markets.".

1 (3)(A) The section heading for section 121 is
2 amended by striking "**reproduction**" and insert-
3 ing "**Reproduction**".
4 (B) The item relating to section 121 in the
5 table of contents for chapter 1 is amended by strik-
6 ing "reproduction" and inserting "Reproduction".
7 (4)(A) Section 106 is amended by striking "107
8 through 121" and inserting "107 through 122".
9 (B) Section 501(a) is amended by striking "106
10 through 121" and inserting "106 through 122".
11 (C) Section 511(a) is amended by striking "106
12 through 121" and inserting "106 through 122".
13 (5) Section 101 is amended—
14 (A) by moving the definition of "computer
15 program" so that it appears after the definition
16 of "compilation"; and
17 (B) by moving the definition of "registra-
18 tion" so that it appears after the definition of
19 "publicly".
20 (6) Section 110(4)(B) is amended in the matter
21 preceding clause (i) by striking "conditions;" and in-
22 serting "conditions:".
23 (7) Section 118(b)(1) is amended in the second
24 sentence by striking "to it".
25 (8) Section 119(b)(1)(A) is amended—

(A) by striking "transmitted" and inserting "retransmitted"; and

(B) by striking "transmissions" and inserting "retransmissions".

(9) Section 203(a)(2) is amended—

(A) in subparagraph (A)—

(i) by striking "(A) the" and inserting "(A) The"; and

(ii) by striking the semicolon at the end and inserting a period;

(B) in subparagraph (B)—

(i) by striking "(B) the" and inserting "(B) The"; and

(ii) by striking the semicolon at the end and inserting a period; and

(C) in subparagraph (C), by striking "(C) the" and inserting "(C) The".

(10) Section 304(c)(2) is amended—

(A) in subparagraph (A)—

(i) by striking "(A) the" and inserting "(A) The"; and

(ii) by striking the semicolon at the end and inserting a period;

(B) in subparagraph (B)—

1 (i) by striking "(B) the" and inserting
2 "(B) The"; and
3 (ii) by striking the semicolon at the
4 end and inserting a period; and
5 (C) in subparagraph (C), by striking "(C)
6 the" and inserting "(C) The".
7 (11) The item relating to section 903 in the
8 table of contents for chapter 9 is amended by strik-
9 ing "licensure" and inserting "licensing".

10 **SEC. 12. OTHER COPYRIGHT RELATED TECHNICAL AMEND-**
11 **MENTS.**

12 (a) AMENDMENT TO TITLE 18.—Section 2319(e)(2)
13 of title 18, United States Code, is amended by striking
14 "107 through 120" and inserting "107 through 122".
15 (b) STANDARD REFERENCE DATA.—(1) Section
16 105(f) of Public Law 94–553 is amended by striking "sec-
17 tion 290(e) of title 15" and inserting "section 6 of the
18 Standard Reference Data Act (15 U.S.C. 290e)".
19 (2) Section 6(a) of the Standard Reference Data Act
20 (15 U.S.C. 290e) is amended by striking "Notwith-
21 standing" and all that follows through "United States
22 Code," and inserting "Notwithstanding the limitations
23 under section 105 of title 17, United States Code,".

Mr. COBLE. Mr. Chairman, as you so correctly pointed out, Mr. Berman and I have enlisted this several times, and the committee-at-large is familiar with the issue.

S.320, the Intellectual Property and High Technology Technical Amendments Act of 2001 makes noncontroversial technical amendments to the patent trademark and copyright laws.

In 1999, the Congress successfully passed landmark legislation, the American Inventors' Protection Act, to modernize our patent system and transform the Patent and Trademark Office into a more autonomous and efficient agency.

At the same time, the act contained a small number of clerical and other technical drafting errors. S.320 corrects these errors and makes important clarifications. Periodically, the United States Copyright Office forwards to Congress recommendations for technical corrections to the copyright law. S.320 makes these technical amendments to title 1 of the Intellectual Property and Communications Omnibus Reform Act of 1999; title 17 of other copyright related technical amendments. It corrects errors in references, spelling and punctuation, conforms the Table of Contents with section headings, restores the definition in Chapter 1 to alphabetical, deletes an expired paragraph and creates continuity in grammatical style used throughout title 17.

S.320 passed the Senate by a vote of 98 to nothing. It makes necessary improvements to the patent, trademark and copyright laws, and is noncontroversial, and I urge the members to support S.320 and the amendment thereto.

Chairman SENSENBRENNER. The gentleman from California?

Mr. BERMAN. Yes, thank you, Mr. Chairman. I think everything that's been said about this measure—everything that needs to be said has been said, and I'd urge its adoption.

Chairman SENSENBRENNER. Having heard that, the question now occurs on the amendment offered by Mr. Coble.

Those in favor will say aye.

Those opposed nay.

The ayes appear to have it. The ayes have it, and the amendment in the nature of a substitute is adopted.

The question now occurs on the motion to report the bill S.320 favorably, as amended.

All of those in favor will say aye.

Opposed, no.

The ayes have it. The motion to report favorably is adopted.

Without objection, the bill will be reported favorably to the House in the form of a single amendment in the nature of a substitute, incorporating the amendments adopted here today. Without objection, the chairman is authorized to move to go to conference, pursuant to House rules. Also, without objection, the staff is directed to make any technical and conforming changes, and all members will be given 2 days, as provided by House rules, in which to submit additional dissenting supplemental or minority views.

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