Calendar No. 1324

98TH CONGRESS
2D SESSION

H. R. 6286

IN THE SENATE OF THE UNITED STATES

OCTOBER 2 (legislative day, SEPTEMBER 24), 1984
Received; read twice and referred to the Committee on the Judiciary

OCTOBER 4 (legislative day, SEPTEMBER 24), 1984
Ordered to be placed on the calendar

AN ACT

To amend title 35, United States Code, to increase the effectiveness of the patent laws, and for other purposes.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,

SHORT TITLE

SECTION 1. This Act may be cited as the "Patent Law Amendments Act of 1984".

TITLE I—PATENT IMPROVEMENT PROVISIONS

USE OF PATENTED INVENTIONS OUTSIDE THE UNITED STATES

SEC. 101. (a) Section 271 of title 35, United States Code, is amended by adding at the end thereof the following new subsections:

"(e) Whoever without authority imports into or sells or uses within the United States a product which is made in another country by a process patented in the United States shall be liable as an infringer, if the importation, sale, or use of the product occurs during the term of such process patent.

"(f)(1) Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

"(2) Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.".

(b) Section 287 of title 35, United States Code, is amended by adding at the end thereof the following: "No damages may be recovered for an infringement under section 271(e) of this title unless the infringer was on notice that the product was made by a process patented in the United States.".

STATUTORY INVENTION REGISTRATION

SEC. 102. (a) Chapter 14 of title 35, United States Code, is amended by adding at the end thereof the following new section:

"§ 156. Statutory invention registration

"(a) Notwithstanding any other provision of this title, the 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 Commissioner;

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

"(4) pays application, publication, and other processing fees established by the 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.

"(b) The waiver under subsection (a)(3) of this section by an applicant shall take effect upon publication of the statutory invention registration.

"(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 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.".

(b) The table of sections at the beginning of chapter 14 of title 35, United States Code, is amended by adding at the end thereof the following:

"156. Statutory invention registration.".

(c) The amendments made by this section shall take effect six months after the date of the enactment of this Act.

FILING OF APPLICATIONS IN FOREIGN COUNTRIES

SEC. 103. (a) Section 184 of title 35, United States Code, is amended—

(1) in the third sentence—

(A) by striking out "inadvertently"; and

(B) by inserting "through error and without deceptive intent" after "filed abroad"; and

(2) by adding at the end thereof the following new paragraph:

"Subject to such conditions as the Commissioner may set by regulations, the scope of a license shall permit subsequent modifications, amendments, and supplements containing additional subject matter when the application upon which the request for the license is based is not required to be made available for inspection under section 181 of this title."

(b) Section 185 of title 35, United States Code, is amended by inserting immediately before the period in the last sentence the following: ", unless the failure to procure such license was through error and without deceptive intent, and the patent does not disclose subject matter within the scope of section 181 of this title".

(c) Section 186 of title 35, United States Code, is amended by inserting "willfully" after "whoever", the second place it appears.

PRIOR ART

SEC. 104. Section 103 of title 35, United States Code, is amended by adding at the end thereof the following:

"Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.".

JOINT INVENTORS

SEC. 105. (a) Section 116 of title 35, United States Code, is amended by amending the first paragraph to read as follows:

"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."

(b) Section 120 of title 35, United States Code, is amended by striking out "by the same inventor" and inserting in lieu thereof "which is filed by an inventor or inventors named in the previously filed application".

ARBITRATION OF INTERFERENCES

SEC. 106. Section 135 of title 35, United States Code, is amended by adding at the end thereof the following new subsection:

"(d) Parties to a patent interference, within such time as may be specified by the 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 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 Commissioner from determining patentability of the invention involved in the interference."

EFFECTIVE DATE

SEC. 107. (a) Subject to subsections (b), (c), (d), and (e) of this section, the amendments made by this Act shall apply to all United States patents granted before, on, or after the date of enactment of this Act, and to all applications for United States patents pending on or filed after the date of enactment, except that part of the amendment made by section 101 which adds section 271(e) to title 35 shall only apply to patents granted after the date of enactment.

(b) The amendments made by this Act shall not affect any final decision made by the court or the Patent and Trademark Office before the date of enactment of this Act with respect to a patent or application for patent, if no appeal from such decision is pending and the time for filing an appeal has expired.

(c) Section 271(f) of title 35, United States Code, added by section 101 of this Act shall apply only to the supplying, or causing to be supplied, or any component or components of a patented invention after the date of enactment of this Act.

(d) No United States patent granted before the date of enactment of this Act shall abridge or affect the right of any person or his successors in business who made, purchased, or used prior to such effective date anything protected by the patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased, or used, if the patent claims were invalid or otherwise unenforceable on a ground obviated by section 103, 104, or 105 of this Act and the person made, purchased, or used the specific thing in reasonable reliance on such invalidity or unenforceability. If a person reasonably relied on such invalidity or unenforceability, the court before which such matter is in question may provide for the continued manufacture, use, or sale of the thing made, purchased, or used as specified, or for the manu-

facture, use, or sale of which substantial preparation was made before the date of enactment of this Act, and it may also provide for the continued practice of any process practiced, or for the practice of which substantial preparation was made, prior to the date of enactment, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the date of enactment.

(e) The amendments made by this Act shall not affect the right of any party in any case pending in court on the date of enactment to have their rights determined on the basis of the substantive law in effect prior to the date of enactment.

TITLE II—PATENT AND TRADEMARK OFFICE PROCEDURES

BOARD OF PATENT APPEALS AND INTERFERENCES

SEC. 201. (a) Section 7 of title 35, United States Code, is amended to read as follows:

"§ 7. Board of Patent Appeals and Interferences

"(a) The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, who shall be appointed to the competitive service. The Commissioner, the Deputy Commissioner, the Assistant Commissioners, and the examiners-in-chief shall constitute the Board of Patent Appeals and Interferences.

"(b) 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 priority and patentability of invention in interferences declared under section 135(a) of this title. Each appeal and interference shall be heard by at least three members of the Board of Patent Appeals and Interferences, who shall be designated by the Commissioner. Only the Board of Patent Appeals and Interferences has the authority to grant rehearings.

"(c) Whenever the Commissioner considers it necessary, in order to keep current the work of the Board of Patent Appeals and Interferences, the Commissioner may designate any patent examiner of the primary examiner grade or higher, having the requisite ability, to serve as examiner-in-chief for periods not exceeding six months each. An examiner so designated shall be qualified to act as a member of the Board of Patent Appeals and Interferences. Not more than one of the members of the Board of Patent Appeals and Interferences hearing an appeal or determining an interference may be an examiner so designated. The Secretary of Commerce is authorized to fix the pay of each designated examiner-in-chief in the Patent and Trademark Office at not to exceed the maximum rate of basic pay payable for grade GS–16 of the General Schedule under section 5332 of title 5.

The rate of basic pay of each individual designated examiner-in-chief shall be adjusted, at the close of the period for which that individual was designated to act as examiner-in-chief, to the rate of basic pay which that individual would have been receiving at the close of such period if such designation had not been made.".

(b) The item relating to section 7 in the table of sections at the beginning of chapter 1 of title 35, United States Code, is amended by striking out "Appeals" and inserting in lieu thereof "Patent Appeals and Interferences".

INTERFERENCES

SEC. 202. Section 135(a) of title 35, United States Code, is amended to read as follows:

"(a) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the 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 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.".

APPEALS AND CIVIL ACTIONS

SEC. 203. (a) Section 141 of title 35, United States Code, is amended—

(1) in the first sentence—

(A) by striking out "of the Board of Patent Appeals may appeal" and inserting in lieu thereof "in an appeal to the Board of Patent Appeals and Interferences under section 134 of this title may appeal the decision"; and

(B) by striking out ", thereby waiving his right" and inserting in lieu thereof ". By filing such an appeal the applicant waives his or her right";

(2) in the second sentence—

(A) by striking out "board of patent interferences on the question of priority may appeal" and inserting in lieu thereof "Board of Patent Appeals and Interferences on the interference may appeal the decision";

(B) by striking out "according to" and inserting in lieu thereof "in accordance with"; and

(C) by striking out "he" and inserting in lieu thereof "the party"; and

(3) by amending the last sentence to read as follows:

"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.".

(b) Section 145 of title 35, United States Code, is amended—

(1) in the first sentence by striking out "Appeals may" and inserting in lieu thereof "Patent Appeals and Interferences in an appeal under section 134 of this title may,"; and

(2) in the second sentence by striking out "Appeals" and inserting in lieu thereof "Patent Appeals and Interferences".

(c) Section 146 of title 35, United States Code, is amended by striking out "board of patent interferences on the question of priority" and inserting in lieu thereof "Board of Patent Appeals and Interferences on the interference".

TECHNICAL AND CONFORMING AMENDMENTS

SEC. 204. (a) Section 41(a)(6) of title 35, United States Code, is amended—

(1) by striking out "Appeals" each place it appears and inserting in lieu thereof "Patent Appeals and Interferences"; and

(2) by inserting "in the appeal" after "oral hearing".

(b)(1) Section 134 of title 35, United States Code, is amended—

(A) in the section caption by striking out "APPEALS" and inserting in lieu thereof "PATENT APPEALS AND INTERFERENCES"; and

(B) by striking out "Appeals" and inserting in lieu thereof "Patent Appeals and Interferences".

(2) The item relating to section 134 in the table of sections at the beginning of chapter 12 of title 35, United States Code, is amended by striking out "Appeals" and inserting in lieu thereof "Patent Appeals and Interferences".

(c) Section 305 of title 35, United States Code, is amended by striking out "Appeals" and inserting in lieu thereof "Patent Appeals and Interferences".

AMENDMENTS TO OTHER PROVISIONS OF LAW

SEC. 205. (a) Section 1295(a)(4)(A) of title 28, United States Code, is amended by striking out "Appeals or the Board of Patent" and inserting in lieu thereof "Patent Appeals and".

(b) Section 152 of the Atomic Energy Act of 1954 (42 U.S.C. 2182) is amended in the third paragraph—

(1) by striking out "a Board of Patent Interferences" and inserting in lieu thereof "the Board of Patent Appeals and Interferences"; and

(2) by striking out "the Board of Patent Interferences" and inserting in lieu thereof "the Board of Patent Appeals and Interferences".

(c)(1) Section 305(d) of the National Aeronautics and Space Act of 1958 (42 U.S.C. 2457(d)) is amended—

(A) by striking out "a Board of Patent Interferences" and inserting in lieu thereof "the Board of Patent Appeals and Interferences"; and

(B) by striking out "the Board of Patent Interferences" and inserting in lieu thereof "the Board of Patent Appeals and Interferences".

(2) Section 305(e) of the National Aeronautics and Space Act of 1958 (42 U.S.C. 2457(e)) is amended by striking out "a Board of Patent Interferences" and inserting in lieu thereof "the Board of Patent Appeals and Interferences".

SAVINGS PROVISION

SEC. 206. Any individual who, on the effective date of this title, is an examiner-in-chief of the Board of Patent Appeals of the Patent and Trademark Office or an examiner of interferences of the Board of Patent Interferences of such office shall be entitled to continue in office as a member of

the Board of Patent Appeals and Interferences of the Patent and Trademark Office as of such effective date.

EFFECTIVE DATE

SEC. 207. Section 206 of this Act and the amendments made by this title shall take effect three months after the date of the enactment of this Act.

TITLE III—NATIONAL COMMISSION ON INNOVATION AND PRODUCTIVITY

ESTABLISHMENT

SEC. 301. There is hereby established a National Commission on Innovation and Productivity (hereinafter in this title referred to as the "Commission").

MEMBERSHIP OF COMMISSION

SEC. 302. (a) The Commission shall be composed of—

(1) three Members of the Senate appointed by the President of the Senate;

(2) three Members of the House of Representatives appointed by the Speaker of the House of Representatives; and

(3) three members appointed by the President of the United States, one of whom the President shall designate as Chairman.

Of the members appointed by the President, one member should be an appropriate officer or employee of the United States, one member should be an employer who employs inventors, and one member should be an employed inventor.

(b) At no time shall more than two of the members appointed under paragraph (1), (2), or (3) of subsection (a) be persons who are members of the same political party.

(c) Any vacancy in the Commission shall not affect its powers but shall be filled in the same manner in which the original appointment was made, and subject to the limitation set forth in subsection (b) with respect to the original appointment.

(d) Six members of the Commission shall constitute a quorum, but a lesser number may conduct hearings.

DUTIES OF THE COMMISSION

SEC. 303. The Commission shall make a full and complete review and study of the level of innovation and productivity of employed inventors. Such study shall include an analysis of the various methods available to inspire or stimulate individual and corporate innovation and productivity, including an assessment of the techniques used in other countries to achieve this objective. Such study may include an assessment of those aspects of other areas of intellectual property law that inspire or stimulate such innovation and productivity. The Commission shall make recommendations for such revisions of the laws of the United States, including the repeal of unnecessary or undesirable statutes, and such other changes as the Commission considers will better foster innovation and productivity.

COMPENSATION OF MEMBERS OF THE COMMISSION

SEC. 304. (a) A member of the Commission who is a Member of Congress or a full-time officer or employee of the United States shall receive no additional compensation by reason of his or her service on the Commission.

(b) Subject to amounts provided in advance in appropriations Acts, a member of the Commission from private life shall receive the daily equivalent of the annual rate of basic pay payable for level III of the Executive Schedule for each day (including traveltime) during which such member is engaged in the actual performance of duties vested in the Commission, plus reimbursement for travel, subsistence, and other necessary expenses incurred in the performance of such duties, in accordance with subchapter I of chapter 57 of title 5, United States Code.

DIRECTOR AND STAFF

SEC. 305. (a) The Commission shall have a Director who shall be appointed by the Commission and who shall be paid at a rate not to exceed the rate of basic pay payable for level IV of the Executive Schedule. The Director, subject to the direction of the Commission, shall supervise the activities of persons employed by the Commission and the preparation of the reports of the Commission and shall perform such other duties as may be assigned to the Director by the Commission.

(b) The Commission may appoint and fix the pay of such additional personnel as it considers appropriate.

(c) The staff of the Commission may be appointed without regard to the provisions of title 5, United States Code, governing appointments in the competitive service, and may be paid without regard to the provisions of chapter 51 and subchapter III of chapter 53 of such title relating to classification and General Schedule pay rates, except that no individual so appointed may receive pay in excess of the maximum annual rate of basic pay payable for GS–16 of the General Schedule.

(d) The Chairman of the Commission may procure temporary and intermittent services under section 3109(b) of title 5, United States Code.

GOVERNMENT AGENCY COOPERATION

SEC. 306. The Commission is authorized to request from any department, agency, or independent instrumentality of the Government any information and assistance it considers necessary to carry out its functions under this title. Each such department, agency, and instrumentality is authorized to cooperate with the Commission and, to the extent permitted by law, to furnish such information and assistance to the Commission.

REPORT OF THE COMMISSION; TERMINATION

SEC. 307. The Commission shall submit interim reports on its activities to the President and the Congress at such

times as the Commission considers appropriate, except that at least one such report shall be so submitted within one year after the date of the enactment of this Act. The Commission shall submit its final report on its activities to the President and the Congress within two years after such date of enactment. The Commission shall cease to exist sixty days after the date of the submission of its final report.

ADMINISTRATIVE SERVICES

SEC. 308. The General Services Administration shall provide administrative services for the Commission on a reimbursable basis.

AUTHORIZATION OF APPROPRIATIONS

SEC. 309. There is authorized to be appropriated $1,000,000 to carry out this title.

EFFECTIVE DATE

SEC. 310. This title shall take effect on January 21, 1985.

TITLE IV—MISCELLANEOUS PROVISIONS

INTERNATIONAL STAGE

SEC. 401. (a) Section 361(d) of title 35, United States Code, is amended in the first sentence by inserting "or within one month after the date of such filing" after "application".

(b) Section 366 of title 35, United States Code, is amended—

(1) in the first sentence—

(A) by inserting "after the date of withdrawal," after "effect"; and

(B) by inserting before the period the following: ", unless a claim for the benefit of a prior filing date under section 365(c) of this part was made in a national application, or an international application designating the United States, filed before the date of such withdrawal"; and

(2) in the second sentence by inserting "withdrawn" after "such".

NATIONAL STAGE

SEC. 402. (a) Section 371(a) of title 35, United States Code, is amended—

(1) by striking out "is" and inserting in lieu thereof "may be"; and

(2) by striking out ", except those filed in the Patent Office".

(b) Section 371(b) of title 35, United States Code, is amended to read as follows:

"(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) of the treaty.".

(c) Section 371(c)(2) of title 35, United States Code, is amended—

(1) by striking out "received from" and inserting in lieu thereof "communicated by"; and

(2) by striking out "verified" before "translation".

(d) Section 371(d) of title 35, United States Code, is amended to read as follows:

"(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 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 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.".

(e) Section 372(b) of title 35, United States Code, is amended—

(1) by striking out the period at the end of paragraph (2) and inserting in lieu thereof "; and"; and

(2) by adding at the end thereof the following:

"(3) the 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.".

(f) Section 372 of title 35, United States Code, is amended by striking out subsection (c).

(g) Section 376(a) of title 35, United States Code, is amended by striking out paragraph (5) and redesignating paragraph (6) as paragraph (5).

TECHNICAL AMENDMENTS

SEC. 403. (a) Title 35, United States Code, is amended by striking out "Patent Office" each place it appears and inserting in lieu thereof "Patent and Trademark Office".

(b) The table of parts at the beginning of title 35, United States Code, is amended by adding at the end thereof the following:

"IV. Patent Cooperation Treaty ..... 351".

PATENT FEES

SEC. 404. (a) Notwithstanding section 41 of title 35, United States Code, as in effect before the enactment of

Public Law 97–247 (96 Stat. 317), no fee shall be collected for maintaining a plant patent in force.

(b) Notwithstanding section 41(c) of title 35, United States Code, as in effect before the enactment of Public Law 97–247 (96 Stat. 317), the Commissioner of Patents and Trademarks may accept, after the six-month grace period referred to in such section 41(c), the payment of any maintenance fee due on any patent based on an application filed in the Patent and Trademark Office on or after December 12, 1980, and before August 27, 1982, to the same extent as in the case of patents based on applications filed in the Patent and Trademark Office on or after August 27, 1982.

TRADEMARK TRIAL AND APPEAL BOARD

SEC. 405. Section 3 of title 35, United States Code, is amended by adding at the end thereof the following:

"(e) The members of the Trademark Trial and Appeal Board of the Patent and Trademark Office shall each be paid at a rate not to exceed the maximum rate of basic pay payable for GS–16 of the General Schedule under section 5332 of title 5.".

EFFECTIVE DATE

SEC. 406. (a) Section 404 of this Act and the amendments made by section 403 of this Act shall take effect on the date of the enactment of this Act.

(b) The amendments made by sections 401, 402, and 405 of this Act shall take effect six months after the date of the enactment of this Act.

Passed the House of Representatives October 1, 1984.

Attest: BENJAMIN J. GUTHRIE,

Clerk.

By W. RAYMOND COLLEY,

Deputy Clerk.

Calendar No. 1324

98TH CONGRESS
2D SESSION

H. R. 6286

AN ACT

To amend title 35, United States Code, to increase the effectiveness of the patent laws, and for other purposes.

OCTOBER 4 (legislative day, SEPTEMBER 24), 1984

Committee discharged; ordered to be placed on the calendar