Calendar No. 1016

98TH CONGRESS
2D SESSION

S. 1538

To amend the patent laws of the United States.

IN THE SENATE OF THE UNITED STATES

JUNE 23 (legislative day, JUNE 20), 1983

Mr. MATHIAS (for himself, Mr. DOLE, and Mr. LEAHY) introduced the following bill; which was read twice and referred to the Committee on the Judiciary

JUNE 26 (legislative day, JUNE 25), 1984

Reported by Mr. THURMOND, with amendments

[Omit the part struck through and insert the part printed in italic]

A BILL

To amend the patent laws of the United States.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That this Act may be cited as the "Patent Law Amendments of 1983".

SEC. 2. (a) Chapter 14 of title 35, United States Code, is amended by adding at the end thereof the following new section:

"§ 156. ~~Issuance of patents without examination~~ *Statutory invention recording*

"(a) Notwithstanding any other provisions of this title, the Commissioner is authorized to ~~issue a patent on an invention without the examination required by sections 131 and 132 of this title,~~ *publish a statutory invention registration containing the specification and drawings of a regularly filed application for a patent without examination,* except as may be required to conduct an interference proceeding, to determine compliance with section 112 of this title, or to review for formalities required for printing, if the applicant—

"(1) waives ~~all remedies with respect to the patent and any reissue thereof, arising under sections 183 and 271 through 289 of this title and under any other provision of Federal law, within such time as the Commissioner specifies, and~~ *the right to receive a patent on the invention within such period as may be prescribed by the Commissioner, and*

"(2) pays *application, publication and other processing fees* ~~fees, which may be less than those specified in section 41 of this title,~~ established by the ~~Commissioner for the filing and issuance of such a patent.~~ *Commissioner.*

"(b) The waiver under this section shall take effect upon ~~issuance of the patent. No maintenance fees shall be required with respect to patents issued~~

~~under this section.".~~ *publication of the statutory invention recording.*

"(c) A statutory invention recording 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 recording shall not have any of the attributes specified for patents in any other title of this Code.".

(b) The analysis for chapter 14 of title 35, United States Code, is amended by adding at the end the following:

"156. ~~Issuance of patents without examination.".~~ *Statutory invention recording.".*

(c) The Secretary of Commerce shall convene an interagency committee to co-ordinate policy on the use of the statutory invention recording procedure by agencies of the United States. Such policy shall ordinarily require use of the statutory invention recording procedure for inventions as to which the United States may have the right of ownership that do not have commercial potential. The interagency committee shall also, after obtaining views from the public, establish standards for evaluating the commercial potential of inventions to which the government may have the right of ownership. The head of each agency which has a significant research program (as determined by the Secretary of Commerce) shall designate either the senior technology transfer

official or the senior research policy official to participate as a member of the interagency committee. The Secretary of Commerce shall report to the Congress annually on the use of statutory invention recordings. Such report shall include an assessment of the degree to which agencies of the Federal Government are making use of the statutory invention recording 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.

SEC. 3. Section 134 of title 35, United States Code, is amended by striking out "primary".

~~SEC. 4. Section 151 of title 35, United States Code, is amended—~~

~~(1) by amending the second sentence in the first paragraph to read as follows: "The notice shall specify the issue fee which shall be paid within three months thereafter, or within such shorter time, not less than one month, as fixed by the Commissioner in such notice."; and~~

~~(2) by striking out the third paragraph.~~

SEC. ~~5.~~ *4.* Section 361(d) of title 35, United States Code, is amended by inserting "or within one month ~~thereafter~~" *after such date*" after "application" in the first sentence.

SEC. ~~6.~~ *5.* Section 366 of title 35, United States Code, is amended—

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

(2) by inserting ", 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" before the period at the end of the first sentence; and

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

SEC. ~~7.~~ *6.* (a) Section 371(a) of title 35, United States Code, is amended by—

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

(2) 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 by—

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

(2) 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 ~~for~~ *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 amend-

ments to the claims in the international application made under article 19 of the treaty.".

SEC. ~~8.~~ *7.* (a) Section 372(b) of title 35, United States Code, is amended by—

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

(2) inserting 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 thereto if the application or other document was filed in a language other than English.".

(b) Section 372 of title 35, United States Code, is amended by deleting subsection (c).

SEC. ~~9.~~ *8.* Section 376(a) of title 35, United States Code, is amended by striking out paragraph (5) and redesignating paragraph (6) as paragraph (5).

SEC. ~~10.~~ *9.* Title 35, United States Code, is amended by striking out "Patent Office" each place it appears and inserting in ~~its place~~ *lieu thereof* "Patent and Trademark Office".

SEC. ~~11.~~ *10.* Notwithstanding section 2 of Public Law 96–517, no fee shall be collected for maintaining a plant patent in force.

SEC. 11. (a) Section 7 of title 35, United States Code, is amended to read as follows:

"§ 7. Board of Patent Appeals and Interferences

"The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, who shall be appointed under the classified civil service. The Commissioner, the deputy commissioner, the assistant commissioners, and the examiners-in-chief shall constitute a Board of Patent Appeals and Interferences."

"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 pursuant to 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, the members to be designated by the Commissioner. The Board of Patent Appeals and Interferences has sole power to grant rehearings.

"Whenever the Commissioner considers it necessary to maintain the work of the Board of Patent Appeals and Interferences current, he 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 such primary examiner shall be a member of the Board of Patent Appeals and Interferences hearing an appeal or determining an interference. The Secretary of Commerce is authorized to fix the per annum rate of basic compensation of each designated examiner-in-chief in the Patent and Trademark Office at not in excess of the maximum scheduled rate provided for positions at GS–16 pursuant to section 5332 of title 5, United States Code. The per annum rate of basic compensation of each designated examiner-in-chief shall be adjusted, at the close of the period for which he was designated to act as examiner-in-chief, to the per annum rate of basic compensation which he 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 analysis for chapter 1 of title 35, United States Code, is amended by inserting "Board of Patent Appeals and Interferences" in lieu of "Board of Appeals".

SEC. 12. Section 41(a)(6) of title 35, United States Code, is amended by inserting "Board of Patent Appeals and Interferences" in lieu of "Board of Appeals", each place it appears and inserting "in the appeal" after "oral hearing".

SEC. 13. (a) Section 134 of title 35, United States Code, including the section heading, is amended by inserting

"Board of Patent Appeals and Interferences" in lieu of "Board of Appeals" each place it appears.

(b) The item relating to section 134 in the analysis for chapter 12 of title 35, United States Code, is amended by inserting "Board of Patent Appeals and Interferences" in lieu of "Board of Appeals".

SEC. 14. (a) 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 thereof to the applicants, or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine the priority and patentability of invention in interferences. 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 of the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent and Trademark Office.".

(b) Section 135(b) of title 35, United States Code, is amended by striking out "may" and inserting in lieu thereof "shall".

SEC. 15. Section 141 of title 35, United States Code, is amended to read as follows:

"§ 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 to the United States Court of Appeals for the Federal Circuit, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences may appeal 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 according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.".

SEC. 16. Section 145 of title 35, United States Code, is amended—

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

(2) by inserting "Board of Patent Appeals and Interferences" in lieu of "Board of Appeals" in the second sentence.

SEC. 17. Section 146 of title 35, United States Code, is amended by striking "board of patent interferences on the question of priority" and inserting in lieu thereof "Board of Patent Appeals and Interferences".

SEC. 18. Section 305 of title 35, United States Code, is amended by inserting "Board of Patent Appeals and Interferences" in lieu of "Board of Appeals".

SEC. 19. 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".

SEC. 20. Section 152 of the Atomic Energy Act of 1954 (42 U.S.C. 2182), is amended by striking out "a Board of Patent Interferences" and inserting in lieu thereof "the Board of Patent Appeals and Interferences", and by striking out "the Board of Patent Interferences" and inserting in lieu thereof "the Board of Patent Appeals and Interferences".

SEC. 21. (a) Section 305(d) of the National Aeronautics and Space Act of 1952 (42 U.S.C. 2457(d)) is amended by—

(1) striking out "Patent" in the title and inserting in lieu thereof "Patent Appeals and",

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

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

(b) 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".

SEC. 22. The examiners-in-chief of the Board of Appeals and the examiners of interferences of the Board of Patent Interferences on the effective date of this Act shall continue in office as members of the Board of Patent Appeals and Interferences.

SEC. 23. 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 receive compensation equal to that paid a GS–16 under the General

Schedule contained in section 5332 of title 5, United States Code.".

SEC. ~~12.~~ *24.* (a) Sections ~~10~~ *9* and ~~11~~ *10* of this Act shall take effect upon the date of enactment.

(b) Sections 1 through ~~9~~ *8* of this Act shall take effect ~~six~~ *three* months after the date of enactment.

(c) Sections 11 through 23 of this Act shall take effect three months after the date of enactment.

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