An Act To authorize appropriations for the Department of Justice for fiscal year 2002, and for other purposes.

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

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TITLE III--INTELLECTUAL PROPERTY
Subtitle A--Patent and Trademark Office Authorization

Sec. 13101. Short title.

Sec. 13102. Authorization of amounts available to the Patent and Trademark Office.

Sec. 13103. Electronic filing and processing of patent and trademark applications.

Sec. 13104. Strategic plan.

Sec. 13105. Determination of substantial new question of patentability in reexamination proceedings.

Sec. 13106. Appeals in inter partes reexamination proceedings.

Subtitle B--Intellectual Property and High Technology Technical Amendments

Sec. 13201. Short title.

Sec. 13202. Clarification of Reexamination Procedure Act of 1999; technical amendments.


Sec. 13205. Domestic publication of patent applications published abroad.

Sec. 13206. Miscellaneous clerical amendments.

Sec. 13207. Technical corrections in trademark law.

Sec. 13208. Patent and trademark fee clerical amendment.

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TITLE III--INTELLECTUAL PROPERTY
Subtitle A--Patent and Trademark Office Authorization

SEC. 13101. SHORT TITLE.

This subtitle may be cited as the "Patent and Trademark Office Authorization Act of 2002".

<< 35 USCA § 42 NOTE >>

SEC. 13102. AUTHORIZATION OF AMOUNTS AVAILABLE TO THE PATENT AND TRADEMARK OFFICE.

(a) IN GENERAL.--There are authorized to be appropriated to the United States Patent and Trademark Office for salaries and necessary expenses for each of the fiscal years 2003 through 2008 an amount equal to the fees estimated by the Secretary of Commerce to be collected in each such fiscal year, respectively, under--

(1) title 35, United States Code; and

(2) the Act entitled "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", approved July 5, 1946 (15 U.S.C. 1051 et seq.) (commonly referred to as the Trademark Act of 1946).

(b) ESTIMATES.--Not later than February 15, of each fiscal year, the Undersecretary of Commerce for Intellectual Property and the Director of the Patent and Trademark Office (in this subtitle referred to as the Director) shall submit an estimate of all fees referred to under subsection (a) to be collected in the next fiscal year to the chairman
and ranking member of--

(1) the Committees on Appropriations and Judiciary of the Senate; and

(2) the Committees on Appropriations and Judiciary of the House of Representatives.

SEC. 13103. ELECTRONIC FILING AND PROCESSING OF PATENT AND TRADEMARK APPLICATIONS.

(a) ELECTRONIC FILING AND PROCESSING.--The Director shall, beginning not later than 90 days after the date of enactment of this Act, and during the 3-year period thereafter, develop an electronic system for the filing and processing of patent and trademark applications, that--

(1) is user friendly; and

(2) includes the necessary infrastructure--

(A) to allow examiners and applicants to send all communications electronically; and

(B) to allow the Office to process, maintain, and search electronically the contents and history of each application.

(b) AUTHORIZATION OF APPROPRIATIONS.--Of amounts authorized under section 13102, there is authorized to be appropriated to carry out subsection (a) of this section not more than $50,000,000 *1900 for each of fiscal years 2003, 2004, and 2005. Amounts made available pursuant to this subsection shall remain available until expended.

SEC. 13104. STRATEGIC PLAN.

(a) DEVELOPMENT OF PLAN.--

(1) IN GENERAL.--The Director shall, in close consultation with the Patent Public Advisory Committee and the Trademark Public Advisory Committee, develop a strategic plan that sets forth the goals and methods by which the United States Patent and Trademark Office will, during the 5-year period beginning on January 1, 2003--

(A) enhance patent and trademark quality;

(B) reduce patent and trademark pendency; and

(C) develop and implement an effective electronic system for use by the Patent and Trademark Office and the public for all aspects of the patent and trademark processes, including, in addition to the elements set forth in section 13103, searching, examining, communicating,
publishing, and making publicly available, patents and trademark registrations.

(2) CONTENTS AND CONSULTATION.--The strategic plan shall include milestones and objective and meaningful criteria for evaluating the progress and successful achievement of the plan. The Director shall consult with the Public Advisory Committees with respect to the development of each aspect of the strategic plan.

(b) REPORT TO CONGRESSIONAL COMMITTEES.--Not later than 4 months after the date of enactment of this Act, the Director shall submit the plan developed under subsection (a) to the Committees on the Judiciary of the Senate and the House of Representatives.

SEC. 13105. DETERMINATION OF SUBSTANTIAL NEW QUESTION OF PATENTABILITY IN REEXAMINATION PROCEEDINGS.

<< 35 USCA § 303 >>
<< 35 USCA § 312 >>

(a) IN GENERAL.--Sections 303(a) and 312(a) of title 35, United States Code, are each amended by adding at the end the following: "The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office."

<< 35 USCA § 303 NOTE >>

(b) EFFECTIVE DATE.--The amendments made by this section shall apply with respect to any determination of the Director of the United States Patent and Trademark Office that is made under section 303(a) or 312(a) of title 35, United States Code, on or after the date of enactment of this Act.

SEC. 13106. APPEALS IN INTER PARTES REEXAMINATION PROCEEDINGS.

<< 35 USCA § 315 >>

(a) APPEALS BY THIRD-PARTY REQUESTER IN PROCEEDINGS.--Section 315(b) of title 35, United States Code, is amended to read as follows:

"(b) THIRD-PARTY REQUESTER.--A third-party requester--"

"(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or
proposed amended or new claim of the patent; and

*1901 "(2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144."

** 35 USCA § 134 >>

(b) APPEAL TO BOARD OF PATENT APPEALS AND INTERFERENCES.--Section 134(c) of title 35, United States Code, is amended by striking the last sentence.

** 35 USCA § 141 >>

(c) APPEAL TO COURT OF APPEALS FOR THE FEDERAL CIRCUIT.--Section 141 of title 35, United States Code, is amended in the third sentence by inserting ", or a third-party requester in an inter partes reexamination proceeding, who is" after "patent owner".

** 35 USCA § 134 NOTE >>

(d) EFFECTIVE DATE.--The amendments made by this section apply with respect to any reexamination proceeding commenced on or after the date of enactment of this Act.

Subtitle B--Intellectual Property and High Technology Technical Amendments

** 35 USCA § 1 NOTE >>

SEC. 13201. SHORT TITLE.

This subtitle may be cited as the "Intellectual Property and High Technology Technical Amendments Act of 2002".

SEC. 13202. 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--

** 35 USCA § 311 >>

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

<< 35 USCA § 311 >>

(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--

<< 35 USCA § 312 >>

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

<< 35 USCA § 312 >>

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

(3) Section 314(b)(1) is amended--

<< 35 USCA § 314 >>

(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

<< 35 USCA § 314 >>

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

<< 35 USCA § 315 >>

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

(5) Section 317 is amended--

<< 35 USCA § 317 >>

(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

<< 35 USCA § 317 >>
(B) in subsection (b), by striking "United States Code,"

(b) CONFORMING AMENDMENTS.--

<< 35 USCA § 134 >>

(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".

<< 35 USCA § 143 >>

(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 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. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.".

(c) CLERICAL AMENDMENTS.--

<< 35 USCA prec. § 311 >>

<< 35 USCA §§ 311, 312, 313, 314, 315, 316, 317, 318 >>

(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".

<< 35 USCA prec. § 251 >>

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

<< 35 USCA § 134 NOTE >>

(d) EFFECTIVE DATE.--The amendments made by section 4605 (b), (c), and (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 enactment of Public Law 106-113.

SEC. 13203. PATENT AND TRADEMARK EFFICIENCY ACT AMENDMENTS.
(a) DEPUTY COMMISSIONER.--

<< 15 USCA § 1067 >>

(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,".

<< 35 USCA § 6 >>

(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--

<< 35 USCA § 5 >>

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

<< 35 USCA § 5 >>

(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.".

<< 35 USCA § 153 >>

(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 Director,"

<< 35 USCA § 154 >>

SEC. 13204. 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. 13205. 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:

<< 35 USCA § 102 >>

*1903 "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--

<< 35 USCA § 10 >>

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

<< 35 USCA § 11 >>

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

<< 35 USCA § 12 >>

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

<< 35 USCA prec. § 1 >>

(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 4504 and 4506 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 section 4504 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 Director. Except as otherwise provided in this section, the amendments made by section 4505 shall be effective as of November 29, 2000 and shall apply to all patents and all applications for patents pending on or filed after November 29, 2000. Patents resulting from an international application filed before November 29, 2000 and applications published pursuant to section 122(b) or Article 21(2) of the treaty defined in section 351(a) resulting from an international application filed before November 29, 2000 shall not be effective as prior art as of the filing date of the international application; however, such patents shall be effective as prior art in accordance with section 102(e) in effect on November 28, 2000."

*1904 SEC. 13206. 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,".

<< 35 USCA § 5 >>

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

<< 35 USCA prec. § 1 >>

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

<< 35 USCA prec. § 21 >>

(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.".

<< 35 USCA prec. § 100 >>

(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".

<< 35 USCA prec. § 111 >>

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

"116. Inventors.".

<< 35 USCA § 154 >>

(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 "submitted" 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—

*1905 (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 

<< 35 USCA § 202 >>

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

<< 35 USCA § 203 >>

(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)".

<< 35 USCA § 209 >>

(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)-- 

<< 35 USCA § 210 >>

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

<< 35 USCA § 210 >>

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

<< 35 USCA § 210 >>

(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.".

<< 35 USCA prec. § 251 >>

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

<< 35 USCA prec. § 251 >>

(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."

<< 35 USCA § 294 >>

(19) Section 294 is amended--

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

<< 35 USCA § 294 >>

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

<< 35 USCA § 371 >>

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

<< 35 USCA § 376 >>

(21) 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--

<< 35 USCA § 303 >>
(A) in paragraph (9)(A)(ii), by inserting "in subsection (b)," after "(ii)"; and


<< 35 USCA prec. § 301 >>

*1906 (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),".

<< 35 USCA § 119 >>

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

<< 35 USCA §§ 10, 12 >>

(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".

<< 35 USCA § 282 >>

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

. . .