

***In the Senate of the United States,***

*November 15, 2001.*

*Resolved*, That the Senate agree to the amendment of the House of Representatives to the bill (S. 320) entitled “An Act to make technical corrections in patent, copyright, and trademark laws.” with the following

**SENATE AMENDMENT TO HOUSE AMENDMENT:**

In lieu of the matter proposed to be inserted by the House amendment, insert:

1 ***SECTION 1. SHORT TITLE.***

2       *This Act may be cited as the “Intellectual Property*  
3 *and High Technology Technical Amendments Act of 2001”.*

1 **SEC. 2. OFFICERS AND EMPLOYEES.**

2 (a) *RENAMING OF OFFICERS.*—(1)(A) *Except as pro-*  
 3 *vided in subparagraph (B), title 35, United States Code,*  
 4 *other than section 210(d), is amended—*

5 (i) *by striking “Director” each place it appears*  
 6 *and inserting “Commissioner”; and*

7 (ii) *by striking “Director’s” each place it ap-*  
 8 *pears and inserting “Commissioner’s”.*

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

12 (C) *Section 3(a) of title 35, United States Code, is*  
 13 *amended in the subsection heading, by striking “DIREC-*  
 14 *TOR” and inserting “COMMISSIONER”.*

15 (D) *Section 3(b)(1) of title 35, United States Code, is*  
 16 *amended in the paragraph heading, by striking “DIREC-*  
 17 *TOR” and inserting “COMMISSIONER”.*

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

22 (3)(A) *Title 35, United States Code, other than sub-*  
 23 *section (f) of section 3, is amended by striking “Commis-*  
 24 *sioner for Patents” each place it appears and inserting “As-*  
 25 *stant Commissioner for Patents”.*

1       (B) Title 35, United States Code, other than subsection  
 2 (f) of section 3, is amended by striking “Commissioner for  
 3 Trademarks” each place it appears and inserting “Assist-  
 4 ant Commissioner for Trademarks”.

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

7           (i) in the paragraph heading, by striking “COM-  
 8 MISSIONERS” and inserting “ASSISTANT COMMIS-  
 9 SIONERS”;

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

11           (I) by striking “a Commissioner” and in-  
 12 serting “an Assistant Commissioner”; and

13           (II) by striking “the Commissioner” and  
 14 inserting “the Assistant Commissioner”;

15          (iii) in subparagraph (B)—

16           (I) by striking “Commissioners” each place  
 17 it appears and inserting “Assistant Commis-  
 18 sioners”;

19           (II) by striking “Commissioners’” each  
 20 place it appears and inserting “Assistant Com-  
 21 missioners’”;

22          (iv) in subparagraph (C), by striking “Commis-  
 23 sioners” and inserting “Assistant Commissioners”.

24       (D) Section 3(b) of title 35, United States Code, is  
 25 amended—

1           (i) by redesignating paragraphs (3), (4), and (5)  
2 as paragraphs (4), (5), and (6), respectively; and

3           (ii) by inserting after paragraph (2) the fol-  
4 lowing:

5           “(3) *SPECIAL COUNSEL FOR INTELLECTUAL*  
6 *PROPERTY POLICY AND DEPUTY COMMISSIONER FOR*  
7 *LEGISLATIVE AND INTERNATIONAL AFFAIRS OF THE*  
8 *UNITED STATES PATENT AND TRADEMARK OFFICE.—*

9           “(A) *APPOINTMENT AND DUTIES.—The Spe-*  
10 *cial Counsel for Intellectual Property Policy*  
11 *shall be a citizen of the United States and shall*  
12 *be appointed by the President, after consultation*  
13 *with the Secretary of Commerce. The Deputy*  
14 *Commissioner for Legislative and International*  
15 *Affairs shall be a citizen of the United States*  
16 *and shall be appointed by the President, after*  
17 *consultation with the Secretary of Commerce.*  
18 *The Special Counsel shall serve as the chief intel-*  
19 *lectual property policy advisor to the Under Sec-*  
20 *retary of Commerce for Intellectual Property and*  
21 *Commissioner for Patents and Trademarks. The*  
22 *Deputy Commissioner for Legislative and Inter-*  
23 *national Affairs shall serve as the chief advisor*  
24 *on all congressional and international matters*

1           *relating to intellectual property and administra-*  
2           *tion of the Office.*

3           “(B) OATH.—*The Special Counsel and the*  
4           *Deputy Commissioner for Legislative and Inter-*  
5           *national Affairs shall, before taking office, take*  
6           *an oath to discharge faithfully responsible duties.*

7           “(C) REMOVAL.—*The Special Counsel and*  
8           *the Deputy Commissioner for Legislative and*  
9           *International Affairs may be removed from office*  
10          *by the President. The President shall provide no-*  
11          *tification of any such removal to both Houses of*  
12          *Congress.*

13          “(D) COMPENSATION.—*The Special Counsel*  
14          *and the Deputy Commissioner for Legislative*  
15          *and International Affairs of the United States*  
16          *Patent and Trademark Office shall be paid an*  
17          *annual rate of basic pay—*

18                 “(i) *not less than the minimum rate of*  
19                 *basic pay for a position at ES-4 of the*  
20                 *Senior Executive Service established under*  
21                 *section 5382 of title 5; and*

22                 “(ii) *not to exceed the maximum rate*  
23                 *of basic pay for the Senior Executive Serv-*  
24                 *ice established under section 5382 of title 5,*  
25                 *including any applicable locality-based*

1                    *comparability payment that may be author-*  
2                    *ized under section 5304(h)(2)(C) of title 5.”.*

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

5                    *(i) by striking “the Commissioner” each place it*  
6                    *appears and inserting “the Assistant Commissioner”;*  
7                    *and*

8                    *(ii) by striking “a Commissioner” each place it*  
9                    *appears and inserting “an Assistant Commissioner”.*

10           *(F) Section 13 of title 35, United States Code, is*  
11 *amended—*

12                    *(i) by striking “Commissioner of” each place it*  
13                    *appears and inserting “Assistant Commissioner for”;*  
14                    *and*

15                    *(ii) by striking “Commissioners” and inserting*  
16                    *“Assistant Commissioners”.*

17           *(G) Chapter 17 of title 35, United States Code, is*  
18 *amended by striking “Commissioner of Patents” each place*  
19 *it appears and inserting “Assistant Commissioner for Pat-*  
20 *ents”.*

21           *(H) Section 297 of title 35, United States Code, is*  
22 *amended by striking “Commissioner of Patents” each place*  
23 *it appears and inserting “Commissioner”.*

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

1           “Under Secretary of Commerce for Intellectual  
2           Property and Director of the United States Patent  
3           and Trademark Office.”

4 *and inserting*

5           “Under Secretary of Commerce for Intellectual  
6           Property and Commissioner of the United States Pat-  
7           ent and Trademark Office.”.

8           (5) Section 5315 of title 5, United States Code, is  
9 *amended by striking the following:*

10           “Deputy Under Secretary of Commerce for Intel-  
11           lectual Property and Deputy Director of the United  
12           States Patent and Trademark Office.”.

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

16           (B) *The items relating to sections 303 and 304 in the*  
17 *table of sections for chapter 30 of title 35, United States*  
18 *Code, are each amended by striking “Director” and insert-*  
19 *ing “Commissioner”.*

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

23           (B) *The items relating to sections 312 and 313 in the*  
24 *table of sections for chapter 31 of title 35, United States*

1 Code, are each amended by striking “Director” and insert-  
2 ing “Commissioner”.

3 (8) Section 17(b) of the Trademark Act of 1946 (15  
4 U.S.C. 1067) is amended by striking “Commissioner for  
5 Patents, the Commissioner for Trademarks” and inserting  
6 “Assistant Commissioner for Patents, the Assistant Com-  
7 missioner for Trademarks”.

8 (b) *ADDITIONAL CLERICAL AMENDMENTS.*—

9 (1) The following provisions of law are amended  
10 by striking “Director” each place it appears and in-  
11 serting “Commissioner”.

12 (A) Section 9(p)(1)(B) of the Small Busi-  
13 ness Act (15 U.S.C. 638(p)(1)(B)).

14 (B) Section 19 of the Tennessee Valley Au-  
15 thority Act of 1933 (16 U.S.C. 831r).

16 (C) Section 182(b)(2)(A) of the Trade Act of  
17 1974 (19 U.S.C. 2242(b)(2)(A)).

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

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

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

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



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

3           (I) *Section 152 of the Atomic Energy Act of*  
4           *1954 (42 U.S.C. 2182).*

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

7           (K) *Section 12(a) of the Solar Heating and*  
8           *Cooling Demonstration Act of 1974 (42 U.S.C.*  
9           *5510(a)), the last place such term appears.*

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

12          (M) *Sections 4203, 4506, 4606, and*  
13          *4804(d)(2) of the Intellectual Property and Com-*  
14          *munications Omnibus Reform Act of 1999, as*  
15          *enacted by section 1000(a)(9) of Public Law*  
16          *106–113.*

17          (2) *The item relating to section 1744 in the table*  
18          *of sections for chapter 115 of title 28, United States*  
19          *Code, is amended by striking “generally” and insert-*  
20          *ing “, generally”.*

21          (c) *PRESIDENTIAL APPOINTMENT AND COMPENSATION*  
22          *FOR DEPUTY DIRECTOR.—Section 3(b)(1) of title 35,*  
23          *United States Code, is amended by—*

1           (1) *striking “The Secretary of Commerce, upon*  
2           *nomination by the Director,” and inserting the fol-*  
3           *lowing:*

4                   “(A) *IN GENERAL.—The President, after*  
5                   *consultation with the Secretary of Commerce,”;*  
6                   *and*

7           (2) *inserting at the end the following:*

8                   “(B) *COMPENSATION.—The Deputy Com-*  
9                   *missioner shall be paid an annual rate of basic*  
10                  *pay—*

11                          “(i) *not less than the minimum rate of*  
12                          *basic pay for a position at ES-4 of the*  
13                          *Senior Executive Service established under*  
14                          *section 5382 of title 5; and*

15                          “(ii) *not to exceed the maximum rate*  
16                          *of basic pay for the Senior Executive Serv-*  
17                          *ice established under section 5382 of title 5,*  
18                          *including any applicable locality-based*  
19                          *comparability payment that may be author-*  
20                          *ized under section 5304(h)(2)(C) of title 5.”.*

21           (d) *REFERENCES.—Any reference in any other Federal*  
22           *law, Executive order, rule, regulation, or delegation of au-*  
23           *thority, or any document of or pertaining to the Patent and*  
24           *Trademark Office—*

1           (1) *to the Director of the United States Patent*  
 2 *and Trademark Office or to the Commissioner of Pat-*  
 3 *ents and Trademarks is deemed to refer to the Under*  
 4 *Secretary of Commerce for Intellectual Property and*  
 5 *Commissioner of the United States Patent and Trade-*  
 6 *mark Office;*

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

9           (3) *to the Commissioner for Trademarks is*  
 10 *deemed to refer to the Assistant Commissioner for*  
 11 *Trademarks.*

12 **SEC. 3. CLARIFICATION OF REEXAMINATION PROCEDURE**

13 **ACT OF 1999; TECHNICAL AMENDMENTS.**

14           (a) *OPTIONAL INTER PARTES REEXAMINATION PRO-*  
 15 *CEDURES.—Title 35, United States Code, is amended as fol-*  
 16 *lows:*

17           (1) *Section 311 is amended—*

18           (A) *in subsection (a), by striking “person”*  
 19 *and inserting “third-party requester”; and*

20           (B) *in subsection (c), by striking “Unless*  
 21 *the requesting person is the owner of the patent,*  
 22 *the” and inserting “The”.*

23           (2) *Section 312 is amended—*

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

1           (B) in subsection (b), by striking “, if any”.

2           (3) Section 314(b)(1) is amended—

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

5           (B) by striking “the third-party requester  
6           shall receive a copy” and inserting “the Office  
7           shall send to the third-party requester a copy”;  
8           and

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

11          (4) Section 315(c) is amended by striking  
12          “United States Code,”.

13          (5) Section 317 is amended—

14           (A) in subsection (a), by striking “patent  
15           owner nor the third-party requester, if any, nor  
16           privies of either” and inserting “third-party re-  
17           quester nor its privies”; and

18           (B) in subsection (b), by striking “United  
19           States Code,”.

20          (b) CONFORMING AMENDMENTS.—

21           (1) APPEAL TO THE BOARD OF PATENT APPEALS  
22           AND INTERFERENCES.—Subsections (a), (b), and (c)  
23           of section 134 of title 35, United States Code, are each  
24           amended by striking “administrative patent judge”

1       each place it appears and inserting “primary exam-  
2       iner”.

3           (2) *PROCEEDING ON APPEAL.*—Section 143 of  
4       title 35, United States Code, is amended by amending  
5       the third sentence to read as follows: “In an *ex parte*  
6       case or any reexamination case, the Commissioner  
7       shall submit to the court in writing the grounds for  
8       the decision of the Patent and Trademark Office, ad-  
9       dressing all the issues involved in the appeal. The  
10      court shall, before hearing an appeal, give notice of  
11      the time and place of the hearing to the Commissioner  
12      and the parties in the appeal.”.

13      (c) *CLERICAL AMENDMENTS.*—

14           (1) Section 4604(a) of the Intellectual Property  
15      and Communications Omnibus Reform Act of 1999,  
16      as enacted by section 1000(a)(9) of Public Law 106–  
17      113, is amended by striking “Part 3” and inserting  
18      “Part III”.

19           (2) Section 4604(b) of that Act is amended by  
20      striking “title 25” and inserting “title 35”.

21      (d) *EFFECTIVE DATE.*—The amendments made by sec-  
22      tion 4605 (b), (c), and (e) of the Intellectual Property and  
23      Communications Omnibus Reform Act, as enacted by sec-  
24      tion 1000(a)(9) of Public Law 106–113, shall apply to any  
25      reexamination filed in the United States Patent and Trade-

1 mark Office on or after the date of the enactment of Public  
2 Law 106–113.

3 **SEC. 4. PATENT AND TRADEMARK EFFICIENCY ACT AMEND-**  
4 **MENTS.**

5 (a) *DEPUTY COMMISSIONER.*—

6 (1) Section 17(b) of the Act of July 5, 1946  
7 (commonly referred to as the “Trademark Act of  
8 1946”) (15 U.S.C. 1067(b)), is amended by inserting  
9 “the Deputy Commissioner,” after “Commissioner,”.

10 (2) Section 6(a) of title 35, United States Code,  
11 is amended by inserting “the Deputy Commissioner,”  
12 after “Commissioner,”.

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

15 (1) in subsection (i), by inserting “, privileged,”  
16 after “personnel”; and

17 (2) by adding at the end the following new sub-  
18 section:

19 “(j) *INAPPLICABILITY OF PATENT PROHIBITION.*—Sec-  
20 tion 4 shall not apply to voting members of the Advisory  
21 Committees.”.

22 (c) *MISCELLANEOUS.*—Section 153 of title 35, United  
23 States Code, is amended by striking “and attested by an  
24 officer of the Patent and Trademark Office designated by  
25 the Commissioner,”.

1 **SEC. 5. DOMESTIC PUBLICATION OF FOREIGN FILED PAT-**  
 2 **ENT APPLICATIONS ACT OF 1999 AMEND-**  
 3 **MENTS.**

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

6 *(1) by striking “on which the Patent and Trade-*  
 7 *mark Office receives a copy of the” and inserting*  
 8 *“of”; and*

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

11 **SEC. 6. DOMESTIC PUBLICATION OF PATENT APPLICATIONS**  
 12 **PUBLISHED ABROAD.**

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

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

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

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

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

1 *vention by the applicant for patent, except that an inter-*  
2 *national application filed under the treaty defined in sec-*  
3 *tion 351(a) shall have the effects for the purposes of this*  
4 *subsection of an application filed in the United States only*  
5 *if the international application designated the United*  
6 *States and was published under Article 21(2) of such treaty*  
7 *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 States*  
18 *Code, as amended by paragraph (10), by striking*  
19 *“confer the same rights and shall have the same*  
20 *effect under this title as an application for pat-*  
21 *ent published” and inserting “be deemed a publi-*  
22 *cation”;* 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, sections*  
7           *4502 through 4504 and 4506 through 4507, and the amend-*  
8           *ments made by such sections, shall be effective as of Novem-*  
9           *ber 29, 2000, and shall apply only to applications (includ-*  
10           *ing international applications designating the United*  
11           *States) filed on or after that date. The amendments made*  
12           *by section 4504 shall additionally apply to any pending*  
13           *application filed before November 29, 2000, if such pending*  
14           *application is published pursuant to a request of the appli-*  
15           *cant under such procedures as may be established by the*  
16           *Commissioner. Except as otherwise provided in this section,*  
17           *the amendments made by section 4505 shall be effective as*  
18           *of November 29, 2000 and shall apply to all patents and*  
19           *all applications for patents pending on or filed after No-*  
20           *vember 29, 2000. Patents resulting from an international*  
21           *application filed before November 29, 2000 and applica-*  
22           *tions published pursuant to section 122(b) or Article 21(2)*  
23           *of the treaty defined in section 351(a) resulting from an*  
24           *international application filed before November 29, 2000*  
25           *shall not be effective as prior art as of the filing date of*

1 *the international application; however, such patents shall*  
 2 *be effective as prior art in accordance with section 102(e)*  
 3 *in effect on November 28, 2000.”.*

4 **SEC. 7. MISCELLANEOUS CLERICAL AMENDMENTS.**

5 *(a) AMENDMENTS TO TITLE 35.—The following provi-*  
 6 *sions of title 35, United States Code, are amended:*

7 *(1) Section 2(b) is amended in paragraphs*  
 8 *(2)(B) and (4)(B), by striking “, United States*  
 9 *Code”.*

10 *(2) Section 3 is amended—*

11 *(A) in subsection (a)(2)(B), by striking*  
 12 *“United States Code,”;*

13 *(B) in subsection (b)(2)—*

14 *(i) in the first sentence of subpara-*  
 15 *graph (A), by striking “, United States*  
 16 *Code”;*

17 *(ii) in the first sentence of subpara-*  
 18 *graph (B)—*

19 *(I) by striking “United States*  
 20 *Code,”; and*

21 *(II) by striking “, United States*  
 22 *Code”;*

23 *(iii) in the second sentence of subpara-*  
 24 *graph (B)—*

- 1 (I) by striking “United States
- 2 Code,”; and
- 3 (II) by striking “, United States
- 4 Code.” and inserting a period;
- 5 (iv) in the last sentence of subpara-
- 6 graph (B), by striking “, United States
- 7 Code”; and
- 8 (v) in subparagraph (C), by striking “,
- 9 United States Code”; and
- 10 (C) in subsection (c)—
- 11 (i) in the subsection caption, by strik-
- 12 ing “, UNITED STATES CODE”; and
- 13 (ii) by striking “United States Code.”.
- 14 (3) Section 5 is amended in subsections (e) and
- 15 (g), by striking “, United States Code” each place it
- 16 appears.
- 17 (4) The table of chapters for part I is amended
- 18 in the item relating to chapter 3, by striking “**be-**
- 19 **fore**” and inserting “**Before**”.
- 20 (5) The item relating to section 21 in the table
- 21 of contents for chapter 2 is amended to read as fol-
- 22 lows:
- “21. Filing date and day for taking action.”.
- 23 (6) The item relating to chapter 12 in the table
- 24 of chapters for part II is amended to read as follows:
- “12. Examination of Application ..... 131”.

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

          “116. *Inventors.*”.

4           (8) *Section 154(b)(4) is amended by striking “,*  
5           *United States Code,”.*

6           (9) *Section 156 is amended—*

7                   (A) *in subsection (b)(3)(B), by striking*  
8                   *“paragraphs” and inserting “paragraph”;*

9                   (B) *in subsection (d)(2)(B)(i), by striking*  
10                   *“below the office” and inserting “below the Of-*  
11                   *fice”; and*

12                   (C) *in subsection (g)(6)(B)(iii), by striking*  
13                   *“submitted” and inserting “submitted”.*

14           (10) *The item relating to section 183 in the table*  
15           *of contents for chapter 17 is amended by striking “of”*  
16           *and inserting “to”.*

17           (11) *Section 185 is amended by striking the sec-*  
18           *ond period at the end of the section.*

19           (12) *Section 201(a) is amended—*

20                   (A) *by striking “United States Code,”; and*

21                   (B) *by striking “5, United States Code.”*  
22                   *and inserting “5.”.*

23           (13) *Section 202 is amended—*

1           (A) in subsection (b)(4), by striking “last  
2 paragraph of section 203(2)” and inserting “sec-  
3 tion 203(b)”;

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)”;

18          (B) in the first paragraph—

19           (i) by striking “(a)”, “(b)”, “(c)”, and  
20 “(d)” and inserting “(1)”, “(2)”, “(3)”, and  
21 “(4)”, respectively; and

22           (ii) by striking “(1.” and inserting  
23 “(a)”.

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

4           (16) Section 210 is amended—

5           (A) in subsection (a)—

6           (i) in paragraph (11), by striking  
7           “5901” and inserting “5908”; and

8           (ii) in paragraph (20) by striking  
9           “178(j)” and inserting “178j”; and

10          (B) in subsection (c)—

11          (i) by striking “paragraph 202(c)(4)”  
12          and inserting “section 202(c)(4)”; and

13          (ii) by striking “title..” and inserting  
14          “title.”.

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

18          (18) The item relating to section 256 in the table  
19          of contents for chapter 25 is amended to read as fol-  
20          lows:

“256. Correction of named inventor.”.

21          (19) Section 294 is amended—

22          (A) in subsection (b), by striking “United  
23          States Code,”; and

24          (B) in subsection (c), in the second sentence  
25          by striking “court to” and inserting “court of”.

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

3           (21) *Paragraphs (1), (2), and (3) of section*  
4 *376(a) are each amended by striking the semicolon*  
5 *and inserting a period.*

6           **(b) OTHER AMENDMENTS.—**

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

10           (A) *in paragraph (9)(A)(ii), by inserting*  
11 *“in subsection (b),” after “(ii)”;* and

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

16           (2) *Section 4802(1) of that Act is amended by*  
17 *inserting “to” before “citizens”.*

18           (3) *Section 4804 of that Act is amended—*

19           (A) *in subsection (b), by striking “11(a)”*  
20 *and inserting “10(a)”;* and

21           (B) *in subsection (c), by striking “13” and*  
22 *inserting “12”.*

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

1 **SEC. 8. TECHNICAL CORRECTIONS IN TRADEMARK LAW.**

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

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

9 (1) Section 1(d)(1) (15 U.S.C. 1051(d)(1)) is  
10 amended in the first sentence by striking “specifying  
11 the date of the applicant’s first use” and all that fol-  
12 lows through the end of the sentence and inserting  
13 “specifying the date of the applicant’s first use of the  
14 mark in commerce and those goods or services speci-  
15 fied in the notice of allowance on or in connection  
16 with which the mark is used in commerce.”.

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

19 “(e) If the applicant is not domiciled in the United  
20 States the applicant 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 States  
23 on whom may be served notices or process in proceedings  
24 affecting the mark. Such notices or process may be served  
25 upon the person so designated by leaving with that person  
26 or mailing to that person a copy thereof at the address spec-



1 *ified in the last designation so filed. If the person so des-*  
2 *ignated cannot be found at the address given in the last*  
3 *designation, or if the registrant does not designate by a doc-*  
4 *ument filed in the United States Patent and Trademark*  
5 *Office the name and address of a person resident in the*  
6 *United States on whom may be served notices or process*  
7 *in proceedings affecting the mark, such notices or process*  
8 *may be served on the Commissioner.”.*

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

11           “(f) *If the registrant is not domiciled in the United*  
12 *States, the registrant may designate, by a document filed*  
13 *in the United States Patent and Trademark Office, the*  
14 *name and address of a person resident in the United States*  
15 *on whom may be served notices or process in proceedings*  
16 *affecting the mark. Such notices or process may be served*  
17 *upon the person so designated by leaving with that person*  
18 *or mailing to that person a copy thereof at the address spec-*  
19 *ified in the last designation so filed. If the person so des-*  
20 *ignated cannot be found at the address given in the last*  
21 *designation, or if the registrant does not designate by a doc-*  
22 *ument filed in the United States Patent and Trademark*  
23 *Office the name and address of a person resident in the*  
24 *United States on whom may be served notices or process*

1 *in proceedings affecting the mark, such notices or process*  
2 *may be served on the Commissioner.”.*

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

5 *“(c) If the registrant is not domiciled in the United*  
6 *States the registrant may designate, by a document filed*  
7 *in the United States Patent and Trademark Office, the*  
8 *name and address of a person resident in the United States*  
9 *on whom may be served notices or process in proceedings*  
10 *affecting the mark. Such notices or process may be served*  
11 *upon the person so designated by leaving with that person*  
12 *or mailing to that person a copy thereof at the address spec-*  
13 *ified in the last designation so filed. If the person so des-*  
14 *ignated cannot be found at the address given in the last*  
15 *designation, or if the registrant does not designate by a doc-*  
16 *ument filed in the United States Patent and Trademark*  
17 *Office the name and address of a person resident in the*  
18 *United States on whom may be served notices or process*  
19 *in proceedings affecting the mark, such notices or process*  
20 *may be served on the Commissioner.”.*

21 *(5) Subsections (a) and (b) of section 10 (15*  
22 *U.S.C. 1060(a) and (b)) are amended to read as fol-*  
23 *lows:*

24 *“(a)(1) A registered mark or a mark for which an ap-*  
25 *plication to register has been filed shall be assignable with*

1 *the good will of the business in which the mark is used,*  
2 *or with that part of the good will of the business connected*  
3 *with the use of and symbolized by the mark. Notwith-*  
4 *standing the preceding sentence, no application to register*  
5 *a mark under section 1(b) shall be assignable prior to the*  
6 *filing of an amendment under section 1(c) to bring the ap-*  
7 *plication into conformity with section 1(a) or the filing of*  
8 *the verified statement of use under section 1(d), except for*  
9 *an assignment to a successor to the business of the appli-*  
10 *cant, or portion thereof, to which the mark pertains, if that*  
11 *business is ongoing and existing.*

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

17       “(3) *Assignments shall be by instruments in writing*  
18 *duly executed. Acknowledgment shall be prima facie evi-*  
19 *dence of the execution of an assignment, and when the pre-*  
20 *scribed information reporting the assignment is recorded in*  
21 *the United States Patent and Trademark Office, the record*  
22 *shall be prima facie evidence of execution.*

23       “(4) *An assignment shall be void against any subse-*  
24 *quent purchaser for valuable consideration without notice,*  
25 *unless the prescribed information reporting the assignment*

1 *is recorded in the United States Patent and Trademark Of-*  
2 *fice within 3 months after the date of the assignment or*  
3 *prior to the subsequent purchase.*

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

7       “(b) *An assignee not domiciled in the United States*  
8 *may designate by a document filed in the United States*  
9 *Patent and Trademark Office the name and address of a*  
10 *person resident in the United States on whom may be*  
11 *served notices or process in proceedings affecting the mark.*  
12 *Such notices or process may be served upon the person so*  
13 *designated by leaving with that person or mailing to that*  
14 *person a copy thereof at the address specified in the last*  
15 *designation so filed. If the person so designated cannot be*  
16 *found at the address given in the last designation, or if the*  
17 *assignee does not designate by a document filed in the*  
18 *United States Patent and Trademark Office the name and*  
19 *address of a person resident in the United States on whom*  
20 *may be served notices or process in proceedings affecting*  
21 *the mark, such notices or process may be served upon the*  
22 *Commissioner.”.*

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

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 110”*  
5 *and all that follows through “(36 U.S.C. 380)” and*  
6 *inserting “section 220506 of title 36, United States*  
7 *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 in-*  
15 *serting “6621(a)(2) of the Internal Revenue Code of*  
16 *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 inserting*  
21 *“section 220506 of title 36, United States Code,”;*  
22 *and*

23                   (B) *by striking “6621 of the Internal Rev-*  
24 *enue Code of 1954” and inserting “6621(a)(2) of*  
25 *the Internal Revenue Code of 1986”.*

1           (12) Section 44(e) (15 U.S.C. 1126(e)) is amend-  
 2           ed by striking “a certification” and inserting “a true  
 3           copy, a photocopy, a certification,”.

4 **SEC. 9. PATENT AND TRADEMARK FEE CLERICAL AMEND-**  
 5 **MENT.**

6           *The Patent and Trademark Fee Fairness Act of 1999*  
 7 *(113 Stat. 1537–546 et seq.), as enacted by section*  
 8 *1000(a)(9) of Public Law 106–113, is amended in section*  
 9 *4203, by striking “111(a)” and inserting “1113(a)”.*

10 **SEC. 10. COPYRIGHT RELATED CORRECTIONS TO 1999 OM-**  
 11 **NIBUS REFORM ACT.**

12           *Title I of the Intellectual Property and Communica-*  
 13 *tions Omnibus Reform Act of 1999, as enacted by section*  
 14 *1000(a)(9) of Public Law 106–113, is amended as follows:*

15           (1) Section 1007 is amended—

16                   (A) in paragraph (2), by striking “para-

17                   graph (2)” and inserting “paragraph (2)(A)”;

18                   and

19                   (B) in paragraph (3), by striking “1005(e)”

20                   and inserting “1005(d)”.

21           (2) Section 1006(b) is amended by striking

22           “119(b)(1)(B)(iii)” and inserting “119(b)(1)(B)(ii)”.

23           (3)(A) Section 1006(a) is amended—

24                   (i) in paragraph (1), by adding “and” after

25                   the semicolon;

1                   (ii) by striking paragraph (2); and  
 2                   (iii) by redesignating paragraph (3) as  
 3 paragraph (2).

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

6                   “(A) in paragraph (1), by striking ‘pri-  
 7 mary transmission made by a superstation and  
 8 embodying a performance or display of a work’  
 9 and inserting ‘performance or display of a work  
 10 embodied in a primary transmission made by a  
 11 superstation or by the Public Broadcasting Serv-  
 12 ice satellite feed’;”.

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

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

15                   (1) Section 119(a)(6) is amended by striking “of  
 16 performance” and inserting “of a performance”.

17                   (2)(A) The section heading for section 122 is  
 18 amended by striking “**rights; secondary**” and in-  
 19 serting “**rights: Secondary**”.

20                   (B) The item relating to section 122 in the table  
 21 of contents for chapter 1 is amended to read as fol-  
 22 lows:

“122. Limitations on exclusive rights: Secondary transmissions by satellite car-  
 riers 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 table*  
5 *of contents for chapter 1 is amended by striking “re-*  
6 *production” 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—*



1           (A) by striking “transmitted” and inserting  
2           “retransmitted”; and

3           (B) by striking “transmissions” and insert-  
4           ing “retransmissions”.

5           (9) Section 203(a)(2) is amended—

6           (A) in subparagraph (A)—

7                 (i) by striking “(A) the” and inserting  
8                 “(A) The”; and

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

11           (B) in subparagraph (B)—

12                 (i) by striking “(B) the” and inserting  
13                 “(B) The”; and

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

16           (C) in subparagraph (C), by striking “(C)  
17           the” and inserting “(C) The”.

18           (10) Section 304(c)(2) is amended—

19           (A) in subparagraph (A)—

20                 (i) by striking “(A) the” and inserting  
21                 “(A) The”; and

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

24           (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 table  
8                   of contents for chapter 9 is amended by striking “li-  
9                   censure” and inserting “licensing”.

10 **SEC. 12. OTHER COPYRIGHT RELATED TECHNICAL AMEND-**  
11 **MENTS.**

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

15                   (b) *STANDARD REFERENCE DATA.*—(1) Section 105(f)  
16 of Public Law 94–553 is amended by striking “section  
17 290(e) of title 15” and inserting “section 6 of the Standard  
18 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 “Notwithstanding”  
21 and all that follows through “United States Code,” and in-

- 1 *serting “Notwithstanding the limitations under section 105*
- 2 *of title 17, United States Code,”.*

Attest:

*Secretary.*

107TH CONGRESS  
1ST SESSION

**S. 320**

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**SENATE AMENDMENT TO  
HOUSE AMENDMENT**