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[Report No. 107-18]

IN THE HOUSE OF REPRESENTATIVES

FEBRUARY 26, 2001

Referred to the Committee on the Judiciary

MARCH 12, 2001

Reported with an amendment, committed to the Committee of the Whole
House on the State of the Union, and ordered to be printed

[Strike out all after the enacting clause and insert the part printed in italic]

[For text of Senate passed bill, see copy of bill as printed in the House of Representatives on
February 26, 2001]

AN ACT

To make technical corrections in patent, copyright, and
trademark laws.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 *This Act may be cited as the “Intellectual Property*
5 *and High Technology Technical Amendments Act of 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 *sistant 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(f) of title 35, United States Code, is
25 amended in subparagraphs (A) and (B) of paragraph (2)—

1 (i) by striking “the Commissioner” each place it
2 appears and inserting “the Assistant Commissioner”;
3 and

4 (ii) by striking “a Commissioner” each place it
5 appears and inserting “an Assistant Commissioner”.

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

8 (i) by striking “Commissioner of” each place it
9 appears and inserting “Assistant Commissioner for”;
10 and

11 (ii) by striking “Commissioners” and inserting
12 “Assistant Commissioners”.

13 (F) Chapter 17 of title 35, United States Code, is
14 amended by striking “Commissioner of Patents” each place
15 it appears and inserting “Assistant Commissioner for Pat-
16 ents”.

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

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

22 “Under Secretary of Commerce for Intellectual
23 Property and Director of the United States Patent
24 and Trademark Office.”

25 and inserting

1 “Under Secretary of Commerce for Intellectual
2 Property and Commissioner of the United States Pat-
3 ent and Trademark Office.”.

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

6 “Deputy Under Secretary of Commerce for Intel-
7 lectual Property and Deputy Director of the United
8 States Patent and Trademark Office.”

9 and inserting

10 “Deputy Under Secretary of Commerce for Intel-
11 lectual Property and Deputy Commissioner of the
12 United 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) *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 tions 4605(c) and 4605(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 4507, and the amendments made by such sec-*
8 *tions, shall be effective as of November 29, 2000, and shall*
9 *apply only to applications (including international appli-*
10 *cations designating the United States) filed on or after that*
11 *date. The amendments made by sections 4504 and 4505*
12 *shall additionally apply to any pending application filed*
13 *before November 29, 2000, if such pending application is*
14 *published pursuant to a request of the applicant under such*
15 *procedures as may be established by the Commissioner. If*
16 *an application is filed on or after November 29, 2000, or*
17 *is published pursuant to a request from the applicant, and*
18 *the application claims the benefit of one or more prior-filed*
19 *applications under section 119(e), 120, or 365(c) of title*
20 *35, United States Code, then the amendment made by sec-*
21 *tion 4505 shall apply to the prior-filed application in deter-*
22 *mining the filing date in the United States of the applica-*
23 *tion.*”.

1 **SEC. 7. MISCELLANEOUS CLERICAL AMENDMENTS.**

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

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

7 (2) *Section 3 is amended—*

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

10 (B) *in subsection (b)(2)—*

11 (i) *in the first sentence of subpara-*
12 *graph (A), by striking “, United States*
13 *Code”;*

14 (ii) *in the first sentence of subpara-*
15 *graph (B)—*

16 (I) *by striking “United States*
17 *Code,”; and*

18 (II) *by striking “, United States*
19 *Code”;*

20 (iii) *in the second sentence of subpara-*
21 *graph (B)—*

22 (I) *by striking “United States*
23 *Code,”; and*

24 (II) *by striking “, United States*
25 *Code.” and inserting a period;*

1 (iv) in the last sentence of subpara-
2 graph (B), by striking “, United States
3 Code”; and

4 (v) in subparagraph (C), by striking “,
5 United States Code”; and

6 (C) in subsection (c)—

7 (i) in the subsection caption, by strik-
8 ing “, UNITED STATES CODE”; and

9 (ii) by striking “United States Code.”.

10 (3) Section 5 is amended in subsections (e) and
11 (g), by striking “, United States Code” each place it
12 appears.

13 (4) The table of chapters for part I is amended
14 in the item relating to chapter 3, by striking “**be-**
15 **fore**” and inserting “**Before**”.

16 (5) The item relating to section 21 in the table
17 of contents for chapter 2 is amended to read as fol-
18 lows:

“21. Filing date and day for taking action.”.

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

“12. **Examination of Application** **131**”.

21 (7) The item relating to section 116 in the table
22 of contents for chapter 11 is amended to read as fol-
23 lows:

“116. *Inventors.*”.

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

3 (9) *Section 156 is amended—*

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

6 (B) *in subsection (d)(2)(B)(i), by striking*
7 *“below the office” and inserting “below the Of-*
8 *fice”;* and

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

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

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

16 (12) *Section 201(a) is amended—*

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

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

20 (13) *Section 202 is amended—*

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

24 (B) *in subsection (c)—*

1 (i) in paragraph (4), by striking
2 “rights;” and inserting “rights;” and

3 (ii) in paragraph (5), by striking “of
4 the United States Code”.

5 (14) Section 203 is amended—

6 (A) in paragraph (2)—

7 (i) by striking “(2)” and inserting
8 “(b)”;

9 (ii) by striking the quotation marks
10 and comma before “as appropriate”; and

11 (iii) by striking “paragraphs (a) and
12 (c)” and inserting “paragraphs (1) and (3)
13 of subsection (a)”; and

14 (B) in the first paragraph—

15 (i) by striking “(a)”, “(b)”, “(c)”, and
16 “(d)” and inserting “(1)”, “(2)”, “(3)”, and
17 “(4)”, respectively; and

18 (ii) by striking “(1.” and inserting
19 “(a)”.

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

23 (16) Section 210 is amended—

24 (A) in subsection (a)—

1 (i) in paragraph (11), by striking
2 “5901” and inserting “5908”; and

3 (ii) in paragraph (20) by striking
4 “178(j)” and inserting “178j”; and

5 (B) in subsection (c)—

6 (i) by striking “paragraph 202(c)(4)”
7 and inserting “section 202(c)(4)”; and

8 (ii) by striking “title..” and inserting
9 “title.”.

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

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

“256. Correction of named inventor.”.

16 (19) Section 294 is amended—

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

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

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

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

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

4 (b) OTHER AMENDMENTS.—

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

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

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

14 (2) Section 4802(1) of that Act is amended by
15 inserting “to” before “citizens”.

16 (3) Section 4804 of that Act is amended—

17 (A) in subsection (b), by striking “11(a)”
18 and inserting “10(a)”; and

19 (B) in subsection (c), by striking “13” and
20 inserting “12”.

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

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

24 (a) AWARD OF DAMAGES.—Section 35(a) of the Act
25 of July 5, 1946 (commonly referred to as the “Trademark

1 Act of 1946”) (15 U.S.C. 1117(a)), is amended by striking
2 “a violation under section 43(a), (c), or (d),” and inserting
3 “a violation under section 43(a) or (d),”.

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

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

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

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

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

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

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

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

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

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

22 “(a)(1) *A registered mark or a mark for which an ap-*
23 *plication to register has been filed shall be assignable with*
24 *the good will of the business in which the mark is used,*
25 *or with that part of the good will of the business connected*

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

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

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

21 “(4) *An assignment shall be void against any subse-*
22 *quent purchaser for valuable consideration without notice,*
23 *unless the prescribed information reporting the assignment*
24 *is recorded in the United States Patent and Trademark Of-*

1 *file within 3 months after the date of the assignment or*
2 *prior to the subsequent purchase.*

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

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

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

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

1 (8) Section 34(d)(1)(A) (15 U.S.C.
2 1116(d)(1)(A)) is amended by striking “section 110”
3 and all that follows through “(36 U.S.C. 380)” and
4 inserting “section 220506 of title 36, United States
5 Code,”.

6 (9) Section 34(d)(1)(B)(ii) (15 U.S.C.
7 1116(d)(1)(B)(ii)) is amended by striking “section
8 110” and all that follows through “(36 U.S.C. 380)”
9 and inserting “section 220506 of title 36, United
10 States Code”.

11 (10) Section 34(d)(11) is amended by striking
12 “6621 of the Internal Revenue Code of 1954” and in-
13 serting “6621(a)(2) of the Internal Revenue Code of
14 1986”.

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

17 (A) by striking “section 110” and all that
18 follows through “(36 U.S.C. 380)” and inserting
19 “section 220506 of title 36, United States Code,”;
20 and

21 (B) by striking “6621 of the Internal Rev-
22 enue Code of 1954” and inserting “6621(a)(2) of
23 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-
22 serting “Notwithstanding the limitations under section 105
23 of title 17, United States Code,”.

Union Calendar No. 13

107TH CONGRESS
1ST SESSION

S. 320

[Report No. 107-18]

AN ACT

To make technical corrections in patent, copyright,
and trademark laws.

MARCH 12, 2001

Reported with an amendment, committed to the Com-
mittee of the Whole House on the State of the Union,
and ordered to be printed