

# A BILL

To make certain technical and conforming amendments to the Lanham Act, implement the provisions of the Hague Agreement, implement the Provisions of the Patent Law Treaty, authorize expenditure of funds for certain travel-related expenses and to provide for the equitable adjustment of pay for administrative patent judges and administrative trademark judges.

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

1 **SECTION 1. SHORT TITLE.**

2 This Act may be cited as the “*United States Patent and Trademark Office Technical*  
3 *Adjustments Act of 2010.*”

4 **TITLE I — TECHNICAL AND CONFORMING**  
5 **AMENDMENTS TO TRADEMARK LAW**

6 **SECTION 101. TECHNICAL AND CONFORMING AMENDMENTS.**

7 (a) CERTIFICATES OF REGISTRATION. -- Section 1057 of title 15, United States  
8 Code, is amended to read as follows:

9 “§ 1057 Certificates of registration

10 “(a) *Issuance and form.* -- Certificates of registration of marks registered upon the  
11 principal register shall be issued in the name of the United States of America,  
12 under the seal of the United States Patent and Trademark Office, and shall be  
13 signed by the Director or have his signature placed thereon, and a record thereof  
14 shall be kept in the United States Patent and Trademark Office. The registration  
15 shall reproduce the mark, and state that the mark is registered on the principal

1 register under this chapter, the date of the first use of the mark, the date of the first  
2 use of the mark in commerce, the particular goods or services for which it is  
3 registered, the number and date of the registration, the term thereof, the date on  
4 which the application for registration was received in the United States Patent and  
5 Trademark Office, and any conditions and limitations that may be imposed in the  
6 registration.

7 “(b) *Certificate as prima facie evidence.* -- A certificate of registration of a mark  
8 upon the principal register provided by this chapter shall be prima facie evidence  
9 of the validity of the registered mark and of the registration of the mark, of the  
10 ownership of the mark, and of the owner’s exclusive right to use the registered  
11 mark in commerce on or in connection with the goods or services specified in the  
12 certificate, subject to any conditions or limitations stated in the certificate.

13 “(c) *Application to register mark considered constructive use.* -- Contingent on  
14 the registration of a mark on the principal register provided by this chapter, the  
15 filing of the application to register such mark shall constitute constructive use of  
16 the mark, conferring a right of priority, nationwide in effect, on or in connection  
17 with the goods or services specified in the registration against any other person  
18 except for a person whose mark has not been abandoned and who, prior to such  
19 filing—

20 “(1) has used the mark;

21 “(2) has filed an application to register the mark which is pending or has  
22 resulted in registration of the mark; or

1           “(3) has filed a foreign application to register the mark on the basis of  
2           which he or she has acquired a right of priority, and timely files an  
3           application under section 1126(d) to register the mark which is pending or  
4           has resulted in registration of the mark.

5           “(d) *Issuance to assignee.* -- A certificate of registration of a mark may be issued  
6           to the assignee of the applicant, but the assignment must first be recorded in the  
7           United States Patent and Trademark Office. In case of change of ownership the  
8           Director shall, at the request of the owner and upon a proper showing and the  
9           payment of the prescribed fee, issue to such assignee a new certificate of  
10          registration of the said mark in the name of such assignee, and for the unexpired  
11          part of the original period.

12          “(e) *Surrender, cancellation, or amendment by owner.* -- Upon application of the  
13          owner the Director may permit any registration to be surrendered for cancellation,  
14          and upon cancellation appropriate entry shall be made in the records of the United  
15          States Patent and Trademark Office. Upon application of the owner and payment  
16          of the prescribed fee, the Director for good cause may permit any registration to  
17          be amended or to be disclaimed in part: *Provided*, That the amendment or  
18          disclaimer does not alter materially the character of the mark. Appropriate entry  
19          shall be made in the records of the United States Patent and Trademark Office and  
20          upon the certificate of registration.

21          “(f) *Copies of United States Patent and Trademark Office records as evidence.* --  
22          Copies of any records, books, papers, or drawings belonging to the United States  
23          Patent and Trademark Office relating to marks, and copies of registrations, when

1 authenticated by the seal of the United States Patent and Trademark Office and  
2 certified by the Director, or in his name by an employee of the Office duly  
3 designated by the Director, shall be evidence in all cases wherein the originals  
4 would be evidence; and any person making application therefor and paying the  
5 prescribed fee shall have such copies.

6 “(g) *Correction of United States Patent and Trademark Office mistake.* --

7 Whenever a material mistake in a registration, incurred through the fault of the  
8 United States Patent and Trademark Office, is clearly disclosed by the records of  
9 the Office a certificate stating the fact and nature of such mistake shall be issued  
10 without charge and recorded and a printed copy thereof shall be attached to each  
11 printed copy of the registration and such corrected registration shall thereafter  
12 have the same effect as if the same had been originally issued in such corrected  
13 form, or in the discretion of the Director a new certificate of registration may be  
14 issued without charge. All certificates of correction heretofore issued in  
15 accordance with the rules of the United States Patent and Trademark Office and  
16 the registrations to which they are attached shall have the same force and effect as  
17 if such certificates and their issue had been specifically authorized by statute.

18 “(h) *Correction of applicant’s mistake.* -- Whenever a mistake has been made in a  
19 registration and a showing has been made that such mistake occurred in good  
20 faith through the fault of the applicant, the Director is authorized to issue a  
21 certificate of correction or, in his discretion, a new certificate upon the payment of  
22 the prescribed fee: *Provided*, That the correction does not involve such changes  
23 in the registration as to require republication of the mark.”

1 (b) DURATION, AFFIDAVITS AND FEES. -- Section 1058 of title 15, United States  
2 Code, is amended to read as follows:

3 **"§ 1058 Duration, affidavits and fees**

4 "(a) *Time periods for required affidavits.* -- Each registration shall remain in force  
5 for 10 years, except that the registration of any mark shall be canceled by the  
6 Director unless the owner of the registration files in the United States Patent and  
7 Trademark Office affidavits that meet the requirements of subsection (b), within  
8 the following time periods:

9 "(1) Within the 1-year period immediately preceding the expiration of 6  
10 years following the date of registration under this Act or the date of the  
11 publication under section 1062(c); and

12 "(2) Within the 1-year period immediately preceding the expiration of 10  
13 years following the date of registration, and each successive 10-year  
14 period following the date of registration.

15 "(3) The owner may file the affidavit required under this section within the  
16 6-month grace period immediately following the expiration of the periods  
17 in subparagraphs (1) and (2), together with the fee described in  
18 subsection (b) and the additional grace period surcharge prescribed by the  
19 Director.

20 "(b) *Requirements for affidavit.* -- The affidavit referred to in subsection (a) must:

21 "(1) (A) State that the mark is in use in commerce;

22 "(B) Set forth the goods and/or services recited in the registration  
23 on or in connection with which the mark is in use in commerce;

1                   “(C) Be accompanied by such number of specimens or facsimiles  
2                   showing current use of the mark in commerce as may be required  
3                   by the Director; and

4                   “(D) Be accompanied by the fee prescribed by the Director; or

5                   “(2) (A) Set forth the goods and/or services recited in the  
6                   registration on or in connection with which the mark is not in use  
7                   in commerce;

8                   “(B) Include a showing that any nonuse is due to special  
9                   circumstances which excuse such nonuse and is not due to any  
10                  intention to abandon the mark; and

11                  “(C) Be accompanied by the fee prescribed by the Director.

12                  “(c) *Deficient affidavit.* -- If any submission filed within the period set forth in  
13                  subsection (a) is deficient, including that the affidavit was not filed in the name of  
14                  the owner of the registration, the deficiency may be corrected after the statutory  
15                  time period, within the time prescribed after notification of the deficiency. Such  
16                  submission must be accompanied by the additional deficiency surcharge  
17                  prescribed by the Director.

18                  “(d) *Notice of requirement.* -- Special notice of the requirement for such affidavit  
19                  shall be attached to each certificate of extension of protection.

20                  “(e) *Notification of acceptance or refusal.* -- The Director shall notify any owner  
21                  who files any affidavit required by this section of the Director’s acceptance or  
22                  refusal thereof and, in the case of a refusal, the reasons therefor.

1           “(f) *Designation of resident for service of process and notices.* -- If the owner is  
2           not domiciled in the United States, the owner may designate, by a document filed  
3           in the United States Patent and Trademark Office, the name and address of a  
4           person resident in the United States on whom may be served notices or process in  
5           proceedings affecting the mark. Such notices or process may be served upon the  
6           person so designated by leaving with that person or mailing to that person a copy  
7           thereof at the address specified in the last designation so filed. If the person so  
8           designated cannot be found at the last designated address, or if the owner does not  
9           designate by a document filed in the United States Patent and Trademark Office  
10          the name and address of a person resident in the United States on whom may be  
11          served notices or process in proceedings affecting the mark, such notices or  
12          process may be served on the Director.”

13       **(c) INCONTESTABILITY OF RIGHT TO USE MARK UNDER CERTAIN**  
14       **CONDITIONS. -- Section 1065 of title 15, United States Code, is amended to read as**  
15       **follows:**

16          “§ 1065 Incontestability of right to use mark under certain conditions  
17          “Except on a ground for which application to cancel may be filed at anytime  
18          under paragraphs (3) and (5) of section 1064 of this title, and except to the extent,  
19          if any, to which the use of a mark registered on the principal register infringes a  
20          valid right acquired under the law of any State or Territory by use of a mark or  
21          trade name continuing from a date prior to the date of registration under this  
22          chapter of such registered mark, the right of the owner to use such registered mark  
23          in commerce for the goods or services on or in connection with which such

1 registered mark has been in continuous use for five consecutive years subsequent  
2 to the date of such registration and is still in use in commerce, shall be  
3 incontestable: *Provided*, That—

4 “(1) there has been no final decision adverse to the owner’s claim of  
5 ownership of such mark for such goods or services, or to the owner’s right  
6 to register the same or to keep the same on the register; and

7 “(2) there is no proceeding involving said rights pending in the United  
8 States Patent and Trademark Office or in a court and not finally disposed  
9 of; and

10 “(3) an affidavit is filed with the Director within one year after the  
11 expiration of any such five-year period setting forth those goods or  
12 services stated in the registration on or in connection with which such  
13 mark has been in continuous use for such five consecutive years and is  
14 still in use in commerce, and the other matters specified in paragraphs (1)  
15 and (2) of this section; and

16 “(4) no incontestable right shall be acquired in a mark which is the generic  
17 name for the goods or services or a portion thereof, for which it is  
18 registered.

19 “Subject to the conditions above specified in this section, the incontestable right  
20 with reference to a mark registered under this chapter shall apply to a mark  
21 registered under the Act of March 3, 1881, or the Act of February 20, 1905, upon  
22 the filing of the required affidavit with the Director within one year after the

1 expiration of any period of five consecutive years after the date of publication of a  
2 mark under the provisions of subsection (c) of section 1062 of this title.

3 "The Director shall notify any owner who files the above-prescribed affidavit of  
4 the filing thereof."

5 **(d) APPEAL TO COURTS. -- Section 1071 of title 15, United States Code, is**  
6 **amended to read as follows:**

7 "§ 1071 Appeal to courts

8 "(a)(1) An applicant for registration of a mark, party to an interference  
9 proceeding, party to an opposition proceeding, party to an application to register  
10 as a lawful concurrent user, party to a cancellation proceeding, a registrant who  
11 has filed an affidavit as provided in section 1058 or section 1141k, or an applicant  
12 for renewal, who is dissatisfied with the decision of the Director or the Trademark  
13 Trial and Appeal Board, may appeal to the United States Court of Appeals for the  
14 Federal Circuit thereby waiving his right to proceed under subsection (b) of this  
15 section: *Provided*, That such appeal shall be dismissed if any adverse party to the  
16 proceeding, other than the Director, shall, within twenty days after the appellant  
17 has filed notice of appeal according to paragraph (2) of this subsection, files  
18 notice with the Director that he elects to have all further proceedings conducted as  
19 provided in subsection (b) of this section. Thereupon the appellant shall have  
20 thirty days thereafter within which to file a civil action under subsection (b) of  
21 this section, in default of which the decision appealed from shall govern the  
22 further proceedings in the case.

1 “(2) When an appeal is taken to the United States Court of Appeals for the  
2 Federal Circuit, the appellant shall file in the United States Patent and Trademark  
3 Office a written notice of appeal directed to the Director, within such time after  
4 the date of the decision from which the appeal is taken as the Director prescribes,  
5 but in no case less than 60 days after that date.

6 “(3) The Director shall transmit to the United States Court of Appeals for the  
7 Federal Circuit a certified list of the documents comprising the record in the  
8 United States Patent and Trademark Office. The court may request that the  
9 Director forward the original or certified copies of such documents during  
10 pendency of the appeal. In an ex parte case, the Director shall submit to that court  
11 a brief explaining the grounds for the decision of the United States Patent and  
12 Trademark Office, addressing all the issues involved in the appeal. The court  
13 shall, before hearing an appeal, give notice of the time and place of the hearing to  
14 the Director and parties in the appeal.

15 “(4) The United States Court of Appeals for the Federal Circuit shall review the  
16 decision from which the appeal is taken on the record before the United States  
17 Patent and Trademark Office. Upon its determination the court shall issue its  
18 mandate and opinion to the Director, which shall be entered of record in the  
19 United States Patent and Trademark Office and shall govern the further  
20 proceedings in the case. However, no final judgment shall be entered in favor of  
21 an applicant under section 1051(b) before the mark is registered, if such applicant  
22 cannot prevail without establishing constructive use pursuant to section 1057(c).

1 “(b)(1) Whenever a person authorized by subsection (a) of this section to appeal  
2 to the United States Court of Appeals for the Federal Circuit is dissatisfied with  
3 the decision of the Director or the Trademark Trial and Appeal Board, said person  
4 may, unless appeal has been taken to said United States Court of Appeals for the  
5 Federal Circuit, have remedy by a civil action if commenced within such time  
6 after such decision, not less than sixty days, as the Director appoints or as  
7 provided in subsection (a) of this section. The court may adjudge that an  
8 applicant is entitled to a registration upon the application involved, that a  
9 registration involved should be canceled, or such other matter as the issues in the  
10 proceeding require, as the facts in the case may appear. Such adjudication shall  
11 authorize the Director to take any necessary action, upon compliance with the  
12 requirements of law. However, no final judgment shall be entered in favor of an  
13 applicant under section 1051(b) before the mark is registered, if such applicant  
14 cannot prevail without establishing constructive use pursuant to section 1057(c).

15 “(2) The Director shall not be made a party to an inter partes proceeding under  
16 this subsection, but he shall be notified of the filing of the complaint by the clerk  
17 of the court in which it is filed and shall have the right to intervene in the action.

18 “(3) In any case where there is no adverse party, a copy of the complaint shall be  
19 served on the Director, and, unless the court finds the expenses to be  
20 unreasonable, all the expenses of the proceeding shall be paid by the party  
21 bringing the case, whether the final decision is in favor of such party or not. In  
22 suits brought hereunder, the record in the United States Patent and Trademark  
23 Office shall be admitted on motion of any party, upon such terms and conditions

1 as to costs, expenses, and the further cross-examination of the witnesses as the  
2 court imposes, without prejudice to the right of any party to take further  
3 testimony. The testimony and exhibits of the record in the United States Patent  
4 and Trademark Office, when admitted, shall have the same effect as if originally  
5 taken and produced in the suit.

6 “(4) Where there is an adverse party, such suit may be instituted against the party  
7 in interest as shown by the records of the United States Patent and Trademark  
8 Office at the time of the decision complained of, but any party in interest may  
9 become a party to the action. If there are adverse parties residing in a plurality of  
10 districts not embraced within the same State, or an adverse party residing in a  
11 foreign country, the United States District Court for the District of Columbia shall  
12 have jurisdiction and may issue summons against the adverse parties directed to  
13 the marshal of any district in which any adverse party resides. Summons against  
14 adverse parties residing in foreign countries may be served by publication or  
15 otherwise as the court directs.”

16 **(e) DURATION, AFFIDAVITS AND FEES. -- Section 1141k of title 15, United**  
17 **States Code, is amended to read as follows:**

18 “§ 1141k Duration, affidavits and fees

19 “(a) *Time periods for required affidavits.* -- Each extension of protection for  
20 which a certificate has been issued under section 1141i shall remain in force for  
21 the term of the international registration upon which it is based, except that the  
22 extension of protection of any mark shall be canceled by the Director unless the  
23 holder of the international registration files in the United States Patent and

1 Trademark Office affidavits that meet the requirements of subsection (b), within  
2 the following time periods:

3 “(1) Within the 1-year period immediately preceding the expiration of 6  
4 years following the date of issuance of the certificate of extension of  
5 protection; and

6 “(2) Within the 1-year period immediately preceding the expiration of  
7 10 years following the date of issuance of the certificate of extension of  
8 protection, and each successive 10-year period following the date of  
9 issuance of the certificate of extension of protection.

10 “(3) The holder may file the affidavit required under this section within  
11 a grace period of 6 months after the end of the applicable time period in  
12 subparagraph (1) or (2) of this section, together with the fee described in  
13 paragraph (b) and the additional grace period surcharge prescribed by the  
14 Director.

15 “(b) *Requirements for affidavit.* -- The affidavit referred to in subsection (a) must:

16 “(1) (A) State that the mark is in use in commerce;

17 “(B) Set forth the goods and/or services recited in the extension of  
18 protection on or in connection with which the mark is in use in  
19 commerce;

20 “(C) Be accompanied by such number of specimens or facsimiles  
21 showing current use of the mark in commerce as may be required  
22 by the Director; and

23 “(D) Be accompanied by the fee prescribed by the Director; or



1 on whom may be served notices or process in proceedings affecting the mark.  
2 Such notices or process may be served upon the person so designated by leaving  
3 with that person or mailing to that person a copy thereof at the address specified  
4 in the last designation so filed. If the person so designated cannot be found at the  
5 last designated address, or if the holder does not designate by a document filed in  
6 the United States Patent and Trademark Office the name and address of a person  
7 resident in the United States on whom may be served notices or process in  
8 proceedings affecting the mark, such notices or process may be served on the  
9 Director.”

10  
11 **TITLE II — PROVISIONS TO IMPLEMENT THE**  
12 **HAGUE AGREEMENT CONCERNING THE**  
13 **INTERNATIONAL REGISTRATION OF**  
14 **INDUSTRIAL DESIGNS.**

15 **SEC. 201.** Title 35, United States Code, is amended by inserting after chapter 37 the

16 following new part:

17 **“PART V - THE HAGUE AGREEMENT CONCERNING INTERNATIONAL**  
18 **REGISTRATION OF INDUSTRIAL DESIGNS.**

19 **“Chapter 38--INTERNATIONAL DESIGN APPLICATIONS.**

20 **“§ 381. Definitions.**

21 **“When used in this part unless the context otherwise indicates:**

1 “(a) the term “treaty” means the Geneva Act of the Hague Agreement Concerning the  
2 International Registration of Industrial Designs adopted at Geneva on July 2, 1999.

3 “(b) the term “Regulations,” when capitalized, means the Common Regulations under the  
4 treaty. The term “regulations,” when not capitalized, means the regulations established  
5 by the Director under this title.

6 “(c) the term “designation” means a request that an international registration have effect  
7 in a Contracting Party to the treaty.

8 “(d) the term “International Bureau” means the international intergovernmental  
9 organization that is recognized as the coordinating body under the treaty and the  
10 Regulations.

11 “(e) the term “effective registration date” means the date of international registration  
12 indicated by the International Bureau under the treaty.

13 “(f) the term “international design application” means an application for international  
14 registration.

15 “(g) the term “international registration” means the international registration of an  
16 industrial design filed under the treaty.

17 “(h) Terms and expressions not defined in this part are to be taken in the sense indicated  
18 by the treaty and the Regulations.

19 **“§ 382. Filing International Design Applications.**

20 “(a) Any person who is a national of the United States, or has a domicile, a  
21 habitual residence or a real and effective industrial or commercial establishment in the  
22 United States, may file an international design application by submitting to the Patent and

1 Trademark Office an application in such form, together with such fees, as may be  
2 prescribed by the Director.

3 “(b) The Patent and Trademark Office shall perform all acts connected with the  
4 discharge of its duties under the treaty, including the collection of international fees and  
5 transmittal thereof to the International Bureau. Subject to chapter 17 of this title,  
6 international design applications shall be forwarded by the Patent and Trademark Office  
7 to the International Bureau, upon payment of a transmittal fee.

8 “(c) Except as otherwise provided in this chapter, the provisions of chapter 16 of  
9 this title shall apply.

10 “(d) An international design application filed at the International Bureau or in a  
11 country other than the United States on an industrial design made in this country shall be  
12 considered to constitute the filing of an application in a foreign country within the  
13 meaning of chapter 17 of this title.

14 **“§ 383. International Design Application.**

15 “In addition to any requirements pursuant to chapter 16 of this title, the international  
16 design application shall contain:

17 “(a) a request for international registration under the treaty;

18 “(b) an indication of the designated Contracting Parties;

19 “(c) data concerning the applicant as prescribed in the treaty and the Regulations;

20 “(d) copies of a reproduction or, at the choice of the applicant, of several different  
21 reproductions of the industrial design that is the subject of the international application,  
22 presented in the number and manner prescribed in the treaty and the Regulations;

1 “(e) an indication of the product or products which constitute the industrial design or in  
2 relation to which the industrial design is to be used, as prescribed in the treaty and the  
3 Regulations;

4 “(f) the fees prescribed in the treaty and the Regulations; and

5 “(g) any other particulars prescribed in the Regulations.

6 **“§ 384. Filing Date.**

7 “(a) Subject to subsection (b), the filing date of an international design  
8 application in the United States shall be the effective registration date. Notwithstanding  
9 the provisions of this part, any international design application designating the United  
10 States that otherwise meets the requirements of chapter 16 of this title may be treated as a  
11 design application under chapter 16 of this title.

12 “(b) An applicant may request review by the Director of the filing date of the  
13 international design application in the United States. The Director may determine that  
14 the filing date of the international design application in the United States is a date other  
15 than the effective registration date. The Director may establish procedures, including the  
16 payment of a surcharge, to review the filing date under this section. Such review may  
17 result in a determination that the application has a filing date in the United States other  
18 than the effective registration date.

19 **“§ 385. Effect Of International Design Application.**

20 “An international design application designating the United States shall have the  
21 effect, for all purposes, from its filing date determined in accordance with section 384 of  
22 this part, of an application for patent filed in the Patent and Trademark Office pursuant to  
23 chapter 16 of this title.

1    **“§ 386. Right of Priority.**

2           “(a) In accordance with the conditions and requirements of subsections (a)  
3 through (d) of section 119 of this title and section 172 of this title, a national application  
4 shall be entitled to the right of priority based on a prior international design application  
5 which designated at least one country other than the United States.

6           “(b) In accordance with the conditions and requirements of subsections (a)  
7 through (d) of section 119 of this title and section 172 of this title and the treaty and the  
8 Regulations, an international design application designating the United States shall be  
9 entitled to the right of priority based on a prior foreign application, a prior international  
10 application as defined in section 351(c) of this title designating at least one country other  
11 than the United States, or a prior international design application designating at least one  
12 country other than the United States.

13           “(c) In accordance with the conditions and requirements of section 120 of this  
14 title, an international design application designating the United States shall be entitled to  
15 the benefit of the filing date of a prior national application, a prior international  
16 application as defined in section 351(c) of this title designating the United States, or a  
17 prior international design application designating the United States, and a national  
18 application shall be entitled to the benefit of the filing date of a prior international design  
19 application designating the United States. If any claim for the benefit of an earlier filing  
20 date is based on a prior international application as defined in section 351(c) of this title  
21 which designated but did not originate in the United States or a prior international design  
22 application which designated but did not originate in the United States, the Director may  
23 require the filing in the Patent and Trademark Office of a certified copy of such

1 application together with a translation thereof into the English language, if it was filed in  
2 another language.

3 **“§ 387. Relief From Prescribed Time Limits.**

4 “An applicant’s failure to act within prescribed time limits in connection with  
5 requirements pertaining to a pending international design application may be excused as  
6 to the United States upon a showing satisfactory to the Director of unintentional delay.

7 **“§ 388. Withdrawn or Abandoned International Design Application.**

8 “Subject to sections 384 and 387 of this part, if an international design application  
9 designating the United States is withdrawn, renounced or canceled or considered  
10 withdrawn or abandoned, either generally or as to the United States, under the conditions  
11 of the treaty and the Regulations, the designation of the United States shall have no effect  
12 after the date of withdrawal, renunciation, cancellation, or abandonment and shall be  
13 considered as not having been made, unless a claim for benefit of a prior filing date under  
14 section 386(c) of this part was made in a national application, or an international design  
15 application designating the United States, filed before the date of such withdrawal,  
16 renunciation, cancellation, or abandonment. However, such withdrawn, renounced,  
17 canceled, or abandoned international design application may serve as the basis for a claim  
18 of priority under sections 386(a) and (b) of this part, if it designated a country other than  
19 the United States.

20 **“§ 389. Examination of International Design Application.**

21 “(a) The Director shall cause an examination pursuant to this title of an  
22 international design application designating the United States.

1           “(b) All questions of substance, and, unless otherwise required by the treaty and  
2 Regulations, procedures regarding an international design application designating the  
3 United States shall be determined as in the case of applications filed under chapter 16 of  
4 this title.

5           “(c) The Director may prescribe fees for filing international design applications,  
6 for designating the United States, and for any other processing, services, or materials  
7 relating to international design applications, and may provide for later payment of such  
8 fees, including surcharges for later submission of fees.

9           “(d) An international design application designating the United States shall not be  
10 accepted by the Patent and Trademark Office for examination if it was filed by anyone  
11 not qualified under chapter 16 of this title to be an applicant for the purpose of filing a  
12 design application under chapter 16 of this title in the United States. Such international  
13 design applications shall not serve as the basis for the benefit of an earlier filing date  
14 under section 120 of this title in a subsequently filed application, but may serve as the  
15 basis for a claim of the right of priority under subsections (a) through (d) of section 119  
16 of this title, if the United States was not the sole country designated in such international  
17 design application.

18           “(e) The Director may issue a patent based on an international design application  
19 designating the United States, in accordance with the provisions of this title. Such patent  
20 shall have the force and effect of a patent issued on an application filed under chapter 16  
21 of this title.

22       **“§ 390. Publication of International Design Application.**

1 “The publication under the treaty defined in section 381(a) of an international design  
2 application designating the United States shall be deemed a publication under section  
3 122(b).”.

4 **SEC. 202. CONFORMING AMENDMENTS.**

5 (a) Section 111(b)(7) is amended by striking “section 119 or 365(a)” and  
6 inserting “section 119, 365(a), or 386(a)”; and by striking “section 120, 121, or 365(c)”  
7 and inserting “section 120, 121, 365(c), or 386(c)”.

8 (b) Section 120 of title 35 is amended by striking “section 363” and inserting  
9 “section 363 or 385”.

10 (c) Section 154(a)(3) of title 35 is amended by striking “section 119, 365(a), or  
11 365(b)” and inserting “section 119, 365(a), 365(b), 386(a), or 386(b)”.

12 (d) Section 154(d)(1) of title 35 is amended by inserting “or an international  
13 design application filed under the treaty defined in section 381(a) designating the United  
14 States under Article 5 of such treaty” after “Article 21(2)(a) of such treaty”.

15 (e) Section 173 of title 35, United States Code, is amended by striking “fourteen”  
16 and inserting “fifteen”.

17 (f) Section 365(c) of title 35 is amended by replacing “or” with “,” after “of a  
18 prior national application” and inserting “, or a prior international design application as  
19 defined in section 381(f) of this title designating the United States” after “application, a  
20 prior international application designating the United States”.

21 (g) Section 365(c) of title 35 is further amended by inserting “or a prior  
22 international design application as defined in section 381(f) of this title which designated  
23 but did not originate in the United States” after “did not originate in the United States”.

1 (h) Section 368(b) is amended by inserting “at the International Bureau or” before  
2 “in a country other than the United States”.

3 **SEC. 203. EFFECTIVE DATE.**

4 This Act shall come into force on the same day as the entry into force of the treaty with  
5 respect to the United States. It shall apply to international design applications,  
6 international applications as defined in section 351(c) of title 35 and national applications  
7 filed on and after this effective date, even though entitled to the benefit of an earlier filing  
8 date.

9 Applications for patent on file in the Patent and Trademark Office prior to the  
10 effective date of this Act and patents issued on such applications shall be governed by the  
11 provisions of title 35, United States Code, in effect immediately prior to the effective date  
12 of this Act.

13  
14 **TITLE III — IMPLEMENTING THE PROVISIONS**  
15 **TO IMPLEMENT THE PATENT LAW TREATY.**

16 **SEC. 301. PROVISIONS TO IMPLEMENT THE PATENT LAW TREATY**

17 (a) APPLICATION FILING DATE. --

18 (1) Sections 111(a)(3) and (4) of title 35, United States Code, are amended to read as  
19 follows:

20 “(3) FEE, OATH, AND CLAIMS. - The application must be accompanied by the  
21 fee required by law. The fee, oath, and one or more claims may be submitted after the  
22 filing date of the application, within such period and under such conditions, including the

1 payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the  
2 fee, oath and one or more claims within such prescribed period, the application shall be  
3 regarded as abandoned.

4 “(4) FILING DATE. - The filing date of an application shall be the date on which  
5 a specification, with or without claims, is received in the United States Patent and  
6 Trademark Office.”

7 (2) Sections 111(b)(3) and (4) of title 35, United States Code, are amended to read as  
8 follows:

9 “(3) FEE. - The application must be accompanied by the fee required by law. The  
10 fee may be submitted after the filing date of the application, within such period and under  
11 such conditions, including the payment of a surcharge, as may be prescribed by the  
12 Director. Upon failure to submit the fee within such prescribed period, the application  
13 shall be regarded as abandoned.

14 “(4) FILING DATE. - The filing date of a provisional application shall be the date  
15 on which a specification, with or without claims, is received in the United States Patent  
16 and Trademark Office.”

17 (3) Section 111 of title 35, United States Code, is amended by adding at the end, the  
18 following new subsection (c):

19 “(c) The Director may prescribe the conditions, including the payment of a  
20 surcharge, under which a reference made upon the filing of an application under  
21 subsection (a) to a previously filed application, specifying the previously filed application  
22 by application number and the intellectual property authority or country in which the  
23 application was filed, shall constitute the specification and any drawings of the

1 subsequent application for purposes of a filing date. A copy of the specification and any  
2 drawings of the previously filed application must be submitted within such period and  
3 under such conditions as may be prescribed by the Director. A failure to submit the copy  
4 of the specification and any drawings of the previously filed application within the  
5 prescribed period shall result in application being regarded as abandoned.”

6

7 (b) RELIEF IN RESPECT OF TIME LIMITS AND REINSTATEMENT OF RIGHTS. --

8 (1) Section 21(b) of title 35, United States Code, is amended to read as follows:

9 “(b) If the day, or the last day, for taking any action or paying any fee in the  
10 United States Patent and Trademark Office, or of any of the periods fixed in sections 102,  
11 111, 119, 122, 135, 151, 156, 172, 251 and 304 of this title, falls on Saturday, Sunday, or  
12 a federal holiday within the District of Columbia, the action may be taken, or fee paid on,  
13 and the period shall be extended to, the next succeeding secular or business day.”

14 (2) Unintentional Standard. -- Chapter 2 of title 35, United States Code, is amended by  
15 adding at the end the following new section:

16 “Sec. 27. Revival of applications; reinstatement of reexamination proceedings.

17 “The Director may establish procedures, including the requirement for payment of  
18 the fee specified in section 41(a)(7) of this title, to revive an unintentionally abandoned  
19 application for patent, accept an unintentionally delayed payment of the fee for issuing  
20 each patent, or accept an unintentionally delayed response by the patent owner in a  
21 reexamination proceeding, upon petition by the applicant for patent or patent owner.”

22

1 (3) The Director may refund any part of the fee specified in section 41(a)(7) of title 35,  
2 United States Code, in exceptional circumstances as determined by the Director.

3 (c) RESTORATION OF PRIORITY RIGHT --

4 (1) Section 119(a) of title 35, United States Code, is amended to read as follows:

5 “(a) An application for patent for an invention filed in this country by any person  
6 who has, or whose legal representatives or assigns have, previously regularly filed an  
7 application for a patent for the same invention in a foreign country which affords similar  
8 privileges in the case of applications filed in the United States or to citizens of the United  
9 States, or in a World Trade Organization member country, shall have the same effect as  
10 the same application would have if filed in this country on the date on which the  
11 application for patent for the same invention was first filed in such foreign country, if the  
12 application in this country is filed within twelve months from the earliest date on which  
13 such foreign application was filed; but no patent shall be granted on any application for  
14 patent for an invention which had been patented or described in a printed publication in  
15 any country more than twelve months before the date of the application for patent in this  
16 country, or which had been in public use or on sale in this country more than twelve  
17 months prior to such filing. The Director may prescribe regulations, including the  
18 requirement for payment of the fee specified in section 41(a)(7) of this title, under which  
19 the twelve-month periods set forth in this subsection may be extended by an additional  
20 two months if the delay in filing the application in this country within the twelve-month  
21 periods was unintentional.”

22

1           (2) Section 119(e)(1) of title 35, United States Code, is amended to read as  
2 follows:

3           “(e)(1) An application for patent filed under section 111(a) or section 363 of this  
4 title for an invention disclosed in the manner provided by the first paragraph of  
5 section 112 of this title in a provisional application filed under section 111(b) of this title,  
6 by an inventor or inventors named in the provisional application, shall have the same  
7 effect, as to such invention, as though filed on the date of the provisional application filed  
8 under section 111(b) of this title, if the application for patent filed under section 111(a) or  
9 section 363 of this title is filed not later than 12 months after the date on which the  
10 provisional application was filed and if it contains or is amended to contain a specific  
11 reference to the provisional application. The Director may prescribe regulations,  
12 including the requirement for payment of the fee specified in section 41(a)(7) of this title,  
13 under which the twelve-month period set forth in this subsection may be extended by an  
14 additional two months if the delay in filing the application under section 111(a) within  
15 the twelve-month period was unintentional. No application shall be entitled to the benefit  
16 of an earlier filed provisional application under this subsection unless an amendment  
17 containing the specific reference to the earlier filed provisional application is submitted at  
18 such time during the pendency of the application as required by the Director. The  
19 Director may consider the failure to submit such an amendment within that time period as  
20 a waiver of any benefit under this subsection. The Director may establish procedures,  
21 including the payment of the fee specified in section 41(a)(7) of this title, to accept an  
22 unintentionally delayed submission of an amendment under this subsection.”

23

1 (3) Section 365(b) of title 35, United States Code, is amended to read as follows:

2 “(b) In accordance with the conditions and requirements of section 119(a) of this  
3 title and the treaty and the Regulations, an international application designating the  
4 United States shall be entitled to the right of priority based on a prior foreign application,  
5 or a prior international application designating at least one country other than the United  
6 States. The Director may establish procedures, including the requirement for payment of  
7 the fee specified in section 41(a)(7) of this title, to accept an unintentionally delayed  
8 claim for priority based on the treaty and the Regulations, and to accept a priority claim  
9 where such priority claim pertains to an application that was not filed within the priority  
10 period specified in the treaty and Regulations but was filed within the additional two-  
11 month period specified under section 119(a).”

12 (4) Section 102(b) of title 35, United States Code, is amended to read as follows:

13 “(b) the invention was patented or described in a printed publication in this or a  
14 foreign country or in public use or on sale in this country, before the earlier of (1) twelve  
15 months prior to the date of the application for patent in the United States, or (2) the filing  
16 date of the earliest priority application to which the application is entitled and claims  
17 priority under sections 119(a) - (d) or (f), 172, 365(a) or (b), or 386(a) or (b), or”.

18 (5) Section 102(d) of title 35, United States Code, is amended to read as follows:

19 “(d) the invention was first patented or caused to be patented, or was the subject  
20 of an inventor’s certificate, by the applicant or his legal representatives or assigns in a  
21 foreign country prior to the date of the application for patent in this country on an  
22 application for patent or inventor’s certificate filed before the earlier of (1) twelve months  
23 before the filing of the application in the United States, or (2) the filing date of the

1 earliest priority application to which the application is entitled and claims priority under  
2 sections 119(a) - (d) or (f), 172, 365(a) or (b), or 386(a) or (b)”.

3 **SEC. 302. CONFORMING AMENDMENTS.**

4 (a) FILING DATE FOR APPLICATIONS FOR DESIGN PATENTS. -- Section 171 of  
5 title 35, United States Code, is amended by adding the following sentence:

6 “The filing date of an application for design patent shall be the date on which the  
7 specification as prescribed by section 112 of this title and any required drawings are  
8 filed.”

9 (b) RELIEF IN RESPECT OF TIME LIMITS AND REINSTATEMENT OF RIGHTS. --

10 (1) Section 41(a)(7) of title 35, United States Code, is amended to read as follows:

11 “(7) On filing each petition for the revival of an abandoned application for a  
12 patent, for the delayed payment of the fee for issuing each patent, for the delayed  
13 response by the patent owner in any reexamination proceeding, for the delayed payment  
14 of the fee for maintaining a patent in force, for the delayed submission of a priority or  
15 benefit claim, or for the extension of the twelve-month period for filing a subsequent  
16 application, \$1,700.00.”

17 (2) Section 41(a)(7) of title 35, United States Code, as that section is to be administered  
18 pursuant to section 801(a) of Division B of Public Law 108-447, is amended to read as  
19 follows:

20 “(7) On filing each petition for the revival of an abandoned application for a  
21 patent, for the delayed payment of the fee for issuing each patent, for the delayed  
22 response by the patent owner in any reexamination proceeding, for the delayed payment  
23 of the fee for maintaining a patent in force, for the delayed submission of a priority or

1 benefit claim, or for the extension of the twelve-month period for filing a subsequent  
2 application, \$1,700.00.”

3 (3) Section 41(c)(1) of title 35, United States Code, is amended to read as follows:

4 “(c)(1) The Director may accept the payment of any maintenance fee required by  
5 subsection (b) after the six-month grace period if the delay is shown to the satisfaction of  
6 the Director to have been unintentional. The Director may require the payment of the fee  
7 specified in section 41(a)(7) of this title as a condition of accepting payment of any  
8 maintenance fee after the six-month grace period. If the Director accepts payment of a  
9 maintenance fee after the six-month grace period, the patent shall be considered as not  
10 having expired at the end of the grace period.”

11 (4) Section 119(b)(2) is amended by striking “including the payment of a surcharge” and  
12 inserting “including the requirement for payment of the fee specified in section 41(a)(7)  
13 of this title”.

14 (5) Section 120 of title 35 is amended by striking “including the payment of a surcharge”  
15 and inserting “including the requirement for payment of the fee specified in section  
16 41(a)(7) of this title”.

17 (6) Section 122(b)(2)(B)(iii) of title 35, United States Code, is amended by deleting at the  
18 end thereof the following: “, unless it is shown to the satisfaction of the Director that the  
19 delay in submitting the notice was unintentional”.

20 (7) Section 133 of title 35, United States Code, is amended to read as follows:

21 “Upon failure of the applicant to prosecute the application within six months after  
22 any action therein, of which notice has been given or mailed to the applicant, or within

1 such shorter time, not less than one month, as fixed by the Director in such action, the  
2 application shall be regarded as abandoned by the parties thereto.”

3 (8) Section 151 of title 35, United States Code, is amended to read as follows:

4 “If it appears that applicant is entitled to a patent under the law, a written notice of  
5 allowance of the application shall be given or mailed to the applicant. The notice shall  
6 specify a sum, constituting the issue fee and any required publication fee, which shall be  
7 paid within three months thereafter.”

8 “Upon payment of this sum the patent may issue, but if payment is not timely  
9 made, the application shall be regarded as abandoned.”

10 (9) Section 361(c) of title 35, United States Code, is amended to read as follows:

11 “(c) International applications filed in the Patent and Trademark Office shall be  
12 filed in the English language, or an English translation shall be filed within such later  
13 time as may be fixed by the Director.”

14 (10) Section 364(b) of title 35, United States Code, is amended to read as follows:

15 “(b) An applicant's failure to act within prescribed time limits in connection with  
16 requirements pertaining to an international application may be excused as provided in the  
17 treaty and the Regulations.”

18 (11) Section 371(d) of title 35, United States Code, is amended, in the third sentence, by  
19 deleting the phrase “, unless it be shown to the satisfaction of the Director that such  
20 failure to comply was unavoidable”.

## 21 **SECTION 303. EFFECTIVE DATE**

22 The amendments made by this Act shall be effective on the date that is one year after the  
23 date of enactment of this Act, and shall apply to all patents, whenever granted, and to all

1 applications for patent pending on or filed after the date that is one year after the date of  
2 enactment of this Act. The amendments made by this Act, however, shall have no effect  
3 with respect to any patent that is the subject of litigation in an action commenced before  
4 the date that is one year after the date of enactment of this Act.

5  
6 **TITLE IV — AUTHORIZING EXPENDITURE OF**  
7 **FUNDS FOR TRAVEL-RELATED EXPENSES OF**  
8 **NON-FEDERAL EMPLOYEES ATTENDING**  
9 **PROGRAMS REGARDING INTELLECTUAL**  
10 **PROPERTY LAW.**

11 **SECTION 401. AUTHORIZATION FOR EXPENDITURE OF FUNDS.**

12 Section 2(b)(11) of title 35, United States Code, is amended by inserting “and  
13 funds are authorized to be expended to cover the subsistence expenses and travel-related  
14 expenses, including per diem, lodging costs and transportation costs, of non-federal  
15 employees attending such programs” after “world”.

16  
17 **TITLE V — PROVIDING FOR THE EQUITABLE**  
18 **ADJUSTMENT OF PAY FOR ADMINISTRATIVE**

1                   **PATENT JUDGES AND ADMINISTRATIVE**

2                                   **TRADEMARK JUDGES.**

3   **SECTION 501. EQUITABLE PAY FOR ADMINISTRATIVE PATENT JUDGES**  
4   **AND ADMINISTRATIVE TRADEMARK JUDGES.**

5   ADMINISTRATIVE PATENT JUDGES - Section 3 of title 35, United States Code, is  
6   amended by adding at the end of subsection (b) the following:

7           “(6) ADMINISTRATIVE PATENT JUDGES AND ADMINISTRATIVE  
8           TRADEMARK JUDGES. – The Director has the authority to fix the rate of basic  
9           pay for the administrative patent judges appointed pursuant to Section 6 of this title  
10          and administrative trademark judges appointed pursuant to Section 1067 of title 15  
11          at not greater than the rate of basic pay payable for Level III of the Executive  
12          Schedule. The payment of a rate of basic pay under this section shall not be subject  
13          to the pay limitation of section 5306(e) or 5373 of title 5.”.