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2D SESSION

S. 3486

To implement the provisions of the Hague Agreement and the Patent Law Treaty.

IN THE SENATE OF THE UNITED STATES

AUGUST 2, 2012

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

SEPTEMBER 20, 2012

Reported by Mr. LEAHY, with an amendment

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

A BILL

To implement the provisions of the Hague Agreement and the Patent Law Treaty.

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

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

~~This Act may be cited as the "Patent Law Treaties Implementation Act of 2012".~~

TITLE I—HAGUE AGREEMENT CONCERNING INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS

SEC. 101. THE HAGUE AGREEMENT CONCERNING INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS.

(a) IN GENERAL.—Title 35, United States Code, is amended by adding at the end the following:

"PART V—THE HAGUE AGREEMENT CONCERNING INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS

"CHAPTER Sec.
"38. International design applications ..... 381.

"CHAPTER 38—INTERNATIONAL DESIGN APPLICATIONS

"Sec.
"381. Definitions.
"382. Filing international design applications.
"383. International design application.
"384. Filing date.
"385. Effect of international design application.
"386. Right of priority.
"387. Relief from prescribed time limits.
"388. Withdrawn or abandoned international design application.
"389. Examination of international design application.
"390. Publication of international design application.

"§ 381. Definitions

"(a) IN GENERAL.—When used in this part, unless the context otherwise indicates—

~~"(1) the term 'treaty' means the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs adopted at Geneva on July 2, 1999;~~

~~"(2) the term 'regulations'—~~

~~"(A) when capitalized, means the Common Regulations under the treaty; and~~

~~"(B) when not capitalized, means the regulations established by the Director under this title;~~

~~"(3) the term 'designation' means a request that an international registration have effect in a Contracting Party to the treaty;~~

~~"(4) the term 'International Bureau' means the international intergovernmental organization that is recognized as the coordinating body under the treaty and the Regulations;~~

~~"(5) the term 'effective registration date' means the date of international registration indicated by the International Bureau under the treaty;~~

~~"(6) the term 'international design application' means an application for international registration; and~~

~~"(7) the term 'international registration' means the international registration of an industrial design filed under the treaty.~~

~~"(b) RULE OF CONSTRUCTION.—Terms and expressions not defined in this part are to be taken in the sense indicated by the treaty and the Regulations.~~

~~"§ 382. Filing international design applications~~

~~"(a) IN GENERAL.—Any person who is a national of the United States, or has a domicile, a habitual residence, or a real and effective industrial or commercial establishment in the United States, may file an international design application by submitting to the Patent and Trademark Office an application in such form, together with such fees, as may be prescribed by the Director.~~

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

~~"(c) APPLICABILITY OF CHAPTER 16.—Except as otherwise provided in this chapter, the provisions of chapter 16 of this title shall apply.~~

~~"(d) APPLICATION FILED IN ANOTHER COUNTRY.—An international design application on an industrial design made in this country shall be considered to constitute the filing of an application in a foreign country within the meaning of chapter 17 of this title if the international design application is filed—~~

~~"(1) in a country other than the United States;~~

~~"(2) at the International Bureau; or~~

~~"(3) with an intergovernmental organization.~~

~~"§ 383. International design application~~

~~"In addition to any requirements pursuant to chapter 16 of this title, the international design application shall contain—~~

~~"(1) a request for international registration under the treaty;~~

~~"(2) an indication of the designated Contracting Parties;~~

~~"(3) data concerning the applicant as prescribed in the treaty and the Regulations;~~

~~"(4) copies of a reproduction or, at the choice of the applicant, of several different reproductions of the industrial design that is the subject of the international application, presented in the number and manner prescribed in the treaty and the Regulations;~~

~~"(5) an indication of the product or products which constitute the industrial design or in relation to which the industrial design is to be used, as prescribed in the treaty and the Regulations;~~

~~"(6) the fees prescribed in the treaty and the Regulations; and~~

~~"(7) any other particulars prescribed in the Regulations.~~

~~"§ 384. Filing date~~

~~"(a) IN GENERAL.—Subject to subsection (b), the filing date of an international design application in the United States shall be the effective registration date. Notwithstanding the provisions of this part, any international design application designating the United States that otherwise meets the requirements of chapter 16 of this title may be treated as a design application under chapter 16 of this title.~~

~~"(b) REVIEW.—An applicant may request review by the Director of the filing date of the international design application in the United States. The Director may determine that the filing date of the international design application in the United States is a date other than the effective registration date. The Director may establish procedures, including the payment of a surcharge, to review the filing date under this section. Such review may result in~~

a determination that the application has a filing date in the United States other than the effective registration date.

"§ 385. Effect of international design application

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

"§ 386. Right of priority

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

"(b) PRIOR FOREIGN APPLICATION.—In accordance with the conditions and requirements of subsections (a) through (d) of section 119 of this title and section 172 of this title and the treaty and the Regulations, an international design application designating the United States shall be entitled to the right of priority based on a prior foreign application, a prior international application as defined in section 351(c) of this title designating at least

~~one country other than the United States, or a prior international design application designating at least one country other than the United States.~~

~~"(c) PRIOR NATIONAL APPLICATION.—In accordance with the conditions and requirements of section 120 of this title, an international design application designating the United States shall be entitled to the benefit of the filing date of a prior national application, a prior international application as defined in section 351(c) of this title designating the United States, or a prior international design application designating the United States, and a national application shall be entitled to the benefit of the filing date of a prior international design application designating the United States. If any claim for the benefit of an earlier filing date is based on a prior international application as defined in section 351(c) of this title which designated but did not originate in the United States or a prior international design application which designated but did not originate in the United States, the Director may require the filing in the Patent and Trademark Office of a certified copy of such application together with a translation thereof into the English language, if it was filed in another language.~~

“§ 387. Relief from prescribed time limits

“An applicant’s failure to act within prescribed time limits in connection with requirements pertaining to an international design application may be excused as to the United States upon a showing satisfactory to the Director of unintentional delay and under such conditions, including a requirement for payment of the fee specified in section 41(a)(7) of this title, as may be prescribed by the Director.

“§ 388. Withdrawn or abandoned international design application

“Subject to sections 384 and 387 of this part, if an international design application designating the United States is withdrawn, renounced or canceled or considered withdrawn or abandoned, either generally or as to the United States, under the conditions of the treaty and the Regulations, the designation of the United States shall have no effect after the date of withdrawal, renunciation, cancellation, or abandonment and shall be considered as not having been made, unless a claim for benefit of a prior filing date under section 386(c) of this part was made in a national application, or an international design application designating the United States, or a claim for benefit under section 365(c) was made in an international application designating the United States, filed before the date of such withdrawal, renunciation, cancellation, or aban-

~~donment. However, such withdrawn, renounced, canceled, or abandoned international design application may serve as the basis for a claim of priority under subsections (a) and (b) of section 386, or under subsection (a) or (b) of section 365, if it designated a country other than the United States.~~

~~"§ 389. Examination of international design application~~

~~"(a) IN GENERAL.—The Director shall cause an examination pursuant to this title of an international design application designating the United States.~~

~~"(b) APPLICABILITY OF CHAPTER 16.—All questions of substance, and, unless otherwise required by the treaty and Regulations, procedures regarding an international design application designating the United States shall be determined as in the case of applications filed under chapter 16 of this title.~~

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

~~"(d) ISSUANCE OF PATENT.—The Director may issue a patent based on an international design application des-~~

~~ignating the United States, in accordance with the provisions of this title. Such patent shall have the force and effect of a patent issued on an application filed under chapter 16 of this title.~~

~~"§ 390. Publication of international design application~~

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

~~(b) CONFORMING AMENDMENT.—The table of parts at the beginning of title 35, United States Code, is amended by adding at the end the following:~~

~~"V. The Hague Agreement concerning international registration of industrial designs ..... 401".~~

~~SEC. 102. CONFORMING AMENDMENTS.~~

~~Title 35, United States Code, is amended—~~

~~(1) in section 100(i)(1)(B), by striking "right of priority under section 119, 365(a), or 365(b) or to the benefit of an earlier filing date under section 120, 121, or 365(c)" and inserting "right of priority under section 119, 365(a), 365(b), 386(a), or 386(b) or to the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c)";~~

~~(2) in section 102(d)(2), by striking "to claim a right of priority under section 119, 365(a), or~~

~~365(b), or to claim the benefit of an earlier filing date under section 120, 121, or 365(c)'' and inserting ''to claim a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b), or to claim the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c)'';~~

~~(3) in section 111(b)(7)—~~

~~(A) by striking ''section 119 or 365(a)'' and inserting ''section 119, 365(a), or 386(a)''; and~~

~~(B) by striking ''section 120, 121, or 365(c)'' and inserting ''section 120, 121, 365(c), or 386(c)'';~~

~~(4) in section 115(g)(1), by striking ''section 120, 121, or 365(c)'' and inserting ''section 120, 121, 365(c), or 386(c)'';~~

~~(5) in section 120, in the first sentence, by striking ''section 363'' and inserting ''section 363 or 385'';~~

~~(6) in section 154—~~

~~(A) in subsection (a)—~~

~~(i) in paragraph (2), by striking ''section 120, 121, or 365(c)'' and inserting ''section 120, 121, 365(c), or 386(c)''; and~~

~~(ii) in paragraph (3), by striking "section 119, 365(a), or 365(b)" and inserting "section 119, 365(a), 365(b), 386(a), or 386(b)"; and~~

~~(B) in subsection (d)(1), by inserting "or an international design application filed under the treaty defined in section 381(a)(1) designating the United States under Article 5 of such treaty" after "Article 21(2)(a) of such treaty";~~

~~(7) in section 173, by striking "fourteen years" and inserting "15 years";~~

~~(8) in section 365(c)—~~

~~(A) in the first sentence, by striking "or a prior international application designating the United States" and inserting ", a prior international application designating the United States, or a prior international design application as defined in section 381(a)(6) of this title designating the United States"; and~~

~~(B) in the second sentence, by inserting "or a prior international design application as defined in section 381(a)(6) of this title which designated but did not originate in the United~~

~~States'' after ''did not originate in the United States''; and~~

~~(9) in section 366—~~

~~(A) in the first sentence, by striking ''unless a claim'' and all that follows through ''withdrawl.'' and inserting ''unless a claim for benefit of a prior filing date under section 365(c) of this section was made in a national application, or an international application designating the United States, or a claim for benefit under section 386(c) was made in an international design application designating the United States, filed before the date of such withdrawal.''; and~~

~~(B) by striking the second sentence and inserting the following: ''However, such withdrawn international application may serve as the basis for a claim of priority under section 365 (a) and (b) of this part, or under section 386 (a) or (b), if it designated a country other than the United States.''.~~

~~SEC. 103. EFFECTIVE DATE.~~

~~(a) IN GENERAL.—The amendments made by this title shall be effective on the later of—~~

~~(1) the date that is 1 year after the date of enactment of this Act, or~~

~~(2) the date of entry into force of the treaty, as defined in section 381 of title 35, as amended by this Act, with respect to the United States.~~

~~(b) APPLICABILITY OF AMENDMENTS.—~~

~~(1) IN GENERAL.—Subject to paragraph (2), the amendments made by this title shall apply only to international design applications, international applications as defined in section 351(c) of title 35, United States Code, and national applications filed on and after the effective date set forth in subsection (a), and patents issuing thereon.~~

~~(2) EXCEPTION.—Sections 100(i) and 102(d) of title 35, United States Code, as amended by this title, shall not apply to an application, or any patent issuing thereon, unless it is described in section 3(n)(1) of the Leahy-Smith America Invents Act (35 U.S.C. 100 note).~~

~~TITLE II—PATENT LAW TREATY IMPLEMENTATION~~

~~SEC. 201. PROVISIONS TO IMPLEMENT THE PATENT LAW TREATY.~~

~~(a) APPLICATION FILING DATE.—Section 111 of title 35, United States Code, is amended—~~

~~(1) in subsection (a), by striking paragraphs (3) and (4) and inserting the following:~~

~~"(3) FEE, OATH OR DECLARATION, AND CLAIMS.—The application shall be accompanied by the fee required by law. The fee, oath or declaration, and 1 or more claims may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the fee, oath or declaration, and 1 or more claims within such prescribed period, the application shall be regarded as abandoned.~~

~~"(4) FILING DATE.—The filing date of an application shall be the date on which a specification, with or without claims, is received in the United States Patent and Trademark Office.";~~

~~(2) in subsection (b), by striking paragraphs (3) and (4) and inserting the following:~~

~~"(3) FEE.—The application shall be accompanied by the fee required by law. The fee may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the~~

fee within such prescribed period, the application shall be regarded as abandoned.

"(4) FILING DATE.—The filing date of a provisional application shall be the date on which a specification, with or without claims, is received in the United States Patent and Trademark Office."; and

(3) by adding at the end the following:

"(e) PRIOR FILED APPLICATION.—The Director may prescribe the conditions, including the payment of a surcharge, under which a reference made upon the filing of an application under subsection (a) to a previously filed application, specifying the previously filed application by application number and the intellectual property authority or country in which the application was filed, shall constitute the specification and any drawings of the subsequent application for purposes of a filing date. A copy of the specification and any drawings of the previously filed application shall be submitted within such period and under such conditions as may be prescribed by the Director. A failure to submit the copy of the specification and any drawings of the previously filed application within the prescribed period shall result in application being regarded as abandoned and treated as having never been filed.".

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

(1) IN GENERAL.—Chapter 2 of title 35, United States Code, is amended by adding at the end the following:

"§ 27. Revival of applications; reinstatement of reexamination proceedings

"(a) IN GENERAL.—The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to revive an unintentionally abandoned application for patent, accept an unintentionally delayed payment of the fee for issuing each patent, or accept an unintentionally delayed response by the patent owner in a reexamination proceeding, upon petition by the applicant for patent or patent owner.".

(2) TECHNICAL AND CONFORMING AMENDMENT.—The table of sections for chapter 2 of title 35, United States Code, is amended by adding at the end the following:

"27. Revival of applications; reinstatement of reexamination proceedings.".

(c) RESTORATION OF PRIORITY RIGHT.—Title 35, United States Code, is amended—

(1) in section 119—

(A) in subsection (a), by adding at the end the following: "The Director may prescribe regulations, including the requirement for payment of the fee specified in section 41(a)(7), pursuant to which the 12-month period set forth in

~~this subsection may be extended by an additional 2 months if the delay in filing the application in this country within the 12-month period was unintentional.''; and~~

~~(B) in subsection (c)—~~

~~(i) in paragraph (1)—~~

~~(I) by inserting after the first sentence the following: ''The Director may prescribe regulations, including the requirement for payment of the fee specified in section 41(a)(7), pursuant to which the 12-month period set forth in this subsection may be extended by an additional 2 months if the delay in filing the application under section 111(a) or section 363 within the 12-month period was unintentional.''; and~~

~~(II) in the last sentence—~~

~~(aa) by striking ''including the payment of a surcharge'' and inserting ''including the payment of the fee specified in section 41(a)(7)''; and~~

~~(bb) by striking "during the pendency of the application"; and~~

~~(ii) in paragraph (3), by adding at the end the following: "For an application for patent filed under section 363 in a foreign Receiving Office, the 12-month and additional 2 month period set forth in this subsection shall be extended as provided under the treaty and Regulations as defined in section 351."; and~~

~~(2) in section 365(b), by adding at the end the following: "The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed claim for priority under the treaty and the Regulations, and to accept a priority claim where such priority claim pertains to an application that was not filed within the priority period specified in the treaty and Regulations, but was filed within the additional 2-month period specified under section 119(a) or the treaty and Regulations.".~~

~~(d) RECORDATION OF OWNERSHIP INTERESTS.—Section 261 of title 35, United States Code, is amended—~~

~~(1) in the first undesignated paragraph by adding at the end the following: "The Patent and~~

~~Trademark Office shall maintain a register of interests in applications for patents and patents and shall record any document related thereto upon request, and may require a fee therefor.''; and~~

~~(2) in the fourth undesignated paragraph by striking ''An assignment'' and inserting ''An interest that constitutes an assignment''.~~

~~SEC. 202. CONFORMING AMENDMENTS.~~

~~(a) IN GENERAL.—Section 171 of title 35, United States Code, is amended by adding at the end the following:~~

~~''The filing date of an application for patent for design shall be the date on which the specification as prescribed by section 112 and any required drawings are filed.''.~~

~~(b) RELIEF IN RESPECT OF TIME LIMITS AND REINSTATEMENT OF RIGHT.—Title 35, United States Code, is amended—~~

~~(1) in section 41—~~

~~(A) in subsection (a), by striking subsection (7) and inserting the following:~~

~~''(7) REVIVAL FEES.—On filing each petition for the revival of an abandoned application for a patent, for the delayed payment of the fee for issuing each patent, for the delayed response by the~~

~~patent owner in any reexamination proceeding, for the delayed payment of the fee for maintaining a patent in force, for the delayed submission of a priority or benefit claim, or for the extension of the 12-month period for filing a subsequent application, $1,700.00. The Director may refund any part of the fee specified in this paragraph, in exceptional circumstances as determined by the Director'';~~ ~~and~~

~~(B) in subsection (c), by striking paragraph (1) and inserting the following:~~

~~''(1) ACCEPTANCE.—The Director may accept the payment of any maintenance fee required by subsection (b) after the 6-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional. The Director may require the payment of the fee specified in paragraph (a)(7) as a condition of accepting payment of any maintenance fee after the 6-month grace period. If the Director accepts payment of a maintenance fee after the 6-month grace period, the patent shall be considered as not having expired at the end of the grace period.'';~~

~~(2) in section 119(b)(2), in the second sentence, by striking ''including the payment of a surcharge''~~

~~and inserting "including the requirement for payment of the fee specified in section 41(a)(7)";~~

~~(3) in section 120, in the fourth sentence, by striking "including the payment of a surcharge" and inserting "including the requirement for payment of the fee specified in section 41(a)(7)";~~

~~(4) in section 122(b)(2)(B)(iii), in the second sentence, by striking ", unless it is shown" and all that follows through "unintentional";~~

~~(5) in section 133, by striking ", unless it be shown" and all that follows through "unavoidable";~~

~~(6) by striking section 151 and inserting the following:~~

~~"§ 151. Issue of patent~~

~~"If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee and any required publication fee, which shall be paid within 3 months thereafter.~~

~~"Upon payment of this sum the patent may issue, but if payment is not timely made, the application shall be regarded as abandoned.";~~

~~(7) in section 361, by striking subsection (c) and inserting the following:~~

1 ~~"(c) International applications filed in the Patent and~~
2 ~~Trademark Office shall be filed in the English language,~~
3 ~~or an English translation shall be filed within such later~~
4 ~~time as may be fixed by the Director.";~~
5 ~~(8) in section 364, by striking subsection (b)~~
6 ~~and inserting the following:~~
7 ~~"(b) An applicant's failure to act within prescribed~~
8 ~~time limits in connection with requirements pertaining to~~
9 ~~an international application may be excused as provided~~
10 ~~in the treaty and the Regulations."; and~~
11 ~~(9) in section 371(d), in the third sentence, by~~
12 ~~striking ", unless it be shown to the satisfaction of~~
13 ~~the Director that such failure to comply was un-~~
14 ~~avoidable".~~
15 **~~SEC. 203. EFFECTIVE DATE.~~**
16 ~~(a) IN GENERAL.—Except as provided in subsection~~
17 ~~(b), the amendments made by this title shall be effective~~
18 ~~on the date that is 1 year after the date of enactment~~
19 ~~of this Act and shall apply to all patents and to all applica-~~
20 ~~tions for patent pending on or filed after the date that~~
21 ~~is 1 year after the date of enactment of this Act.~~
22 ~~(b) EXCEPTIONS.—~~
23 ~~(1) SECTION 201(a).—The amendments made~~
24 ~~by section 201(a) shall apply only to applications~~

~~filed on or after the date that is 1 year after the date of enactment of this Act.~~

~~(2) PATENT THAT IS SUBJECT OF LITIGATION.—The amendments made by this title shall have no effect with respect to any patent that is the subject of litigation in an action commenced before the date that is 1 year after the date of enactment of this Act.~~

SECTION 1. SHORT TITLE.

This Act may be cited as the "Patent Law Treaties Implementation Act of 2012".

TITLE I—HAGUE AGREEMENT CONCERNING INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS

SEC. 101. THE HAGUE AGREEMENT CONCERNING INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS.

(a) IN GENERAL.—Title 35, United States Code, is amended by adding at the end the following:

"PART V—THE HAGUE AGREEMENT CONCERNING INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS

"CHAPTER *Sec.*
"38. International design applications ..... *381.*

"CHAPTER 38—INTERNATIONAL DESIGN APPLICATIONS

"Sec.
"381. Definitions.
"382. Filing international design applications.
"383. International design application.
"384. Filing date.
"385. Effect of international design application.
"386. Right of priority.
"387. Relief from prescribed time limits.
"388. Withdrawn or abandoned international design application.
"389. Examination of international design application.
"390. Publication of international design application.

"§ 381. Definitions

"(a) IN GENERAL.—When used in this part, unless the context otherwise indicates—

"(1) the term 'treaty' means the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs adopted at Geneva on July 2, 1999;

"(2) the term 'regulations'—

"(A) when capitalized, means the Common Regulations under the treaty; and

"(B) when not capitalized, means the regulations established by the Director under this title;

"(3) the terms 'designation', 'designating', and 'designate' refer to a request that an international registration have effect in a Contracting Party to the treaty;

"(4) the term 'International Bureau' means the international intergovernmental organization that is recognized as the coordinating body under the treaty and the Regulations;

"(5) the term 'effective registration date' means the date of international registration determined by the International Bureau under the treaty;

"(6) the term 'international design application' means an application for international registration; and

"(7) the term 'international registration' means the international registration of an industrial design filed under the treaty.

"(b) RULE OF CONSTRUCTION.—Terms and expressions not defined in this part are to be taken in the sense indicated by the treaty and the Regulations.

"§ 382. Filing international design applications

"(a) IN GENERAL.—Any person who is a national of the United States, or has a domicile, a habitual residence, or a real and effective industrial or commercial establishment in the United States, may file an international design application by submitting to the Patent and Trademark Office an application in such form, together with such fees, as may be prescribed by the Director.

"(b) REQUIRED ACTION.—The Patent and Trademark Office shall perform all acts connected with the discharge of its duties under the treaty, including the collection of international fees and transmittal thereof to the International Bureau. Subject to chapter 17, international design applications shall be forwarded by the Patent and Trademark Office to the International Bureau, upon payment of a transmittal fee.

"(c) APPLICABILITY OF CHAPTER 16.—Except as otherwise provided in this chapter, the provisions of chapter 16 shall apply.

"(d) APPLICATION FILED IN ANOTHER COUNTRY.—An international design application on an industrial design made in this country shall be considered to constitute the filing of an application in a foreign country within the meaning of chapter 17 if the international design application is filed—

"(1) in a country other than the United States;

"(2) at the International Bureau; or

"(3) with an intergovernmental organization.

"§ 383. International design application

"In addition to any requirements pursuant to chapter 16, the international design application shall contain—

"(1) a request for international registration under the treaty;

"(2) an indication of the designated Contracting Parties;

"(3) data concerning the applicant as prescribed in the treaty and the Regulations;

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

"(5) an indication of the product or products that constitute the industrial design or in relation to which the industrial design is to be used, as prescribed in the treaty and the Regulations;

"(6) the fees prescribed in the treaty and the Regulations; and

"(7) any other particulars prescribed in the Regulations.

"§ 384. Filing date

"(a) IN GENERAL.—Subject to subsection (b), the filing date of an international design application in the United States shall be the effective registration date. Notwithstanding the provisions of this part, any international design application designating the United States that other-

wise meets the requirements of chapter 16 may be treated as a design application under chapter 16.

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

"§ 385. Effect of international design application

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

"§ 386. Right of priority

"(a) NATIONAL APPLICATION.—In accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172, a national application shall be entitled to the right of priority based on a prior international design application that designated at least 1 country other than the United States.

"(b) PRIOR FOREIGN APPLICATION.—In accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172 and the treaty and the Regulations, an international design application designating the United States shall be entitled to the right of priority based on a prior foreign application, a prior international application as defined in section 351(c) designating at least 1 country other than the United States, or a prior international design application designating at least 1 country other than the United States.

"(c) PRIOR NATIONAL APPLICATION.—In accordance with the conditions and requirements of section 120, an international design application designating the United States shall be entitled to the benefit of the filing date of a prior national application, a prior international application as defined in section 351(c) designating the United States, or a prior international design application designating the United States, and a national application shall be entitled to the benefit of the filing date of a prior international design application designating the United States. If any claim for the benefit of an earlier filing date is based on a prior international application as defined in section 351(c) which designated but did not originate in the United States or a prior international design application which designated but did not originate in the United States, the

Director may require the filing in the Patent and Trademark Office of a certified copy of such application together with a translation thereof into the English language, if it was filed in another language.

"§ 387. Relief from prescribed time limits

"An applicant's failure to act within prescribed time limits in connection with requirements pertaining to an international design application may be excused as to the United States upon a showing satisfactory to the Director of unintentional delay and under such conditions, including a requirement for payment of the fee specified in section 41(a)(7), as may be prescribed by the Director.

"§ 388. Withdrawn or abandoned international design application

"Subject to sections 384 and 387, if an international design application designating the United States is withdrawn, renounced or canceled or considered withdrawn or abandoned, either generally or as to the United States, under the conditions of the treaty and the Regulations, the designation of the United States shall have no effect after the date of withdrawal, renunciation, cancellation, or abandonment and shall be considered as not having been made, unless a claim for benefit of a prior filing date under section 386(c) was made in a national application, or an international design application designating the United

States, or a claim for benefit under section 365(c) was made in an international application designating the United States, filed before the date of such withdrawal, renunciation, cancellation, or abandonment. However, such withdrawn, renounced, canceled, or abandoned international design application may serve as the basis for a claim of priority under subsections (a) and (b) of section 386, or under subsection (a) or (b) of section 365, if it designated a country other than the United States.

"§ 389. Examination of international design application

"(a) IN GENERAL.—The Director shall cause an examination to be made pursuant to this title of an international design application designating the United States.

"(b) APPLICABILITY OF CHAPTER 16.—All questions of substance and, unless otherwise required by the treaty and Regulations, procedures regarding an international design application designating the United States shall be determined as in the case of applications filed under chapter 16.

"(c) FEES.—The Director may prescribe fees for filing international design applications, for designating the United States, and for any other processing, services, or materials relating to international design applications, and

may provide for later payment of such fees, including surcharges for later submission of fees.

"(d) ISSUANCE OF PATENT.—The Director may issue a patent based on an international design application designating the United States, in accordance with the provisions of this title. Such patent shall have the force and effect of a patent issued on an application filed under chapter 16.

"§ 390. Publication of international design application

"The publication under the treaty of an international design application designating the United States shall be deemed a publication under section 122(b).".

(b) CONFORMING AMENDMENT.—The table of parts at the beginning of title 35, United States Code, is amended by adding at the end the following:

"V. The Hague Agreement concerning international registration of industrial designs ..... 401".

SEC. 102. CONFORMING AMENDMENTS.

Title 35, United States Code, is amended—

(1) in section 100(i)(1)(B) (as amended by the Leahy-Smith America Invents Act (Public Law 112–29; 125 Stat. 284)), by striking "right of priority under section 119, 365(a), or 365(b) or to the benefit of an earlier filing date under section 120, 121, or 365(c)" and inserting "right of priority under section

119, 365(a), 365(b), 386(a), or 386(b) or to the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c)";

(2) in section 102(d)(2) (as amended by the Leahy-Smith America Invents Act (Public Law 112–29; 125 Stat. 284)), by striking "to claim a right of priority under section 119, 365(a), or 365(b), or to claim the benefit of an earlier filing date under section 120, 121, or 365(c)" and inserting "to claim a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b), or to claim the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c)";

(3) in section 111(b)(7)—

(A) by striking "section 119 or 365(a)" and inserting "section 119, 365(a), or 386(a)"; and

(B) by striking "section 120, 121, or 365(c)" and inserting "section 120, 121, 365(c), or 386(c)";

(4) in section 115(g)(1) (as amended by the Leahy-Smith America Invents Act (Public Law 112–29; 125 Stat. 284)), by striking "section 120, 121, or 365(c)" and inserting "section 120, 121, 365(c), or 386(c)";

(5) in section 120, in the first sentence, by striking "section 363" and inserting "section 363 or 385";

(6) in section 154—

(A) in subsection (a)—

(i) in paragraph (2), by striking "section 120, 121, or 365(c)" and inserting "section 120, 121, 365(c), or 386(c)"; and

(ii) in paragraph (3), by striking "section 119, 365(a), or 365(b)" and inserting "section 119, 365(a), 365(b), 386(a), or 386(b)"; and

(B) in subsection (d)(1), by inserting "or an international design application filed under the treaty defined in section 381(a)(1) designating the United States under Article 5 of such treaty" after "Article 21(2)(a) of such treaty";

(7) in section 173, by striking "fourteen years" and inserting "15 years";

(8) in section 365(c)—

(A) in the first sentence, by striking "or a prior international application designating the United States" and inserting ", a prior international application designating the United States, or a prior international design application as defined in section 381(a)(6) designating the United States"; and

(B) in the second sentence, by inserting "or a prior international design application as defined in section 381(a)(6) which designated but did not originate in the United States" after "did not originate in the United States"; and

(9) in section 366—

(A) in the first sentence, by striking "unless a claim" and all that follows through "withdrawal." and inserting "unless a claim for benefit of a prior filing date under section 365(c) of this section was made in a national application, or an international application designating the United States, or a claim for benefit under section 386(c) was made in an international design application designating the United States, filed before the date of such withdrawal."; and

(B) by striking the second sentence and inserting the following: "However, such withdrawn international application may serve as the basis for a claim of priority under section 365 (a) and (b), or under section 386 (a) or (b), if it designated a country other than the United States.".

SEC. 103. EFFECTIVE DATE.

(a) IN GENERAL.—The amendments made by this title shall take effect on the later of—

(1) the date that is 1 year after the date of the enactment of this Act; or

(2) the date of entry into force of the treaty with respect to the United States.

(b) APPLICABILITY OF AMENDMENTS.—

(1) IN GENERAL.—Subject to paragraph (2), the amendments made by this title shall apply only to international design applications, international applications, and national applications filed on and after the effective date set forth in subsection (a), and patents issuing thereon.

(2) EXCEPTION.—Sections 100(i) and 102(d) of title 35, United States Code, as amended by this title, shall not apply to an application, or any patent issuing thereon, unless it is described in section 3(n)(1) of the Leahy-Smith America Invents Act (35 U.S.C. 100 note).

(c) DEFINITIONS.—For purposes of this section—

(1) the terms "treaty" and "international design application" have the meanings given those terms in section 381 of title 35, United States Code, as added by this title;

(2) the term "international application" has the meaning given that term in section 351(c) of title 35, United States Code; and

(3) the term "national application" means "national application" within the meaning of chapter 38 of title 35, United States Code, as added by this title.

TITLE II—PATENT LAW TREATY IMPLEMENTATION

SEC. 201. PROVISIONS TO IMPLEMENT THE PATENT LAW TREATY.

(a) APPLICATION FILING DATE.—Section 111 of title 35, United States Code, is amended—

(1) in subsection (a), by striking paragraphs (3) and (4) and inserting the following:

"(3) FEE, OATH OR DECLARATION, AND CLAIMS.—The application shall be accompanied by the fee required by law. The fee, oath or declaration, and 1 or more claims may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the fee, oath or declaration, and 1 or more claims within such prescribed period, the application shall be regarded as abandoned.

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

(2) in subsection (b), by striking paragraphs (3) and (4) and inserting the following:

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

"(4) FILING DATE.—The filing date of a provisional application shall be the date on which a specification, with or without claims, is received in the United States Patent and Trademark Office."; and

(3) by adding at the end the following:

"(c) PRIOR FILED APPLICATION.—Notwithstanding the provisions of subsection (a), the Director may prescribe the conditions, including the payment of a surcharge, under which a reference made upon the filing of an application under subsection (a) to a previously filed application, specifying the previously filed application by application num-

ber and the intellectual property authority or country in which the application was filed, shall constitute the specification and any drawings of the subsequent application for purposes of a filing date. A copy of the specification and any drawings of the previously filed application shall be submitted within such period and under such conditions as may be prescribed by the Director. A failure to submit the copy of the specification and any drawings of the previously filed application within the prescribed period shall result in the application being regarded as abandoned. Such application shall be treated as having never been filed, unless—

"(1) the application is revived under section 27; and

"(2) a copy of the specification and any drawings of the previously filed application are submitted to the Director.".

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

(1) IN GENERAL.—Chapter 2 of title 35, United States Code, is amended by adding at the end the following:

"§ 27. Revival of applications; reinstatement of reexamination proceedings

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

(2) CONFORMING AMENDMENT.—The table of sections for chapter 2 of title 35, United States Code, is amended by adding at the end the following:

"27. Revival of applications; reinstatement of reexamination proceedings.".

(c) RESTORATION OF PRIORITY RIGHT.—Title 35, United States Code, is amended—

(1) in section 119—

(A) in subsection (a)—

(i) by striking "twelve" and inserting "12"; and

(ii) by adding at the end the following: "The Director may prescribe regulations, including the requirement for payment of the fee specified in section 41(a)(7), pursuant to which the 12-month period set forth in this subsection may be extended by an

additional 2 months if the delay in filing the application in this country within the 12-month period was unintentional."; and

(B) in subsection (e)—

(i) in paragraph (1)—

(I) by inserting after the first sentence the following: "The Director may prescribe regulations, including the requirement for payment of the fee specified in section 41(a)(7), pursuant to which the 12-month period set forth in this subsection may be extended by an additional 2 months if the delay in filing the application under section 111(a) or section 363 within the 12-month period was unintentional."; and

(II) in the last sentence—

(aa) by striking "including the payment of a surcharge" and inserting "including the payment of the fee specified in section 41(a)(7)"; and

(bb) by striking "during the pendency of the application"; and

(ii) in paragraph (3), by adding at the end the following: "For an application for patent filed under section 363 in a Receiving Office other than the Patent and Trademark Office, the 12-month and additional 2-month period set forth in this subsection shall be extended as provided under the treaty and Regulations as defined in section 351."; and

(2) in section 365(b), by adding at the end the following: "The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed claim for priority under the treaty and the Regulations, and to accept a priority claim that pertains to an application that was not filed within the priority period specified in the treaty and Regulations, but was filed within the additional 2-month period specified under section 119(a) or the treaty and Regulations.".

(d) RECORDATION OF OWNERSHIP INTERESTS.—Section 261 of title 35, United States Code, is amended—

(1) in the first undesignated paragraph by adding at the end the following: "The Patent and Trademark Office shall maintain a register of interests in

patents and applications for patents and shall record any document related thereto upon request, and may require a fee therefor.''; and

(2) in the fourth undesignated paragraph by striking ''An assignment'' and inserting ''An interest that constitutes an assignment''.

SEC. 202. CONFORMING AMENDMENTS.

(a) IN GENERAL.—Section 171 of title 35, United States Code, is amended—

(1) by striking ''Whoever'' and inserting ''(a) IN GENERAL.—Whoever'';

(2) by striking ''The provisions'' and inserting ''(b) APPLICABILITY OF THIS TITLE.—The provisions''; and

(3) by adding at the end the following:

''(c) FILING DATE.—The filing date of an application for patent for design shall be the date on which the specification as prescribed by section 112 and any required drawings are filed.''.

(b) RELIEF IN RESPECT OF TIME LIMITS AND REINSTATEMENT OF RIGHT.—Title 35, United States Code, is amended—

(1) in section 41—

(A) in subsection (a), by striking paragraph (7) and inserting the following:

"(7) REVIVAL FEES.—On filing each petition for the revival of an abandoned application for a patent, for the delayed payment of the fee for issuing each patent, for the delayed response by the patent owner in any reexamination proceeding, for the delayed payment of the fee for maintaining a patent in force, for the delayed submission of a priority or benefit claim, or for the extension of the 12-month period for filing a subsequent application, $1,700.00. The Director may refund any part of the fee specified in this paragraph, in exceptional circumstances as determined by the Director"; and

(B) in subsection (c), by striking paragraph (1) and inserting the following:

"(1) ACCEPTANCE.—The Director may accept the payment of any maintenance fee required by subsection (b) after the 6-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional. The Director may require the payment of the fee specified in subsection (a)(7) as a condition of accepting payment of any maintenance fee after the 6-month grace period. If the Director accepts payment of a maintenance fee after the 6-month grace period, the patent shall be considered as not having expired at the end of the grace period.";

(2) in section 119(b)(2), in the second sentence, by striking "including the payment of a surcharge" and inserting "including the requirement for payment of the fee specified in section 41(a)(7)";

(3) in section 120, in the fourth sentence, by striking "including the payment of a surcharge" and inserting "including the requirement for payment of the fee specified in section 41(a)(7)";

(4) in section 122(b)(2)(B)(iii), in the second sentence, by striking ", unless it is shown" and all that follows through "unintentional";

(5) in section 133, by striking ", unless it be shown" and all that follows through "unavoidable";

(6) by striking section 151 and inserting the following:

"§ 151. Issue of patent

"(a) IN GENERAL.—If it appears that an applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee and any required publication fee, which shall be paid within 3 months thereafter.

"(b) EFFECT OF PAYMENT.—Upon payment of this sum the patent may issue, but if payment is not timely made, the application shall be regarded as abandoned.";

(7) in section 361, by striking subsection (c) and inserting the following:

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

(8) in section 364, by striking subsection (b) and inserting the following:

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

(9) in section 371(d), in the third sentence, by striking ", unless it be shown to the satisfaction of the Director that such failure to comply was unavoidable".

SEC. 203. EFFECTIVE DATE.

(a) IN GENERAL.—The amendments made by this title—

(1) shall take effect on the date that is 1 year after the date of the enactment of this Act; and

(2) shall apply to—

(A) any patent issued before, on, or after the effective date set forth in paragraph (1); and

(B) any application for patent that is pending on or filed after the effective date set forth in paragraph (1).

(b) EXCEPTIONS.—

(1) SECTION 201(a).—The amendments made by section 201(a) shall apply only to applications that are filed on or after the effective date set forth in subsection (a)(1).

(2) PATENTS IN LITIGATION.—The amendments made by this title shall have no effect with respect to any patent that is the subject of litigation in an action commenced before the effective date set forth in subsection (a)(1).

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S. 3486

A BILL

To implement the provisions of the Hague Agreement and the Patent Law Treaty.

September 20, 2012

Reported with an amendment