

# H. R. 10673

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IN THE HOUSE OF REPRESENTATIVES

OCTOBER 2, 1973

Mr. KASTENMEIER introduced the following bill; which was referred to the Committee on the Judiciary

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## A BILL

To carry into effect certain provisions of the Patent Cooperation Treaty, and for other purposes.

1       *Be it enacted by the Senate and House of Representa-*  
2       *tives of the United States of America in Congress assembled,*  
3       That title 35, United States Code, entitled "Patents," be  
4       amended by adding at the end thereof a new part IV to  
5       read as follows:

6       **"PART IV—PATENT COOPERATION TREATY**

7               **"Chapter 35.—DEFINITIONS**

"Sec.

"351. Definitions.

8       **"§ 351. Definitions**

9       "When used in this part unless the context otherwise  
10       indicates—

1       “(a) The term ‘treaty’ means the Patent Cooperation  
2 Treaty done at Washington, on June 19, 1970, excluding  
3 chapter II thereof.

4       “(b) The term ‘Regulations’, when capitalized, means  
5 the Regulations under the treaty excluding part C thereof,  
6 done at Washington on the same date as the treaty. The  
7 term ‘regulations’, when not capitalized, means the regula-  
8 tions established by the Commissioner under this title.

9       “(c) The term ‘international application’ means an ap-  
10 plication filed under the treaty.

11       “(d) The term ‘international application originating in  
12 the United States’ means an international application filed  
13 in the Patent Office when it is acting as a Receiving Office  
14 under the treaty, irrespective of whether or not the United  
15 States has been designated in that international application.

16       “(e) The term ‘international application designating the  
17 United States’ means an international application specifying  
18 the United States as a country in which a patent is sought.

19       “(f) The term ‘Receiving Office’ means a national pat-  
20 ent office or intergovernmental organization which receives  
21 and processes international applications as prescribed by the  
22 treaty and the Regulations.

23       “(g) The term ‘International Searching Authority’  
24 means a national patent office or intergovernmental organiza-  
25 tion as appointed under the treaty which processes interna-

1 tional applications as prescribed by the treaty and the Regu-  
2 lations.

3 “(h) The term ‘International Bureau’ means the inter-  
4 national intergovernmental organization which is recognized  
5 as the coordinating body under the treaty and the Regu-  
6 lations.

7 “(i) Terms and expressions not defined in this part  
8 are to be taken in the sense indicated by the treaty and  
9 the Regulations.

10 **“Chapter 36.—INTERNATIONAL STAGE**

“Sec.

“361. Receiving Office.

“362. International Searching Authority.

“363. International application designating the United States: Effect.

“364. International stage: Procedure.

“365. Right of priority; benefit of the filing date of a prior application.

“366. Withdrawn international application.

“367. Actions of other authorities: Review.

“368. Secrecy of certain inventions; filing international applications in  
foreign countries.

11 **“§ 361. Receiving Office**

12 “(a) The Patent Office shall act as a Receiving Of-  
13 fice for international applications filed by nationals or resi-  
14 dents of the United States. In accordance with any agree-  
15 ment made between the United States and another country,  
16 the Patent Office may also act as a Receiving Office for  
17 international applications filed by residents or nationals  
18 of such country who are entitled to file international appli-  
19 cations.

1       “(b) The Patent Office shall perform all acts con-  
2 nected with the discharge of duties required of a Receiving  
3 Office, including the collection of international fees and  
4 their transmittal to the International Bureau.

5       “(c) International applications filed in the Patent  
6 Office shall be in the English language.

7       “(d) The basic fee portion of the international fee,  
8 and the transmittal and search fees prescribed under sec-  
9 tion 376 (a) of this part, shall be paid on filing of an inter-  
10 national application. Payment of designation fees may be  
11 made on filing and shall be made not later than one year  
12 from the priority date of the international application.

13       **“§ 362. International Searching Authority**

14       “The Patent Office may act as an International Search-  
15 ing Authority with respect to international applications in  
16 accordance with the terms and conditions of an agreement  
17 which may be concluded with the International Bureau.

18       **“§ 363. International application designating the United**  
19               **States: Effect**

20       “An international application designating the United  
21 States shall have the effect, from its international filing date  
22 under article 11 of the treaty, of a national application for  
23 patent regularly filed in the Patent Office except as otherwise  
24 provided in section 102 (e) of this title.

1   **“§ 364. International stage: Procedure**

2       “(a) International applications shall be processed by  
3 the Patent Office when acting as a receiving office or inter-  
4 national Searching Authority, or both, in accordance with  
5 the applicable provisions of the treaty, the Regulations, and  
6 this title.

7       “(b) An applicant’s failure to act within prescribed  
8 time limits in connection with requirements pertaining to a  
9 pending international application may be excused upon a  
10 showing satisfactory to the Commissioner of unavoidable de-  
11 lay, to the extent not precluded by the treaty and the Reg-  
12 ulations, and provided the conditions imposed by the treaty  
13 and the Regulations regarding the excuse of such failure to  
14 act are complied with.

15   **“§ 365. Right of priority; benefit of the filing date of a**  
16                   **prior application**

17       “(a) In accordance with the conditions and require-  
18 ments of section 119 of this title, a national application shall  
19 be entitled to the right of priority based on a prior filed inter-  
20 national application which designated at least one country  
21 other than the United States.

22       “(b) In accordance with the conditions and require-  
23 ment of the first paragraph of section 119 of this title and  
24 the treaty and the Regulations, an international application  
25 designating the United States shall be entitled to the right of

1 priority based on a prior foreign application, or a prior inter-  
2 national application designating at least one country other  
3 than the United States.

4 “(c) In accordance with the conditions and require-  
5 ments of section 120 of this title, an international applica-  
6 tion designating the United States shall be entitled to the  
7 benefit of the filing date of a prior national application or a  
8 prior international application designating the United States,  
9 and a national application shall be entitled to the benefit of  
10 the filing date of a prior international application designating  
11 the United States. If any claim for the benefit of an earlier  
12 filing date is based on a prior international application which  
13 designated but did not originate in the United States, the  
14 Commissioner may require the filing in the Patent Office of a  
15 certified copy of such application together with a translation  
16 thereof into the English language, if it was filed in another  
17 language.

18 **“§ 366. Withdrawn international application**

19 “Subject to section 367 of this part, if an international  
20 application designating the United States is withdrawn or  
21 considered withdrawn, either generally or as to the United  
22 States, under the conditions of the treaty and the Regula-  
23 tions, before the applicant has complied with the applicable  
24 requirements prescribed by section 371 (c) of this part, the  
25 designation of the United States shall have no effect and

1 shall be considered as not having been made. However,  
2 such international application may serve as the basis for a  
3 claim of priority under section 365 (a) and (b) of this  
4 part, if it designated a country other than the United States.

5 **“§ 367. Actions of other authorities: Review**

6 “(a) Where a Receiving Office other than the Patent  
7 Office has refused to accord an international filing date to  
8 an international application designating the United States or  
9 where it has held such application to be withdrawn either  
10 generally or as to the United States, the applicant may  
11 request review of the matter by the Commissioner, on com-  
12 pliance with the requirements of and within the time limits  
13 specified by the treaty and the Regulations. Such review  
14 may result in a determination that such application be con-  
15 sidered as pending in the national stage.

16 “(b) The review under subsection (a) of this section,  
17 subject to the same requirements and conditions, may also  
18 be requested in those instances where an international appli-  
19 cation designating the United States is considered withdrawn  
20 due to a finding by the International Bureau under article  
21 12 (3) of the treaty.

22 **“§ 368. Secrecy of certain inventions; filing international**  
23 **applications in foreign countries**

24 “(a) International applications filed in the Patent

1 Office shall be subject to the provisions of chapter 17 of  
2 this title.

3 “(b) In accordance with article 27 (8) of the treaty,  
4 the filing of an international application in a country other  
5 than the United States on an invention made in this country  
6 shall be considered to constitute the filing of an application  
7 in a foreign country within the meaning of chapter 17 of  
8 this title, whether or not the United States is designated  
9 in that international application.

10 “(c) If a license to file in a foreign country is refused  
11 or if an international application is ordered to be kept secret  
12 and a permit refused, the Patent Office when acting as a  
13 Receiving Office or International Searching Authority, or  
14 both, may not disclose the contents of such application to  
15 anyone not authorized to receive such disclosure.

16 **“Chapter 37.—NATIONAL STAGE**

“Sec.

“371. National stage: Commencement.

“372. National stage: Requirements and procedure.

“373. Improper applicant.

“374. Publication of international application: Effect.

“375. Patent issued on international application: Effect.

“376. Fees.

17 **“§ 371. National stage: Commencement**

18 “(a) Receipt from the International Bureau of copies  
19 of international applications with amendments to the claims,  
20 if any, and international search reports is required in the

1 case of all international applications designating the United  
2 States, except those filed in the Patent Office.

3 “(b) Subject to subsection (f) of this section, the  
4 national stage shall commence with the expiration of the  
5 applicable time limit under article 22 (1) or (2) of the  
6 treaty, and provided that the applicant shall have complied  
7 with the applicable requirements specified in subsection (c)  
8 of this section.

9 “(c) The applicant shall file in the Patent Office—

10 “(1) the national fee prescribed under section 376  
11 (a) (4) of this part;

12 “(2) a copy of the international application, un-  
13 less not required under subsection (a) of this section  
14 or already received from the International Bureau, and  
15 a verified translation into the English language of the  
16 international application, if it was filed in another  
17 language;

18 “(3) amendments, if any, to the claims in the inter-  
19 national application, made under article 19 of the treaty,  
20 unless such amendments have been communicated to the  
21 Patent Office by the International Bureau, and a trans-  
22 lation into the English language if such amendments  
23 were made in another language;

24 “(4) an oath or declaration of the inventor (or other  
25 person authorized under chapter 11 of this title) com-

1       plying with the requirements of section 115 of this title  
2       and with regulations prescribed for oaths or declarations  
3       of applicants.

4       “(d) Failure to comply with any of the requirements of  
5       subsection (c) of this section, within the time limit provided  
6       by article 22 (1) or (2) of the treaty shall result in aban-  
7       donment of the international application.

8       “(e) After an international application has entered the  
9       national stage, no patent may be granted or refused thereon  
10       before the expiration of the applicable time limit under  
11       article 28 of the treaty, except with the express consent  
12       of the applicant. The applicant may present amendments to  
13       the specification, claims, and drawings of the application after  
14       the national stage has commenced.

15       “(f) At the express request of the applicant, the national  
16       stage of processing may be commenced at any time at which  
17       the application is in order for such purpose and the applicable  
18       requirements of subsection (c) of this section have been  
19       complied with.

20       **“§ 372. National stage: Requirements and procedure:**

21       “(a) All questions of substance and procedure in an  
22       international application designating the United States shall  
23       be determined as in the case of national applications regu-  
24       larly filed in the Patent Office.

1       “(b) Where the nature of the invention admits of illus-  
2 tration by a drawing, without being necessary for the under-  
3 standing of the invention, and the applicant has not furnished  
4 such a drawing, the Commissioner may require its submission  
5 not earlier than two months after the sending of a notice  
6 thereof. Drawings submitted after the filing date of the inter-  
7 national application may not be used to overcome any in-  
8 sufficiency of the specification due to an adequate disclosure  
9 therein.

10       “(c) In case of international applications designating  
11 but not originating in, the United States—

12               “(1) the Commissioner may cause to be reex-  
13 amined questions relating to form and contents of the  
14 application in accordance with the requirements of the  
15 treaty and the Regulations;

16               “(2) The Commissioner may cause the question of  
17 unity of invention to be reexamined under section 121  
18 of this title, within the scope of the requirements of the  
19 treaty and the Regulations.

20       “(d) Any claim not searched in the international stage  
21 in view of a holding, found to be justified by the Commis-  
22 sioner upon review, that the international application did  
23 not comply with the requirement for unity of invention under  
24 the treaty and the Regulations, shall be considered canceled,  
25 unless payment of a special fee is made by the applicant.

1 Such special fee shall be paid with respect to each claim not  
2 searched in the international stage and shall be submitted not  
3 later than one month after a notice was sent to the applicant  
4 informing him that the said holding was deemed to be justi-  
5 fied. The payment of the special fee shall not prevent the  
6 Commissioner from requiring that the international applica-  
7 tion be restricted to one of the inventions claimed therein  
8 under section 121 of this title, and within the scope of the  
9 requirements of the treaty and the Regulations.

10 **“§ 373. Improper applicant**

11 “An international application designating the United  
12 States, shall not be accepted by the Patent Office for the  
13 national stage if it was filed by anyone not qualified under  
14 chapter 11 of this title to be an applicant for the purpose of  
15 filing a national application in the United States. Such inter-  
16 national applications shall not serve as the basis for the bene-  
17 fit of an earlier filing date under section 120 of this title in a  
18 subsequently filed application, but may serve as the basis for  
19 a claim of the right of priority under section 119 of this title,  
20 if the United States was not the sole country designated in  
21 such international application.

22 **“§ 374. Publication of international application: Effect**

23 “The publication under the treaty of an international  
24 application shall confer no rights and shall have no effect  
25 under this title other than that of a printed publication.

1 **“§ 375. Patent issued on international application: Effect**

2 “(a) A patent may be issued by the Commissioner based  
3 on an international application designating the United States,  
4 in accordance with the provisions of this title. Subject to  
5 section 102 (e) of this title, such patent shall have the force  
6 and effect of a patent issued on a national application filed  
7 under the provisions of chapter 11 of this title.

8 “(b) Where due to an incorrect translation the scope  
9 of a patent granted on an international application designat-  
10 ing the United States, which was not originally filed in the  
11 English language, exceeds the scope of the international  
12 application in its original language, a court of competent  
13 jurisdiction may retroactively limit the scope of the patent,  
14 by declaring it unenforceable to the extent that it exceeds  
15 the scope of the international application in its original  
16 language.

17 **“§ 376. Fees**

18 “(a) The required payment of the international fee,  
19 which amount is specified in the Regulations, shall be paid  
20 in United States currency. The Patent Office may also  
21 charge the following fees:

22 “(1) a transmittal fee (see section 361 (d) );

23 “(2) a search fee (see section 361 (d) );

24 “(3) a supplemental search fee (to be paid when  
25 required) ;

1           “(4) a national fee (see section 371 (c) ) ;

2           “(5) a special fee (to be paid when required; see  
3 section 372 (d) ) ;

4           “(6) such other fees as established by the Com-  
5 missioner.

6           “(b) The amounts of fees specified in subsection (a)  
7 of this section, except the international fee, shall be pre-  
8 scribed by the Commissioner. He may refund any sum paid  
9 by mistake or in excess of the fees so specified, or if required  
10 under the treaty and the Regulations. The Commissioner may  
11 also refund any part of the search fee, where he determines  
12 such refund to be warranted.”.

13           SEC. 2. Section 6 of title 35, United States Code, is  
14 amended by adding a paragraph (d) to read as follows:

15   **“§ 6. Duties of Commissioner**

16           \*           \*           \*           \*           \*           \*           \*

17           “(d) The Commissioner, under the direction of the Sec-  
18 retary of Commerce, may, with the concurrence of the Sec-  
19 retary of State, allocate funds appropriated to the Patent  
20 Office, to the Department of State for the purpose of pay-  
21 men of the share on the part of the United States to the work-  
22 ing capital fund established under the Patent Cooperation  
23 Treaty. Contributions to cover the share on the part of the  
24 United States of any operating deficits of the International  
25 Bureau under the Patent Cooperation Treaty shall be in-

1 cluded in the annual budget of the Patent Office and may  
2 be transferred by the Commissioner, under the direction of  
3 the Secretary of Commerce, to the Department of State for  
4 the purpose of making payments thereof to the International  
5 Bureau.”.

6 SEC. 3. Item 1 of section 41 (a) of title 35, United  
7 States Code, is amended to read as follows:

8 “§ 41. Patent fees

9 “(a) The Commissioner shall charge the following fees:

10 “1. On filing each application for an original patent,  
11 except in design cases, \$65; in addition on filing or on  
12 presentation at any other time, \$10 for each claim in in-  
13 dependent form which is in excess of one, and \$2 for each  
14 claim (whether independent or dependent) which is in  
15 excess of ten. For the purpose of computing fees, a multiple  
16 dependent claim as referred to in section 112 of this title  
17 or any claim depending therefrom shall be considered as  
18 separate dependent claims in accordance with the number of  
19 claims to which reference is made. Errors in payment of the  
20 additional fees may be rectified in accordance with regulations  
21 of the Commissioner.”.

22 SEC. 4. Paragraph (e) of section 102 of title 35, United  
23 States Code, is amended to read as follows:

1 **“§ 102. Conditions for patentability; novelty and loss of**  
 2 **right to patent**

\* \* \* \* \*

3 “(e) the invention was described in a patent  
 4 granted on an application for patent by another filed in  
 5 the United States before the invention thereof by the  
 6 applicant for patent, or on an international application  
 7 by another who has fulfilled the requirements of para-  
 8 graphs (1), (2), and (4) of section 371 (c) of this  
 9 title before the invention thereof by the applicant for  
 10 patent, or”.

11 SEC. 5. The second sentence of the second paragraph  
 12 of section 112 of title 35, United States Code, is amended  
 13 to read as follows:

14 **“§ 112. Specification**

\* \* \* \* \*

15 “A claim may be written in independent or, if the nature  
 16 of the case admits, in dependent or multiple dependent form.

17 “Subject to the following paragraph, a claim in de-  
 18 pendent form shall contain a reference to a claim previously  
 19 set forth and then specify a further limitation of the sub-  
 20 ject matter claimed. A claim in dependent form shall be  
 21 construed to incorporate by reference all the limitations of  
 22 the claim to which it refers.

1       “A claim in multiple dependent form shall contain a  
2 reference, in the alternative only, to more than one claim  
3 previously set forth and then specify a further limitation of  
4 the subject matter claimed. A multiple dependent claim shall  
5 not serve as a basis for any other multiple dependent claim.  
6 A multiple dependent claim shall be construed to incor-  
7 porate by reference all the limitations of the particular claim  
8 in relation to which it is being considered.”.

9       SEC. 6. Section 113 of title 35, United States Code,  
10 is amended to read as follows:

11       “§ 113. Drawings

12       “The applicant shall furnish a drawing where necessary  
13 for the understanding of the subject matter sought to be  
14 patented. When the nature of such subject matter admits of  
15 illustration by a drawing and the applicant has not furnished  
16 such a drawing, the Commissioner may require its submission  
17 within a time period of not less than two months from the  
18 sending of a notice thereof. Drawings submitted after the  
19 filing date of the application may not be used (i) to  
20 overcome any insufficiency of the specification due to lack  
21 of an enabling disclosure or otherwise inadequate disclosure  
22 therein, or (ii) to supplement the original disclosure thereof  
23 for the purpose of interpretation of the scope of any claim.”.

24       SEC. 7. The first paragraph of section 282 of title 35,  
25 United States Code, is amended to read as follows:

1 **“§ 282. Presumption of validity; defenses**

2 “A patent shall be presumed valid. Each claim of a  
3 patent (whether in independent, dependent, or multiple de-  
4 pendent form) shall be presumed valid independently of the  
5 validity of other claims; dependent or multiple dependent  
6 claims shall be presumed valid even though dependent upon  
7 an invalid claim. The burden of establishing invalidity of a  
8 patent or any claim thereof shall rest on the party asserting  
9 such invalidity.”.

10 SEC. 8. (a) Section 1 of this Act shall come into force on  
11 the same day as the entry into force of the Patent Coopera-  
12 tion Treaty with respect to the United States. It shall apply  
13 to international and national applications filed on and after  
14 this effective date, even though entitled to the benefit of an  
15 earlier filing date, and to patents issued on such applications.

16 (b) Sections 2 to 6 of this Act, shall take effect on the  
17 same day as section 1 of this Act and shall apply to all appli-  
18 cations for patent actually filed in the United States on and  
19 after this effective date, as well as to international applica-  
20 tions where applicable.

21 (c) Applications for patent on file in the Patent Office  
22 on the effective date of this Act, and patents issued on such  
23 applications, shall be governed by the provisions of title 35,  
24 United States Code, in effect immediately prior to the effec-  
25 tive date of this Act.

93<sup>d</sup> CONGRESS  
1<sup>ST</sup> SESSION

**H. R. 10673**

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**A BILL**

To carry into effect certain provisions of the  
Patent Cooperation Treaty, and for other  
purposes.

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By **MR. KASTENMEIER**

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OCTOBER 2, 1973

Referred to the Committee on the Judiciary

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