

## Calendar No. 456

99TH CONGRESS  
1ST SESSION**S. 1230**

To amend the patent laws implementing the Patent Cooperation Treaty.

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## IN THE SENATE OF THE UNITED STATES

JUNE 4 (legislative day, JUNE 3), 1985

Mr. MATHIAS introduced the following bill; which was read twice and referred to the Committee on the Judiciary

DECEMBER 10 (legislative day, DECEMBER 9), 1985

Reported by Mr. THURMOND, without amendment

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**A BILL**

To amend the patent laws implementing the Patent Cooperation Treaty.

1       *Be it enacted by the Senate and House of Representa-*  
2 *tives of the United States of America in Congress assembled,*  
3 That this Act may be cited as the "Act to authorize the  
4 United States to participate in chapter II of the Patent  
5 Cooperation Treaty".

6       SEC. 2. (a) Section 351(a) of title 35, United States  
7 Code, is amended by striking out " , excluding chapter II  
8 thereof".

1 (b) Section 351(b) of title 35, United States Code, is  
2 amended by striking out “excluding part C thereof”.

3 (c) Section 351(g) of title 35, United States Code, is  
4 amended by—

5 (1) striking out “term” and inserting in lieu there-  
6 of “terms”;

7 (2) inserting “and ‘International Preliminary Ex-  
8 amining Authority’ ” after “Authority”; and

9 (3) striking out “means” and inserting in lieu  
10 thereof “mean”.

11 (d) Section 361(d) of title 35, United States Code, is  
12 amended to read as follows:

13 “(d) The international fee, and the transmittal and  
14 search fees prescribed under section 376(a) of this part, shall  
15 either be paid on filing of an international application or  
16 within such later time as may be fixed by the Commis-  
17 sioner.”.

18 SEC. 3. The item relating to section 362 in the analysis  
19 for chapter 36 of title 35, United States Code, is amended to  
20 read as follows:

“362. International Searching Authority and International Preliminary Examining  
Authority.”.

21 SEC. 4. Section 362 of title 35, United States Code, is  
22 amended to read as follows:

1 **“§ 362. International Searching Authority and Interna-**  
2 **tional Preliminary Examining Authority**

3 “(a) The Patent and Trademark Office may act as an  
4 International Searching Authority and International Prelimi-  
5 nary Examining Authority with respect to international ap-  
6 plications in accordance with the terms and conditions of an  
7 agreement which may be concluded with the International  
8 Bureau, and may discharge all duties required of such Au-  
9 thorities, including the collection of handling fees and their  
10 transmittal to the International Bureau.

11 “(b) The handling fee, preliminary examination fee, and  
12 any additional fees due for international preliminary examina-  
13 tion shall be paid within such time as may be fixed by the  
14 Commissioner.”.

15 SEC. 5. Section 364(a) of title 35, United States Code,  
16 is amended by—

17 (a) striking out “or”, first occurrence and insert-  
18 ing in lieu thereof “,”;

19 (b) inserting “International Preliminary Examin-  
20 ing Authority” after “Authority, or”; and

21 (c) striking out “both”.

22 SEC. 6. Section 368(c) of title 35, United States Code,  
23 is amended by—

24 (a) striking out the second occurrence of “or” and  
25 inserting in lieu thereof “,”; and

1 (b) striking out “both” and inserting in lieu there-  
2 of “International Preliminary Examining Authority”.

3 SEC. 7. (a) Section 371(a) of title 35, United States  
4 Code, is amended to read as follows:

5 “(a) Receipt from the International Bureau of copies of  
6 international applications with any amendments to the  
7 claims, international search reports, and international prelim-  
8 inary examination reports including any annexes thereto may  
9 be required in the case of international applications designat-  
10 ing or electing the United States.”.

11 (b) Section 371(b) of title 35, United States Code, is  
12 amended to read as follows:

13 “(b) Subject to subsection (f) of this section, the national  
14 stage shall commence with the expiration of the applicable  
15 time limit under article 22(1) or (2), or under article 39(1)(a)  
16 of the treaty.”.

17 (c) Section 371(c)(4) of title 35, United States Code, is  
18 amended by striking the “.” and inserting in lieu thereof “;”.

19 (d) Section 371(c) of title 35, United States Code, is  
20 amended by adding at the end thereof the following new  
21 paragraph (5):

22 “(5) a translation into the English language of  
23 any annexes to the international preliminary examina-  
24 tion report, if such annexes were made in another lan-  
25 guage.”.

1 (e) Section 371(d) of title 35, United States Code, is  
2 amended by adding at the end thereof the following sentence:  
3 “The requirement of subsection (c)(5) shall be complied with  
4 at such time as may be fixed by the Commissioner and failure  
5 to do so shall be regarded as cancellation of the amendments  
6 made under article 34(2)(b) of the treaty.”

7 (f) Section 371(e) of title 35, United States Code, is  
8 amended by inserting “or article 41” after “28”.

9 SEC. 8. (a) Section 376(a) of title 35, United States  
10 Code, is amended by—

11 (1) inserting “and the handling fee” after the first  
12 occurrence of “fee”;

13 (2) striking “amount is” and inserting in lieu  
14 thereof “amounts are”;

15 (3) redesignating paragraph (5) as paragraph (6);

16 and

17 (4) inserting the following new paragraph (5):

18 “(5) A preliminary examination fee and any addi-  
19 tional fees (see section 362(b)).”

20 (b) Section 376(b) of title 35, United States Code, is  
21 amended by—

22 (1) inserting “and the handling fee” after the first  
23 occurrence of “fee” in the first sentence; and

24 (2) inserting “the preliminary examination fee and  
25 any additional fees,” after “fee,” in the third sentence.

1           SEC. 9. Sections 2 through 8 of this Act shall come into  
2 force on the same day as the effective date of entry into force  
3 of chapter II of the Patent Cooperation Treaty with respect  
4 to the United States, by virtue of the withdrawal of the dec-  
5 laration under article 64(1)(a) of the Patent Cooperation  
6 Treaty. It shall apply to all international applications pending  
7 before or after its effective date.

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