

S. 24

IN THE SENATE OF THE UNITED STATES

JANUARY 15, 1975

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

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 read
5 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
10 application 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
17 the United States’ means an international application speci-
18 fying the United States as a country in which a patent is
19 sought, *regardless where such international application is*
20 *filed.*

21 “(f) The term ‘Receiving Office’ means a national
22 patent office or intergovernmental organization which re-
23 ceives and processes international applications as prescribed
24 by the treaty and the Regulations.

25 “(g) The term ‘International Searching Authority’

1 means a national patent office or intergovernmental organi-
 2 zation as appointed under the treaty which processes inter-
 3 national applications as prescribed by the treaty and the
 4 Regulations.

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

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

12 **“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.

13 **“§ 361. Receiving Office**

14 “(a) The Patent Office shall act as a Receiving Office
 15 for international applications filed by nationals or residents
 16 of the United States. In accordance with any agreement
 17 made between the United States and another country, the
 18 Patent Office may also act as a Receiving Office for interna-
 19 tional applications filed by residents or nationals of such
 20 country who are entitled to file international applications.

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

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

7 “(d) The basic fee portion of the international fee, and
8 the transmittal and search fees prescribed under section 376
9 (a) of this part, shall be paid on filing of an international
10 application. Payment of designation fees may be made on
11 filing and shall be made not later than one year from the
12 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
11 delay, to the extent not precluded by the treaty and the
12 Regulations, and provided the conditions imposed by the
13 treaty and the Regulations regarding the excuse of such
14 failure to act are compiled 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
20 international application which designated at least one coun-
21 try 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

1 designating the United States shall be entitled to the right of
2 priority based on a prior foreign application, or a prior
3 international application designating at least one country
4 other than the United States.

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

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

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

1 shall be considered as not having been made. However, such
2 international application may serve as the basis for a claim
3 of priority under section 365 (a) and (b) of this part, if it
4 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 re-
11 quest 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 may
14 result in a determination that such application be considered
15 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 with-
20 drawn due to a finding by the International Bureau under
21 article 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 Office
25 shall be subject to the provisions of chapter 17 of this title.

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

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

14 **“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.

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

16 “(a) Receipt from the International Bureau of copies
 17 of international applications with amendments to the claims,
 18 if any, and international search reports is required in the
 19 case of all international applications designating the United
 20 States, except those filed in the Patent Office.

21 “(b) Subject to subsection (f) of this section, the na-

1 tional stage shall commence with the expiration of the appli-
2 cable time limit under article 22 (1) or (2) of the treaty,
3 at which time the applicant shall have complied with the
4 applicable requirements specified in subsection (c) of this
5 section.

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

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

9 “(2) a copy of the international application, unless
10 not required under subsection (a) of this section or al-
11 ready received from the International Bureau, and a
12 verified translation into the English language of the in-
13 ternational application, if it was filed in another
14 language;

15 “(3) amendments, if any, to the claims in the
16 international application, made under article 19 of the
17 treaty, unless such amendments have been communicated
18 to the Patent Office by the International Bureau, and a
19 translation into the English language if such amendments
20 were made in another language;

21 “(4) an oath or declaration of the inventor (or
22 other person authorized under chapter 11 of this title)
23 complying with the requirements of section 115 of this
24 title and with regulations prescribed for oaths or declara-
25 tions of applicants.

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

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

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

17 “§ 372. National stage: Requirements and procedure

18 “(a) All questions of substance and, within the scope of
19 the requirements of the treaty and Regulations, procedure in
20 an international application designating the United States
21 shall be determined as in the case of national applications
22 regularly filed in the Patent Office.

23 “(b) In case of international applications designating
24 but not originating in, the United States—

1 “(1) the Commissioner may cause to be re-
2 examined questions relating to form and contents of the
3 application in accordance with the requirements of the
4 treaty and the Regulations;

5 “(2) the Commissioner may cause the question
6 of unity of invention to be reexamined under section 121
7 of this title, within the scope of the requirements of the
8 treaty and the Regulations.

9 “(c) Any claim not searched in the international stage
10 in view of a holding, found to be justified by the Commis-
11 sioner upon review, that the international applica-
12 tion did not comply with the requirement for unity of in-
13 vention under the treaty and the Regulations, shall be
14 considered canceled, unless payment of a special fee is made
15 by the applicant. Such special fee shall be paid with respect
16 to each claim not searched in the international stage and
17 shall be submitted not later than one month after a notice
18 was sent to the applicant informing him that the said hold-
19 ing was deemed to be justified. The payment of the special
20 fee shall not prevent the Commissioner from requiring that
21 the international application be restricted to one of the
22 inventions claimed therein under section 121 of this title,
23 and within the scope of the requirements of the treaty and
24 the Regulations.

1 **“§ 373. Improper applicant**

2 “An international application designating the United
3 States, shall not be accepted by the Patent Office for the
4 national stage if it was filed by anyone not qualified under
5 chapter 11 of this title to be an applicant for the purpose
6 of filing a national application in the United States. Such
7 international applications shall not serve as the basis for
8 the benefit of an earlier filing date under section 120 of this
9 title in a subsequently filed application, but may serve as the
10 basis for a claim of the right of priority under section 119 of
11 this title, if the United States was not the sole country desig-
12 nated in such international application.

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

14 “The publication under the treaty of an international ap-
15 plication shall confer no rights and shall have no effect under
16 this title other than that of a printed publication.

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

18 “(a) A patent may be issued by the Commissioner based
19 on an international application designating the United States,
20 in accordance with the provisions of this title. Subject to sec-
21 tion 102 (e) of this title, such patent shall have the force
22 and effect of a patent issued on a national application filed
23 under the provisions of chapter 11 of this title.

24 “(b) Where due to an incorrect translation the scope
25 of a patent granted on an international application desig-

1 nating the United States, which was not originally filed in
2 the English language, exceeds the scope of the international
3 application in its original language, a court of competent
4 jurisdiction may retroactively limit the scope of the patent,
5 by declaring it unenforceable to the extent that it exceeds
6 the scope of the international application in its original
7 language.

8 **“§ 376. Fees**

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

13 “(1) A transmittal fee (see section 361(d));

14 “(2) A search fee (see section 361(d));

15 “(3) A supplemental search fee (to be paid when
16 required);

17 “(4) A national fee (see section 371(c));

18 “(5) A special fee (to be paid when required; see
19 section 372(c));

20 “(6) Such other fees as established by the Com-
21 missioner.

22 “(b) The amounts of fees specified in subsection (a)
23 of this section, except the international fee, shall be pre-
24 scribed by the Commissioner. He may refund any sum paid
25 by mistake or in excess of the fees so specified, or if required

1 under the treaty and the Regulations. The Commissioner
 2 may also refund any part of the search fee, where he de-
 3 termines such refund to be warranted.”.

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

6 **“§ 6. Duties of Commissioner**

* * * * *

7 “(d) The Commissioner, under the direction of the Sec-
 8 retary of Commerce, may, with the concurrence of the Secre-
 9 tary of State, allocate funds appropriated to the Patent Office,
 10 to the Department of State for the purpose of payment of the
 11 share on the part of the United States to the working capital
 12 fund established under the Patent Cooperation Treaty. Con-
 13 tributions to cover the share on the part of the United States
 14 of any operating deficits of the International Bureau under
 15 the Patent Cooperation Treaty shall be included in the an-
 16 nual budget of the Patent Office and may be transferred by
 17 the Commissioner, under the direction of the Secretary of
 18 Commerce, to the Department of State for the purpose of
 19 making payments thereof to the International Bureau.”.

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

22 **“§ 41. Patent fees**

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

24 “1. On filing each application for an original patent, ex-

1 cept in design cases, \$65; in addition on filing or on presen-
 2 tation at any other time, \$10 for each claim in independent
 3 form which is in excess of one, and \$2, for each claim
 4 (whether independent or dependent) which is in excess of
 5 ten. For the purpose of computing fees, a multiple dependent
 6 claim as referred to in section 112 of this title or any claim
 7 depending therefrom shall be considered as separate depend-
 8 ent claims in accordance with the number of claims to which
 9 reference is made. Errors in payment of the additional fees
 10 may be rectified in accordance with regulations of the
 11 Commissioner.”.

12 SEC. 4. Section 42 of title 35, United States Code, is
 13 amended to read as follows:

14 **“§ 42. Payment of patent fees; return of excess amounts**

15 All patent fees shall be paid to the Commissioner who,
 16 except as provided in sections 361 (b) and 376 (b) of this
 17 title, shall deposit the same in the Treasury of the United
 18 States in such manner as the Secretary of the Treasury
 19 directs, and the Commissioner may refund any sum paid by
 20 mistake or in excess of the fee required by law.”

21 SEC. 5. Paragraph (e) of section 102 of title 35,
 22 United States Code, is amended to read as follows:

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

* * * * *

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

9 SEC. 6. The first sentence of section 104 of title 35,
10 United States Code, is amended to read as follows:

11 **“§ 104. Invention made abroad**

12 In proceedings in the Patent Office and in the courts,
13 an applicant for a patent, or a patentee, may not establish
14 a date of invention by reference to knowledge or use thereof,
15 or other activity with respect thereto, in a foreign country,
16 except as provided in sections 119 and 365 of this title.”

17 SEC. 7. The second sentence of the second paragraph
18 of section 112 of title 35, United States Code, is amended
19 to read as follows:

20 **“§ 112. Specification**

 * * * * * * *

21 “A claim may be written in independent or, if the
22 nature of the case admits, in dependent or multiple de-
23 pendent form.

24 “Subject to the following paragraph, a claim in de-

1 pendent form shall contain a reference to a claim previ-
2 ously set forth and then specify a further limitation of the
3 subject matter claimed. A claim in dependent form shall
4 be construed to incorporate by reference all the limitations
5 of the claim to which it refers.

6 “A claim in multiple dependent form shall contain a
7 reference, in the alternative only, to more than one claim
8 previously set forth and then specify a further limitation of
9 the subject matter claimed. A multiple dependent claim shall
10 not serve as a basis for any other multiple dependent claim.
11 A multiple dependent claim shall be construed to incorporate
12 by reference all the limitations of the particular claim in
13 relation to which it is being considered.”.

14 SEC. 8. Section 113 of title 35, United States Code, is
15 amended to read as follows:

16 **“§ 113. Drawings**

17 “The applicant shall furnish a drawing where necessary
18 for the understanding of the subject matter sought to be
19 patented. When the nature of such subject matter admits of
20 illustration by a drawing and the applicant has not furnished
21 such a drawing, the Commissioner may require its submis-
22 sion within a time period of not less than two months from
23 the sending of a notice thereof. Drawings submitted after the
24 filing date of the application may not be used (i) to over-
25 come any insufficiency of the specification due to lack of an

1 enabling disclosure or otherwise inadequate disclosure
2 therein, or (ii) to supplement the original disclosure thereof
3 for the purpose of interpretation of the scope of any claim.”

4 SEC. 9. Section 120 of title 35, United States Code, is
5 amended to read as follows:

6 **“§ 120. Benefit of earlier filing date in the United States**

7 “An application for patent for an invention disclosed in
8 the manner provided by the first paragraph of section 112
9 of this title in an application previously filed in the United
10 States, or as provided by section 363 of this title, by the same
11 inventor shall have the same effect, as to such invention, as
12 though filed on the date of the prior application, if filed before
13 the patenting or abandonment of or termination of proceed-
14 ings on the first application or on an application similarly
15 entitled to the benefit of the filing date of the first application
16 and if it contains or is amended to contain a specific reference
17 to the earlier filed application.”.

18 SEC. 10. The first paragraph of section 282 of title 35,
19 United States Code, is amended to read as follows:

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

21 “A patent shall be presumed valid. Each claim of a pat-
22 ent (whether in independent, dependent, or multiple de-
23 pendent form) shall be presumed valid independently of the
24 validity of other claims; dependent or multiple dependent
25 claims shall be presumed valid even though dependent upon

1 an invalid claim. The burden of establishing invalidity of a
2 patent or any claim thereof shall rest on the party asserting
3 such invalidity.”.

4 SEC. 11. (a) Section 1 of this Act shall come into force
5 on the same day as the entry into force of the Patent Co-
6 operation Treaty with respect to the United States. It shall
7 apply to international and national applications filed on and
8 after this effective date, even though entitled to the benefit
9 of an earlier filing date, and to patents issued on such appli-
10 cations.

11 (b) Sections 2 to 10 of this Act shall take effect on the
12 same day as section 1 of this Act and shall apply to all
13 applications for patent actually filed in the United States on
14 and after this effective date, as well as to international ap-
15 plications where applicable.

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

94TH CONGRESS
1ST SESSION

S. 24

A BILL

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

By Mr. McCLELLAN

JANUARY 15, 1975

Read twice and referred to the Committee on the
Judiciary