

107TH CONGRESS  
1ST SESSION

# S. 320

---

## AN ACT

To make technical corrections in patent, copyright, and  
trademark laws.

1        *Be it enacted by the Senate and House of Representa-*  
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4        This Act may be cited as the “Intellectual Property  
5 and High Technology Technical Amendments Act of  
6 2001”.

1 **SEC. 2. OFFICERS AND EMPLOYEES.**

2 (a) RENAMING OF OFFICERS.—(1) Title 35, United  
3 States Code, is amended—

4 (A) by striking “Director” each place it appears  
5 and inserting “Commissioner”; and

6 (B) by striking “Director’s” each place it ap-  
7 pears and inserting “Commissioner’s”.

8 (2) The Act of July 5, 1946 (commonly referred to  
9 as the “Trademark Act of 1946”; 15 U.S.C. 1051 et seq.)  
10 is amended by striking “Director” each place it appears  
11 and inserting “Commissioner”.

12 (3)(A) Title 35, United States Code, is amended by  
13 striking “Commissioner for Patents” each place it appears  
14 and inserting “Assistant Commissioner for Patents”.

15 (B) Section 3(b)(2) of title 35, United States Code,  
16 is amended—

17 (i) in the paragraph heading, by striking “COM-  
18 MISSIONERS” and inserting “ASSISTANT COMMIS-  
19 SIONERS”;

20 (ii) in subparagraph (A), in the last sentence—

21 (I) by striking “a Commissioner” and in-  
22 serting “an Assistant Commissioner”; and

23 (II) by striking “the Commissioner” and  
24 inserting “the Assistant Commissioner”;

25 (iii) in subparagraph (B)—

1 (I) by striking “Commissioners” each place  
2 it appears and inserting “Assistant Commis-  
3 sioners”;

4 (II) by striking “Commissioners’” each  
5 place it appears and inserting “Assistant Com-  
6 missioners’”; and

7 (iv) in subparagraph (C), by striking “Commis-  
8 sioners” and inserting “Assistant Commissioners”.

9 (C) Section 3(f) of title 35, United States Code, is  
10 amended in paragraphs (2) and (3), by striking “the Com-  
11 missioner” each place it appears and inserting “the Assist-  
12 ant Commissioner”.

13 (D) Section 13 of title 35, United States Code, is  
14 amended—

15 (i) by striking “Commissioner of” each place it  
16 appears and inserting “Assistant Commissioner for”;  
17 and

18 (ii) by striking “Commissioners” and inserting  
19 “Assistant Commissioners”.

20 (E) Chapter 17 of title 35, United States Code, is  
21 amended by striking “Commissioner of Patents” each  
22 place it appears and inserting “Assistant Commissioner  
23 for Patents”.

1 (F) Section 297 of title 35, United States Code, is  
2 amended by striking “Commissioner of Patents” each  
3 place it appears and inserting “Commissioner”.

4 (4) Title 35, United States Code, is amended by  
5 striking “Commissioner for Trademarks” each place it ap-  
6 pears and inserting “Assistant Commissioner for Trade-  
7 marks”.

8 (5) Section 5314 of title 5, United States Code, is  
9 amended by striking

10 “Under Secretary of Commerce for Intellectual  
11 Property and Director of the United States Patent  
12 and Trademark Office.”

13 and inserting

14 “Under Secretary of Commerce for Intellectual  
15 Property and Commissioner of the United States  
16 Patent and Trademark Office.”.

17 (6)(A) Section 303 of title 35, United States Code,  
18 is amended—

19 (i) in the section heading by striking “**Direct-**  
20 **tor**” and inserting “**Commissioner**”; and

21 (ii) by striking “Director’s” and inserting  
22 “Commissioner’s”.

23 (B) The item relating to section 303 in the table of  
24 sections for chapter 30 of title 35, United States Code,

1 is amended by striking “Director” and inserting “Com-  
2 missioner”.

3 (b) ADDITIONAL CLERICAL AMENDMENTS.—

4 (1) The following provisions of law are amended  
5 by striking “Director” each place it appears and in-  
6 serting “Commissioner”.

7 (A) Section 9(p)(1)(B) of the Small Busi-  
8 ness Act (15 U.S.C. 638(p)(1)(B)).

9 (B) Section 19 of the Tennessee Valley  
10 Authority Act of 1933 (16 U.S.C. 831r).

11 (C) Section 182(b)(2)(A) of the Trade Act  
12 of 1974 (19 U.S.C. 2242(b)(2)(A)).

13 (D) Section 302(b)(2)(D) of the Trade Act  
14 of 1974 (19 U.S.C. 2412(b)(2)(D)).

15 (E) Section 702(d) of the Federal Food,  
16 Drug, and Cosmetic Act (21 U.S.C. 372(d)).

17 (F) Section 1295(a)(4)(B) of title 28,  
18 United States Code.

19 (G) Section 1744 of title 28, United States  
20 Code.

21 (H) Section 151 of the Atomic Energy Act  
22 of 1954 (42 U.S.C. 2181).

23 (I) Section 152 of the Atomic Energy Act  
24 of 1954 (42 U.S.C. 2182).

1           (J) Section 305 of the National Aero-  
2           nautics and Space Act of 1958 (42 U.S.C.  
3           2457).

4           (K) Section 12(a) of the Solar Heating  
5           and Cooling Demonstration Act of 1974 (42  
6           U.S.C. 5510(a)).

7           (L) Section 10(i) of the Trading with the  
8           enemy Act (50 U.S.C. App. 10(i)).

9           (M) Section 4203 of the Intellectual Prop-  
10          erty and Communications Omnibus Reform Act  
11          of 1999, as enacted by section 1000(a)(9) of  
12          Public Law 106–113.

13          (2) The item relating to section 1744 in the  
14          table of sections for chapter 115 of title 28, United  
15          States Code, is amended by striking “generally” and  
16          inserting “, generally”.

17          (c) REFERENCES.—Any reference in any other Fed-  
18          eral law, Executive order, rule, regulation, or delegation  
19          of authority, or any document of or pertaining to the Pat-  
20          ent and Trademark Office—

21                 (1) to the Director of the United States Patent  
22                 and Trademark Office or to the Commissioner of  
23                 Patents and Trademarks is deemed to refer to the  
24                 Under Secretary of Commerce for Intellectual Prop-

1 erty and Commissioner of the United States Patent  
2 and Trademark Office;

3 (2) to the Commissioner for Patents is deemed  
4 to refer to the Assistant Commissioner for Patents;  
5 and

6 (3) to the Commissioner for Trademarks is  
7 deemed to refer to the Assistant Commissioner for  
8 Trademarks.

9 **SEC. 3. CLARIFICATION OF REEXAMINATION PROCEDURE**

10 **ACT OF 1999; TECHNICAL AMENDMENTS.**

11 (a) **OPTIONAL INTER PARTES REEXAMINATION PRO-**  
12 **CEDURES.**—Title 35, United States Code, is amended as  
13 follows:

14 (1) Section 311 is amended—

15 (A) in subsection (a), by striking “person”  
16 and inserting “third-party requester”; and

17 (B) in subsection (c), by striking “Unless  
18 the requesting person is the owner of the pat-  
19 ent, the” and inserting “The”.

20 (2) Section 312 is amended—

21 (A) in subsection (a), by striking the last  
22 sentence; and

23 (B) by striking “, if any”.

24 (3) Section 314(b)(1) is amended—

1 (A) by striking “(1) This” and all that fol-  
2 lows through “(2)” and inserting “(1)”;

3 (B) by striking “the third-party requester  
4 shall receive a copy” and inserting “the Office  
5 shall send to the third-party requester a copy”;  
6 and

7 (C) by redesignating paragraph (3) as  
8 paragraph (2).

9 (4) Section 315(c) is amended by striking  
10 “United States Code,”.

11 (5) Section 317 is amended—

12 (A) in subsection (a), by striking “patent  
13 owner nor the third-party requester, if any, nor  
14 privies of either” and inserting “third-party re-  
15 quester nor its privies”; and

16 (B) in subsection (b), by striking “United  
17 States Code,”.

18 (b) CONFORMING AMENDMENTS.—

19 (1) APPEAL TO THE BOARD OF PATENT AP-  
20 PEALS AND INTERFERENCES.—Subsections (a), (b),  
21 and (c) of section 134 of title 35, United States  
22 Code, are each amended by striking “administrative  
23 patent judge” each place it appears and inserting  
24 “primary examiner”.

1           (2) PROCEEDING ON APPEAL.—Section 143 of  
2 title 35, United States Code, is amended by amend-  
3 ing the third sentence to read as follows: “In an ex  
4 parte case or any reexamination case, the Commis-  
5 sioner shall submit to the court in writing the  
6 grounds for the decision of the Patent and Trade-  
7 mark Office, addressing all the issues involved in the  
8 appeal. The court shall, before hearing an appeal,  
9 give notice of the time and place of the hearing to  
10 the Commissioner and the parties in the appeal.”.

11           (c) CLERICAL AMENDMENTS.—

12           (1) Section 4604(a) of the Intellectual Property  
13 and Communications Omnibus Reform Act of 1999,  
14 is amended by striking “Part 3” and inserting “Part  
15 III”.

16           (2) Section 4604(b) of that Act is amended by  
17 striking “title 25” and inserting “title 35”.

18           (d) EFFECTIVE DATE.—The amendments made by  
19 sections 4605(c) and 4605(e) of the Intellectual Property  
20 and Communications Omnibus Reform Act, as enacted by  
21 section 1000(a)(9) of Public Law 106–113, shall apply to  
22 any reexamination filed in the United States Patent and  
23 Trademark Office on or after the date of the enactment  
24 of Public Law 106–113.

1 **SEC. 4. PATENT AND TRADEMARK EFFICIENCY ACT AMEND-**  
2 **MENTS.**

3 (a) DEPUTY COMMISSIONER.—

4 (1) Section 17(b) of the Act of July 5, 1946  
5 (commonly referred to as the “Trademark Act of  
6 1946”) (15 U.S.C. 1067(b)), is amended by insert-  
7 ing “the Deputy Commissioner,” after “Commis-  
8 sioner,”.

9 (2) Section 6(a) of title 35, United States Code,  
10 is amended by inserting “the Deputy Commis-  
11 sioner,” after “Commissioner,”.

12 (b) PUBLIC ADVISORY COMMITTEES.—Section 5 of  
13 title 35, United States Code, is amended—

14 (1) in subsection (i), by inserting “, privileged,”  
15 after “personnel”; and

16 (2) by adding at the end the following new sub-  
17 section:

18 “(j) INAPPLICABILITY OF PATENT PROHIBITION.—  
19 Section 4 shall not apply to voting members of the Advi-  
20 sory Committees.”.

21 (c) MISCELLANEOUS.—Section 153 of title 35,  
22 United States Code, is amended by striking “and attested  
23 by an officer of the Patent and Trademark Office des-  
24 igned by the Commissioner,”.

1 **SEC. 5. DOMESTIC PUBLICATION OF FOREIGN FILED PAT-**  
2 **ENT APPLICATIONS ACT OF 1999 AMEND-**  
3 **MENTS.**

4 Section 154(d)(4)(A) of title 35, United States Code,  
5 as in effect on November 29, 2000, is amended—

6 (1) by striking “on which the Patent and  
7 Trademark Office receives a copy of the” and insert-  
8 ing “of”; and

9 (2) by striking “international application” the  
10 last place it appears and inserting “publication”.

11 **SEC. 6. DOMESTIC PUBLICATION OF PATENT APPLICA-**  
12 **TIONS PUBLISHED ABROAD.**

13 Subtitle E of title IV of the Intellectual Property and  
14 Communications Omnibus Reform Act of 1999, as enacted  
15 by section 1000(a)(9) of Public Law 106–113, is amended  
16 as follows:

17 (1) Section 4505 is amended to read as follows:  
18 **“SEC. 4505. PRIOR ART EFFECT OF PUBLISHED APPLICA-**  
19 **TIONS.**

20 “Section 102(e) of title 35, United States Code, is  
21 amended to read as follows:

22 ““(e) the invention was described in (1) an applica-  
23 tion for patent, published under section 122(b), by another  
24 filed in the United States before the invention by the ap-  
25 plicant for patent or (2) a patent granted on an applica-  
26 tion for patent by another filed in the United States before

1 the invention by the applicant for patent, except that an  
2 international application filed under the treaty defined in  
3 section 351(a) shall have the effects for the purposes of  
4 this subsection of an application filed in the United States  
5 if and only if the international application designated the  
6 United States and was published under Article 21(2) of  
7 such treaty in the English language; or’”.

8 (2) Section 4507 is amended—

9 (A) in paragraph (1), by striking “Section  
10 11” and inserting “Section 10”;

11 (B) in paragraph (2), by striking “Section  
12 12” and inserting “Section 11”.

13 (C) in paragraph (3), by striking “Section  
14 13” and inserting “Section 12”;

15 (D) in paragraph (4), by striking “12 and  
16 13” and inserting “11 and 12”;

17 (E) in section 374 of title 35, United  
18 States Code, as amended by paragraph (10), by  
19 striking “confer the same rights and shall have  
20 the same effect under this title as an applica-  
21 tion for patent published” and inserting “be  
22 deemed a publication”; and

23 (F) by adding at the end the following:

1           “(12) The item relating to section 374 in the  
2           table of contents for chapter 37 of title 35, United  
3           States Code, is amended to read as follows:

          “374. Publication of international application.”.

4           (3) Section 4508 is amended to read as follows:

5   **“SEC. 4508. EFFECTIVE DATE.**

6           “Except as otherwise provided in this section, sec-  
7           tions 4502 through 4507, and the amendments made by  
8           such sections, shall take effect on November 29, 2000, and  
9           shall apply only to applications (including international  
10          applications designating the United States) filed on or  
11          after that date. The amendments made by sections 4504  
12          and 4505 shall additionally apply to any pending applica-  
13          tion filed before November 29, 2000, if such pending ap-  
14          plication is published pursuant to a request of the appli-  
15          cant under such procedures as may be established by the  
16          Commissioner. If an application is filed on or after No-  
17          vember 29, 2000, or is published pursuant to a request  
18          from the applicant, and the application claims the benefit  
19          of one or more prior-filed applications under section  
20          119(e), 120, or 365(c) of title 35, United States Code,  
21          then the amendment made by section 4505 shall apply to  
22          the prior-filed application in determining the filing date  
23          in the United States of the application.”.

1 **SEC. 7. MISCELLANEOUS CLERICAL AMENDMENTS.**

2 (a) AMENDMENTS TO TITLE 35.—The following pro-  
3 visions of title 35, United States Code, are amended:

4 (1) Section 2(b) is amended in paragraphs  
5 (2)(B) and (4)(B), by striking “, United States  
6 Code”.

7 (2) Section 3 is amended—

8 (A) in subsection (a)(2)(B), by striking  
9 “United States Code,”;

10 (B) in subsection (b)(2)—

11 (i) in the first sentence of subpara-  
12 graph (A), by striking “, United States  
13 Code”;

14 (ii) in the first sentence of subpara-  
15 graph (B)—

16 (I) by striking “United States  
17 Code,”; and

18 (II) by striking “, United States  
19 Code”;

20 (iii) in the second sentence of sub-  
21 paragraph (B)—

22 (I) by striking “United States  
23 Code,”; and

24 (II) by striking “, United States  
25 Code.” and inserting a period;

1 (iv) in the last sentence of subpara-  
2 graph (B), by striking “, United States  
3 Code”; and

4 (v) in subparagraph (C), by striking  
5 “, United States Code”; and  
6 (C) in subsection (c)—

7 (i) in the subsection caption, by strik-  
8 ing “, UNITED STATES CODE”; and

9 (ii) by striking “United States Code,”.

10 (3) Section 5 is amended in subsections (e) and  
11 (g), by striking “, United States Code” each place  
12 it appears.

13 (4) The table of chapters for part I is amended  
14 in the item relating to chapter 3, by striking “**be-**  
15 **fore**” and inserting “**Before**”.

16 (5) The item relating to section 21 in the table  
17 of contents for chapter 2 is amended to read as fol-  
18 lows:

“21. Filing date and day for taking action.”.

19 (6) The item relating to chapter 12 in the table  
20 of chapters for part II is amended to read as fol-  
21 lows:

“12. Examination of Application ..... 131”.

1           (7) The item relating to section 116 in the table  
2           of contents for chapter 11 is amended to read as fol-  
3           lows:

“116. Inventors.”.

4           (8) Section 154(b)(4) is amended by striking “,  
5           United States Code,”.

6           (9) Section 156 is amended—

7                 (A) in subsection (b)(3)(B), by striking  
8                 “paragraphs” and inserting “paragraph”;

9                 (B) in subsection (d)(2)(B)(i), by striking  
10                “below the office” and inserting “below the Of-  
11                fice”; and

12                (C) in subsection (g)(6)(B)(iii), by striking  
13                “submittted” and inserting “submitted”.

14           (10) The item relating to section 183 in the  
15           table of contents for chapter 17 is amended by strik-  
16           ing “of” and inserting “to”.

17           (11) Section 185 is amended by striking the  
18           second period at the end of the section.

19           (12) Section 201(a) is amended—

20                 (A) by striking “United States Code,”; and

21                 (B) by striking “5, United States Code.”  
22                 and inserting “5.”.

23           (13) Section 202 is amended—

1 (A) in subsection (b)(4), by striking “last  
2 paragraph of section 203(2)” and inserting  
3 “section 203(b)”;

4 (B) in subsection (c)—

5 (i) in paragraph (4) by striking  
6 “rights;” and inserting “rights;”; and

7 (ii) in paragraph (5) by striking “of  
8 the United States Code”.

9 (14) Section 203 is amended—

10 (A) in paragraph (2)—

11 (i) by striking “(2)” and inserting  
12 “(b)”;

13 (ii) by striking the quotation marks  
14 and comma before “as appropriate”; and

15 (iii) by striking “paragraphs (a) and  
16 (c)” and inserting “paragraphs (1) and (3)  
17 of subsection (a)”;

18 (B) in the first paragraph—

19 (i) by striking “(a)”, “(b)”, “(c)”,  
20 and (d)” and inserting “(1)”, “(2)”, “(3)”,  
21 and (4)”, respectively; and

22 (ii) by striking “(1.” and inserting  
23 “(a)”.

24 (15) Section 209 is amended in subsections (a)  
25 and (f)(1), by striking “of the United States Code”.

1 (16) Section 210 is amended—

2 (A) in subsection (a)—

3 (i) in paragraph (11), by striking  
4 “5901” and inserting “5908”; and

5 (ii) in paragraph (20) by striking  
6 “178(j)” and inserting “178j”; and

7 (B) in subsection (c)—

8 (i) by striking “paragraph 202(c)(4)”  
9 and inserting “section 202(c)(4)”; and

10 (ii) by striking “title..” and inserting  
11 “title.”.

12 (17) The item relating to chapter 29 in the  
13 table of chapters for part III is amended by insert-  
14 ing a comma after “**Patent**”.

15 (18) The item relating to section 256 in the  
16 table of contents for chapter 25 is amended to read  
17 as follows:

“256. Correction of named inventor.”.

18 (19) Section 294 is amended—

19 (A) in subsection (b), by striking “United  
20 States Code,”; and

21 (B) in subsection (c), in the second sen-  
22 tence by striking “court to” and inserting  
23 “court of”.

1           (20)(A) The item relating to section 374 in the  
2           table of contents for chapter 37 is amended to read  
3           as follows:

“374. Publication of international application.”.

4           (B) The amendment made by subparagraph (A)  
5           shall take effect on November 29, 2000.

6           (21) Section 371(b) is amended by adding at  
7           the end a period.

8           (22) Section 371(d) is amended by adding at  
9           the end a period.

10          (23) Paragraphs (1), (2), and (3) of section  
11          376(a) are each amended by striking the semicolon  
12          and inserting a period.

13          (b) OTHER AMENDMENTS.—

14          (1) Section 4732(a) of the Intellectual Property  
15          and Communications Omnibus Reform Act of 1999  
16          is amended—

17                 (A) in paragraph (9)(A)(ii), by inserting  
18                 “in subsection (b),” after “(ii)”; and

19                 (B) in paragraph (10)(A), by inserting  
20                 after “title 35, United States Code,” the fol-  
21                 lowing: “other than sections 1 through 6 (as  
22                 amended by chapter 1 of this subtitle),”.

23          (2) Section 4802(1) of that Act is amended by  
24          inserting “to” before “citizens”.

25          (3) Section 4804 of that Act is amended—

1 (A) in subsection (b), by striking “11(a)”  
2 and inserting “10(a)”; and

3 (B) in subsection (c), by striking “13” and  
4 inserting “12”.

5 (4) Section 4402(b)(1) of that Act is amended  
6 by striking “in the fourth paragraph”.

7 **SEC. 8. TECHNICAL CORRECTIONS IN TRADEMARK LAW.**

8 (a) AWARD OF DAMAGES.—Section 35(a) of the Act  
9 of July 5, 1946 (commonly referred to as the “Trademark  
10 Act of 1946”) (15 U.S.C. 1117(a)), is amended by strik-  
11 ing “a violation under section 43(a), (c), or (d),” and in-  
12 serting “a violation under section 43(a) or (d),”.

13 (b) ADDITIONAL TECHNICAL AMENDMENTS.—The  
14 Trademark Act of 1946 is further amended as follows:

15 (1) Section 1(d)(1) (15 U.S.C. 1051(d)(1)) is  
16 amended in the first sentence by striking “specifying  
17 the date of the applicant’s first use” and all that fol-  
18 lows through the end of the sentence and inserting  
19 “specifying the date of the applicant’s first use of  
20 the mark in commerce and those goods or services  
21 specified in the notice of allowance on or in connec-  
22 tion with which the mark is used in commerce.”.

23 (2) Section 1(e) (15 U.S.C. 1051(e)) is amend-  
24 ed to read as follows:

1           “(e) If the applicant is not domiciled in the United  
2 States the applicant may designate, by a document filed  
3 in the United States Patent and Trademark Office, the  
4 name and address of a person resident in the United  
5 States on whom may be served notices or process in pro-  
6 ceedings affecting the mark. Such notices or process may  
7 be served upon the person so designated by leaving with  
8 that person or mailing to that person a copy thereof at  
9 the address specified in the last designation so filed. If  
10 the person so designated cannot be found at the address  
11 given in the last designation, or if the registrant does not  
12 designate by a document filed in the United States Patent  
13 and Trademark Office the name and address of a person  
14 resident in the United States on whom may be served no-  
15 tices or process in proceedings affecting the mark, such  
16 notices or process may be served on the Commissioner.”;

17           (3) Section 8(f) (15 U.S.C. 1058(f)) is amend-  
18 ed to read as follows:

19           “(f) If the registrant is not domiciled in the United  
20 States, the registrant may designate, by a document filed  
21 in the United States Patent and Trademark Office, the  
22 name and address of a person resident in the United  
23 States on whom may be served notices or process in pro-  
24 ceedings affecting the mark. Such notices or process may  
25 be served upon the person so designated by leaving with

1 that person or mailing to that person a copy thereof at  
2 the address specified in the last designation so filed. If  
3 the person so designated cannot be found at the address  
4 given in the last designation, or if the registrant does not  
5 designate by a document filed in the United States Patent  
6 and Trademark Office the name and address of a person  
7 resident in the United States on whom may be served no-  
8 tices or process in proceedings affecting the mark, such  
9 notices or process may be served on the Commissioner.”;

10 (4) Section 9(c) (15 U.S.C. 1059(c)) is amend-  
11 ed to read as follows:

12 “(c) If the registrant is not domiciled in the United  
13 States the registrant may designate, by a document filed  
14 in the United States Patent and Trademark Office, the  
15 name and address of a person resident in the United  
16 States on whom may be served notices or process in pro-  
17 ceedings affecting the mark. Such notices or process may  
18 be served upon the person so designated by leaving with  
19 that person or mailing to that person a copy thereof at  
20 the address specified in the last designation so filed. If  
21 the person so designated cannot be found at the address  
22 given in the last designation, or if the registrant does not  
23 designate by a document filed in the United States Patent  
24 and Trademark Office the name and address of a person  
25 resident in the United States on whom may be served no-

1 tices or process in proceedings affecting the mark, such  
2 notices or process may be served on the Commissioner.”;

3 (5) Subsections (a) and (b) of section 10 (15  
4 U.S.C. 1060(a) and (b)) are amended to read as fol-  
5 lows:

6 “(a)(1) A registered mark or a mark for which an  
7 application to register has been filed shall be assignable  
8 with the good will of the business in which the mark is  
9 used, or with that part of the good will of the business  
10 connected with the use of and symbolized by the mark.  
11 Notwithstanding the preceding sentence, no application to  
12 register a mark under section 1(b) shall be assignable  
13 prior to the filing of an amendment under section 1(c)  
14 to bring the application into conformity with section 1(a)  
15 or the filing of the verified statement of use under section  
16 1(d), except for an assignment to a successor to the busi-  
17 ness of the applicant, or portion thereof, to which the  
18 mark pertains, if that business is ongoing and existing.

19 “(2) In any assignment authorized by this section,  
20 it shall not be necessary to include the good will of the  
21 business connected with the use of and symbolized by any  
22 other mark used in the business or by the name or style  
23 under which the business is conducted.

24 “(3) Assignments shall be by instruments in writing  
25 duly executed. Acknowledgment shall be prima facie evi-

1 dence of the execution of an assignment, and when the  
2 prescribed information reporting the assignment is re-  
3 corded in the United States Patent and Trademark Office,  
4 the record shall be prima facie evidence of execution.

5       “(4) An assignment shall be void against any subse-  
6 quent purchaser for valuable consideration without notice,  
7 unless the prescribed information reporting the assign-  
8 ment is recorded in the United States Patent and Trade-  
9 mark Office within 3 months after the date of the assign-  
10 ment or prior to the subsequent purchase.

11       “(5) The United States Patent and Trademark Office  
12 shall maintain a record of information on assignments, in  
13 such form as may be prescribed by the Commissioner.

14       “(b) An assignee not domiciled in the United States  
15 may designate by a document filed in the United States  
16 Patent and Trademark Office the name and address of  
17 a person resident in the United States on whom may be  
18 served notices or process in proceedings affecting the  
19 mark. Such notices or process may be served upon the  
20 person so designated by leaving with that person or mail-  
21 ing to that person a copy thereof at the address specified  
22 in the last designation so filed. If the person so designated  
23 cannot be found at the address given in the last designa-  
24 tion, or if the assignee does not designate by a document  
25 filed in the United States Patent and Trademark Office

1 the name and address of a person resident in the United  
2 States on whom may be served notices or process in pro-  
3 ceedings affecting the mark, such notices or process may  
4 be served upon the Commissioner.”;

5 (7) Section 23(c) (15 U.S.C. 1091(c)) is  
6 amended by striking the second comma after “nu-  
7 meral”.

8 (8) Section 33(b)(8) (15 U.S.C. 1115(b)(8)) is  
9 amended by aligning the text with paragraph (7).

10 (9) Section 34(d)(1)(A) (15 U.S.C.  
11 1116(d)(1)(A)) is amended by striking “section  
12 110” and all that follows through “(36 U.S.C. 380)”  
13 and inserting “section 220506 of title 36, United  
14 States Code,”.

15 (10) Section 34(d)(1)(B)(ii) (15 U.S.C.  
16 1116(d)(1)(B)(ii)) is amended by striking “section  
17 110” and all that follows through “(36 U.S.C. 380)”  
18 and inserting “section 220506 of title 36, United  
19 States Code”.

20 (11) Section 34(d)(11) is amended by striking  
21 “6621 of the Internal Revenue Code of 1954” and  
22 inserting “6621(a)(2) of the Internal Revenue Code  
23 of 1986”.

24 (12) Section 35(b) (15 U.S.C. 1117(b)) is  
25 amended—

1 (A) by striking “section 110” and all that  
 2 follows through “(36 U.S.C. 380)” and insert-  
 3 ing “section 220506 of title 36, United States  
 4 Code,”; and

5 (B) by striking “6621 of the Internal Rev-  
 6 enue Code of 1954” and inserting “6621(a)(2)  
 7 of the Internal Revenue Code of 1986”.

8 (13) Section 44(e) (15 U.S.C. 1126(e)) is  
 9 amended by striking “a certification” and inserting  
 10 “a true copy, a photocopy, a certification,”.

11 **SEC. 9. PATENT AND TRADEMARK FEE CLERICAL AMEND-**  
 12 **MENT.**

13 The Patent and Trademark Fee Fairness Act of 1999  
 14 (113 Stat. 1537–546 et seq.), as enacted by section  
 15 1000(a)(9) of Public Law 106–113, is amended in section  
 16 4203, by striking “111(a)” and inserting “1113(a)”.

17 **SEC. 10. COPYRIGHT RELATED CORRECTIONS TO 1999 OM-**  
 18 **NIBUS REFORM ACT.**

19 Title I of the Intellectual Property and Communica-  
 20 tions Omnibus Reform Act of 1999, as enacted by section  
 21 1000(a)(9) of Public Law 106–113, is amended as follows:

22 (1) Section 1007 is amended—

23 (A) in paragraph (2), by striking “para-  
 24 graph (2)” and inserting “paragraph (2)(A)”;  
 25 and

1 (B) in paragraph (3), by striking  
2 “1005(e)” and inserting “1005(d)”.

3 (2) Section 1006(b) is amended by striking  
4 “119(b)(1)(B)(iii)” and inserting  
5 “119(b)(1)(B)(ii)”.

6 (3)(A) Section 1006(a) is amended—

7 (i) in paragraph (1), by adding “and”  
8 after the semicolon;

9 (ii) by striking paragraph (2); and

10 (iii) by redesignating paragraph (3) as  
11 paragraph (2).

12 (B) Section 1011(b)(2)(A) is amended to read  
13 as follows:

14 “(A) in paragraph (1), by striking ‘pri-  
15 mary transmission made by a superstation and  
16 embodying a performance or display of a work’  
17 and inserting ‘performance or display of a work  
18 embodied in a primary transmission made by a  
19 superstation or by the Public Broadcasting  
20 Service satellite feed’;”.

21 **SEC. 11. AMENDMENTS TO TITLE 17, UNITED STATES CODE.**

22 Title 17, United States Code, is amended as follows:

23 (1) Section 119(a)(6) is amended by striking  
24 “of performance” and inserting “of a performance”.

1           (2)(A) The section heading for section 122 is  
2 amended by striking “**rights; secondary**” and  
3 inserting “**rights: Secondary**”.

4           (B) The item relating to section 122 in the  
5 table of contents for chapter 1 is amended to read  
6 as follows:

“122. Limitations on exclusive rights: Secondary transmissions by satellite carriers within local markets.”.

7           (3)(A) The section heading for section 121 is  
8 amended by striking “**reproduction**” and insert-  
9 ing “**Reproduction**”.

10           (B) The item relating to section 121 in the  
11 table of contents for chapter 1 is amended by strik-  
12 ing “reproduction” and inserting “Reproduction”.

13           (4)(A) Section 106 is amended by striking “107  
14 through 121” and inserting “107 through 122”.

15           (B) Section 501(a) is amended by striking “106  
16 through 121” and inserting “106 through 122”.

17           (C) Section 511(a) is amended by striking “106  
18 through 121” and inserting “106 through 122”.

19           (5) Section 101 is amended—

20               (A) by moving the definition of “computer  
21 program” so that it appears after the definition  
22 of “compilation”; and

1 (B) by moving the definition of “registra-  
2 tion” so that it appears after the definition of  
3 “publicly”.

4 (6) Section 110(4)(B) is amended in the matter  
5 preceding clause (i) by striking “conditions;” and in-  
6 serting “conditions:”.

7 (7) Section 118(b)(1) is amended in the second  
8 sentence by striking “to it”.

9 (8) Section 119(b)(1)(A) is amended—

10 (A) by striking “transmitted” and insert-  
11 ing “retransmitted”; and

12 (B) by striking “transmissions” and insert-  
13 ing “retransmissions”.

14 (9) Section 203(a)(2) is amended—

15 (A) in subparagraph (A)—

16 (i) by striking “(A) the” and inserting  
17 “(A) The”; and

18 (ii) by striking the semicolon at the  
19 end and inserting a period;

20 (B) in subparagraph (B)—

21 (i) by striking “(B) the” and inserting  
22 “(B) The”; and

23 (ii) by striking the semicolon at the  
24 end and inserting a period; and

1 (C) in subparagraph (C), by striking “(C)  
2 the” and inserting “(C) The”.

3 (10) Section 304(e)(2) is amended—

4 (A) in subparagraph (A)—

5 (i) by striking “(A) the” and inserting  
6 “(A) The”; and

7 (ii) by striking the semicolon at the  
8 end and inserting a period;

9 (B) in subparagraph (B)—

10 (i) by striking “(B) the” and inserting  
11 “(B) The”; and

12 (ii) by striking the semicolon at the  
13 end and inserting a period; and

14 (C) in subparagraph (C), by striking “(C)  
15 the” and inserting “(C) The”.

16 (11) The item relating to section 903 in the  
17 table of contents for chapter 9 is amended by strik-  
18 ing “licensure” and inserting “licensing”.

19 **SEC. 12. OTHER COPYRIGHT RELATED TECHNICAL AMEND-**  
20 **MENTS.**

21 (a) AMENDMENT TO TITLE 18.—Section 2319(e)(2)  
22 of title 18, United States Code, is amended by striking  
23 “107 through 120” and inserting “107 through 122”.

24 (b) STANDARD REFERENCE DATA.—(1) Section  
25 105(f) of Public Law 94–553 is amended by striking “sec-

1 tion 290(e) of title 15” and inserting “section 6 of the  
2 Standard Reference Data Act (15 U.S.C. 290e)”.

3 (2) Section 6(a) of the Standard Reference Data Act  
4 (15 U.S.C. 290e) is amended by striking “Notwith-  
5 standing” and all that follows through “United States  
6 Code,” and inserting “Notwithstanding the limitations  
7 under section 105 of title 17, United States Code,”.

Passed the Senate February 14, 2001.

Attest:

*Secretary.*



107TH CONGRESS  
1ST SESSION

**S. 320**

---

---

**AN ACT**

To make technical corrections in patent, copyright,  
and trademark laws.

S 320 ES—2

S 320 ES—3

S 320 ES—4

S 320 ES—5