

112TH CONGRESS
2D SESSION

S. 3486

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

IN THE SENATE OF THE UNITED STATES

AUGUST 2, 2012

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

A BILL

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

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 “Patent Law Treaties
5 Implementation Act of 2012”.

1 **TITLE I—HAGUE AGREEMENT**
 2 **CONCERNING INTER-**
 3 **NATIONAL REGISTRATION OF**
 4 **INDUSTRIAL DESIGNS**

5 **SEC. 101. THE HAGUE AGREEMENT CONCERNING INTER-**
 6 **NATIONAL REGISTRATION OF INDUSTRIAL**
 7 **DESIGNS.**

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

10 **“PART V—THE HAGUE AGREEMENT CONCERNING**
 11 **INTERNATIONAL REGISTRATION OF INDUS-**
 12 **TRIAL DESIGNS**

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

13 **“CHAPTER 38—INTERNATIONAL DESIGN**
 14 **APPLICATIONS**

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 Withdrawn or abandoned international design application.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

15 **“§ 381. Definitions**

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

1 “(1) the term ‘treaty’ means the Geneva Act of
2 the Hague Agreement Concerning the International
3 Registration of Industrial Designs adopted at Gene-
4 va on July 2, 1999;

5 “(2) the term ‘regulations’—

6 “(A) when capitalized, means the Common
7 Regulations under the treaty; and

8 “(B) when not capitalized, means the regu-
9 lations established by the Director under this
10 title;

11 “(3) the term ‘designation’ means a request
12 that an international registration have effect in a
13 Contracting Party to the treaty;

14 “(4) the term ‘International Bureau’ means the
15 international intergovernmental organization that is
16 recognized as the coordinating body under the treaty
17 and the Regulations;

18 “(5) the term ‘effective registration date’ means
19 the date of international registration indicated by
20 the International Bureau under the treaty;

21 “(6) the term ‘international design application’
22 means an application for international registration;
23 and

1 “(7) the term ‘international registration’ means
2 the international registration of an industrial design
3 filed under the treaty.

4 “(b) RULE OF CONSTRUCTION.—Terms and expres-
5 sions not defined in this part are to be taken in the sense
6 indicated by the treaty and the Regulations.

7 **“§ 382. Filing international design applications**

8 “(a) IN GENERAL.—Any person who is a national of
9 the United States, or has a domicile, a habitual residence,
10 or a real and effective industrial or commercial establish-
11 ment in the United States, may file an international de-
12 sign application by submitting to the Patent and Trade-
13 mark Office an application in such form, together with
14 such fees, as may be prescribed by the Director.

15 “(b) REQUIRED ACTION.—The Patent and Trade-
16 mark Office shall perform all acts connected with the dis-
17 charge of its duties under the treaty, including the collec-
18 tion of international fees and transmittal thereof to the
19 International Bureau. Subject to chapter 17 of this title,
20 international design applications shall be forwarded by the
21 Patent and Trademark Office to the International Bu-
22 reau, upon payment of a transmittal fee.

23 “(c) APPLICABILITY OF CHAPTER 16.—Except as
24 otherwise provided in this chapter, the provisions of chap-
25 ter 16 of this title shall apply.

1 “(d) APPLICATION FILED IN ANOTHER COUNTRY.—
2 An international design application on an industrial design
3 made in this country shall be considered to constitute the
4 filing of an application in a foreign country within the
5 meaning of chapter 17 of this title if the international de-
6 sign application is filed—

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

8 “(2) at the International Bureau; or

9 “(3) with an intergovernmental organization.

10 **“§ 383. International design application**

11 “In addition to any requirements pursuant to chapter
12 16 of this title, the international design application shall
13 contain—

14 “(1) a request for international registration
15 under the treaty;

16 “(2) an indication of the designated Con-
17 tracting Parties;

18 “(3) data concerning the applicant as pre-
19 scribed in the treaty and the Regulations;

20 “(4) copies of a reproduction or, at the choice
21 of the applicant, of several different reproductions of
22 the industrial design that is the subject of the inter-
23 national application, presented in the number and
24 manner prescribed in the treaty and the Regula-
25 tions;

1 “(5) an indication of the product or products
2 which constitute the industrial design or in relation
3 to which the industrial design is to be used, as pre-
4 scribed in the treaty and the Regulations;

5 “(6) the fees prescribed in the treaty and the
6 Regulations; and

7 “(7) any other particulars prescribed in the
8 Regulations.

9 **“§ 384. Filing date**

10 “(a) IN GENERAL.—Subject to subsection (b), the fil-
11 ing date of an international design application in the
12 United States shall be the effective registration date. Not-
13 withstanding the provisions of this part, any international
14 design application designating the United States that oth-
15 erwise meets the requirements of chapter 16 of this title
16 may be treated as a design application under chapter 16
17 of this title.

18 “(b) REVIEW.—An applicant may request review by
19 the Director of the filing date of the international design
20 application in the United States. The Director may deter-
21 mine that the filing date of the international design appli-
22 cation in the United States is a date other than the effec-
23 tive registration date. The Director may establish proce-
24 dures, including the payment of a surcharge, to review the
25 filing date under this section. Such review may result in

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

4 **“§ 385. Effect of international design application**

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

10 **“§ 386. Right of priority**

11 “(a) NATIONAL APPLICATION.—In accordance with
12 the conditions and requirements of subsections (a)
13 through (d) of section 119 of this title and section 172
14 of this title, a national application shall be entitled to the
15 right of priority based on a prior international design ap-
16 plication which designated at least one country other than
17 the United States.

18 “(b) PRIOR FOREIGN APPLICATION.—In accordance
19 with the conditions and requirements of subsections (a)
20 through (d) of section 119 of this title and section 172
21 of this title and the treaty and the Regulations, an inter-
22 national design application designating the United States
23 shall be entitled to the right of priority based on a prior
24 foreign application, a prior international application as de-
25 fined in section 351(c) of this title designating at least

1 one country other than the United States, or a prior inter-
2 national design application designating at least one coun-
3 try other than the United States.

4 “(c) PRIOR NATIONAL APPLICATION.—In accordance
5 with the conditions and requirements of section 120 of this
6 title, an international design application designating the
7 United States shall be entitled to the benefit of the filing
8 date of a prior national application, a prior international
9 application as defined in section 351(c) of this title desig-
10 nating the United States, or a prior international design
11 application designating the United States, and a national
12 application shall be entitled to the benefit of the filing date
13 of a prior international design application designating the
14 United States. If any claim for the benefit of an earlier
15 filing date is based on a prior international application as
16 defined in section 351(c) of this title which designated but
17 did not originate in the United States or a prior inter-
18 national design application which designated but did not
19 originate in the United States, the Director may require
20 the filing in the Patent and Trademark Office of a cer-
21 tified copy of such application together with a translation
22 thereof into the English language, if it was filed in another
23 language.

1 **“§ 387. Relief from prescribed time limits**

2 “An applicant’s failure to act within prescribed time
3 limits in connection with requirements pertaining to an
4 international design application may be excused as to the
5 United States upon a showing satisfactory to the Director
6 of unintentional delay and under such conditions, includ-
7 ing a requirement for payment of the fee specified in sec-
8 tion 41(a)(7) of this title, as may be prescribed by the
9 Director.

10 **“§ 388. Withdrawn or abandoned international design**
11 **application**

12 “Subject to sections 384 and 387 of this part, if an
13 international design application designating the United
14 States is withdrawn, renounced or canceled or considered
15 withdrawn or abandoned, either generally or as to the
16 United States, under the conditions of the treaty and the
17 Regulations, the designation of the United States shall
18 have no effect after the date of withdrawal, renunciation,
19 cancellation, or abandonment and shall be considered as
20 not having been made, unless a claim for benefit of a prior
21 filing date under section 386(c) of this part was made in
22 a national application, or an international design applica-
23 tion designating the United States, or a claim for benefit
24 under section 365(e) was made in an international appli-
25 cation designating the United States, filed before the date
26 of such withdrawal, renunciation, cancellation, or aban-

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

7 **“§ 389. Examination of international design applica-**
8 **tion**

9 “(a) IN GENERAL.—The Director shall cause an ex-
10 amination pursuant to this title of an international design
11 application designating the United States.

12 “(b) APPLICABILITY OF CHAPTER 16.—All questions
13 of substance, and, unless otherwise required by the treaty
14 and Regulations, procedures regarding an international
15 design application designating the United States shall be
16 determined as in the case of applications filed under chap-
17 ter 16 of this title.

18 “(c) FEES.—The Director may prescribe fees for fil-
19 ing international design applications, for designating the
20 United States, and for any other processing, services, or
21 materials relating to international design applications, and
22 may provide for later payment of such fees, including sur-
23 charges for later submission of fees.

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

1 ignating the United States, in accordance with the provi-
 2 sions of this title. Such patent shall have the force and
 3 effect of a patent issued on an application filed under
 4 chapter 16 of this title.

5 **“§ 390. Publication of international design applica-
 6 tion**

7 “The publication under the treaty defined in section
 8 381(a)(1) of an international design application desig-
 9 nating the United States shall be deemed a publication
 10 under section 122(b).”.

11 (b) CONFORMING AMENDMENT.—The table of parts
 12 at the beginning of title 35, United States Code, is amend-
 13 ed by adding at the end the following:

“V. The Hague Agreement concerning international registration of in-
 dustrial designs 401”.

14 **SEC. 102. CONFORMING AMENDMENTS.**

15 Title 35, United States Code, is amended—

16 (1) in section 100(i)(1)(B), by striking “right
 17 of priority under section 119, 365(a), or 365(b) or
 18 to the benefit of an earlier filing date under section
 19 120, 121, or 365(c)” and inserting “right of priority
 20 under section 119, 365(a), 365(b), 386(a), or 386(b)
 21 or to the benefit of an earlier filing date under sec-
 22 tion 120, 121, 365(c), or 386(c)”;

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

1 365(b), or to claim the benefit of an earlier filing
2 date under section 120, 121, or 365(c)” and insert-
3 ing “to claim a right of priority under section 119,
4 365(a), 365(b), 386(a), or 386(b), or to claim the
5 benefit of an earlier filing date under section 120,
6 121, 365(c), or 386(c)”;

7 (3) in section 111(b)(7)—

8 (A) by striking “section 119 or 365(a)”
9 and inserting “section 119, 365(a), or 386(a)”;
10 and

11 (B) by striking “section 120, 121, or
12 365(c)” and inserting “section 120, 121,
13 365(c), or 386(c)”;

14 (4) in section 115(g)(1), by striking “section
15 120, 121, or 365(c)” and inserting “section 120,
16 121, 365(c), or 386(c)”;

17 (5) in section 120, in the first sentence, by
18 striking “section 363” and inserting “section 363 or
19 385”;

20 (6) in section 154—

21 (A) in subsection (a)—

22 (i) in paragraph (2), by striking “sec-
23 tion 120, 121, or 365(c)” and inserting
24 “section 120, 121, 365(c), or 386(c)”;

1 (ii) in paragraph (3), by striking “sec-
2 tion 119, 365(a), or 365(b)” and inserting
3 “section 119, 365(a), 365(b), 386(a), or
4 386(b)”;

5 (B) in subsection (d)(1), by inserting “or
6 an international design application filed under
7 the treaty defined in section 381(a)(1) desig-
8 nating the United States under Article 5 of
9 such treaty” after “Article 21(2)(a) of such
10 treaty”;

11 (7) in section 173, by striking “fourteen years”
12 and inserting “15 years”;

13 (8) in section 365(c)—

14 (A) in the first sentence, by striking “or a
15 prior international application designating the
16 United States” and inserting “, a prior inter-
17 national application designating the United
18 States, or a prior international design applica-
19 tion as defined in section 381(a)(6) of this title
20 designating the United States”;

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

1 States” after “did not originate in the United
2 States”; and

3 (9) in section 366—

4 (A) in the first sentence, by striking “un-
5 less a claim” and all that follows through
6 “withdrawl.” and inserting “unless a claim for
7 benefit of a prior filing date under section
8 365(c) of this section was made in a national
9 application, or an international application des-
10 ignating the United States, or a claim for ben-
11 efit under section 386(c) was made in an inter-
12 national design application designating the
13 United States, filed before the date of such
14 withdrawal.”; and

15 (B) by striking the second sentence and in-
16 serting the following: “However, such with-
17 drawn international application may serve as
18 the basis for a claim of priority under section
19 365 (a) and (b) of this part, or under section
20 386 (a) or (b), if it designated a country other
21 than the United States.”.

22 **SEC. 103. EFFECTIVE DATE.**

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

1 (1) the date that is 1 year after the date of en-
2 actment of this Act, or

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

6 (b) APPLICABILITY OF AMENDMENTS.—

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

14 (2) EXCEPTION.—Sections 100(i) and 102(d) of
15 title 35, United States Code, as amended by this
16 title, shall not apply to an application, or any patent
17 issuing thereon, unless it is described in section
18 3(n)(1) of the Leahy-Smith America Invents Act (35
19 U.S.C. 100 note).

20 **TITLE II—PATENT LAW TREATY** 21 **IMPLEMENTATION**

22 **SEC. 201. PROVISIONS TO IMPLEMENT THE PATENT LAW** 23 **TREATY.**

24 (a) APPLICATION FILING DATE.—Section 111 of title
25 35, United States Code, is amended—

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

3 “(3) FEE, OATH OR DECLARATION, AND
4 CLAIMS.—The application shall be accompanied by
5 the fee required by law. The fee, oath or declaration,
6 and 1 or more claims may be submitted after the fil-
7 ing date of the application, within such period and
8 under such conditions, including the payment of a
9 surcharge, as may be prescribed by the Director.
10 Upon failure to submit the fee, oath or declaration,
11 and 1 or more claims within such prescribed period,
12 the application shall be regarded as abandoned.

13 “(4) FILING DATE.—The filing date of an ap-
14 plication shall be the date on which a specification,
15 with or without claims, is received in the United
16 States Patent and Trademark Office.”;

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

19 “(3) FEE.—The application shall be accom-
20 panied by the fee required by law. The fee may be
21 submitted after the filing date of the application,
22 within such period and under such conditions, in-
23 cluding the payment of a surcharge, as may be pre-
24 scribed by the Director. Upon failure to submit the

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

3 “(4) FILING DATE.—The filing date of a provi-
4 sional application shall be the date on which a speci-
5 fication, with or without claims, is received in the
6 United States Patent and Trademark Office.”; and

7 (3) by adding at the end the following:

8 “(c) PRIOR FILED APPLICATION.—The Director may
9 prescribe the conditions, including the payment of a sur-
10 charge, under which a reference made upon the filing of
11 an application under subsection (a) to a previously filed
12 application, specifying the previously filed application by
13 application number and the intellectual property authority
14 or country in which the application was filed, shall con-
15 stitute the specification and any drawings of the subse-
16 quent application for purposes of a filing date. A copy of
17 the specification and any drawings of the previously filed
18 application shall be submitted within such period and
19 under such conditions as may be prescribed by the Direc-
20 tor. A failure to submit the copy of the specification and
21 any drawings of the previously filed application within the
22 prescribed period shall result in application being regarded
23 as abandoned and treated as having never been filed.”.

24 (b) RELIEF IN RESPECT OF TIME LIMITS AND REIN-
25 STATEMENT OF RIGHTS.—

1 this subsection may be extended by an addi-
2 tional 2 months if the delay in filing the appli-
3 cation in this country within the 12-month pe-
4 riod was unintentional.”; and

5 (B) in subsection (e)—

6 (i) in paragraph (1)—

7 (I) by inserting after the first
8 sentence the following: “The Director
9 may prescribe regulations, including
10 the requirement for payment of the
11 fee specified in section 41(a)(7), pur-
12 suant to which the 12-month period
13 set forth in this subsection may be ex-
14 tended by an additional 2 months if
15 the delay in filing the application
16 under section 111(a) or section 363
17 within the 12-month period was unin-
18 tentional.”; and

19 (II) in the last sentence—

20 (aa) by striking “including
21 the payment of a surcharge” and
22 inserting “including the payment
23 of the fee specified in section
24 41(a)(7)”;

1 (bb) by striking “during the
2 pendency of the application”; and

3 (ii) in paragraph (3), by adding at the
4 end the following: “For an application for
5 patent filed under section 363 in a foreign
6 Receiving Office, the 12-month and addi-
7 tional 2 month period set forth in this sub-
8 section shall be extended as provided under
9 the treaty and Regulations as defined in
10 section 351.”; and

11 (2) in section 365(b), by adding at the end the
12 following: “The Director may establish procedures,
13 including the requirement for payment of the fee
14 specified in section 41(a)(7), to accept an uninten-
15 tionally delayed claim for priority under the treaty
16 and the Regulations, and to accept a priority claim
17 where such priority claim pertains to an application
18 that was not filed within the priority period specified
19 in the treaty and Regulations, but was filed within
20 the additional 2-month period specified under sec-
21 tion 119(a) or the treaty and Regulations.”.

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

24 (1) in the first undesignated paragraph by add-
25 ing at the end the following: “The Patent and

1 Trademark Office shall maintain a register of inter-
2 ests in applications for patents and patents and shall
3 record any document related thereto upon request,
4 and may require a fee therefor.”; and

5 (2) in the fourth undesignated paragraph by
6 striking “An assignment” and inserting “An interest
7 that constitutes an assignment”.

8 **SEC. 202. CONFORMING AMENDMENTS.**

9 (a) IN GENERAL.—Section 171 of title 35, United
10 States Code, is amended by adding at the end the fol-
11 lowing:

12 “The filing date of an application for patent for de-
13 sign shall be the date on which the specification as pre-
14 scribed by section 112 and any required drawings are
15 filed.”.

16 (b) RELIEF IN RESPECT OF TIME LIMITS AND REIN-
17 STATEMENT OF RIGHT.—Title 35, United States Code, is
18 amended—

19 (1) in section 41—

20 (A) in subsection (a), by striking sub-
21 section (7) and inserting the following:

22 “(7) REVIVAL FEES.—On filing each petition
23 for the revival of an abandoned application for a
24 patent, for the delayed payment of the fee for
25 issuing each patent, for the delayed response by the

1 patent owner in any reexamination proceeding, for
2 the delayed payment of the fee for maintaining a
3 patent in force, for the delayed submission of a pri-
4 ority or benefit claim, or for the extension of the 12-
5 month period for filing a subsequent application,
6 \$1,700.00. The Director may refund any part of the
7 fee specified in this paragraph, in exceptional cir-
8 cumstances as determined by the Director”;

9 (B) in subsection (c), by striking para-
10 graph (1) and inserting the following:

11 “(1) ACCEPTANCE.—The Director may accept
12 the payment of any maintenance fee required by
13 subsection (b) after the 6-month grace period if the
14 delay is shown to the satisfaction of the Director to
15 have been unintentional. The Director may require
16 the payment of the fee specified in paragraph (a)(7)
17 as a condition of accepting payment of any mainte-
18 nance fee after the 6-month grace period. If the Di-
19 rector accepts payment of a maintenance fee after
20 the 6-month grace period, the patent shall be consid-
21 ered as not having expired at the end of the grace
22 period.”;

23 (2) in section 119(b)(2), in the second sentence,
24 by striking “including the payment of a surcharge”

1 and inserting “including the requirement for pay-
2 ment of the fee specified in section 41(a)(7)”;

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

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

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

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

14 **“§ 151. Issue of patent**

15 “If it appears that applicant is entitled to a patent
16 under the law, a written notice of allowance of the applica-
17 tion shall be given or mailed to the applicant. The notice
18 shall specify a sum, constituting the issue fee and any re-
19 quired publication fee, which shall be paid within 3 months
20 thereafter.

21 “Upon payment of this sum the patent may issue,
22 but if payment is not timely made, the application shall
23 be regarded as abandoned.”;

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

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

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

7 “(b) An applicant’s failure to act within prescribed
8 time limits in connection with requirements pertaining to
9 an international application may be excused as provided
10 in the treaty and the Regulations.”; and

11 (9) in section 371(d), in the third sentence, by
12 striking “, unless it be shown to the satisfaction of
13 the Director that such failure to comply was un-
14 avoidable”.

15 **SEC. 203. EFFECTIVE DATE.**

16 (a) IN GENERAL.—Except as provided in subsection
17 (b), the amendments made by this title shall be effective
18 on the date that is 1 year after the date of enactment
19 of this Act and shall apply to all patents and to all applica-
20 tions for patent pending on or filed after the date that
21 is 1 year after the date of enactment of this Act.

22 (b) EXCEPTIONS.—

23 (1) SECTION 201(a).—The amendments made
24 by section 201(a) shall apply only to applications

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

3 (2) PATENT THAT IS SUBJECT OF LITIGA-
4 TION.—The amendments made by this title shall
5 have no effect with respect to any patent that is the
6 subject of litigation in an action commenced before
7 the date that is 1 year after the date of enactment
8 of this Act.

○