

***In the Senate of the United States,***

*June 26, 2002.*

*Resolved,* That the bill from the House of Representatives (H.R. 2047) entitled “An Act to authorize appropriations for the United States Patent and Trademark Office for fiscal year 2002, and for other purposes.”, do pass with the following

**AMENDMENTS:**

Strike out all after the enacting clause and insert:

1 ***SECTION 1. SHORT TITLE.***

2 *This Act may be cited as the “Patent and Trademark*

3 *Office Authorization Act of 2002”.*

1 **SEC. 2. AUTHORIZATION OF AMOUNTS AVAILABLE TO THE**  
2 **PATENT AND TRADEMARK OFFICE.**

3 (a) *IN GENERAL.*—*There are authorized to be appro-*  
4 *priated to the United States Patent and Trademark Office*  
5 *for salaries and necessary expenses for each of the fiscal*  
6 *years 2003 through 2008 an amount equal to the fees esti-*  
7 *mated by the Secretary of Commerce to be collected in each*  
8 *such fiscal year, respectively, under—*

9 (1) *title 35, United States Code; and*

10 (2) *the Act entitled “An Act to provide for the*  
11 *registration and protection of trademarks used in*  
12 *commerce, to carry out the provisions of certain inter-*  
13 *national conventions, and for other purposes”, ap-*  
14 *proved July 5, 1946 (15 U.S.C. 1051 et seq.) (com-*  
15 *monly referred to as the Trademark Act of 1946).*

16 (b) *ESTIMATES.*—*Not later than February 15, of each*  
17 *fiscal year, the Undersecretary of Commerce for Intellectual*  
18 *Property and the Director of the Patent and Trademark*  
19 *Office (in this Act referred to as the Director) shall submit*  
20 *an estimate of all fees referred to under subsection (a) to*  
21 *be collected in the next fiscal year to the chairman and*  
22 *ranking member of—*

23 (1) *the Committees on Appropriations and Judi-*  
24 *ciary of the Senate; and*

25 (2) *the Committees on Appropriations and Judi-*  
26 *ciary of the House of Representatives.*

1 **SEC. 3. ELECTRONIC FILING AND PROCESSING OF PATENT**  
2 **AND TRADEMARK APPLICATIONS.**

3 (a) *ELECTRONIC FILING AND PROCESSING.*—Not later  
4 than December 1, 2004, the Director shall complete the de-  
5 velopment of an electronic system for the filing and proc-  
6 essing of patent and trademark applications, that—

7 (1) *is user friendly; and*

8 (2) *includes the necessary infrastructure to—*

9 (A) *allow examiners and applicants to send*  
10 *all communications electronically; and*

11 (B) *allow the Office to process, maintain,*  
12 *and search electronically the contents and his-*  
13 *tory of each application.*

14 (b) *AUTHORIZATION OF APPROPRIATIONS.*—Of  
15 amounts authorized under section 2, there are authorized  
16 to be appropriated to carry out subsection (a) of this section  
17 not more than \$50,000,000 for each of fiscal years 2003 and  
18 2004. Amounts made available under this subsection shall  
19 remain available until expended.

20 **SEC. 4. ANNUAL REPORTS ON STRATEGIC PLAN.**

21 *In each of the 5 calendar years following the date of*  
22 *enactment of this Act, the Secretary of Commerce shall sub-*  
23 *mit a report to the Committees on the Judiciary of the Sen-*  
24 *ate and the House of Representatives on—*

25 (1) *the progress made in implementing the 21st*  
26 *Century Strategic Plan issued on June 3, 2002; and*

1           (2) *any amendments made to the plan.*

2   **SEC. 5. DETERMINATION OF SUBSTANTIAL NEW QUESTION**  
3                           **OF PATENTABILITY IN REEXAMINATION PRO-**  
4                           **CEEDINGS.**

5           (a) *IN GENERAL.*—Sections 303(a) and 312(a) of title  
6 35, United States Code, are each amended by adding at  
7 the end the following: “The existence of a substantial new  
8 question of patentability is not precluded by the fact that  
9 a patent or printed publication was previously cited by or  
10 to the Office or considered by the Office.”.

11          (b) *EFFECTIVE DATE.*—The amendments made by this  
12 section shall apply with respect to any determination of the  
13 Director of the United States Patent and Trademark Office  
14 that is made under section 303(a) or 312(a) of title 35,  
15 United States Code, on or after the date of the enactment  
16 of this Act.

17   **SEC. 6. APPEALS IN INTER PARTES REEXAMINATION PRO-**  
18                           **CEEDINGS.**

19          (a) *APPEALS BY THIRD-PARTY REQUESTER IN PRO-*  
20 *CEEDINGS.*—Section 315(b) of title 35, United States Code,  
21 is amended to read as follows:

22           “(b) *THIRD-PARTY REQUESTER.*—A *third-party*  
23 *requester*—

24                   “(1) *may appeal under the provisions of section*  
25           *134, and may appeal under the provisions of sections*

1       141 through 144, with respect to any final decision  
2       favorable to the patentability of any original or pro-  
3       posed amended or new claim of the patent; and

4               “(2) may, subject to subsection (c), be a party to  
5       any appeal taken by the patent owner under the pro-  
6       visions of section 134 or sections 141 through 144.”.

7       (b) *APPEAL TO BOARD OF PATENT APPEALS AND*  
8       *INTERFERENCES.*—Section 134(c) of title 35, United States  
9       Code, is amended by striking the last sentence.

10       (c) *APPEAL TO COURT OF APPEALS FOR THE FEDERAL*  
11       *CIRCUIT.*—Section 141 of title 35, United States Code, is  
12       amended in the third sentence by inserting “, or a third-  
13       party requester in an inter partes reexamination pro-  
14       ceeding, who is” after “patent owner”.

15       (d) *EFFECTIVE DATE.*—The amendments made by this  
16       section apply with respect to any reexamination proceeding  
17       commenced on or after the date of the enactment of this  
18       Act.

Amend the title so as to read: “An Act to authorize appropriations for the United States Patent and Trademark Office for fiscal years 2003 through 2008, and for other purposes.”.

Attest:

*Secretary.*



107TH CONGRESS  
2D SESSION

**H. R. 2047**

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**AMENDMENTS**