

Issues with certain priority documents retrieved from the European Union Intellectual Property Office via the World Intellectual Property Organization Digital Access Service

Summary

As part of the United States Patent and Trademark Office's (USPTO) ongoing efforts to automate and enhance patent examination practices to support robust and reliable patent rights and speed the issuance of patents, the USPTO continues to support the exchange of priority documents with other foreign intellectual property (IP) offices via the World Intellectual Property Organization Digital Access Service (WIPO DAS). The WIPO DAS is an electronic system that allows priority documents to be securely exchanged between participating IP offices and allows applicants to meet the requirements of the Paris Convention for certification in an electronic environment. This notice provides information regarding recent technical issues with WIPO DAS experienced by the European Union Intellectual Property Office (EUIPO) and provides guidance for impacted design patent applicants and owners.

Background

The EUIPO experienced technical issues with WIPO DAS that resulted in: (1) retrieval of priority documents having an incorrect filing date on the EUIPO certification page, but the correct filing date identified on the WIPO DAS Certificate of Availability page and on the “Date of receipt” identified on the underlying application; and (2) retrieval of a Certificate of Registration when the design was registered, rather than the priority document itself (that is, the copy of the original application with a certification by the EUIPO).

Once alerted to the issues, the USPTO worked with the EUIPO to identify the priority documents retrieved in U.S. applications and patents that were impacted by the technical issues at the EUIPO. In January 2023, the EUIPO made the corrected priority documents available through WIPO DAS and the USPTO began retrieving the corrected priority documents in the identified applications and patents. This corrective action was completed in April 2023.

The EUIPO has recently informed the USPTO that the technical issue concerning the incorrect filing date on the EUIPO certification page was resolved in August 2022, and that the technical issue concerning retrieval of a Certificate of Registration was resolved in December 2022. Therefore, priority documents retrieved from the EUIPO after those respective dates should not have these issues. The EUIPO informed the USPTO of an update to their system so that the priority document itself (that is, the copy of the original application with a certification by the EUIPO) may be retrieved through WIPO DAS, even after the Certificate of Registration is available.

Guidance for impacted design patent applicants and design patent owners

(1) Retrieval of priority documents that contained an incorrect filing date on the EUIPO certification page

A. For pending design applications: In some of the impacted applications, applicants may have been notified of an incorrect filing date on the EUIPO certification page in an Office action by the examiner or in a notice by the Patent Publications Branch. If a response is still needed, applicants should clarify the record by filing a response to the Office action or notice stating that the incorrect filing date on the EUIPO certification page was due to a known technical issue in the EUIPO and that the correct filing date is identified on the WIPO DAS Certificate of Availability page. Applicants may refer to this Official Gazette notice in their response.

B. For design patents: No corrective action is needed in design patents to address this technical issue when the design patent includes the correct priority claim, the EUIPO priority document was retrieved prior to patent grant, and the correct filing date is identified on the WIPO DAS Certificate of Availability page. If the priority claim was removed before the patent issued due to failure to respond to a notice regarding the incorrect filing date identified on the EUIPO certification page, patent owners may want to consider filing a request for a certificate of correction under 37 CFR 1.323 to include the priority claim. The request should explain that the incorrect filing date on the EUIPO certification page was due to a known technical issue in the EUIPO and that the correct filing date is identified on the WIPO DAS Certificate of Availability page. Patent owners may refer to this Official Gazette notice in the request.

(2) Retrieval of a certificate of registration when the design was registered, rather than the priority document itself

A. For pending design applications: Applicants should carefully review the record in any design applications that claim priority to an application filed in the EUIPO to ensure that the correct priority document from the EUIPO has been retrieved. The certified copy which must be filed is a copy of the original foreign application with a certification by the patent office of the foreign country in which it was filed. See section 215, subsection II, of the Manual of Patent Examining Procedure (MPEP) (9th ed., rev. 7.2022, February 2023). The Certificate of Registration is not a copy of the original EUIPO application and, therefore, does not satisfy the requirement for a certified copy. Note that if a Certificate of Registration has been issued for the Registered Community Design, the document that was retrieved as a result of the corrective action by the USPTO will include both the Certificate of Registration and the correct priority document.

In the rare situation where the application only contains a Certificate of Registration, applicants should take steps to ensure that the correct priority document is retrieved through WIPO DAS or filed in paper. Applicants are reminded that if the correct priority document is filed after the date the issue fee is paid, the patent will not include the priority claim unless corrected by a certificate of correction under 37 CFR 1.323. See 37 CFR 1.55(g). For questions about retrieval of a priority document via the WIPO DAS

Exchange, contact the Patent Electronic Business Center (EBC) at 1-866-217-9197 (toll-free) or 571-272-4100 (local).

B. For design patents: In situations where the correct priority document was retrieved after payment of the issue fee, but before patent grant, and the patent does not include the priority claim, the patent owner should submit a request for a certificate of correction under 37 CFR 1.323. A petition under 37 CFR 1.55(g) is not needed in this situation since the correct priority document was received before the patent grant.

In situations where the correct priority document was retrieved after the patent grant, the patentee should submit a petition under 37 CFR 1.55(g) for delayed submission of a certified copy, and, if the priority claim is not on the patent, request a certificate of correction under 37 CFR 1.323. See section 216.01, subsection I.A, of the MPEP.

Important reminders

In general, when claiming foreign priority, applicants are encouraged to access the Patent Center at www.uspto.gov/PatentStatus as necessary to confirm receipt by the USPTO of appropriate foreign priority documents. Applicants relying on the retrieval process for electronic priority document exchange continue to bear the ultimate responsibility for ensuring that the correct priority document is filed during the pendency of the application and before the patent is issued. See section 215.02(a) of the MPEP.

For more information regarding the electronic priority document exchange (PDX) program and WIPO DAS, see www.uspto.gov/PatentsPDX.

Contact information

For questions about retrieval of a priority document via the WIPO DAS Exchange, contact the Patent EBC at 1-866-217-9197 (toll-free) or 571-272-4100 (local). For questions about filing a petition for delayed submission of a certified copy under 37 CFR 1.55(g), contact the Office of Petitions at 571-272-3282. For any other questions about this notice, contact Erin M. Harriman, Senior Legal Advisor, at 571-272-7747, Eugenia A. Jones, Senior Legal Advisor, at 571-272-7727, or Kristie A. Mahone, Senior Legal Advisor, at 571-272-9016, of the Office of Patent Legal Administration; or PatentPractice@uspto.gov.

Dated: _____

Katherine K. Vidal
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office