



UNITED STATES PATENT AND TRADEMARK OFFICE

**MILESTONE CALENDAR: Priority Document Exchange Program**

March 2013

**2006**

**June 13, 2006**

*Notice of recent amendment to filing receipt adding indication regarding request to retrieve priority application*, 1307 Off. Gaz. Pat. Office 66 (June 13, 2006)

Announcement that the USPTO will include an indication on the filing receipt that a separate written request to retrieve has been recorded in a U.S. application

**2007**

**January 16, 2007**

*Changes to implement priority document exchange between intellectual property offices, Final Rule*, 72 Fed. Reg. 1664 (January 16, 2007) and 1315 Off. Gaz. Pat. Office 63 (February 13, 2007)

Direct electronic retrieval of EP priority applications by the United States Patent and Trademark Office (USPTO) from the European Patent Office (EPO) is possible  
Direct electronic retrieval of non-EP applications by the USPTO from the EPO is possible upon filing a proper request to retrieve (e.g., form PTO/SB/38)  
Direct electronic access by the EPO to U.S. priority applications is possible  
Direct electronic access by the EPO to a non-U.S. priority document contained within a U.S. application is possible

**April 23, 2007**

*Electronic exchange of priority documents*, 1318 Off. Gaz. Pat. Office 116 (May 15, 2007)

Reminder that written authority under 35 U.S.C. 122 and 37 CFR 1.14(h) is required to be filed in certain U.S. priority applications in order to permit the EPO access to certain U.S. priority applications

**June 26, 2007**

*Simplification of the electronic exchange of priority documents*, 1319 Off. Gaz. Pat. Office 150 (June 26, 2007)

Automatic direct electronic attempts to retrieve EP priority applications by the USPTO from the European Patent Office (EPO) is possible  
Waiver of the requirement that applicant file a request to retrieve in a separate document pursuant to 37 CFR 1.55(d)(1)(i) and 37 CFR 1.14(h)(2)  
Requirement for the certified copy of the foreign application is considered satisfied if the requirements of 37 CFR 1.55(d)(1)(ii) and (iii) are met

## **MILESTONE CALENDAR: Priority Document Exchange Program**

**July 28, 2007**

***Addition of Japan Patent Office as participating foreign intellectual property office in electronic exchange of priority documents, 1320 Off. Gaz. Pat. Office 173 (July 31, 2007)***

Automatic direct electronic attempts to retrieve JP priority applications by the USPTO from the Japan Patent Office (JPO) is possible  
Direct electronic access to U.S priority applications by the JPO is possible

## **2008**

**March 11, 2008**

***Enhancement of priority document exchange program and USPTO declaration form, 1328 Off. Gaz. Pat. Office 90 (March 11, 2008)***

Modification of the “Declaration for Utility or Design Patent Application” (form PTO/SB/01) to include a check box enabling the applicant to include an Authorization to Permit Access to Application by Participating Offices

**October 14, 2008**

***Addition of Korean Intellectual Property Office as participating foreign intellectual property office in electronic exchange of priority documents and further procedural information, 1336 Off. Gaz. Pat. Office 94 (November 11, 2008)***

Automatic direct electronic attempts to retrieve KR priority applications by the USPTO from the Korean Intellectual Property Office (KIPO) is possible  
Direct electronic access to U.S. priority applications by the KIPO is possible  
Indication that design applications are excluded  
Indication that PCT international applications are excluded

## **2009**

**April 20, 2009**

***Addition of World Intellectual Property Organization as participating foreign intellectual property office in electronic exchange of priority documents, 1343 Off. Gaz. Pat. Office 347 (June 30, 2009)***

Electronic retrieval by the USPTO via the World Intellectual Property Organization (WIPO) Digital Access Service (DAS) of foreign priority applications filed with participating DAS depositing offices (includes PCT/IB applications filed with the International Bureau Receiving Office (RO/IB))<sup>1</sup> and registered into the WIPO DAS

***Electronic exchange of non-participating office priority documents between the Japan Patent Office and the United States Patent and Trademark Office, 1343 Off. Gaz. Pat. Office 348 (June 30, 2009)***

Electronic retrieval to be attempted by the USPTO from the JPO of non-JP priority documents contained within a JP application upon filing a proper request to retrieve (e.g., form PTO/SB/38)

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<sup>1</sup> The foreign priority applications filed with participating DAS depositing offices includes only RO/IB applications which must be registered into the WIPO DAS and steps taken to give the USPTO access to the application.

### **October 1, 2009**

See WIPO DAS announcement at *Addition of World Intellectual Property Office as participating foreign intellectual property office in electronic exchange of priority documents*, 1343 Off. Gaz. Pat. Office 347 (June 30, 2009)

Electronic retrieval by the USPTO via the WIPO DAS of foreign priority applications filed with participating DAS depositing offices<sup>2</sup> (includes ES priority applications filed with the Spanish Patent and Trademark Office (SPTO)) and registered into the WIPO DAS

Electronic access by the SPTO via the WIPO DAS to U.S. priority applications<sup>3</sup> registered into the WIPO DAS

### **October 4, 2009**

See WIPO DAS announcement at *Addition of World Intellectual Property Office as participating foreign intellectual property office in electronic exchange of priority documents*, 1343 Off. Gaz. Pat. Office 347 (June 30, 2009)

Electronic retrieval by the USPTO via the WIPO DAS of foreign priority applications filed with participating DAS depositing offices<sup>4</sup> (includes GB priority applications filed with the United Kingdom Intellectual Property Office (UKIPO)) and registered into the WIPO DAS

Electronic access by the UKIPO via the WIPO DAS to U.S. priority applications<sup>5</sup> registered into the WIPO DAS

### **December 12, 2009**

See WIPO DAS announcement at *Addition of World Intellectual Property Office as participating foreign intellectual property office in electronic exchange of priority documents*, 1343 Off. Gaz. Pat. Office 347 (June 30, 2009)

Electronic retrieval by the USPTO via the WIPO DAS of foreign priority applications filed with participating DAS depositing offices<sup>6</sup> (includes AU priority applications filed with the Australia Intellectual Property Office (IPAU)) and registered into the WIPO DAS

Electronic access by the IPAU via the WIPO DAS to U.S. priority applications<sup>7</sup> registered into the WIPO DAS

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<sup>2</sup> The foreign priority applications filed with participating DAS depositing offices now includes ES applications which must be registered into the WIPO DAS and steps taken to give the USPTO access to the application.

<sup>3</sup> The U.S. application must be registered into the WIPO DAS and steps taken to give the SPTO access to the application. Successful registration requires that the U.S. application is patented, published, or otherwise available to a foreign intellectual property office (*e.g.*, foreign filing license granted and proper written authorization to permit access).

<sup>4</sup> The foreign priority applications filed with participating DAS depositing offices now includes GB applications which must be registered into the WIPO DAS and steps taken to give the USPTO access to the application.

<sup>5</sup> The U.S. application must be registered into the WIPO DAS and steps taken to give the UKIPO access to the application. Successful registration requires that the U.S. application is patented, published, or otherwise available to a foreign intellectual property office (*e.g.*, foreign filing license granted and proper written authorization to permit access).

<sup>6</sup> The foreign priority applications filed with participating DAS depositing offices includes AU applications which must be registered into the WIPO DAS and steps taken to give the USPTO access to the application.

<sup>7</sup> The U.S. application must be registered into the WIPO DAS and steps taken to give the IPAU access to the application. Successful registration requires that the U.S. application is patented, published, or otherwise available to a foreign intellectual property office (*e.g.*, foreign filing license granted and proper written authorization to permit access).

## 2010

### **January 1, 2010**

See WIPO DAS announcement at *Addition of World Intellectual Property Office as participating foreign intellectual property office in electronic exchange of priority documents*, 1343 Off. Gaz. Pat. Office 347 (June 30, 2009)

Electronic access by the International Bureau (pursuant to PCT Rule 17) via the WIPO DAS to U.S. (and other DAS Depositing Office) priority applications<sup>8</sup> registered into the WIPO DAS

## 2011

### **April 15, 2011**

See WIPO DAS announcement at *Addition of World Intellectual Property Office as participating foreign intellectual property office in electronic exchange of priority documents*, 1343 Off. Gaz. Pat. Office 347 (June 30, 2009)

Electronic retrieval by the USPTO via the WIPO DAS of foreign priority applications filed with participating DAS depositing offices<sup>9</sup> (includes FI and RO/FI priority applications filed with the National Board of Patents and Registration of Finland (NBRP)) and registered into the WIPO DAS

Electronic access by the NBPR via the WIPO DAS to U.S. priority applications<sup>10</sup> registered into the WIPO DAS

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<sup>8</sup> The service is available for PCT international applications filed in any receiving Office and requires applicant to take additional steps:

**Register the earlier U.S. (or other DAS Depositing Office) application**

The earlier U.S. (or other DAS Depositing Office) application must be registered into the WIPO DAS and steps taken to give the International Bureau (IB) of the World Intellectual Property Organization access to the application. Successful registration of an earlier U.S. application requires that it is patented, published, or otherwise available to a foreign intellectual property office (*e.g.*, foreign filing license granted and proper written authorization to permit access). Successful registration of an earlier DAS Depositing Office other than the U.S. can be found at the WIPO DAS Web site or the relevant DAS Depositing Office Web site.

**Take the necessary action to give the IB access to the earlier application**

Applicant must manage the Access Control List associated with the earlier application to give access to the application by the IB.

**Request the IB to obtain the U.S. (or other DAS Depositing Office) application from a digital library**

The applicant must request the IB to obtain the earlier U.S. (or other DAS Depositing Office) application from a digital library (*e.g.*, marking the appropriate item in Box No. VI of the Request (Form PCT/RO/101)).

*NOTE: It is recommended, however, that applicants request the receiving Office to prepare and transmit an earlier U.S. application when the PCT international application is filed in the United States Receiving Office (RO/US) to avoid having to register the earlier U.S. application into the WIPO DAS.*

<sup>9</sup> The foreign priority applications filed with participating DAS depositing offices includes FI and RO/FI applications which must be registered into the WIPO DAS and steps taken to give the USPTO access to the application.

<sup>10</sup> The U.S. application must be registered into the WIPO DAS and steps taken to give the NBPR access to the application. Successful registration requires that the U.S. application is patented, published, or otherwise available to a foreign intellectual property office (*e.g.*, foreign filing license granted and proper written authorization to permit access).

### **November 1, 2011**

See WIPO DAS announcement at *Addition of World Intellectual Property Office as participating foreign intellectual property office in electronic exchange of priority documents*, 1343 Off. Gaz. Pat. Office 347 (June 30, 2009)

Electronic retrieval by the USPTO via the WIPO DAS of foreign priority applications filed with participating DAS depositing offices<sup>11</sup> (includes DK and RO/DK priority applications filed with the Danish Patent and Trademark Office) and registered into the WIPO DAS  
The Danish Patent and Trademark Office notification does not indicate that it will serve as a DAS accessing Office, so U.S. applications cannot be made available to that Office at this time

### **November 1, 2011**

See WIPO DAS announcement at *Addition of World Intellectual Property Office as participating foreign intellectual property office in electronic exchange of priority documents*, 1343 Off. Gaz. Pat. Office 347 (June 30, 2009)

Electronic retrieval by the USPTO via the WIPO DAS of foreign priority applications filed with participating DAS depositing offices<sup>12</sup> (includes SE and RO/SE priority applications filed with the Swedish Patent and Trademark Office) and registered into the WIPO DAS  
The Swedish Patent and Trademark Office notification does not indicate that it will serve as a DAS accessing Office, so U.S. applications cannot be made available to that Office at this time

## **2012**

### **March 1, 2012**

See WIPO DAS announcement at *Addition of World Intellectual Property Office as participating foreign intellectual property office in electronic exchange of priority documents*, 1343 Off. Gaz. Pat. Office 347 (June 30, 2009)

Electronic retrieval by the USPTO via the WIPO DAS of foreign priority applications filed with participating DAS depositing offices<sup>13</sup> (includes CN priority applications filed with the State Intellectual Property Office of the People's Republic of China (SIPO)) and registered into the WIPO DAS

Electronic access by the SIPO via the WIPO DAS to U.S. priority applications<sup>14</sup> registered into the WIPO DAS

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<sup>11</sup> The foreign priority applications filed with participating DAS depositing offices includes DK and RO/DK applications which must be registered into the WIPO DAS and steps taken to give the USPTO access to the application.

<sup>12</sup> The foreign priority applications filed with participating DAS depositing offices includes SE and RO/SE applications which must be registered into the WIPO DAS and steps taken to give the USPTO access to the application.

<sup>13</sup> The foreign priority applications filed with participating DAS depositing offices includes CN applications which must be registered into the WIPO DAS and steps taken to give the USPTO access to the application.

<sup>14</sup> The U.S. application must be registered into the WIPO DAS and steps taken to give the SIPO access to the application. Successful registration requires that the U.S. application is patented, published, or otherwise available to a foreign intellectual property office (*e.g.*, foreign filing license granted and proper written authorization to permit access).

### **September 16, 2012**

See 37 CFR 1.55(d)(1)(ii) final rule at *Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act*, 77 FR 48776 (August 14, 2012)

Electronic retrieval by the USPTO of foreign priority applications from a participating foreign intellectual property office under the Priority Document Exchange program, including the WIPO DAS, the foreign application must be identified on the Application Data Sheet (ADS).

## **2013**

### **March 16, 2013**

See 37 CFR 1.55 final rule at *Changes to Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act*, 78 FR 11024 (February 14, 2013)

37 CFR 1.55 as amended provides that compliance with 1.55(h) will satisfy the requirement for a certified copy of the foreign priority application as long as the priority document is obtained under the Priority Document Exchange program before the expiration of the time limit under 1.55(g).

37 CFR 1.55 as amended requires a separate written request to retrieve only when the foreign priority application is filed in a nonparticipating foreign intellectual property office and a certified copy of the foreign priority application is contained in an EP or JP application, which also claims priority to the foreign application. Form SB/38 may be used for this purpose.

### **March 18, 2013**

See *Addition WIPO DAS 2.0 Implementation*,

[http://www.uspto.gov/patents/process/file/pdx/pdx\\_index.jsp](http://www.uspto.gov/patents/process/file/pdx/pdx_index.jsp)

Implementation of the WIPO DAS 2.0 Access Code Procedure which (i) simplifies U.S. application registration into the WIPO DAS, and (ii) increases security of foreign application retrieval via the WIPO DAS, as follows:

- the USPTO registers into the WIPO Digital Access Service U.S. applications filed on or after March 18, 2013 when the application has been published, when the patent has been granted, or earlier when an authorization to permit access by foreign intellectual property office has been accepted, and
- the USPTO registers, at the request of the applicant, U.S. applications filed prior to March 18, 2013 when the applicant is unable to register the U.S. application using the WIPO DAS applicant registration portal, and
- the applicant furnishes to the USPTO the access code for foreign priority applications that are to be retrieved via the WIPO DAS, which the USPTO provides during the retrieval process together with the country code, application number and filing date of the foreign priority application.