



UNITED STATES PATENT AND TRADEMARK OFFICE

Overview of the Electronic Priority Document Exchange Program

August 2011

In January 2007, the United States Patent and Trademark Office (USPTO) implemented a procedure for direct electronic priority document exchange with participating foreign intellectual property offices. The USPTO established agreements to obtain and provide priority documents with the European Patent Office (EPO) beginning January 16, 2007, the Japan Patent Office (JPO) beginning July 28, 2007, the Korean Intellectual Property Office (KIPO) beginning October 14, 2008, and the Digital Access Service of the World Intellectual Property Organization (WIPO DAS) beginning April 20, 2009. See 37 CFR 1.14(h) and 1.55(d).

In accordance with the established PDX procedure, if an application filed with the EPO, the JPO or the KIPO claims foreign priority to a U.S. provisional or nonprovisional application, that office of second filing (OSF) will automatically attempt to retrieve an electronic copy of the U.S. application. However, the USPTO will only allow access to a copy of the U.S. application as-filed to the OSF if the U.S. priority application has received a foreign filing license in accordance with 37 CFR 5.11 and: (1) the applicant of the U.S. application provided an appropriate written authority to permit access to the application by participating offices (e.g., form PTO/SB/39 or form PTO/SB/01) under 37 CFR 1.14 and 35 U.S.C. 122 (if the U.S. application has not yet been published); or (2) the U.S. application has been published or patented. Written authority under 37 CFR 1.14 and 35 U.S.C. 122 may be provided by filing either a properly signed (1) "Authorization to Permit Access to Application by Participating Offices" (form [PTO/SB/39](#) or its equivalent); or (2) "Declaration for Utility or Design Application" (form [PTO/SB/01](#) or its equivalent) in which the "Authorization to Permit Access by Participating Offices" has been checked.

The PDX procedure established with the WIPO Digital Access Service (DAS) for Priority Documents differs from the PDX procedure described above for the EPO, the JPO and the KIPO. PDX via the WIPO DAS requires the prerequisite steps of (1) DAS accessibility confirmation/registration; and (2) ensuring that the OSF has been given access to the foreign application via the DAS Access Control List. The WIPO provides a DAS Portal Web site for performing these steps:

- https://webaccess.wipo.int/priority_documents/

Additional instructions about the WIPO DAS procedure can be found on the USPTO Web site at:

- Access to U.S. Priority Applications by the WIPO via the WIPO Digital Access Service
- USPTO Retrieval of Foreign Priority Applications from the WIPO via the WIPO Digital Access Service

Not all U.S. applications are accessible to the participating intellectual property offices. For example, the USPTO is unable to transmit as-filed U.S. design applications and international applications filed under the Patent Cooperation Treaty with the United States Receiving Office (RO/US). These applications are not supported by the PDX program because all content of a U.S.

Overview of the Electronic Priority Document Exchange Program

design application or PCT international application is not available due to technical limitations of the PDX system.

Retrieval of a foreign application to which priority is claimed will not be attempted in all U.S. applications. For example, the USPTO will not attempt retrieval of a foreign priority application to which priority is claimed in a U.S. design application or a national phase application submitted under 35 U.S.C. 371. The first exception is made because most U.S. design applications claim priority to foreign design applications which are not available to the PDX system. The second exception is made because most applicants meet the requirements of PCT Rule 17.1(a)-(c) by providing a certified copy of the foreign priority application during the international phase and the International Bureau transmits, independently of the PDX system, a copy of the priority application to the USPTO in its capacity as Designated/Elected Office at the time of national phase entry, which renders retrieval by the PDX system unnecessary.

There is no fee for the USPTO to provide U.S. applications to participating offices or for the USPTO to retrieve foreign applications from participating offices.