

**Electronic Exchange of Non-Participating Office Priority Documents
Between the Japan Patent Office and the United States Patent and Trademark Office**

Requests by the USPTO for non-JPO priority documents from the JPO under 37 CFR 1.55(d)(2).

Since April 20, 2009, the United States Patent and Trademark Office (USPTO) has had the ability to electronically retrieve non-participating office priority documents from the Japan Patent Office (JPO) as requested by an applicant under 37 CFR 1.55(d)(2) when applicant has also filed a corresponding application with the JPO and that corresponding application contains a non-participating office priority document. For example, if an applicant files a U.S. application under 35 U.S.C. 111(a) claiming priority to an application previously filed with a non-participating office (e.g., an Australia national application filed with the Australian Patent Office) and the applicant desires the USPTO to electronically obtain that priority document through the Priority Document Exchange (PDX) system from a corresponding JPO application file, the applicant is still required to file a request to retrieve the electronic priority document. The applicant must file the request to retrieve in a separate document (e.g., form PTO/SB/38) under 37 CFR 1.55(d)(1)(i), identifying both the JPO application number and the application number of the Australia priority application. This is the same procedure that went into effect between the USPTO and the European Patent Office (EPO) on January 16, 2007. See “Changes to Implement Priority Document Exchange Between Intellectual Property Offices,” published in the Federal Register at 72 FR 1664 (January 16, 2007) and “Simplification of the Electronic Exchange of Priority Documents,” published in the Off. Gaz. Patent Office at 1319 OG 150 (June 26, 2007). The JPO will provide the USPTO access to priority documents issued by a non-participating office and filed with the JPO, unless the non-participating office has expressly requested the JPO do otherwise.

Applicants continue to bear the ultimate responsibility for ensuring that the priority document is filed by the time of patent grant as required under 37 CFR 1.55(a). Accordingly, applicants are encouraged to check Private PAIR as necessary to confirm receipt of appropriate documents. Priority documents retrieved from the JPO will bear the IFW document title of “Priority documents electronically retrieved by USPTO from a participating IP Office.”

Access by the JPO to U.S. applications containing non-USPTO priority documents.

Since April 1, 2009, the JPO has had the ability to electronically retrieve non-USPTO priority documents contained in a U.S. application from the USPTO. However, the USPTO will release copies of non-USPTO priority applications to the JPO only if the U.S. application containing the non-USPTO priority application has received a foreign filing license in accordance with 37 CFR 5.11, and (1) the applicant of the U.S. application has 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 in a U.S. provisional or nonprovisional application either a properly signed (1) “Authorization to Permit Access to

Application by Participating Offices” (form PTO/SB/39); or (2) “Declaration for Utility or Design Application” (form PTO/SB/01) in which the “Authorization to Permit Access by Participating Offices” has been checked. Form PTO/SB/39 is available from the USPTO Internet Web site at <http://www.uspto.gov/web/forms/sb0039.pdf>. Form PTO/SB/01 is also available from the USPTO Internet Web site at <http://www.uspto.gov/web/forms/sb0001.pdf>. Note that the USPTO cannot currently transmit a non-USPTO priority document contained in design applications or PCT international applications through the PDX system. Similarly, design applications cannot be transmitted through the PDX system.

Applicants are, however, advised that if the applicant files an Authorization to Permit Access to Application by Participating Offices (e.g., using either form PTO/SB/39 or PTO/SB/01), there is no procedure in place to promptly revoke the authorization so as to prevent access by a participating office. Accordingly, if an applicant does not wish a participating office to have access to the applicant’s application, the applicant should not file the Authorization to Permit Access to Application by Participating Offices. Instead the applicant should use the traditional procedure of obtaining and directly providing a certified copy of the non-USPTO priority document to any participating office in which the applicant files a patent application claiming priority to the non-USPTO priority document.

Additional information concerning access to non-USPTO priority documents contained with a U.S. application.

Applicants are strongly encouraged to file written authority in accordance with 37 CFR 1.14 and 35 U.S.C. 122 for any U.S. application containing a non-USPTO priority document in which there is any chance that they will file a subsequent counterpart application in the JPO (or EPO) so that the JPO (or EPO) may timely and successfully retrieve the non-USPTO priority document from the U.S. application containing the non-USPTO priority document at no charge to applicant.

Applicants are advised that JPO (and EPO) regulations require a copy of a priority document to be filed with the corresponding JPO (or EPO) application no later than 16 months from the priority date. Because U.S. applications are ordinarily published by the USPTO at 18 months from the earliest effective filing date, most U.S. applications that contain the non-USPTO priority document that is the basis for a foreign priority claim in a JPO (or EPO) application will not be published by the time the applicant is required to provide a copy of the non-participating office application to the JPO (or EPO). Therefore, in most cases it will be necessary to provide the USPTO with appropriate written authorization (under 35 U.S.C. 122 and 37 CFR 1.14) for the JPO (or EPO) to obtain a copy of the non-USPTO priority document from the USPTO, e.g., by submitting a properly signed form PTO/SB/39.

Neither the USPTO nor the JPO or the EPO charge a fee to either the applicant or the other office for this service.

The Korean Intellectual Property Office (KIPO) does not allow non-participating office priority documents to be retrieved by the USPTO. Similarly, the KIPO does not retrieve non-participating office priority documents from the USPTO.

For further information please contact one of the individuals identified below:

Don Levin
TDA Project Manager
United States Patent and
Trademark Office
571-272-3785
PDX@uspto.gov

OR Tamara Graysay
Special Program Examiner
United States Patent and
Trademark Office
571-272-6728
PDX@uspto.gov

OR Mark Polutta
Senior Legal Advisor
United States Patent and
Trademark Office
571-272-7709
PDX@uspto.gov

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JOHN J. DOLL
Acting Under Secretary of Commerce for Intellectual Property and
Acting Director of the United States Patent and Trademark Office