

Electronic Exchange of Priority Documents

In January 2007, the United States Patent and Trademark Office (USPTO) implemented direct electronic priority document exchange with the European Patent Office (EPO). See "Changes to Implement Priority Document Exchange Between Intellectual Property Offices," published in the *Federal Register* at 72 FR 1664 (January 16, 2007).

This service will be expanded later in 2007 to include electronic exchange of priority documents between the USPTO and the Japan Patent Office.

There is no fee for this service.

The USPTO and the EPO, implemented this program to permit electronic exchange of priority documents between the two Offices. Under this program, if a US application claims foreign priority to an EPO patent application, the applicant may request that the USPTO electronically retrieve a copy of the EPO patent application. Form PTO/SB/38 entitled "Request to Retrieve Electronic Priority Application(s)" is available for making such a request in accordance with 37 CFR 1.55(d) from the USPTO website at <http://www.uspto.gov/web/forms/sb0038.pdf>. In addition, if applicant claims foreign priority to a (non-EPO) foreign application and applicant filed the foreign priority document in an EPO patent application, applicant may also request that the USPTO electronically retrieve a copy of the foreign priority document from EPO by filing a "Request to Retrieve Electronic Priority Application(s)" (Form PTO/SB/38). Note however, that the USPTO will not attempt to retrieve an identified priority application until the applicant identifies the indicated priority application in an oath or declaration or an application data sheet in compliance with 37 CFR 1.63(c).

Receipt of the electronic copy of the priority document from the EPO will constitute satisfaction of the requirement under 37 CFR 1.55(a)(2)-(3) to provide the USPTO with a certified copy of the foreign priority application. See 37 CFR 1.55(d).

Similarly, if an EPO application claims foreign priority to a US application, the applicant may request that the EPO retrieve an electronic copy of the US application. EPO will only retrieve copies of US applications-as-filed, however, if: (1) the USPTO is provided with appropriate written authority under 37 CFR 1.14(h) and 35 USC § 122, if the US application has not yet been published; or (2) the US application has been published or patented. Written authority under 37 CFR 1.14(h) and 35 USC 122 may be provided by filing a properly signed "Authorization to Permit Access to Application by Participating Offices" (Form PTO/SB/39) in a US application. Form PTO/SB/39 is available from USPTO website at <http://www.uspto.gov/web/forms/sb0039.pdf>

Applicants are advised that EPO regulations require a copy of a priority document to be filed with the corresponding EPO application no later than 16 months from the priority date. See EPC Rule 38(3). Because applications are ordinarily published by the USPTO at 18 months from filing, most US applications that are the basis for a foreign priority claim in an EPO application will be unpublished at the time the applicant is required to provide a copy of the US application to the EPO. This means that in most cases it will be necessary to provide the USPTO with appropriate written authorization (under 35 USC 122 and 37 CFR 1.14(h)) for the EPO to access the US application and obtain a copy, e.g., by submitting a properly signed Form PTO/SB/39. To date, however, the USPTO has received very few such written authorizations. As a result, the USPTO is

unable to fulfill the vast majority of requests for US priority documents received by the USPTO from the EPO. **Applicants are strongly encouraged to file written authority in accordance with 37 CFR 1.14(h) and 35 USC § 122 for applications in which they plan to file a subsequent counterpart EPO application so that the EPO may successfully retrieve the US priority document at no charge to the applicant.**

Applicants who decide to make use of this priority document exchange service are advised that:

- Applicants 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, applications are encouraged to check Private PAIR as necessary to confirm receipt of appropriate documents. Priority documents retrieved from the EPO will bear the IFW document title of "Priority documents electronically retrieved by USPTO from a participating IP Office".
- In order to maximize the likelihood of a successful retrieval, the USPTO will delay transmission of priority document retrieval requests to the EPO until one of the following conditions occurs: 17 months from the earliest priority date or when the US application is docketed to an examiner. If the EPO is unable to process the first retrieval request, the USPTO will make another request when the second condition is met.
- For further information please contact one of the individuals identified below:

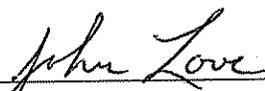
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Date