

# RETRIEVING DOCUMENTS FROM THE WIPO DIGITAL ACCESS SERVICE (DAS)

(Updated September 2009)

The USPTO offers the exchange of documents through the WIPO Digital Access Service (DAS) as both a depositing Office and an accessing Office. Through the DAS accessing Office functions of the USPTO, the DAS allows the USPTO to retrieve foreign priority documents that have been registered into the DAS. In a U.S. application claiming priority to a foreign priority application filed with a DAS participating depositing Office, the USPTO will be able to attempt to retrieve that foreign application as of the date that Office becomes a DAS participating depositing Office. The retrieval will fail unless applicant has successfully registered that foreign application into the DAS. Registration of a foreign application requires that the foreign application be filed with a DAS participating depositing Office and that the foreign application be registered into the DAS. In order to register a foreign application into the DAS an Access Code (provided to the applicant by the DAS depositing Office) is required. For more information regarding the DAS registration process and a list of DAS participating Offices visit the WIPO Web site at <http://www.wipo.int/patentscope/en/pdocforum/participating.html>. Steps 1 and 2 below describe the process and criteria for successful registration of a foreign priority document into the WIPO DAS.

## Exclusion of Design and PCT international applications

Design applications and PCT international applications cannot currently be electronically retrieved through the DAS, with one exception. The USPTO has the ability to retrieve an international application filed with the International Bureau receiving Office (RO/IB) which has been registered into the DAS. However, retrieval of the registered international application may only be attempted when a U.S. national application filed under 35 U.S.C. 111(a) claims priority to that international application. At the present time, applicants that file an international application with the United States receiving Office (RO/US) cannot use this service to meet their PCT priority document requirement under PCT Rule 17. That is, applicants cannot request the USPTO to retrieve their foreign priority documents through the DAS to comply with the requirements of PCT Rule 17. Applicants would have to obtain the certified copy of the foreign priority document and send it to the appropriate Authority. For international applications filed with the RO/US, applicants may continue to ask the RO/US to prepare and transmit a copy of an earlier U.S. application in the usual way (*e.g.*, making the appropriate indication in Box No. VI of the Request (Form PCT/RO/101)). This service is independent of the WIPO DAS.

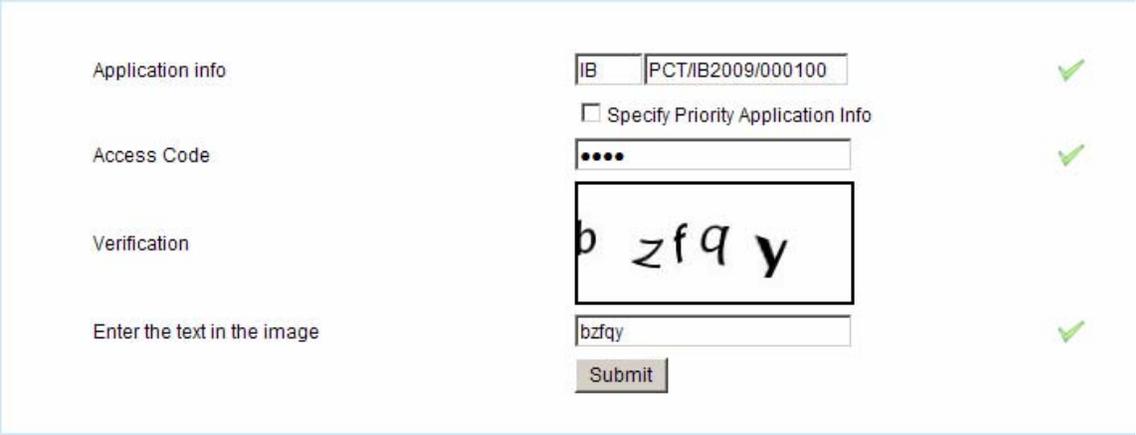
## Direct Electronic Exchange with the Japan Patent Office (JPO),

### the Korean Intellectual Property Office (KIPO), and the European Patent Office (EPO)

Although the JPO (DAS Office code JP) and the KIPO (DAS Office code KR) are indicated as DAS participating depositing Offices, applicants need not register their JPO or KIPO priority documents into the WIPO DAS for exchange with the USPTO. Direct electronic exchange of priority documents with the JPO and KIPO will continue under the Priority Document Exchange (PDX) system bilateral agreements with those Offices, not through the WIPO DAS. Similarly, the USPTO continues direct electronic exchange of priority documents filed with the EPO under an existing PDX system bilateral agreement.

## Step 1: Applicant uses the WIPO Digital Access Service (DAS) to register priority documents filed with a DAS participating depositing Office

1. Launch [https://webaccess.wipo.int/priority\\_documents/](https://webaccess.wipo.int/priority_documents/). (See Figure 1.) Enter the two letter DAS Office code of the DAS participating depositing Office (office of first filing) and application number for the Application Info fields. The list of DAS participating depositing Offices include the International Bureau receiving Office (DAS Office code IB); the Spanish Patent and Trademark Office (DAS Office code ES) expected to begin October 1, 2009; and the United Kingdom Intellectual Property Office (DAS Office code GB) expected to begin October 4, 2009. The list of DAS participating depositing Offices can be found at the WIPO Web site <http://www.wipo.int/patentscope/en/pdocforum/participating.html>.
2. Enter the access code provided by the office of first filing.
3. Enter the CAPTCHA text and click Submit.



The screenshot shows a web form with four main sections, each with a green checkmark on the right side:

- Application info:** Includes a dropdown menu set to 'IB' and a text input field containing 'PCT/IB2009/000100'. Below this is a checkbox labeled 'Specify Priority Application Info' which is unchecked.
- Access Code:** A text input field containing four dots '....'.
- Verification:** A rectangular image containing a CAPTCHA with the characters 'b z f q y'.
- Enter the text in the image:** A text input field containing the characters 'bzfqy'. Below this field is a 'Submit' button.

Figure 1: Sample registration of a Priority Document filed with the IB (a DAS depositing Office)

4. The below screen will launch. Enter applicant's name and e-mail address. The e-mail information given will be used by the DAS to notify the applicant of the application accessibility confirmation status (Registered, Not-Registered, ACL Invalid, or Application was not found) by the office of first filing (OFF).

Application info	IB	PCT/IB2009/000100	
Priority Application Info			
Name	John Doe		✓
Email	john.doe@patent.com		✓
Confirm Email	john.doe@patent.com		✓
	Submit		

Figure 2: Applicant's e-mail information for confirmation status notification

- The below screen will be displayed. The applicant will receive an e-mail regarding their accessibility confirmation status once the registration request has been completely processed. This process will take at least one business day.



Your request has been registered in the system with the following details. You will get the email once request has been processed.

Application info	IB	PCT/IB2009/000100
Priority Application Info		
Name	John Doe	
Email	john.doe@patent.com	

Figure 3: Registration is being processed

- Once the accessibility confirmation status, "Registered" is received, log into DAS and click the "Update Access Control List" tab and select the "US" (and any other desired Office) to grant the USPTO access to the registered priority application and click "Update" to save. (See Figure 4.)

Access Control List			
Select	Office code ↕	State or Office of second filing ↕	Access Granted on ↕
<input type="checkbox"/>	JP	403 Kasumigaseki 3-chome, Chiyoda-ku, TOKYO 100-8915	
<input checked="" type="checkbox"/>	US	Commissioner for Patents, P.O.Box 1450 Alexandria VA 22313-1450	Oct 5, 2009
<input type="checkbox"/>	GB	United Kingdom Intellectual Property Office (an operating name of the Patent Office) Concept House, Cardiff Road Newport, South Wales NP10 8QQ	
<input type="checkbox"/>	ES	Paseo de la Castellana 75, 28020 Madrid	
<input type="checkbox"/>	KR	Government Complex-Daejeon 139 Seonsa-ro, Seo-gu Daejeon 302-701	

Figure 4: Access Control List Management

## Step 2: The USPTO attempts to retrieve DAS Registered Priority Documents From The WIPO

1. The priority documents that the USPTO can attempt to retrieve via the DAS are those filed with the International Bureau Receiving Office (RO/IB) of the World Intellectual Property Organization (WIPO) and the DAS participating depositing Offices (offices of first filing). Please refer to the following WIPO's Web site for the current listing of the participating depositing Offices: <http://www.wipo.int/patentscope/en/pdocforum/participating.html>
2. Prerequisite: *Applicant must have successfully "Registered" with the DAS accessibility confirmation for the intended retrieval of the RO/IB or DAS participating Office priority document(s) as described above in Step 1.*
3. The USPTO will only electronically retrieve a foreign application (priority document) if applicant actually claims foreign priority under 35 U.S.C. 119(a) and 37 CFR 1.55 in a U.S. application. The foreign application must be identified in the oath or declaration or an application data sheet (ADS).
4. Please refer to the WIPO Web site, mentioned in paragraph 1 above, for the designated date of the particular DAS participating depositing Office.
  - a. Starting April 20, 2009, the USPTO will automatically attempt to electronically retrieve via the DAS a copy of any PCT international application filed with the International Bureau receiving Office (RO/IB) (priority document) to which priority

is claimed in a U.S. application filed under 35 U.S.C. 111(a) without the need for the applicant to file a request to retrieve in a separate document.

- b. Starting October 1, 2009, the USPTO will automatically attempt to retrieve via the DAS a copy of any priority application filed with the Spanish Patent and Trademark Office (DAS Office code ES) to which priority is claimed in a U.S. national application filed under 35 U.S.C. 111(a) without the need for the applicant to file a request to retrieve in a separate document.
  - c. Starting October 4, 2009, the USPTO will automatically attempt to retrieve via the DAS a copy of any priority application filed with the United Kingdom Intellectual Property Office (DAS Office code GB) to which priority is claimed in a U.S. national application filed under 35 U.S.C. 111(a) without the need for the applicant to file a request to retrieve in a separate document.
5. In U.S. applications filed prior to the dates indicated in the preceding paragraph, the USPTO will attempt to electronically retrieve a DAS participating depositing Office's priority application if applicant provides a request to retrieve the document (*e.g.*, form PTO/SB/38) and applicant has successfully "Registered" the DAS participating depositing Office priority application as described in Step 1.
6. Procedure for submission of Form PTO/SB/38 (only necessary for U.S. applications as noted in the previous paragraph).
- a. The applicant must file the request to retrieve in a separate document.
  - b. The request should be filed within the later of four months from the filing date of the U.S. application or sixteen months from the filing date of the foreign application.
  - c. Applicant should submit the request by using one of the following methods:
    - i. Electronically via EFS-Web – select Document Description "Request for USPTO to retrieve priority docs" under the Priority Documents category.
    - ii. Mailed to the USPTO mailing address:  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450
    - iii. Faxed to the Central Fax number: 571-273-8300
  - d. The USPTO will send a notice to applicant indicating the request is improper when the submitted PTO/SB/38 does not meet the USPTO requirements under the DAS

program (e.g., request to retrieve a foreign priority document that is not a DAS participating depositing Office).

7. Design applications and non-PCT/IB/yyyy/nnnnn international applications (USPTO can only retrieve RO/IB priority documents) cannot currently be electronically exchanged through the DAS. Further, foreign priority applications to which priority is claimed cannot currently be retrieved via the DAS for placement in PCT international applications filed with the United States Receiving Office (RO/US).
8. The USPTO and the WIPO will not charge any fees to the applicant for this service.
9. The USPTO will only attempt to electronically retrieve the priority document from the WIPO DAS twice (if necessary):
  - The USPTO will make a first attempt at PALM status 20 or greater.
  - If the first attempt to retrieve fails, the USPTO will make a second attempt to retrieve the priority document one week after making the first attempt.
10. Applicant is strongly encouraged to check PAIR after the completion of formalities review of the U.S. application to determine whether the USPTO successfully retrieved the priority document(s). DAS participating depositing Office priority documents retrieved from the WIPO will bear the IFW document descriptor of “Priority Documents electronically retrieved by USPTO from a participating IP Office.” The applicant remains ultimately responsible for the submission of the certified copy of the foreign application before the U.S. application issues as a patent. See 37 CFR 1.55(a). If the retrieval attempt fails, the examiner will notify the applicant in the next Office action that a certified copy of the priority document must be provided. In such a situation, the applicant should file a paper copy of the certified copy of the foreign priority document prior to payment of the issue fee. See 37 CFR 1.55(a)(2).
11. Retrieval of priority documents filed with the European Patent Office (EPO), the Japan Patent Office (JPO), and the Korean Intellectual Property Office (KIPO) will continue in accordance with the respective bilateral exchange agreements under the Priority Document Exchange (PDX) system. Therefore, priority documents filed with the EPO, the JPO, and the KIPO need not be “Registered” in the DAS in order for the USPTO to retrieve those documents. For procedures related to retrieving documents from the EPO, JPO, and KIPO please see [RETRIEVING DOCUMENTS FROM THE EPO, JPO, and KIPO](#).

## **INSTRUCTIONS FOR COMPLETION OF FORM PTO/SB/38**

1. In the upper right-hand corner of the form (the section marked “A” in the sample), please enter as much identifying information as available regarding the U.S. application that claims the priority of the foreign application under 37 CFR 1.55.
2. Check the box labeled “B” in the sample.
3. In column 1 of the area labeled “C” identify the DAS participating depositing Office (*e.g.*, IB).
4. In column 2 of the area labeled “C” identify the application number and filing date of the DAS participating depositing Office application.
5. The form must be signed (in the area labeled “D”) by someone authorized to grant access to the DAS participating depositing Office application(s) (identified in column 2).

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

### Request to Retrieve Electronic Priority Application(s)

Send completed form to: Commissioner for Patents  
P.O. Box 1450, Alexandria, VA 22313-1450

COMPLETE IF KNOWN	
Application Number	
Filing Date	
First Named Inventor	
Art Unit	
Examiner Name	
Attorney Docket Number	

The undersigned hereby requests the USPTO retrieve an electronic copy of each of the following foreign applications for which priority has been claimed under 35 U.S.C. 119(a)-(d) from a foreign intellectual property office participating with the USPTO in a bilateral or multilateral priority document exchange agreement:

**Please retrieve** (check all that apply)

- From EPO, JPO, or KIPO (participating foreign intellectual property office) a priority application
  - Column A.** Participating office where application was originally filed
  - Column B.** Application number and filing date of the application
- From WIPO (participating foreign intellectual property office) a DAS registered priority application
  - Column A.** DAS Depositing Office where application was originally filed
  - Column B.** Application number and filing date of the application
- Copy of certified copy of non-participating office priority document from within a participating foreign intellectual property office application (EPO or JPO)
  - Column A.** Participating office where certified copy of priority document is located
  - Column B.** Application number and filing date of the EPO/JPO application
  - Column C.** Two letter country code and application number of the non-EPO/JPO priority document

	A	B		C	
	Participating Office (e.g., EPO, JPO, KIPO) or DAS Depositing Office (e.g., IB)	Application to be retrieved or application containing the non-participating priority application		Non-participating priority application to be retrieved	
		App. No.	Filing Date	Country Code	App. No.
1					
2					
3					
4					
5					
6					

This Request to Retrieve Electronic Priority Application(s) (Request) should be filed within the later of four months from the date of filing of the above-identified U.S. application claiming foreign priority, or sixteen months from the filing date of the foreign application to which priority is claimed.

This Request should be submitted concurrently with the claim for priority, or thereafter. The USPTO will not attempt to retrieve the identified priority application(s) until applicant indicates the identified priority application(s) on the oath or declaration or an application data sheet in compliance with 37 CFR 1.63(c).

Applicants are advised to consult Private PAIR (accessed through www.uspto.gov) to assure that the retrieval has been successful. The applicant remains ultimately responsible for the submission of the certified copy of the foreign application(s) within the period set forth in 37 CFR 1.55(a) (before the U.S. application issues as a patent) if the USPTO does not timely retrieve the identified priority application(s).

**I hereby declare that I have the authority to grant access to the above-identified foreign application(s).**

Signature	Date
Printed or Typed Name	Telephone Number
Title	Registration Number, if applicable

This collection of information is required by 37 CFR 1.55(d). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process an application). Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Figure 5: PTO/SB/38 Form

For support, please contact:

EBC Customer Support Center

1-866-217-9197 (toll-free)

571-272-4100 (local)

M-F: 6AM – Midnight (Est. Time)

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