

Addition of Japan Patent Office as Participating Foreign Intellectual Property Office in Electronic Exchange of Priority Documents

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. See Changes to Implement Priority Document Exchange Between Intellectual Property Offices, 72 FR 1664 (January 16, 2007), 1315-2 Off. Gaz. Pat. Office (Feb. 13, 2007) (final rule) (hereinafter "Priority Document Exchange Final Rule"). The USPTO established agreements to obtain and provide priority documents with the European Patent Office (EPO) in January 2007.

Effective on July 28, 2007, the Japan Patent Office (JPO) will become the second foreign intellectual property office participating with the USPTO in a priority document exchange agreement (participating foreign intellectual property office). See 37 CFR 1.14(h) and 1.55(d). Thus, the USPTO will have the ability to begin electronically retrieving JPO priority documents from the JPO through the Priority Document Exchange (PDX) system. Similarly, the JPO will also gain the ability to electronically retrieve US priority documents from the USPTO through the PDX system.

US Applications filed on or after July 28, 2007

For US applications filed under 35 U.S.C. 111(a) on or after July 28, 2007, the USPTO will automatically attempt to electronically retrieve a copy of any JPO priority document without the need for the applicant to file a request to retrieve in a separate document (e.g., form PTO/SB/38) if the US application claims foreign priority to the JPO application and identifies the JPO application in the oath or declaration under 37 CFR 1.63(c) or in an application data sheet under 37 CFR 1.76. The USPTO already automatically attempts to electronically retrieve a copy of any EPO priority document to which priority is claimed in a US application filed under 35 U.S.C. 111(a). See the Official Gazette notice entitled "Simplification of the Electronic Exchange of Priority Documents" published on June 26, 2007. In these situations, the requirement under 37 CFR 1.55(d)(1)(i) that the applicant file a request to retrieve, in a separate document, for the USPTO to obtain a copy of the foreign application is waived and the 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.

Thus, if an applicant files a US application under 35 U.S.C. 111(a) on or after July 28, 2007 claiming priority to a prior-filed JPO (or EPO) application that is identified in the oath or declaration under 37 CFR 1.63 or in an application data sheet under 37 CFR 1.76, the USPTO will automatically attempt to electronically retrieve a copy of that JPO (or EPO) application through the PDX system regardless of whether or not the applicant has filed a retrieval request under 37 CFR 1.55(d)(1)(i) in a separate document (e.g., form PTO/SB/38). If the copy of the JPO (or EPO) application is then received by the USPTO within the period set forth in 37 CFR 1.55(a) (e.g., prior to the payment of the issue fee), the requirement under 37 CFR 1.55 for a certified copy of the foreign priority application will be considered satisfied.

Retrieval may not be effected until several months after the filing of a qualifying new US application.

US Applications filed prior to July 28, 2007

If an applicant wishes the USPTO to retrieve a copy of a JPO priority document through the PDX system for a US application filed prior to July 28, 2007, the applicant must file a request to retrieve (e.g., form PTO/SB/38) in a separate document under 37 CFR 1.55(d)(1)(i) requesting that the USPTO retrieve a copy of the JPO priority document. 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)(1)(i) from the USPTO website at <http://www.uspto.gov/web/forms/sb0038.pdf>. Any such request to retrieve a JPO priority document through the PDX system should be filed on or after July 28, 2007, the effective date for PDX agreement between the USPTO and JPO. Any requests to retrieve (e.g., form PTO/SB/38) that are filed prior to July 28, 2007 will not be recognized by the USPTO as a valid retrieval request under 37 CFR 1.55(d)(1)(i).

Requests for Non-Participating Office Priority Documents under 37 CFR 1.55(d)(2)

The USPTO will not have the ability to electronically retrieve non-participating office priority documents from the JPO under 37 CFR 1.55(d)(2). For example, if the applicant files a Korean priority document with the JPO in a JPO application, the USPTO will not have the ability to electronically retrieve the Korean priority document from the JPO through the PDX system. However, this service continues to be available through the EPO. Thus, for example, if an applicant wishes the USPTO to retrieve a copy of a German priority document that has been made of record in an EPO application file, the applicant must file a request to retrieve in a separate document (e.g., form PTO/SB/38) under 37 CFR 1.55(d)(1)(i) and provide the USPTO with the EPO application number from which the German priority document may be retrieved. See the Official Gazette notice entitled "Simplification of the Electronic Exchange of Priority Documents" published on June 26, 2007.

Additional Information Regarding Requests to Retrieve Under 37 CFR 1.55(d)

The USPTO will not retrieve copies of priority applications filed in US national stage applications under 35 U.S.C. 371 unless the applicant files a separate request to retrieve (e.g., form PTO/SB/38) under 37 CFR 1.55(d)(1)(i) since the USPTO already, in most cases, receives copies of such priority applications from the International Bureau in accordance with PCT Rule 17.2.

The following text will be included on the filing receipt of an application in which: (1) applicant filed a proper request to retrieve (e.g., form PTO/SB/38), but the USPTO has not retrieved the foreign priority document through the PDX system prior to the mailing of the filing receipt; or (2) the USPTO successfully retrieves a foreign priority document through the PDX system prior to the mailing of the filing receipt, regardless of whether or not the applicant actually filed a request to retrieve (e.g., form PTO/SB/38):

"A proper Request to Retrieve Electronic Priority Application(s) has been received by the USPTO."

The USPTO is working to revise the PDX system to provide more accurate language on the filing receipts but this may take several months to accomplish.

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 or EPO will bear the IFW document title of "Priority documents electronically retrieved by USPTO from a participating IP Office."

Sending US Priority Documents to the JPO (or EPO)

In similar fashion, if a JPO (or EPO) application claims foreign priority to a US provisional or nonprovisional application, the JPO (or EPO) will automatically attempt to retrieve an electronic copy of the US application. However, the USPTO will release copies of US applications-as-filed to the JPO (or EPO) only if the US priority application has received a foreign filing license in accordance with 37 CFR 5.11 and: (1) the applicant of the US application provided an appropriate written authority to permit access to application by participating offices (e.g., form PTO/SB/39) under 37 CFR 1.14 and 35 U.S.C. 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 and 35 U.S.C. 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 provisional or nonprovisional application. Form PTO/SB/39 is available from the USPTO website at <http://www.uspto.gov/web/forms/sb0039.pdf>

Form PTO/SB/39 has been updated to indicate that the authorized party signing the authorization grants the USPTO authority to provide: (1) the EPO, (2) the JPO, and (3) any other intellectual property offices in which a foreign application claiming priority to the applicant's identified US application is filed, with access to 1) the applicant's identified US application, 2) any foreign application to which the identified US application claims priority under 35 USC 119(a)-(d) if a copy of the foreign application that satisfies the certified copy requirement of 37 CFR 1.55 has been filed in the identified US application, and 3) any US application from which benefit is sought in the identified US application. This revision to the form will allow the USPTO to provide both the EPO and the JPO with copies of the identified US application to which priority is claimed in EPO and JPO patent applications at no charge to the applicant. This revision will also enable the USPTO to provide copies of the identified US priority application to any new participating intellectual property offices. However, the EPO and the JPO are currently the only participating intellectual property offices. Accordingly, at this time, the USPTO will only provide copies of US priority applications to the EPO and/or JPO.

The revised form PTO/SB/39 (revision 06/07) supercedes the previous version of the form PTO/SB/39, which only named the EPO as a participating intellectual property office. Accordingly, applicants are advised to adopt immediate use of the revised form PTO/SB/39 (revision 06/07), as any future use of the previous version of the form may be deemed ineffective for any requests from the JPO.

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 US applications are ordinarily published by the USPTO after the time period of 18 months from filing, most US applications that are the basis for a foreign priority claim in a JPO (or EPO) application will not be published at the time the applicant is required to provide a copy of the US application to the JPO (or EPO). This means that 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 access the US application and obtain a copy, e.g., by submitting a properly signed Form PTO/SB/39. **APPLICANTS ARE STRONGLY ENCOURAGED TO FILE WRITTEN AUTHORITY IN ACCORDANCE WITH 37 CFR 1.14 AND 35 U.S.C. 122 FOR US APPLICATIONS IN WHICH THERE IS ANY CHANCE THAT THEY WILL FILE A SUBSEQUENT COUNTERPART JPO OR EPO APPLICATION SO THAT THOSE PARTICIPATING FOREIGN INTELLECTUAL PROPERTY OFFICES MAY TIMELY AND SUCCESSFULLY RETRIEVE THE US PRIORITY DOCUMENT AT NO CHARGE TO THE APPLICANT.**

There continues to be no fee for this service.

Future Developments

The EPO and USPTO are currently developing an enhancement to the PDX system that will simplify the process for retrieving copies of non-participating office foreign priority documents under 37 CFR 1.55(d)(2). The enhancement will enable the USPTO to retrieve any priority document originally filed in a non-participating office that is contained in the dossier of an EPO patent application without the need to identify the EPO application number specifically. This enhancement is expected to be implemented in mid 2008. Accordingly, it is expected that as of mid 2008 the USPTO will no longer require a request to retrieve in a separate document (e.g., form PTO/SB/38) from the applicant before attempting to electronically retrieve priority documents originally filed in a non-participating office. However, the USPTO will only have the ability to electronically retrieve non-participating office priority documents from the EPO not the JPO.

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


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Date July 10, 2007