

Addition of Korean Intellectual Property Office as Participating Foreign Intellectual Property Office in Electronic Exchange of Priority Documents and Further Procedural Information

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 Off. Gaz. Pat. Office 63 (Feb. 13, 2007) (final rule). The USPTO established agreements to obtain and provide priority documents with the European Patent Office (EPO) as of January 16, 2007, and with the Japan Patent Office (JPO) as of July 28, 2007. See 37 CFR 1.14(h) and 1.55(d) and Addition of Japan Office as Participating Foreign Intellectual Property Office in Electronic Exchange of Priority Documents, 1320 Off. Gaz. Pat. Office 173 (July 31, 2007).

Effective October 14, 2008, the Korean Intellectual Property Office (KIPO) will become the third 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 KIPO priority documents from the KIPO through the Priority Document Exchange (PDX) system. Similarly, the KIPO will also gain the ability to electronically retrieve U.S. priority documents from the USPTO through the PDX system.

KIPO priority document retrievals in U.S. applications filed on or after October 14, 2008

For U.S. applications filed under 35 U.S.C. 111(a) on or after October 14, 2008, the USPTO will automatically attempt to electronically retrieve a copy of any KIPO 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 U.S. application claims foreign priority to the KIPO application and identifies the KIPO 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 or JPO priority document to which priority is claimed in a U.S. application filed under 35 U.S.C. 111(a). See Simplification of the Electronic Exchange of Priority Documents, 1319 Off. Gaz. Pat. Office 150 (June 26, 2007) and Addition of Japan Patent Office as Participating Foreign Intellectual Property Office in Electronic Exchange of Priority Documents, 1320 Off. Gaz. Pat. Office 173 (July 31, 2007). In these situations, 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 U.S. application under 35 U.S.C. 111(a) on or after October 14, 2008, claiming priority to a prior-filed KIPO (or EPO or JPO) 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 KIPO (or EPO or JPO) 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) (e.g.,

form PTO/SB/38). If the copy of the KIPO (or EPO or JPO) 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 U.S. application.

KIPO priority document retrievals in U.S. Applications filed prior to October 14, 2008

If an applicant wishes the USPTO to retrieve a copy of a KIPO priority document through the PDX system for a U.S. application filed prior to October 14, 2008, 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 KIPO 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 Web site at <http://www.uspto.gov/web/forms/sb0038.pdf>. Any such request to retrieve a KIPO priority document through the PDX system must be filed on or after October 14, 2008, the effective date for the PDX agreement between the USPTO and KIPO. Any such requests to retrieve (e.g., form PTO/SB/38) that are filed prior to October 14, 2008, 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 KIPO under 37 CFR 1.55(d)(2). For example, if the applicant files a JPO priority document with the KIPO in a KIPO application, the USPTO will not have the ability to electronically retrieve the JPO priority document from the KIPO through the PDX system. The USPTO similarly does not have the ability to electronically retrieve non-participating office priority documents from the JPO under 37 CFR 1.55(d)(2). See Addition of Japan Patent Office as Participating Foreign Intellectual Property Office in Electronic Exchange of Priority Documents, 1320 Off. Gaz. Pat. Office 173 (July 31, 2007). 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.

Exclusion of Design Applications and PCT International Applications

The USPTO cannot at this time electronically exchange design applications through the PDX system. It is often difficult to distinguish between a design application number and a utility application number. The USPTO has determined that the majority of the foreign priority claims made in U.S. design applications are to foreign design applications as opposed to foreign utility applications. Accordingly, the USPTO will only attempt to electronically retrieve copies of foreign utility priority applications to which priority is claimed in a U.S. design application when the applicant files a separate request to retrieve a KIPO, JPO, or EPO utility application (e.g., form PTO/SB/38) under 37 CFR 1.55(d)(1)(i) in the U.S. design application.

In addition, PCT international applications are currently excluded from the PDX system. Thus, USPTO cannot electronically exchange PCT international applications through the PDX system. Further, the USPTO cannot currently electronically retrieve non-U.S. priority applications to which priority is claimed in a PCT international application.

Note that, in accordance with PCT Rule 17.1(b), an applicant may request the U.S. Receiving Office to transmit a U.S. priority document to the International Bureau. This service is independent from the PDX system.

The USPTO will not retrieve copies of priority applications filed in U.S. 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.

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

The following text will be included on the filing receipt of an application in which: (1) 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); or (2) 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:

Request to Retrieve – This application either claims priority to one or more applications filed in an intellectual property Office that participates in the Priority Document Exchange (PDX) program or contains a proper **Request to Retrieve Electronic Priority Applications(s)** (PTO/SB/38 or its equivalent). Consequently, the USPTO will attempt to electronically retrieve these priority documents.

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 KIPO, JPO or

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

Sending U.S. Priority Documents to a Participating Office

In similar fashion, if a KIPO (or EPO or JPO) application claims foreign priority to a U.S. provisional or nonprovisional application, the KIPO (or EPO or JPO) will automatically attempt to retrieve an electronic copy of the U.S. application. However, the USPTO will release copies of U.S. applications-as-filed to the KIPO (or EPO or JPO) only 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 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’s Internet Web site at <http://www.uspto.gov/web/forms/sb0039.pdf>. Form PTO/SB/01 is available from the USPTO’s Internet Web site at <http://www.uspto.gov/web/forms/sb0001.pdf>. Note that the USPTO cannot currently transmit copies of design applications or PCT applications through the PDX system.

Applicants are advised that KIPO (as well as EPO and JPO) regulations require a copy of a priority document to be filed with the corresponding KIPO (or EPO or JPO) application no later than 16 months from the priority date. Because U.S. applications are ordinarily published by the USPTO after the time period of 18 months from filing, most U.S. applications that are the basis for a foreign priority claim in a KIPO (or EPO or JPO) application will not be published at the time the applicant is required to provide a copy of the U.S. application to the KIPO (or EPO or JPO). 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 KIPO (or EPO or JPO) to access the U.S. application and obtain a copy, e.g., by submitting a properly signed: (1) Form PTO/SB/39; or (2) Form PTO/SB/01 in which the “Authorization to Permit Access by Participating Offices” has been checked. Applicants are strongly encouraged to file written authority in accordance with 37 CFR 1.14 and 35 U.S.C. 122 for U.S. applications in which there is any chance that they will file a subsequent counterpart KIPO, JPO or EPO application so that those participating foreign intellectual property offices may timely and successfully retrieve the U.S. priority document at no charge to the applicant.

Applicants are, however, also advised that if the applicant files an Authorization to Permit Access to Application by Participating Offices, there is no procedure in place that would enable the applicant 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 U.S. priority application to any participating office in which the applicant files a patent application claiming priority to the prior filed U.S. application.


There continues to be no fee for this service.

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

Don Levin
TDA Project Manager
U.S. Patent and Trademark Office OR
571-272-3785
PDX@uspto.gov

Diana Oleksa
Legal Advisor for IT Policy
U.S. Patent and Trademark Office
571-272-3291
PDX@uspto.gov

Date: 10-14-08

ORIGINAL SIGNATURE 

JON W. DUDAS
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office