

Enhancement of Priority Document Exchange Program and USPTO Declaration Form

Background

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 1664-2 (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) as of January 16, 2007. Further, on July 28, 2007, the Japan Patent Office (JPO) became the second foreign intellectual property office participating with the USPTO in a priority document exchange (PDX) agreement (participating foreign intellectual property office). See 37 CFR 1.14(h) and 1.55(d).

In accordance with the established PDX procedure, if an EPO or JPO application claims foreign priority to a US provisional or nonprovisional application, the EPO or JPO 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 EPO or JPO 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 the application by participating offices 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. In accordance with established PDX procedure, written authority under 37 CFR 1.14 and 35 U.S.C. 122 is typically provided by the applicant filing a properly signed "Authorization to Permit Access to Application by Participating Offices" (e.g., 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>

Enhancement of PDX

The patent community has requested that the USPTO investigate ways in which this procedure of providing written authority to participating offices might be streamlined and simplified. In response to this request, the "Declaration for Utility or Design Patent Application" (Form PTO/SB/01) has been modified to include a check box enabling the applicant to include an Authorization to Permit Access to Application by Participating Offices granting the USPTO written authority to provide any intellectual property office in which a foreign application, claiming priority to the US application for which the declaration is made, is filed access to the US application. See 37 CFR 1.14(c) and (h).

In addition, the USPTO has come to understand that the date of filing the Authorization to Permit Access to Application by Participating Offices is sometimes of critical legal significance at the JPO. Accordingly, in order to further streamline the PDX procedure, the PTO/SB/39 (as well as the PTO/SB/01) has been modified to indicate that, in accordance with 37 CFR 1.14(c), access may be provided to information concerning the date of filing the Authorization to Permit Access to Application by Participating Offices.

Accordingly, upon filing an Authorization to Permit Access to Application by Participating Office which could be on a separate paper (e.g., PTO/SB/39) or a proper executed oath or declaration (e.g., the modified Form PTO/SB/01) that includes an Authorization to Permit Access to Application by Participating Offices, any foreign intellectual property office participating with the USPTO in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office) will be provided with access to: 1) the

identified US application for which the declaration is made, 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, 3) any US application from which benefit is sought in the identified US application and 4) information concerning the date of filing the Authorization to Permit Access to Application by Participating Offices. This 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 (as well as information as to the date of filing the Authorization to Permit Access to Application by Participating Offices) at no charge to the applicant. This will also enable the USPTO to provide such information and 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 such information and copies of US priority applications to the EPO and/or JPO.

The requirement under 37 CFR 1.14(h)(2) that the written authority must be submitted on a separate document is hereby waived in the event the applicant files a properly executed oath or declaration (e.g., the modified Form PTO/SB/01) with the Authorization to Permit Access to Application by Participating Offices.

The modified form PTO/SB/39 will continue to be available for applicants who wish to file their Authorization to Permit Access to Application by Participating Offices separate from their declaration.

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 an Authorization to Permit Access to Application by Participating Offices (e.g., by submitting a properly executed modified Form PTO/SB/01 or a Form PTO/SB/39) prior to 16 months from the priority date in order for the JPO or EPO to timely access the US application and obtain a copy. Applicants are encouraged to file an Authorization to Permit Access to Application by Participating Offices 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.

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 US priority application to any participating office in which the applicant files a patent application claiming priority to the prior filed US application.

There continues to be no fee for this service.

Additional Enhancement of USPTO Declaration Form

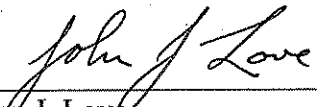
The "WARNING" statement on the PTO/SB/01 declaration form has also been enhanced. The "WARNING" statement now includes text explaining that documents which form the record of a patent application (such as the PTO/SB/01) are placed into the Privacy Act system of records DEPARTMENT OF COMMERCE, COMMERCE-PAT-7, System name: *Patent Application Files*. The "WARNING" statement now also explains that documents that are not retained in an application file (such as the PTO-2038 Credit Card Payment Form) are placed into the Privacy Act system of COMMERCE/PAT-TM-10, System name: *Deposit Accounts and Electronic Funds Transfer Profiles*.

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Date