

RETRIEVING DOCUMENTS FROM EPO, JPO, or KIPO

1. At the present time, the only “participating Offices” with which the USPTO can exchange priority documents are the European Patent Office (EPO), the Japan Patent Office (JPO), and the Korean Intellectual Property Office (KIPO).
2. The USPTO will only electronically retrieve a certified copy of a foreign application (priority document) if applicant actually claims foreign priority under 37 CFR 1.55 in a US application. The foreign application must be identified in the oath or declaration or an application data sheet.
3. The USPTO will automatically attempt to electronically retrieve a copy of any: (1) EPO priority document to which priority is claimed in a US application filed on or after 26 June 2007 under 35 USC 111(a); (2) JPO priority document to which priority is claimed in a US application filed on or after 28 July 2007 under 35 USC 111(a); or (3) KIPO priority document to which priority is claimed in a US application filed on or after October 13, 2008 under 35 USC 111(a) without the need for the applicant to file a request to retrieve in a separate document (e.g., form PTO/SB/38). In US applications filed prior to these relative dates, the USPTO will attempt to electronically retrieve an EP, JP, or KR priority application if applicant provides a request and grants access to the EP, JP, or KR priority application.
4. Design applications and PCT international applications cannot currently be electronically exchanged through the Priority Document Exchange (PDX) program. Further, foreign priority applications to which priority is claimed cannot currently be retrieved in PCT international applications.
5. In addition to retrieving a certified copy of an EPO, JPO, or KIPO application, applicant may request the USPTO to retrieve any priority document that has been made of record within an EP or KR application. For example, if applicant claims priority to a French application and a certified copy of the French application has been made of record in an EP application, applicant may request the USPTO to electronically retrieve a certified copy of the French application EVEN IF the US application does not claim priority to the EP application.
6. Procedure for Submission of Form PTO/SB/38
 - a. The applicant must file the request in a separate document.
 - b. The request should be filed within the later of four months from the filing date of the US 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. faxed to the Central Fax number (571-273-8300)
 - iii. mailed to the USPTO mailing address:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

7. There is no fee for this service no matter how many priority documents are retrieved.
8. The USPTO will notify applicant of any formality problems in the request that are identified.
9. The USPTO will make up to three attempts to electronically retrieve the priority document from the EPO, JPO, or KIPO. The USPTO will make a first attempt to retrieve the priority document upon completion of formalities review of the US application. If the first attempt to retrieve is unsuccessful, the USPTO will make a second attempt to retrieve the priority document one week after making the first attempt. If the second attempt is also unsuccessful, the USPTO will make a third and final attempt to retrieve the priority document one week after making the second attempt.
10. Applicant is strongly encouraged to check PAIR after the completion of formalities review of the US application to determine whether the USPTO successfully retrieved the priority document(s). Priority documents retrieved from the EPO, JPO, or KIPO 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 US 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).

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 US application that claims the priority of the foreign application under 37 CFR 1.55. PLEASE NOTE THAT THE FOREIGN APPLICATION MUST BE IDENTIFIED IN THE OATH OR DECLARATION OR IN AN APPLICATION DATA SHEET.
2. If applicant is requesting the USPTO to retrieve a certified copy of an EPO, JPO, or KIPO application:
 - a. Check the box labeled “B” in the sample;
 - b. In column 1 of the area labeled “D,” identify EPO, JPO, or KIPO as the participating Office. Currently, the EPO, the JPO, and the KIPO are the only options ; and
 - c. In column 2 of the area labeled “D,” identify the application number and filing date of the EPO, JPO, or KIPO application.
3. If applicant is requesting the USPTO to retrieve a non-EP foreign priority document contained within an EP application or a non-KR foreign priority document contained within a KR application:
 - a. Check the box labeled “C” in the attached sample;
 - b. In column 1 of the area labeled “D,” identify either EPO or KIPO as the participating Office;
 - c. In column 2 of the area labeled “D,” identify the application number and filing date of the EP or KR application; and
 - d. In column 3 of the area labeled “D,” identify the IP office in which the non-EP/KR foreign application was originally filed and the application number of the non-EP/KR foreign application.
4. The form must be signed (in the area labeled “E”) by someone authorized to grant access to the EPO, JPO, or KIPO application(s) (that were identified in column 2).

Please direct any questions regarding this form to:

Diana Oleksa
Legal Advisor for IT Policy
US Patent and Trademark
Office

571-272-3291
PDX@uspto.gov

OR

Hung Vuong
US Patent and Trademark
Office

571-272-5727
PDX@uspto.gov

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 benefit 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)

The following applications originally filed in participating offices (only list the Participating Office and the Participating Office Application Number (columns 1 and 2 below)):

The following applications originally filed in non-participating offices (must list the information for all three columns below):

| 1. Participating Office with which the Priority Application, or the Copy, was filed (e.g., EPO) | 2. Participating Office Application Number in which the Priority Application, or a Copy, was filed (e.g., 03101432) | | 3. Non-Participating Office Application Number (Priority Application), if applicable | |
|---|---|-------------|--|----------|
| | App. No. | Filing Date | Office | 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 the above-identified 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 identifies the indicated 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 applications.

| | |
|-----------------------|------------------------------------|
| _____ | _____ |
| 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.