

RETRIEVING DOCUMENTS FROM THE EPO, JPO, OR KIPO

(Updated May 2009)

1. The USPTO can electronically exchange priority documents directly with 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 U.S. 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 U.S. application filed on or after January 16, 2007 under 35 U.S.C. 111(a); (2) JPO priority document to which priority is claimed in a U.S. application filed on or after July 28, 2007 under 35 U.S.C. 111(a); or (3) KIPO priority document to which priority is claimed in a U.S. application filed on or after October 14, 2008 under 35 U.S.C. 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 U.S. applications filed prior to these relative dates, the USPTO will attempt to electronically retrieve an EPO, JPO, or KIPO priority document if applicant provides a request and grants access to the priority application filed with the EPO, JPO, or KIPO.
4. Design applications and PCT international applications cannot currently be electronically exchanged with the EPO, the JPO, or the KIPO 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 copy of an EPO, JPO, or KIPO application, an applicant may request the USPTO to retrieve any priority document that has been made of record within an EPO application. For example, if applicant claims priority to an Australian application and a certified copy of the Australian application has been made of record in an EPO application, applicant may request the USPTO to electronically retrieve a copy of the certified copy of the Australian application EVEN IF the U.S. application does not claim priority to the EPO application. At this time, KIPO does not provide the capability of transmitting priority documents that have been made of record within the KIPO 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 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. 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 only attempt to electronically retrieve the priority document from the EPO, JPO, or KIPO twice (if necessary):
 - The USPTO will make a first attempt to retrieve at PALM status 20.
 - 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). Priority documents retrieved from the EPO, the JPO, or the 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 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 from the WIPO will be attempted via the Digital Access Service (DAS). For procedures related to retrieving documents from the WIPO via the DAS, please see RETRIEVING DOCUMENTS FROM THE WIPO.

INSTRUCTIONS FOR COMPLETION OF FORM PTO/SB/38

1. In the upper right-hand corner of the form (the section marked “1” 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. 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 copy of an EPO, JPO, or KIPO application:
 - a. Check the box labeled “2” in the sample;
 - b. In column A of the area labeled “4,” identify EPO, JPO, or KIPO as the participating Office; and
 - c. In column B of the area labeled “4,” 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-EPO/JPO foreign priority document contained within an EPO or JPO application:
 - a. Check the box labeled “3” in the attached sample;
 - b. In column A of the area labeled “4,” identify either EPO or JPO as the participating Office;
 - c. In column B of the area labeled “4,” identify the application number and filing date of the EPO or JPO application; and
 - d. In column C of the area labeled “4,” identify the IP office in which the non-EPO/JPO foreign application was originally filed and the application number of the non-EPO/JPO foreign application.
4. The form must be signed (in the area labeled “5”) by someone authorized to grant access to the application(s) identified in column B.

Please direct any questions regarding this form to:

EBC Customer Support Center
1-866-217-9197 (toll-free)
571-272-4100 (local)

M-F: 6AM – Midnight (Est. Time) PDX@uspto.gov
PDX@uspto.gov

Hung Vuong
Computer Specialist
571-272-5727

Tamara Graysay
Special Program Examiner
571-272-6728
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 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.