

# **FORWARDING U.S. PRIORITY DOCUMENTS TO THE EPO, JPO, OR KIPO**

(Updated May 2009)

1. If you are filing an application in the European Patent Office (EPO), the Japan Patent Office (JPO), or the Korean Intellectual Property Office (KIPO) and you want the EPO, the JPO, or the KIPO to retrieve one or more priority documents from the USPTO for placement in that file:
2. The EPO, JPO, or KIPO will request retrieval of every U.S. priority application to which an EPO, JPO, or KIPO application claims priority. The JPO will request retrieval of every U.S. priority application to which a JPO application claims priority. Likewise, the KIPO will request retrieval of every U.S. priority application to which a KIPO application claims priority. However, further details and instructions from the EPO will be published in its Official Journal and further details and instructions from the JPO and KIPO will be published on the JPO and KIPO Web sites, respectively.
  - a. Neither design applications nor PCT international applications can currently be exchanged with the EPO, the JPO, or the KIPO through the Priority Document Exchange system. Accordingly, the EPO, the JPO, and the KIPO will not request retrieval of U.S. priority applications that are design applications or PCT international applications filed with the United States Receiving Office (RO/US).
  - b. The USPTO will release a priority document to the EPO, the JPO, or the KIPO ONLY if the U.S. application meets at least one of the following criteria:
    - i. The application has been published
    - OR–
    - ii. The applicant has submitted a proper written authorization to the USPTO in a separate document to release the application for this purpose AND the application has cleared national security review (a foreign filing license has been granted).
  - c. To be considered proper, the applicant must authorize the USPTO to permit the EPO, the JPO, or the KIPO in which a foreign application claiming priority to the identified U.S. application is filed to have access to 1) the U.S. application as-filed, 2) a copy of any foreign priority documents contained within it, 3) a copy-as-filed of any parent applications, i.e., any U.S. application from which benefit is sought in the accessed application, and 4) information concerning the date of filing of the Authorization to Permit Access to Application by Participating Offices (e.g., PTO/SB/39). The USPTO has prepared a standard form (PTO/SB/39, see attached) which may be used to grant this permission. (Alternatively, the declaration form PTO/SB/01 includes an “Authorization to Permit Access to Application by Participating Offices” checkbox which may be used to grant the permission.)
3. Please use one of the routes indicated below when submitting the standard written authority form PTO/SB/39:

- a. electronically via EFS-Web – select Document Description “Authorization to access Appl. by Trilateral Office” under the Priority Documents category
  - b. Fax to the usual Central Fax number (571-273-8300)
  - c. Mail to the usual USPTO mailing address:

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450
4. Neither the USPTO nor the EPO, the JPO, or the KIPO charge a fee to either the applicant or the other office for this service.
  5. Applicants are 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.

## **INSTRUCTIONS FOR COMPLETION OF FORM PTO/SB/39**

1. In the upper right-hand corner of the form (the section marked “1” in the attached sample), please enter the title and as much other identifying information as you have available about the U.S. application to which you are authorizing access.
2. The form must be signed in the area labeled “2” in accordance with 37 CFR 1.14(c).

If at any time you have any questions, please contact:

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|--|--|--|
| EBC Customer Support Center                      | Hung Vuong                                       | Tamara Graysay                                   |
| 1-866-217-9197 (toll-free)                       | Computer Specialist                              | Special Program Examiner                         |
| 571-272-4100 (local)                             | 571-272-5727                                     | 571-272-6728                                     |
| M-F: 6AM – Midnight (Est. Time)                  | <a href="mailto:PDX@uspto.gov">PDX@uspto.gov</a> | <a href="mailto:PDX@uspto.gov">PDX@uspto.gov</a> |
| <a href="mailto:PDX@uspto.gov">PDX@uspto.gov</a> |  |  |

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.

### AUTHORIZATION TO PERMIT ACCESS TO APPLICATION BY PARTICIPATING OFFICES

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   |  |
| Attorney Docket Number |  |
| Title (Required)       |  |

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The undersigned hereby grants the USPTO authority to provide the European Patent Office (EPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the World Intellectual Property Office (WIPO), and any other intellectual property offices in which a foreign application claiming priority to the above-identified patent application is filed access to the above-identified patent application. See 37 CFR 1.14(c) and (h).

In accordance with 37 CFR 1.14(h)(3), access will be provided to a copy of the above-identified application with respect to: 1) the above-identified patent application-as-filed, 2) any foreign application to which the above-identified patent application claims priority under 35 U.S.C. 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 above-identified patent application, and 3) any U.S. application-as-filed from which benefit is sought in the above-identified patent application.

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.

This written authorization should be submitted prior to the filing of a subsequent foreign application, in which priority is claimed to the above-identified patent application, with any intellectual property office (e.g., the EPO, JPO, KIPO, or DAS Accessing Office). However, if applicant does not wish the EPO, JPO, KIPO, WIPO, or other intellectual property office in which a foreign application claiming priority to the above-identified patent application is filed to have access to the above-identified patent application, this written authorization should not be filed.

No fee will be charged under 37 CFR 1.19(b)(1) for providing a participating intellectual property office with an electronic copy of the above-identified patent application.

**This form must be signed by an authorized party in accordance with 37 CFR 1.14(c).**

|                                |   |
|--------------------------------|---|
| _____<br>Signature             | _____<br>Date                               |
| _____<br>Printed or Typed Name | _____<br>Telephone Number                   |
| _____<br>Title                 | _____<br>Registration Number, if applicable |

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This collection of information is required by 37 CFR 1.14(h). 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 6 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.*