

Electronic Priority Document Exchange

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. The USPTO established agreements to obtain and provide priority documents with the European Patent Office (EPO) as of January 16, 2007, the Japan Patent Office (JPO) as of July 28, 2007, and the Korean Intellectual Property Office (KIPO) as of October 14, 2008. Further, on April 20, 2009, the World Intellectual Property Organization (WIPO) became the fourth 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, JPO, and KIPO application claims foreign priority to a US provisional or nonprovisional application, the EPO, JPO, or KIPO 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, JPO, or KIPO 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 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.

The established PDX procedure with WIPO where priority documents are exchanged via Digital Access Service (DAS) differ as described above for the EPO, JPO, and KIPO. PDX via DAS between USPTO and WIPO requires a prerequisite step in DAS accessibility confirmation (Registration) of the requested priority document from the Office of first filing at the WIPO's DAS Portal Website, https://webaccess.wipo.int/priority_documents/ prior to the priority document exchange between the two Offices. For further information, please see http://www.uspto.gov/web/patents/pdx/permitting_access.pdf and http://www.uspto.gov/web/patents/pdx/document_retrieval.pdf

There is no fee associated to PDX service to the applicants.