



UNITED STATES PATENT AND TRADEMARK OFFICE

USPTO RETRIEVAL OF FOREIGN PRIORITY APPLICATIONS FROM THE WIPO VIA THE DIGITAL ACCESS SERVICE

February 2011

Overview

The USPTO offers the exchange of applications through the WIPO Digital Access Service (DAS) as both a depositing Office and an accessing Office. Through the DAS accessing Office functions of the USPTO, the DAS allows the USPTO to retrieve foreign priority applications that have been registered into the DAS. In a U.S. application claiming priority to a foreign priority application filed with a participating DAS depositing Office, the USPTO will be able to attempt to retrieve that foreign application as of the date that Office becomes a participating DAS depositing Office. The retrieval will fail unless applicant has successfully registered that foreign application into the DAS. Successful retrieval of a foreign application requires that the foreign application be filed with a participating DAS depositing Office and that the foreign application be registered into the DAS. The registration process for participating DAS depositing Offices may be different. For more information regarding the DAS registration process and a list of participating DAS Offices visit the WIPO Web site at <http://www.wipo.int/patentscope/en/pdocforum/participating.html>. *Step 1* and *Step 2* below describe the process and criteria for successful registration of a foreign priority application into the DAS and subsequent USPTO retrieval of that application.

1. This document contains information about USPTO retrieval of foreign priority applications from the World Intellectual Property Organization (WIPO) via the WIPO Digital Access Service (DAS). Please see –
 - a. [USPTO RETRIEVAL OF FOREIGN PRIORITY DOCUMENTS FROM THE EPO, THE JPO, AND THE KIPO](#) for information about USPTO retrieval of priority applications filed with the European Patent Office (EPO), the Japan Patent Office (JPO), and the Korean Intellectual Property Office (KIPO), as well as USPTO retrieval of priority documents contained within an application filed with the EPO or JPO.
 - b. [ACCESS TO U.S. PRIORITY DOCUMENTS BY THE EPO, THE JPO, AND THE KIPO](#) for information about access to U.S. priority applications by the European Patent Office, Japan Patent Office, and Korean Intellectual Property.
 - c. [ACCESS TO U.S. PRIORITY DOCUMENTS BY THE WIPO VIA THE WIPO DIGITAL ACCESS SERVICE](#) for information about access to U.S. priority applications by the World Intellectual Property Organization (WIPO) via the WIPO Digital Access Service.

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2. Design applications cannot be retrieved from the WIPO via the WIPO Digital Access Service (DAS).
3. The United States receiving Office (RO/US) has not notified the International Bureau of the WIPO under Administrative Instructions under the Patent Cooperation Treaty (AI) Section 715 that it is prepared to obtain priority documents from a digital library. Accordingly, for PCT international applications filed with the RO/US which indicate at Box No. VI on the Request (Form PCT/RO/101) a priority claim to an earlier application not filed with the USPTO, pursuant to AI Section 716(c) applicant may wish to submit:
 - a. the certified copy of the priority application to the International Bureau or RO/US under PCT Rule 17.1(a), or
 - b. a request to the International Bureau under PCT Rule 17.1(b-*bis*) to obtain the priority application from a digital library if available to the International Bureau by marking the appropriate box on the Request or by separate letter to the International Bureau.

For further information regarding the procedure under (b), including determining whether the priority application is available to the International Bureau from a digital library, see “WIPO Digital Access Service for Priority Documents (DAS)” in the January 2010 issue of the PCT Newsletter (No. 01/2010) available at <http://www.wipo.int/pct/en/index.html>.

4. PCT international applications cannot be retrieved from the WIPO via the DAS, with one exception. The USPTO has the ability to retrieve a PCT international application filed with the International Bureau receiving Office (RO/IB) which has been registered into the DAS. However, retrieval of the registered PCT international application will only be attempted when a U.S. national application filed under 35 U.S.C. 111(a), other than a design application, claims priority to that PCT international application.
5. Retrieval of priority applications filed with the EPO, the JPO, and the KIPO will continue in accordance with the respective bilateral exchange agreements under the Priority Document Exchange (PDX) system. Therefore, a priority application filed with the EPO, the JPO, and the KIPO need not be “Registered” into the WIPO Digital Access Service (DAS) in order for the USPTO to retrieve the application. For procedures related to retrieving priority applications from the JPO, the EPO, and the KIPO please see [USPTO RETRIEVAL OF FOREIGN PRIORITY DOCUMENTS FROM THE EPO, THE JPO, AND THE KIPO](#).

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6. Except as noted in items 2-5 above, the USPTO can electronically retrieve a copy of a foreign priority application that has been registered into the WIPO DAS.
7. The USPTO will only electronically retrieve 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.
8. Except as noted in items 2-5 above, the USPTO will automatically attempt to electronically retrieve a copy of the following foreign priority applications without the need for the applicant to file a request to retrieve in a separate document (*e.g.*, form [PTO/SB/38](#)):
 - a. Starting April 20, 2009, the USPTO will automatically attempt to electronically retrieve via the DAS a copy of any PCT international application filed with the International Bureau receiving Office (RO/IB) (priority document) to which priority is claimed in a U.S. application filed under 35 U.S.C. 111(a) without the need for the applicant to file a request to retrieve in a separate document.
 - b. Starting October 1, 2009, the USPTO will automatically attempt to retrieve via the DAS a copy of any priority application filed with the Spanish Patent and Trademark Office (DAS Office code ES) to which priority is claimed in a U.S. national application filed under 35 U.S.C. 111(a) without the need for the applicant to file a request to retrieve in a separate document.
 - c. Starting October 4, 2009, the USPTO will automatically attempt to retrieve via the DAS a copy of any priority application filed with the United Kingdom Intellectual Property Office (DAS Office code GB) to which priority is claimed in a U.S. national application filed under 35 U.S.C. 111(a) without the need for the applicant to file a request to retrieve in a separate document.
 - d. Starting December 12, 2009, the USPTO will automatically attempt to retrieve via the DAS a copy of any priority application filed with the Australia Patent Office (DAS Office code AU) to which priority is claimed in a U.S. national application filed under 35 U.S.C. 111 (a) without the need for applicant to file a request to retrieve in a separate document.
 - e. Note that the automatic retrieval mentioned above will not be attempted in U.S design applications or PCT international applications.

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9. For U.S. applications filed prior to the dates indicated in the preceding paragraph, the USPTO will not attempt to automatically electronically retrieve a priority application filed with a participating DAS depositing Office unless the applicant files a request to retrieve the foreign application (*e.g.*, form [PTO/SB/38](#)) in the U.S. application.
10. At this time, the WIPO DAS does not have the capability of transmitting priority documents that have been made of record within an application filed with a participating DAS depositing Office.
11. With respect to the preceding two paragraphs, the following procedure is to be used for submission of a request to electronically retrieve a priority application (*e.g.*, form [PTO/SB/38](#)):
 - a. The applicant must file the request to retrieve 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. Mail to the USPTO mailing address:
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450
12. The USPTO does not charge a fee for this service no matter how many priority applications are retrieved.
13. The USPTO will send a notice to applicant indicating the request is improper when the submitted form [PTO/SB/38](#) does not meet the USPTO requirements under the PDX program (*e.g.*, an improper signature).
14. 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 foreign priority application(s). Priority applications retrieved from the WIPO will bear the IFW

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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).

15. For support, please contact:

EBC Customer Support Center
1-866-217-9197 (toll-free)
571-272-4100 (local)
M-F: 6AM – Midnight (Est. Time)
PDX@uspto.gov

Hung Vuong
Computer Specialist
571-272-5727
PDX@uspto.gov

Tamara Graysay
Special Program Examiner
571-272-6728
PDX@uspto.gov

Step 1: Applicant uses the WIPO Digital Access Service (DAS) to register priority applications filed with a participating DAS depositing Office

For participating DAS depositing Offices that provide an access code to the applicant and require the applicant to register the priority application

1a-1. Launch https://webaccess.wipo.int/priority_documents/. (See Figure 1.) Enter the two letter DAS Office code of the participating DAS depositing Office (office of first filing) and application number in the Application Info fields. The list of participating DAS depositing Offices currently includes the International Bureau receiving Office (DAS Office code IB) from April 20, 2009; the Spanish Patent and Trademark Office (DAS Office code ES) from October 1, 2009; the United Kingdom Intellectual Property Office (DAS Office code GB) from October 4, 2009; the Australia Patent Office (DAS Office code AU) from December 12, 2009. The complete list of participating DAS depositing Offices can be found at the WIPO Web site <http://www.wipo.int/patentscope/en/pdocforum/participating.html>.

1a-2. Enter the Access Code provided by the office of first filing.

1a-3. Enter the CAPTCHA text and click Submit.

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Figure 1: Sample registration of a Priority Application filed with the IB (a DAS depositing Office)

1a-4. The below screen will launch. Enter applicant's name and e-mail address and click Submit. The e-mail information given will be used by the DAS to notify the applicant of the application accessibility confirmation status (Registered, Not-Registered, Access Control Code Invalid, or Application was not found) by the office of first filing.

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Application info	<input type="text" value="IB"/>	<input type="text" value="PCT/IB2009/000100"/>	
Priority Application Info			
Name	<input type="text" value="John Doe"/>		✓
Email	<input type="text" value="john.doe@patent.com"/>		✓
Confirm Email	<input type="text" value="john.doe@patent.com"/>		✓
	<input type="button" value="Submit"/>		

Figure 2: Applicant's e-mail information for confirmation status notification

1a-5. The below screen will be displayed. The applicant will receive an e-mail regarding their accessibility confirmation status once the registration request has been completely processed. This process may take one or more business days.



Your request has been registered in the system with the following details. You will get the email once request has been processed.

Application info	<input type="text" value="IB"/>	<input type="text" value="PCT/IB2009/000100"/>	
Priority Application Info			
Name	John Doe		
Email	john.doe@patent.com		

Figure 3: Registration is being processed

1a-6. Once the e-mail indicating the accessibility confirmation status “Registered” is received, log into the DAS and click the “Update Access Control List” tab. Select “US” (and any other desired DAS accessing Office) to grant the USPTO access to the registered priority application. Click “Update” to save. (See Figure 4.)

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Access Control List			
Select	Office code ⇅	State or Office of second filing ⇅	Access Granted on ⇅
<input type="checkbox"/>	JP	403 Kasumigaseki 3-chome, Chiyoda-ku, TOKYO 100-8915	
<input checked="" type="checkbox"/>	US	Commissioner for Patents, P.O.Box 1450 Alexandria VA 22313-1450	Oct 5, 2009
<input type="checkbox"/>	GB	United Kingdom Intellectual Property Office (an operating name of the Patent Office) Concept House, Cardiff Road Newport, South Wales NP10 8QQ	
<input type="checkbox"/>	ES	Paseo de la Castellana 75, 28020 Madrid	
<input type="checkbox"/>	KR	Government Complex-Daejeon 139 Seonsa-ro, Seo-gu Daejeon 302-701	

Figure 4: Access Control List Management

For participating DAS depositing Offices that provide the foreign priority application to the WIPO at the request of the applicant, and upon successful registration the WIPO provides an access code to the applicant for updating the Access Control List for the application (e.g., GB)

1b-1. Applicant makes a request that the foreign priority application be registered into the DAS.

For example, the United Kingdom Intellectual Property Office (UKIPO) (DAS Office code GB) permits DAS registration of patent applications filed electronically on or after October 4, 2009. An applicant filing a patent application in the UKIPO makes the appropriate indication or checks the appropriate box when electronically filing the GB patent application.

The list of participating DAS depositing Offices currently includes the International Bureau receiving Office (DAS Office code IB) from April 20, 2009; the Spanish Patent and Trademark Office (DAS Office code ES) from October 1, 2009; the United Kingdom Intellectual Property Office (DAS Office code GB) from October 4, 2009; the Australia Patent Office (DAS Office code AU) from December 12, 2009.

The complete list of participating DAS depositing Offices and specific information for each Office can be found at the WIPO Web site
<http://www.wipo.int/patentscope/en/pdocforum/participating.html>.

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1b-2. The WIPO will communicate directly by e-mail with the applicant. The WIPO will indicate successful registration of and provide an access code for the particular application.

1b-3. Applicant must update the DAS Access Control List to grant access to the application by the USPTO.

Log into the DAS at https://webaccess.wipo.int/priority_documents/ by entering the DAS Office code and application number, and the Access Code provided by the WIPO.

Click the “Update Access Control List” tab. Select “US” (and any other desired DAS accessing Office) to grant the USPTO access to the registered priority application. Click “Update” to save. (See Figure 1.)

Access Control List			
Select	Office code ⇅	State or Office of second filing ⇅	Access Granted on ⇅
<input type="checkbox"/>	JP	403 Kasumigaseki 3-chome, Chiyoda-ku, TOKYO 100-8915	
<input checked="" type="checkbox"/>	US	Commissioner for Patents, P.O.Box 1450 Alexandria VA 22313-1450	Oct 5, 2009
<input type="checkbox"/>	GB	United Kingdom Intellectual Property Office (an operating name of the Patent Office) Concept House, Cardiff Road Newport, South Wales NP10 8QQ	
<input type="checkbox"/>	ES	Paseo de la Castellana 75, 28020 Madrid	
<input type="checkbox"/>	KR	Government Complex-Daejeon 139 Seonsa-ro, Seo-gu Daejeon 302-701	

Figure 1: Access Control List Management

Step 2: The USPTO Attempts To Retrieve From The WIPO The DAS Registered Priority Applications

- 2-1. Please see Overview above for specific information regarding applications that are not retrieved from the WIPO via the DAS.
- 2-2. Except as noted above, the priority applications that the USPTO can attempt to retrieve via the DAS are those filed with a participating DAS depositing Office (offices of first filing) which have been successfully registered into the DAS. Please refer to the following WIPO Web site for the current listing of the participating DAS depositing Offices:
<http://www.wipo.int/patentscope/en/pdocforum/participating.html>
- 2-3. Prerequisite: ***Applicant must have successfully “Registered” the priority application and received the DAS accessibility confirmation as described above in Step 1 before retrieval of the DAS participating Office priority application(s) is attempted by the USPTO.***
- 2-4. The USPTO will only electronically retrieve a foreign application (priority document) from the WIPO via the DAS if applicant actually claims foreign priority under 35 U.S.C. 119(a) and 37 CFR 1.55 in a U.S. national application. The foreign application must be identified in the Oath or Declaration or an Application Data Sheet (ADS).
- 2-5. The USPTO will send a notice to applicant indicating the request to retrieve is improper when the submitted request (*e.g.*, form PTO/SB/38) does not meet the USPTO requirements under the DAS program (*e.g.*, an improper signature, a request to retrieve a foreign priority application that was not filed with a participating DAS depositing Office).
- 2-6. 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 application(s). Participating DAS depositing Office priority applications retrieved from the WIPO 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

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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 corner of the form (the area labeled “A”), 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.
2. Check the box labeled “B” in the sample.
3. In column 1 of the area labeled “C” identify the participating DAS depositing Office (*e.g.*, IB or GB).
4. In column 2 of the area labeled “C” identify the application number and filing date of the participating DAS depositing Office application.
5. The form must be signed (in the area labeled “D”) by someone authorized to grant access to the participating DAS depositing Office application(s) (identified in column 2).

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Doc Code: .REQ.RETR

PTO/SB/38 (07-09)
Approved for use through 07/31/2012. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
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.

Blank form [PTO/SB/38](#)