



UNITED STATES PATENT AND TRADEMARK OFFICE

USPTO RETRIEVAL OF FOREIGN PRIORITY DOCUMENTS FROM THE EPO, THE JPO AND THE KIPO

February 2011

1. This document contains 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. Please see –
 - a. [USPTO RETRIEVAL OF FOREIGN PRIORITY DOCUMENTS FROM THE WIPO VIA THE WIPO DIGITAL ACCESS SERVICE](#) for information about USPTO retrieval of priority applications from the World Intellectual Property Organization (WIPO) via the WIPO Digital Access Service.
 - 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.
2. Design applications cannot be retrieved from the EPO, the JPO, or the KIPO through the Priority Document Exchange (PDX) system.
3. PCT international applications cannot be retrieved from the EPO, the JPO, or the KIPO through the PDX system.
4. Except as noted in items 2 and 3 above, the USPTO can electronically retrieve a copy of a foreign priority application directly from the EPO, the JPO, and the KIPO.
5. 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.
6. Except as noted in items 2 and 3 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. Priority applications filed with the EPO to which priority is claimed in a U.S. application filed on or after January 16, 2007 under 35 U.S.C. 111(a).

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- b. Priority applications filed with the JPO to which priority is claimed in a U.S. application filed on or after July 28, 2007 under 35 U.S.C. 111(a).
 - c. Priority applications filed with the KIPO to which priority is claimed in a U.S. application filed on or after October 14, 2008 under 35 U.S.C. 111(a).
7. 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 the EPO, the JPO, or the KIPO unless the applicant files a request to retrieve the foreign application (*e.g.*, form [PTO/SB/38](#)) in the U.S. application.
8. In addition to retrieving a copy of an application filed with the EPO, the JPO, or the KIPO, an applicant may request the USPTO to retrieve any priority document that has been made of record within an application filed with the EPO or the JPO. For example, if applicant claims priority to a Canada priority application and a certified copy of the Canada priority document has been made of record in an application filed with the EPO, applicant may request the USPTO to electronically retrieve a copy of the certified Canada priority document from the EPO even if the U.S. application does not claim priority to the application filed with the EPO. At this time, the KIPO does not have the capability of transmitting priority documents that have been made of record within an application filed with the KIPO.
9. 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
10. There is no fee for this service no matter how many priority applications are retrieved.

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11. 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).

12. 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). Priority applications 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).

13. 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, priority applications 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 other foreign priority applications from the WIPO via the DAS please see [USPTO RETRIEVAL OF FOREIGN PRIORITY DOCUMENTS FROM THE WIPO VIA THE WIPO DIGITAL ACCESS SERVICE](#).

14. 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
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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 priority to 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 Office (*e.g.*, IB).
4. In column 2 of the area labeled “C” identify the application number and filing date of the participating Office application.
5. The form must be signed (in the area labeled “D”) by someone authorized to grant access to the participating 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

1 2 3 4 5 6	A Participating Office (e.g., EPO, JPO, KIPO) or DAS Depositing Office (e.g., IB)	B Application to be retrieved or application containing the non-participating priority application		C Non-participating priority application to be retrieved	
		App. No.	Filing Date	Country Code	App. No.

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.

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