



## UNITED STATES PATENT AND TRADEMARK OFFICE

### ACCESS TO U.S. PRIORITY APPLICATIONS BY THE WIPO VIA THE WIPO DIGITAL ACCESS SERVICE

February 2011

#### Overview

The USPTO offers the exchange of documents through the WIPO Digital Access Service (DAS) as both a depositing Office and an accessing Office. Through the DAS depositing Office functions of the USPTO, the DAS allows U.S. applicants to register their U.S. priority applications into the DAS such that their registered U.S. priority applications can be accessed by the selected DAS participating accessing Offices where applications claiming priority to a U.S. application that has been registered into the DAS are filed. A list of DAS participating accessing Offices is available on the 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 U.S. priority application into the DAS.

#### PCT international applications and compliance with PCT Rule 17

With effect from January 1, 2010, the International Bureau for PCT purposes is a DAS participating accessing Office. Applicants that file an international application with a receiving Office other than the United States receiving Office (RO/US) which claims priority to one or more earlier U.S. application may comply with the requirements of PCT Rule 17 by requesting that the International Bureau of the WIPO to obtain a certified copy of their U.S. priority applications to which priority is claimed in the PCT international application and which have been registered into the DAS. Similarly, applicants that file a PCT international application with the RO/US may request the International Bureau to access an earlier foreign application filed with a DAS participating depositing Office by registering the earlier foreign application into the DAS and making the appropriate indication at Box No. VI on the Request (Form PCT/RO/101). Information regarding registration of earlier foreign applications into the DAS can be obtained at the above Web site.

For international applications filed with the RO/US applicants may ask the RO/US to prepare and transmit a copy of an earlier U.S. application in the usual way (*e.g.*, making the appropriate indication at Box No. VI on the Request (Form PCT/RO/101)). This service is independent of the DAS.

#### Direct Electronic Access to U.S. applications (other than U.S. design applications and PCT international applications) by the Japan Patent Office (JPO),

#### the Korean Intellectual Property Office (KIPO), and the European Patent Office (EPO)

Although the JPO (DAS Office code JP) and the KIPO (DAS Office code KR) are indicated as DAS participating accessing Offices, applicants need not register their U.S. priority applications into the DAS for access by the JPO and the KIPO. The USPTO continues direct electronic access to U.S. priority applications by the JPO and the KIPO under existing Priority Document Exchange (PDX) system bilateral agreements. Similarly, the USPTO continues direct electronic

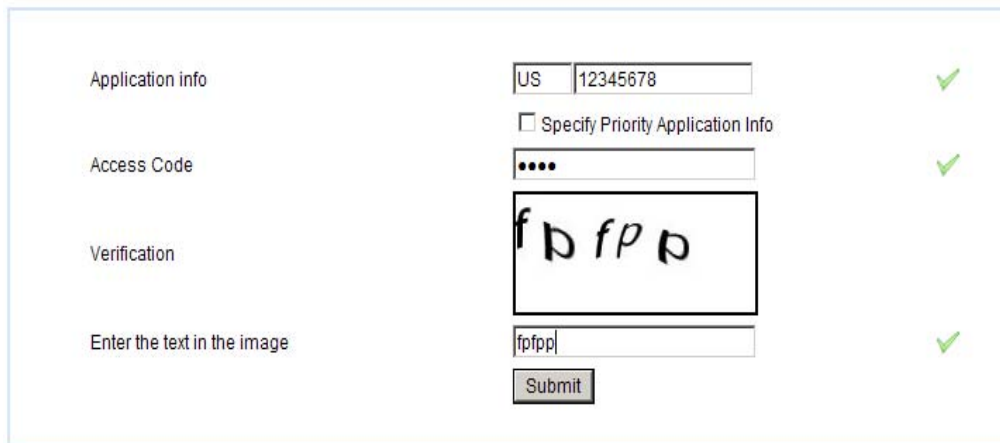
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access to U.S. priority applications by the EPO under an existing PDX system bilateral agreement.

1. This document contains information about access to U.S. priority applications by the World Intellectual Property Organization (WIPO) via the WIPO Digital Access Service (DAS). Please see –
  - a. [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.
  - b. [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.
  - c. [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.
2. Design priority applications are excluded from the WIPO DAS.

## **Step 1: Using the Digital Access Service (DAS) to Register U.S. Priority Applications**

- 1a-1. Launch [https://webaccess.wipo.int/priority\\_documents/](https://webaccess.wipo.int/priority_documents/). (See Figure 1.) Enter “US” as the two letter DAS Office code and enter the application number in the Application Info fields. Do not mark the “Specify Priority Application Info” checkbox – this is irrelevant to the services offered by the USPTO as a DAS depositing Office.
- 1a-2. Enter the Access Code. This is the confirmation number of the U.S. application which can be found on the EFS-Web Electronic Acknowledgment Receipt document and the filing receipt. (See Figure 1.)
- 1a-3. Enter the CAPTCHA text and click Submit. (See Figure 1.)



The screenshot shows a registration form with the following fields and values:

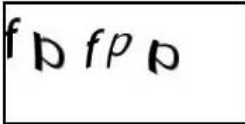
Application info	US   12345678	✓
	<input type="checkbox"/> Specify Priority Application Info	
Access Code	....	✓
Verification		
Enter the text in the image	f D f P D	✓
	<input type="button" value="Submit"/>	

Figure 1: Registration of U.S. application

- 1a-4. The below screen will launch. Enter applicant’s name, 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 (ACC) Invalid, or Application was not found) by the office of first filing.

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Application info	<input type="text" value="US"/>	<input type="text" value="12345678"/>	
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 will take at least one business day.

For successful “Registered” status of a U.S. application all of the following criteria must be met:

- a. The U.S. application number and access code (i.e., confirmation number) are correct and matched.
- b. At least one of the following criteria must be met:
  - i. The application has published.
  - OR –
  - ii. The applicant has submitted the proper authorization to the USPTO (e.g., Form PTO/SB/01 or PTO/SB/39) to permit access to the application for this purpose **AND** the application has cleared national security review.

Form PTO/SB/01 can be found at [PTO/SB/01](#).

Form PTO/SB/39 can be found at [PTO/SB/39](#).

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

Application info	US	12345678
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 the desired DAS participating accessing Offices to grant access to the registered U.S. application by the selected DAS accessing Office. Click “Update” to save. (See Figure 4.)

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 type="checkbox"/>	US	Commissioner for Patents, P.O.Box 1450 Alexandria VA 22313-1450	
<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 checked="" type="checkbox"/>	ES	Paseo de la Castellana 75, 28020 Madrid	Sep 22, 2009
<input type="checkbox"/>	KR	Government Complex-Daejeon 139 Seonsa-ro, Seo-gu Daejeon 302-701	

Figure 4: Access Control List Management

## **Step 2: Asking A DAS Participating Accessing Office To Retrieve The Registered U.S. Priority Application Using The WIPO DAS**

- 2-1. Once the application has been registered with the DAS as above, any DAS participating accessing Office that has been selected on the Access Control List can access the registered priority application via the DAS. For example, Figure 4 above indicates access granted to one DAS accessing Office (ES on Sep 22, 2009). Please refer to the following WIPO Web site for the current listing of the participating accessing Offices:  
<http://www.wipo.int/patentscope/en/pdocforum/participating.html>
- a. Note that some Offices may only offer depositing functions, not accessing functions.
  - b. Note that although the JPO (DAS Office code JP) and the KIPO (DAS Office code KR) are DAS participating accessing Offices, applicants need not register their U.S. priority applications into the DAS for direct electronic exchange with those particular Offices. The USPTO continues direct electronic access to U.S. priority applications by the JPO and the KIPO under existing Priority Document Exchange (PDX) system bilateral agreements. For instructions for access to U.S. priority applications by the JPO and the KIPO (as well as the EPO) please see [ACCESS TO U.S. PRIORITY APPLICATIONS BY THE EPO, THE JPO, OR THE KIPO](#). For PCT international applications filed with the RO/JP, RO/KR, or RO/EP, applicants may request the International Bureau to access an earlier U.S. application filed with a DAS participating depositing office by registering the earlier U.S. application into the DAS, updating the Access Control List to give the International Bureau access, and making the appropriate indication at Box No. VI on the Request (Form PCT/RO/101). Information regarding registration of earlier applications into the DAS can be obtained at the WIPO Web site:  
<http://www.wipo.int/patentscope/en/pdocforum/participating.html>
- 2-2. When an applicant files an application in a DAS participating accessing Office and wants that Office to access one or more U.S. priority application from the USPTO through the DAS for placement in the application filed in the DAS participating accessing Office:
- a. Check with the WIPO or DAS participating accessing Office for instructions on how requests for retrieval of U.S. priority documents should be filed. Usually, this will involve either marking a box when sending the application form or sending a separate letter or form. ***Prerequisite: Applicant must have successfully “Registered” with the DAS accessibility confirmation for the intended retrieval of the U.S. priority application(s) as described above in Step 1.***
  - b. The USPTO will permit access to a U.S. priority application by the WIPO via the DAS only if the U.S. application meets at least one of the following criteria:

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i. The application has been published.

– OR –

ii. The applicant has submitted a proper written authorization (*e.g.*, Form PTO/SB/01 or PTO/SB/39) to the USPTO to permit access to the application by any intellectual property office **AND** the application has cleared national security review (a foreign filing license has been granted).

(1) The USPTO has prepared a standard form [PTO/SB/39](#) which may be used to grant this permission.

(2) 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) For retrieval to be successful, the applicant must authorize the USPTO to permit the WIPO and DAS participating accessing office 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.

2-3. Form PTO/SB/01 can be found at [PTO/SB/01](#).

2-4. Form PTO/SB/39 can be found at [PTO/SB/39](#)

2-5. For authorization, please submit form [PTO/SB/01](#) or form [PTO/SB/39](#) using one of the routes indicated below:

a. Electronically via EFS-Web:

i. For PTO/SB/01, select document description “Oath or Declaration filed” under the category Application Part.

ii. For PTO/SB/39, select document description “Authorization to access Appl. by Trilateral Office” under the category Priority Documents.

b. Mail to the USPTO mailing address:  
Commissioner for Patents

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PO Box 1450  
Alexandria, VA 22313-1450

- 2-6. The USPTO will send a notice to the applicant indicating that the authorization is improper when the submitted [PTO/SB/01](#) or [PTO/SB/39](#) does not meet USPTO requirements (*e.g.*, signature provided is not an attorney or agent of record).
- 2-7. U.S. applicants should not register a U.S. application with the DAS unless the USPTO is the office of first filing. At the present time foreign priority documents contained within a U.S. application cannot be retrieved by a DAS participating accessing Office through the DAS.
- 2-8. The USPTO and the WIPO will not charge any fees to the applicant for this service. It is permitted for DAS participating accessing Offices to charge fees for this service, but at the present time, no DAS accessing Office is actually charging any fees to the applicant for accessing priority applications via the DAS.
- 2-9. 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](mailto:PDX@uspto.gov)

Hung Vuong  
Computer Specialist  
571-272-5727  
[PDX@uspto.gov](mailto:PDX@uspto.gov)

Tamara Graysay  
Special Program Examiner  
571-272-6728  
[PDX@uspto.gov](mailto:PDX@uspto.gov)



# INSTRUCTIONS FOR COMPLETION OF FORM [PTO/SB/01](#)

On the first page of the Declaration place a mark inside the checkbox under “Authorization to Permit Access to Applicant by Participating Offices” paragraph (in the area labeled “1”).

Doc Code: Oath

Document Description: Oath or declaration filed

PTO/SB/01 (04-09)  
Approved for use through 06/30/2010. OMB 0651-0032  
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 contains a valid OMB control number.

<p align="center"><b>DECLARATION FOR UTILITY OR DESIGN PATENT APPLICATION (37 CFR 1.63)</b></p> <p><input type="checkbox"/> Declaration Submitted With Initial Filing      OR      <input type="checkbox"/> Declaration Submitted After Initial Filing (surcharge (37 CFR 1.16(f) required))</p>		Attorney Docket Number	
		First Named Inventor	
<i>COMPLETE IF KNOWN</i>			
		Application Number	
		Filing Date	
		Art Unit	
		Examiner Name	

I hereby declare that: (1) Each inventor's residence, mailing address, and citizenship are as stated below next to their name; and (2) I believe the inventor(s) named below to be the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought on the invention titled:

*(Title of the Invention)*

the application of which

is attached hereto

OR

was filed on (MM/DD/YYYY) \_\_\_\_\_ as United States Application Number or PCT International Application Number \_\_\_\_\_ and was amended on (MM/DD/YYYY) \_\_\_\_\_ (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified application, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

**Authorization To Permit Access To Application by Participating Offices**

If checked, 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). This box should not be checked if the 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.

In accordance with 37 CFR 1.14(h)(3), access will be provided to a copy of the above-identified patent 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.

[Page 1 of 3]

This collection of information is required by 35 U.S.C. 115 and 37 CFR 1.63. The information is required to obtain or retain a benefit by the public which is to be (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 21 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.

**INSTRUCTIONS FOR COMPLETION OF FORM [PTO/SB/39](#)**

1. In the upper right corner of the form (the area labeled “1”) please enter as much identifying information as available about the U.S. application in which permission to access is being authorized.
2. In the box labeled “2” insert the title of the U.S. application in which permission to access is being authorized.
3. The form must be signed in the area labeled “3” in accordance with 37 CFR 1.14(c).

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Doc Code: PD.TO.AUTH  
 Document Description: Authorization to access Appl. by Trilateral Office

PTO/SB/39 (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.

<p><b>AUTHORIZATION TO PERMIT ACCESS TO APPLICATION BY PARTICIPATING OFFICES</b></p> <p>Send completed form to: Commissioner for Patents                  P.O. Box 1450, Alexandria, VA 22313-1450</p>	<small>COMPLETE IF KNOWN</small>	
	Application Number	
	Filing Date	
	First Named Inventor	
	Attorney Docket Number	
Title (Required)		

1

2

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.

3

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

_____	_____
Signature	Date
_____	_____
Printed or Typed Name	Telephone Number
_____	_____
Title	Registration Number, if applicable

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.

Blank form [PTO/SB/39](#)