

REPORT

ELECTRONIC EXCHANGE OF PRIORITY DOCUMENTS

January 26, 2007

Further to our December 6, 2006 Special Report, the U.S. Patent and Trademark Office (USPTO) has announced that the USPTO and the European Patent Office (EPO) are now fully participating in a free service that will allow patent application priority documents to be exchanged between the USPTO and the EPO electronically. This service should eliminate the need to obtain certified paper copies of priority applications for filing in connection with many U.S. and EPO patent applications. The Japanese Patent Office (JPO) is expected to begin participating in this service in July 2007. However, Japanese and other non-U.S./EPO applicants can use aspects of the service immediately.

I. The Priority Document Exchange Service

In order to obtain the benefit of an earlier filing in another patent office, a patent applicant must still present a claim for priority within four months of the filing date or sixteen months of the foreign priority date, as is the current practice. Instead of requiring applicants to file a certified paper copy of the priority application to perfect the claim for priority, the USPTO and the EPO will be able to obtain an electronic copy of any priority application filed in the other of those offices from their electronic records management systems at no cost to the applicant, and will accept that electronic copy in place of the certified paper copy in applications filed on or after January 1, 2006.

Thus for our patent clients who file their priority applications in the EPO, it is no longer necessary to send us a certified paper copy of the EPO priority application. Instead, we merely need your authorization to instruct the USPTO to obtain an electronic copy from the EPO. This authorization need not be in any special form, and may be included in your order letter to us for filing a U.S. application. The USPTO and EPO do not require any additional authorization from the applicant. We do not yet know whether a more formal authorization will be required

to obtain electronic copies from the JPO when the JPO begins participating in July 2007.

For our patent clients who file their priority applications in the USPTO, it is no longer necessary to send our European associates a certified paper copy of the U.S. priority application for filing in an EPO application. Instead, we will authorize our European associates to instruct the EPO to obtain an electronic copy from the USPTO. In accordance with USPTO requirements, we will also file in the USPTO a signed authorization from an attorney of record in the U.S. patent application to permit the EPO to obtain an electronic copy of the priority application from the USPTO if the U.S. priority application has not yet been published. No such formal authorization is required in connection with U.S. priority applications that have been published.

II. Use of the Service with Priority Filings in Non-Participating Offices

Applicants whose priority applications were filed outside of the USPTO and the EPO -- i.e., in non-participating offices -- may also take advantage of the new free service to a limited extent.¹

For U.S. or EPO patent applications that claim priority from a patent application originally filed in a non-participating office, the applicant may request that the USPTO or the EPO retrieve an electronic copy of the priority application that has been filed in another participating office. We only need to identify the

¹ The USPTO and the EPO are considered "participating offices." The USPTO has announced that the JPO will also be considered a participating office in July 2007. All other offices (including the JPO until July 2007) are considered "non-participating offices."

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participating office, the application in which the priority application has been filed, the priority application, and the non-participating office where the priority application was originally filed.

For example, an applicant may file an original patent application in the French Industrial Property Office (INPI) or (prior to its participation in July 2007) in the JPO. Thereafter, the applicant may file a patent application in both the USPTO and the EPO and claim priority from the French or Japanese patent application. Prior to the new service, certified paper copies of the French or Japanese priority application had to be filed in both the USPTO and the EPO. However, it is now only necessary to file a certified paper copy in one of the USPTO or the EPO, but not both. A request can be filed in the other participating office to obtain an electronic copy from the participating office in which the paper copy was filed. Thus the costs of ordering, shipping and tracking certified paper copies can be reduced for all of our clients who file in both the EPO and the USPTO.

III. Recommendations

A. U.S. Application Claiming Priority to an EPO Patent Application

For our clients claiming priority from an EPO patent application in their U.S. patent application, we recommend utilizing this new service in order to eliminate the time and expense involved in obtaining a certified paper copy of an EPO patent application and forwarding the certified paper copy to us for filing in the USPTO. In the absence of instructions to file a certified paper copy of the EPO patent application, we will request that the USPTO obtain an electronic copy of the EPO priority application from the EPO according to the new service.

B. Application Claiming Priority to a Non-Participating Office Patent Application

For our clients claiming priority to a non-participating office patent application, we recommend utilizing this new service in order to reduce the time and expense involved in obtaining multiple certified paper copies of an application from a non-participating office and forwarding the certified paper copies to both the USPTO and the EPO (and to the JPO as of July 2007). Instead of obtaining and forwarding a certified paper copy to each participating office, we recommend filing only one certified paper copy in a

participating office, and requesting the other participating office(s) to obtain an electronic copy of the non-participating office priority application from the participating office in which the certified paper copy was filed.²

If we are to request that the USPTO obtain an electronic copy of an application originally filed in a non-participating office from the EPO (or JPO after July 2007), please instruct us to do so, confirm to us that the certified paper copy has been filed in the EPO (or JPO after July 2007), and identify the application in which it was filed. If you prefer that the EPO (or JPO after July 2007) obtain an electronic copy of an application originally filed in a non-participating office from the USPTO, please instruct us to file the necessary authorization in the USPTO.

C. Application Claiming Priority to a Japanese Patent Application

Until the JPO becomes a participating office (presumably in July 2007), we recommend that clients claiming priority to a Japanese patent application proceed as discussed above for other clients claiming priority to a non-participating office patent application. While it would be possible to wait until the JPO becomes a participating office, this might create confusion in existing files that is better avoided until the JPO's participating status is confirmed. Once the JPO becomes a participating office, we recommend following a procedure corresponding to that discussed above for our clients claiming priority from an EPO patent application.

² In selecting the participating office in which to file the certified paper copy, both convenience and timing should be considered. For example, some European clients may find it more convenient to file the certified paper copy in their local receiving office for the EPO. Absent this factor, consideration should be given to when a serial number will be available for the patent application in which the certified paper copy was filed, as that serial number will have to be used in requesting the other participating office to obtain the priority application. The USPTO will usually provide the serial number for a paper-filed patent application within about one month after its filing date. The USPTO provides the serial number for an electronically filed patent application on the same day that the patent application is filed. For those clients for whom we electronically file U.S. patent applications, we provide the client with the serial number on the filing date.

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D. Application Claiming Priority to a U.S. Patent Application

We will provide the USPTO with written authorization to provide an electronic copy of a U.S. priority application to the EPO or future participating office when we provide filing instructions to our foreign associates, unless requested not to do so. We recommend a similar approach for our U.S. clients who handle their own foreign filings.

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multinational corporations to small privately owned companies, major universities, and individual entrepreneurs.

This Special Report is intended to provide information about legal issues of current interest. It is not intended as legal advice and does not constitute an opinion of Oloff & Berridge, PLC. Readers should seek the advice of professional counsel before acting upon any of the information contained herein.

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