

# REPORT

## ELECTRONIC EXCHANGE OF PRIORITY DOCUMENTS

July 16, 2007

The U.S. Patent and Trademark Office (USPTO) has announced several changes in the electronic exchange of patent application priority documents discussed in our December 6, 2006 and January 26, 2007 Special Reports. The USPTO and the European Patent Office (EPO) are now automatically electronically exchanging priority applications, and the Japanese Patent Office (JPO) will join in that service on July 28. This service should simplify the electronic exchange of priority applications because it will no longer be necessary to file a paper certified copy of a USPTO, EPO or JPO priority application in any of those offices, or even to file a request for the USPTO, EPO or JPO to obtain an electronic copy if the priority application is identified when a patent application is filed.

In addition, the service to electronically exchange priority applications is no longer limited to U.S. patent applications filed on or after January 1, 2006. Thus if an EPO or JPO priority document has not yet been filed in an earlier-filed U.S. patent application, we can simply request the USPTO to obtain it directly from the EPO or JPO.

### **I. The Revised Priority Document Exchange Service With the EPO**

The USPTO and the EPO previously required patent applicants to file a request for the USPTO and the EPO to obtain an electronic copy of a priority application from the other office. The USPTO and the EPO no longer require a request to be filed if the priority application is identified in the Declaration or an Application Data Sheet when the patent application is filed. The USPTO and the EPO will instead automatically attempt to obtain an electronic copy of the priority application. The USPTO and the EPO will still require that a request be filed if the priority application is identified after the patent application is filed, or the patent application was filed prior to June 4, 2007.

For our patent clients who file their priority applications in the USPTO, the EPO will also automatically attempt to obtain an electronic copy. However, the USPTO will not release a U.S. patent application unless we 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. The New Priority Document Exchange Service With the JPO**

The JPO will begin participating in the electronic exchange of priority applications on July 28, 2007, and the electronic exchange will apply to previously filed patent applications. The USPTO and the JPO will not require that a request be filed if the patent application is filed after July 28 and if the priority application is identified when the patent application is filed. The USPTO and the JPO will instead automatically attempt to obtain an electronic copy of the priority application. However, if the priority application is identified after the patent application is filed or if the patent application was filed prior to July 28, 2007, the USPTO and the JPO will require the applicant to file a request.

Thus for our clients claiming priority from a JPO patent application in their U.S. patent application, it is no longer necessary to send us a certified copy of the JPO priority application.

For our clients who file their priority patent applications in the USPTO, the JPO will also automatically attempt to obtain an electronic copy. However, as with the

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EPO, the USPTO will not release a U.S. patent application unless we also file in the USPTO a signed authorization from an attorney of record in the U.S. patent application to permit the JPO 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.

We understand that the JPO began accepting requests to retrieve priority applications from the USPTO on July 1, 2007. However, the USPTO will not provide priority applications to the JPO until after July 28, 2007.

### **III. Application of the Revised Priority Document Exchange Service to Non-Participating Office Priority Documents<sup>1</sup>**

Applicants whose priority applications were filed outside of the USPTO, the EPO and the JPO – i.e., in non-participating offices – may still request that the USPTO or the EPO obtain an electronic copy of the priority application that was filed in the other one of those participating offices. A request is required, and must identify the 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. The USPTO and the EPO are currently developing a system that will simplify the process for retrieving priority applications originally filed in non-participating offices in European Patent Convention (EPC) member states. This system is expected to be implemented in mid 2008.

The USPTO and the JPO will not have the ability to electronically obtain from the other office a priority application originally filed in a non-participating office.

### **IV. Requirements to File Priority Documents with the USPTO**

For a U.S. patent application, the applicant is required to ensure that a priority application is filed (either via paper certified copy or electronic copy) before the Issue Fee is paid in order to obtain the benefit of an earlier filing date in

another Patent Office. Thus, it will be necessary to make sure that the USPTO actually receives the electronic copy or that a paper certified copy is filed.

Accordingly, for a U.S. patent application that has been filed or will be filed, we will determine whether the USPTO will automatically attempt to retrieve the priority application, and if not, either file a request to electronically retrieve the priority application or file a paper certified copy. We will thereafter monitor the U.S. patent application to ensure that the USPTO acknowledges receipt of the priority application, as is our current practice.

### **V. Recommendations**

#### **A. U.S. Patent 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 service in order to reduce the time and expense involved in obtaining a certified copy or requesting that the USPTO obtain an electronic copy of the EPO patent application. Thus we recommend that you no longer obtain or send us paper certified copies of EPO priority applications. We will continue to identify the EPO priority application(s) in an Application Data Sheet, and monitor the file to ensure that an electronic copy is obtained from the EPO. If the EPO priority application is not identified in either the Declaration or the Application Data Sheet, or if the U.S. patent application was filed prior to June 4, we will file a request for the USPTO to obtain an electronic copy from the EPO. If we receive a certified copy from you, we will file it.

#### **B. U.S. Patent Application Claiming Priority to a JPO Patent Application**

After the JPO becomes a participating office on July 28, we recommend that clients claiming priority to a Japanese patent application proceed as discussed above for our clients claiming priority to an EPO patent application. Between now and July 28, we recommend waiting until after July 28 and then requesting that the USPTO obtain an electronic copy of the JPO patent application instead of obtaining and filing a paper certified copy of the JPO patent application. In the absence of instructions to file a paper certified copy of the JPO patent application, we will request that the USPTO obtain an electronic copy of the JPO patent application after July 28.

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<sup>1</sup> The USPTO and the EPO are now "participating offices." The JPO will also be a participating office as of July 28. All other offices are considered "non-participating offices."

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If a paper certified copy has already been ordered or has been received, or the U.S. patent application has been allowed and the Issue Fee is due before October 1, 2007, we recommend filing the paper certified copy according to the current practice.

**C. Application Claiming Priority to a Non-Participating Office Patent Application**

Until the USPTO or the EPO develop additional systems (e.g., for EPC member states), we recommend following the recommendations outlined in our January 26, 2007 Special Report – e.g., file a certified copy in the EPO, and request that the USPTO obtain it directly from the EPO.

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

We will continue to file in the USPTO written authorization to provide an electronic copy of a U.S. priority application to the EPO and JPO 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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*Oloff & Berridge, PLC is a full-service Intellectual Property law firm based in historic Alexandria, Virginia. The firm specializes in patent, copyright, trademark, and antitrust law and litigation, and represents a large and diverse group of domestic and international clients, including businesses ranging from large multinational corporations to small privately owned companies, major universities, and individual entrepreneurs.*

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