

REPORT

ELECTRONIC FILING OF EPO PRIORITY DOCUMENTS

December 6, 2006

Oliff & Berridge is pleased to report that the U.S. Patent and Trademark Office (USPTO) and the European Patent Office (EPO) are preparing to launch a new free service that will allow patent application priority documents to be exchanged between the USPTO and the EPO electronically. This service is scheduled to be available in January 2007, and should eliminate the need to obtain certified copies of EPO priority applications for filing in many U.S. applications, and vice versa.

I. New Priority Document Exchange

Instead of requiring applicants to file a certified paper copy of the foreign application, the USPTO and the EPO will be able to obtain an electronic copy of the foreign application filed in the other office from their electronic records management systems at no cost to the applicant. The USPTO has announced that this new service will apply to any application filed on or after January 1, 2006 that claims priority from a foreign application. A paper certified copy of the foreign application is still required for applications filed in 2005 or earlier.

That is, for U.S. applications filed on or after January 1, 2006 that claim priority from an EPO application, the USPTO will be able to obtain an electronic copy of the EPO application, and applicant will not need to obtain and submit a paper certified copy. For U.S. applications filed before January 1, 2006 that claim priority from an EPO application, the USPTO will not obtain an electronic copy of the EPO application.

The USPTO has stated that testing of this new service will be complete in early December 2006 and full implementation is expected to begin in January 2007. The USPTO has not indicated whether this service will extend

to other countries, although previous discussions and proposals were to also include the Japanese Patent Office.

II. Recommendations

We recommend utilizing this new service in order to reduce the time and expense involved in obtaining a certified copy of an EPO application and forwarding the certified copy to us for filing in the USPTO.

For most clients that filed or are planning to file an application in the USPTO on or after January 1, 2006 claiming priority from an EPO application, but have not yet obtained a paper certified copy of the EPO application, we suggest waiting until after the service is in full effect instead of ordering a certified copy of the EPO application. After the service begins in January 2007 as expected, we suggest requesting that the USPTO obtain an electronic copy of the EPO application. If a certified copy has already been ordered or has been received, or the U.S. application has been allowed and the Issue Fee is due before March 1, 2007, we recommend filing the paper copy according to the current practice.

In order to obtain the benefit of an earlier filing in the USPTO, applicant must still present a claim for priority within four months of the U.S. filing date or sixteen months of the foreign application filing date, as is the current practice. A certified copy of the foreign application, whether paper or electronic, must be filed before the application issues. In the absence of instructions to file a paper certified copy of the EPO application, we will request that the USPTO obtain an electronic copy of the EPO application from the EPO according to the new service.

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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.

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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