

## PDX FAQs

### 1. What is PDX?

"PDX" stands for "Priority Document Exchange" which provides for the electronic transmission of priority documents to and from participating foreign Intellectual Property Offices (if applicant files a request and an authorization) without payment of a fee.

The United States Patent and Trademark Office (USPTO) established agreements to obtain and provide priority documents with the European Patent Office (EPO) as of January 16, 2007, with the Japan Patent Office (JPO) as of July 28, 2007, with the Korean Intellectual Property Office (KIPO) as of October 14, 2008, and with the World

Intellectual Property Organization (WIPO) as of April 20, 2009.

For more information regarding electronic priority document exchange between the USPTO and the WIPO see the PDX Web site at <http://www.uspto.gov/web/patents/pdx/pdx.html>.

### 2. Is there a limit on how many priority documents I can retrieve for a single application?

No.

### 3. Are there any other restrictions or limits on the PDX program?

Due to technical limitations, at present the PDX system can only process priority documents that contain about 1,000 pages or fewer. For very large documents, applicants should file the paper certified copy of the foreign applications rather than filing a request to retrieve electronic priority applications.

Further, priorities claimed in international applications filed under the Patent Cooperation Treaty are excluded from participation. This includes retrieving or transmitting any international application as a priority document as well as requesting retrieval of any priority document for placement within an international application. Additionally, design applications are also excluded from participation.

### 4. How does PDX work?

Each Office has its own procedures. Check the EPO and JPO websites for information on their practices. The USPTO's practice is set forth in the Changes to Implement Priority Document Exchange between Intellectual Property Offices, 1315 Off. Gaz. Pat. Office 63 (February 13, 2007); Electronic Exchange of Priority Documents, 1318 Off. Gaz. Pat. Office 116 (May 15, 2007); Simplification of the Electronic Exchange of Priority Documents, 1319 Off. Gaz. Pat. Office 150 (June 26, 2007); Addition of Japan Patent Office as Participating Foreign Intellectual Property Office in Electronic Exchange of Priority Documents, 1320 Off. Gaz. Pat. Off. 173 (July 31, 2007), Enhancement of Priority Document Exchange Program and USPTO Declaration Form, 1328 Off. Gaz. Pat. Office 90 (March 11, 2008); and, Addition of Korean Intellectual Property Office as Participating Office in Electronic Exchange of Priority Documents and Further Procedural Information, 1336 Off. Gaz. Pat. Office 94 (November 11, 2008).

The USPTO, EPO, JPO, and KIPO do not charge a fee for this service.

The USPTO will automatically request retrieval of priority documents from the appropriate Office if a newly filed U.S. application claims priority to one or more EPO, JPO, or KIPO applications in the Oath, Declaration, or Application Data Sheet. Written instruction ([e.g., PTO/SB/38](#)) is required to request retrieval of:

- EPO priority document for a U.S. application filed prior to June 4, 2007
- Non-EPO priority document that is of record in an EPO application
- JPO priority document for a U.S. application filed prior to July 28, 2007
- Non-JPO priority document that is of record in a JPO application
- KIPO priority document for a U.S. application filed prior to October 14, 2008

Applicants may use Form PTO/SB/38, which is available on the USPTO website at <http://www.uspto.gov/web/forms/sb0038.pdf>.

For example, if an applicant files a U.S. application filed prior to June 4, 2007 and claiming foreign priority to an European patent application, the applicant may file a request (PTO/SB/38) in compliance with 37CFR 1.55(d) signed by a person who has the authority to grant access to the European patent application.

In addition to retrieving a copy of a European patent application itself, the USPTO can retrieve a copy of any priority document contained within a European patent application. For example, if the U.S. application claims foreign priority to a French application under 35 U.S.C.119(a)-(d) and a certified copy of the French application is contained within the electronic record of a European patent application, the USPTO will retrieve and place a copy of the French priority document into the electronic record of the U.S. application that claims priority to the French application when applicant files a request in compliance with 37 CFR 1.55(d). See the instructions that accompany Form PTO/SB/38 for more information on how to request retrieval of such a priority document.

For example, if the U.S. application claims foreign priority to a French application under 35 U.S.C.119(a)-(d) and a certified copy of the French application is contained within the electronic record of a European patent application, the USPTO will retrieve and place a copy of the French priority document into the electronic record of the U.S. application that claims priority to the French application when applicant files a request in compliance with 37 CFR 1.55(d). See the instructions that accompany Form PTO/SB/38 for more information on how to request retrieval of such a priority document.

Upon receipt of a timely filed request, the USPTO anticipates that two attempts will be made to retrieve a copy of the foreign application from the participating office. Applicants should check the private PAIR to determine if the copy of the foreign application has been retrieved by the USPTO. Successful retrieval of priority documents cannot be guaranteed. Also, the examiner will indicate the status of retrieval in an Office action (i.e., PTOL-326 Office Action Summary item 12; PTOL-37 Notice of Allowability item 3). If at the time of allowance, the priority document is still missing, applicant must file a paper certified copy of the priority document prior to the issuance of the application. See 37 CFR 1.55(a).

**5. Can PDX also be used to provide certified copies of US applications as-filed to the EPO or other participating Office?**

Yes. This electronic exchange of priority documents is bidirectional. Please monitor the EPO, JPO, KIPO and websites for information on their plans for implementing this service.

The EPO will use PDX to request an electronic priority document for EVERY U.S. application claimed as priority in a European patent application. This applies to European patent applications filed on/after 16 January 2007. The EPO will initiate a priority document retrieval request to the USPTO shortly after the filing of any European patent application that claims priority to a U.S. application.

The EPO, JPO and KIPO will not charge for either transmitting or retrieving electronic priority documents.

Please note, however, that the USPTO will release a copy of a U.S. application to another participating Office ONLY if it meets one of the following criteria:

1.1 The U.S. application has been published or patented

- OR-

2.1 The applicant has submitted written authorization to transmit the priority document to the participating Office (use of Form [PTO/SB/01](#) or Form [PTO/SB/39](#), is encouraged for this purpose)

-AND-

2.2 The U.S. application has cleared national security review

Because the deadline for submission of priority documents to the EPO (and JPO) normally expires prior to the time a U.S. application is published (criterion 1.1), applicants have to file a Form PTO/SB/39 as soon as they even consider filing a European (or Japan) patent application claiming priority to a U.S. application. Ideally, applicants who frequently file with the EPO (or JPO) would make submission of the Form PTO/SB/39 a regular part of the initial filing of their U.S. applications. There is no consequence for filing a Form PTO/SB/39 well before it is needed. Further, there is no consequence for filing a Form PTO/SB/39 and not subsequently filing in the EPO (or JPO).

Alternative, applicants can also submit authorization by check marking the box, "Authorization To Permit Access To Application by Participating Offices" on Form [PTO/SB/01](#).

**6. If my U.S. application claims priority to a European patent application, will I also have to file with the USPTO a paper copy of the priority document claimed?"**

No, the requirement for the certified copy of the foreign application will be considered satisfied if the electronic copy of the foreign application is received by the USPTO within the period set forth in 37 CFR 1.55(a) (e.g., before the payment of the issue fee).

However, because successful retrieval cannot be guaranteed, please be sure to monitor PAIR to confirm that the electronic copy of the foreign application has been received by the USPTO. At the time of allowance, the examiner will provide an acknowledgement on the Notice of Allowability (PTOL-37). If the priority document is still missing, applicant must file a paper certified copy of the priority document prior to the issuance of the application. See 37 CFR 1.55(a).

**7. Is there any consequence if I were to submit the priority document in paper AND request its electronic retrieval?**

No. However, this is unnecessary. Assuming successful electronic retrieval of the priority document from the EPO, JPO, or KIPO such a course of action will result in the U.S. file containing two copies of the priority document.

**8. How can I tell whether the requested priority document has been successfully retrieved?**

View via PAIR. An entry "Priority Documents electronically retrieved by USPTO from a participating IP Office" will appear in the "Image File Wrapper" tab.

**9. How soon after I file a request for retrieval of a priority document from the participating office (EPO, JPO, and KIPO) should I see the image in PAIR?**

It could take several months or longer.

In order to maximize the likelihood of successful retrieval, the PDX retrieval logic implemented by the USPTO requires the system to wait to transmit the retrieval request to the participating office until the following condition has been met:

The U.S. application into which the priority document will be placed has been forwarded to the Technology Center (i.e., PALM status 20 or greater).

If a first retrieval request is unsuccessful, the system will generate another request one week later.

Consequently, several months could elapse between the time an applicant files a request for priority document retrieval and the actual transmission of the request to the participating office.

**10. How will I know that my request (PTO/SB/38) and/or authorization (PTO/SB/39) have been received by the USPTO?**

The request and/or authorization will be viewable via PAIR.

The filing receipt will include one or both of the following texts:

Request to Retrieve - This application either claims priority to one or more applications filed in an intellectual property Office that participates in the Priority Document Exchange (PDX) program or contains a proper Request to Retrieve Electronic Priority Applications(s) (PTO/SB/38 or its equivalent). Consequently, the USPTO will attempt to electronically retrieve these priority documents.

Permission to Access - A proper Authorization to Permit Access to Application by Participating Office (PTO/SB/39 or its equivalent) has been received by the USPTO.

**11. Who can sign form PTO/SB/39?**

The PTO/SB/39 must be signed in accordance with 37 CFR 1.14(c). Thus it must be signed by:

1. An applicant;
2. An attorney or agent of record;
3. An authorized official of an assignee of record (made of record pursuant to 37 CFR § 3.71); or
4. A registered attorney or agent named in the papers accompanying the application papers filed under 37 CFR 1.53, or the national stage documents filed under 37 CFR 1.495, if an executed oath or declaration pursuant to 37 CFR 1.63 or 1.497 has not been filed

**12. Is retrieval of my priority document from the participating office automatic? If not, what do I have to do to arrange for its retrieval?**

The USPTO will only retrieve a copy of the foreign application from EPO, JPO, or KIPO application from the participating office if applicant: (1) claims the priority to the foreign application under 35 U.S.C. 119(a)-(d) and 37 CFR 1.55 and (2) identifies the foreign application in the oath or declaration (37 CFR 1.63(c)) or an application data sheet (37 CFR 1.76(a)(6)).

Applicants may use form PTO/SB/38 which is available on the USPTO web site at <http://www.uspto.gov/web/forms/sb0038.pdf>

13. **May I retrieve a copy of an EPO, JPO, or KIPO priority document for placement in a U.S. application if priority to that EPO, JPO, or KIPO application is not claimed in the U.S. application (for example, if the EPO application is cited as relevant prior art)?**

No. A copy of an EPO, JPO, or KIPO priority document can only be retrieved under this program if the U.S. application into which the priority document will be placed claims priority to that EPO, JPO, or KIPO application.

14. **Will the copy of the priority document retrieved from the EPO, JPO, or KIPO be certified?**

The requirement under 37 CFR 1.55 for the certified copy of the foreign application will be considered satisfied if applicant files a request in compliance with 37 CFR 1.55(d).

15. **May I print and re-use the priority document retrieved from the EPO, JPO, or KIPO to meet my 37 CFR 1.55 requirements in another application?**

No, applicant must file the request under 37 CFR 1.55(d) in each U.S. application that requires a certified copy of the foreign application. However, where the benefit of a foreign filing date based on a foreign application is claimed in a later filed application (i.e., continuation, continuation-in-part, division) or in a reissue application and an electronic copy of the foreign application as filed has been received in a parent or related application from the EPO, JPO, or KIPO through the priority document exchange program, it is not necessary to request an additional copy in the later application. See [MPEP 201.14\(b\)](#). The applicant when making such claim for priority may simply identify the application containing the electronic copy of the foreign application.

16. **What if my U.S. or European patent application contains a sequence listing CRF?**

At present the PDX system will not process a U.S. or EPO application containing a sequence listing CRF. Applicants should file the paper certified copy of the foreign applications rather than filing a request to retrieve electronic priority applications.

17. **Does the USPTO impose any charge for electronic retrieval or electronic transmission of the priority document?**

No. There is no fee either for retrieving a priority document from a participating Office or for transmitting a priority document to a participating Office.

18. **"Is there any change to the fees charged by the USPTO's Office of Patent and Trademark Copy Sales for preparing a paper (or CD) priority document?"**

No.

**19. For PDX support or questions, who can I 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)