



## United States Patent and Trademark Office

Office of the Deputy Commissioner for International Patent Cooperation

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April 10, 2020

Mr. Carl Oppedahl et al.  
c/o Oppedahl Patent Law Firm  
P.O. Box 351240  
Westminster, CO 80035-1240

Dear Mr. Oppedahl et al.:

Thank you for your letter of February 22, 2020 to the Commissioner for Patents at the United States Patent and Trademark Office (USPTO). Your correspondence has been referred to me for response.

Your correspondence requests that the USPTO make several procedural and technical modifications to our electronic exchanges of priority documents in patent applications. Your first request is that the USPTO “discontinue its present practice of actively aging” priority document retrievals and that going forward the retrievals be executed at the time that the applicant requests such retrieval. I am pleased to inform you that, as of late last year, the USPTO changed the timing of retrievals from docketing to a patent examiner to when the application is released from the Office of Patent Application Processing. The USPTO website has been recently updated to reflect the new timing of retrievals. Please note that the application filing receipt acts as a validation that applicants have made the correct priority claim, the USPTO has captured it correctly and that the applicant has provided the USPTO with the information necessary to affect retrieval.

Your correspondence correctly recognizes that the priority document exchange between the USPTO and the European Patent Office (EPO) is a direct bilateral priority document exchange as opposed to an exchange via the World Intellectual Property Organization’s Digital Access Service (WIPO DAS). In this regard, your second request is that the USPTO migrate this exchange to WIPO DAS so that applicants can benefit from the troubleshooting and validation functionality in WIPO DAS. The USPTO has a goal of migrating eligible priority document exchanges to WIPO DAS. This migration must be agreed to and undertaken bilaterally as there are significant transition issues that require coordination. The USPTO intends to initiate discussion with the EPO on this in the near future.

The third request in your correspondence is in relation to Form PTO/SB/38. Form PTO/SB/38 is used in two unique situations. The first situation is to request the USPTO to retrieve a priority document prepared by a foreign intellectual property office which does not participate with the USPTO in bilateral



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or multilateral priority document exchange but which was filed in an application at the EPO or the Japan Patent Office (JPO). The second situation is to request the USPTO to retrieve a priority document of an application filed in a foreign intellectual property office that participates with the USPTO in bilateral or multilateral priority document exchange but where the claim for priority to such application was made prior to that foreign intellectual property office participating in priority document exchange. Your request is that the USPTO reformat the form so that the boxes are larger and accommodate text in a font size readable by the human eye. Thank you for this observation. In response, the form has been modified and is available on our website.

Your fourth request is for the USPTO to become a DAS depositing office for international applications under the Patent Cooperation Treaty (PCT) filed in the USPTO as receiving Office. The USPTO is not currently in a position to make the technical and procedural changes necessary to implement due in part to the agency's focus on modernization and stabilization of our IT systems. When resources permit, the USPTO will revisit this issue and consider implementation.

Thank you for your constructive feedback. I hope this letter addresses most of your concerns. If you have any further questions relating to this matter, please contact Michael Neas at (571) 272-3289.

Sincerely,

Valencia Martin Wallace  
Deputy Commission for International Patent Cooperation  
US Patent and Trademark Office  
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