

# Training Module for Chapter 5 of the MPEP

*(Revised August 16, 2018)*

## Summary

### Chapter 5: Receipt and Handling of Mail and Papers

#### Section 506 – Completeness of Original Application

- Any papers received by the USPTO which purport to be an application for a patent will be assigned an application number for identification purposes.
- The filing date of an application for patent filed under this section, other than an application for a design patent or provisional application is the date on which a specification, with or without claims, is received in the Office (USPTO).
- The filing date of an application for a design patent filed under this section, except for continued prosecution application, is the date on which the specification, including at least one claim, and any required drawings are received in the Office.
- No new matter may be introduced into an application after the filing date.
- If an inadequate or incomplete application is received by the USPTO, the applicant is so informed and no filing date is granted until the missing items are received.

The oath or declaration, claim(s) and fees may be submitted after the application is submitted.

## Selected Questions and Answers for Chapter 5

### Question 5-2 (Oct03pm-34a)

In accordance with the patent laws, rules and procedures as related in the MPEP , which of the following paper is precluded from receiving the benefit of a certificate of mailing or transmission under 37 CFR 1.8?

- (A) An amendment, replying to an Office action setting a period for reply, transmitted by mail with a certificate of mailing to the USPTO from a foreign country.
- (B) An amendment, replying to an Office action setting a period for reply, transmitted by facsimile with a certificate of transmission to the USPTO from a foreign country.
- (C) An information disclosure statement (IDS) under 37 CFR 1.97 and 1.98 transmitted after the first Office action.
- (D) A request for continued examination (RCE) under 37 CFR 1.114.
- (E) An appeal brief.

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ANSWER: (A) is the most correct answer. See MPEP § 512, which states “The Certificate of Mailing procedure does not apply to papers mailed in a foreign country.”

**[Doug’s Comment:** This is a rather tricky question. However, you’ll never get tricked a second time if you look at a Certificate of Mailing. That’s because it includes a statement that user has verified that the mailing has sufficient First Class U.S. postage. Obviously, that statement would not be valid for mailing from a foreign country.]

(B) is not correct. See MPEP § 512. Certificate of transmission procedure applies to correspondence transmitted to the Office from a foreign country and an amendment is not prohibited from being transmitted by facsimile and is not precluded from receiving the benefits under 37 CFR § 1.8. (C) is not correct. See MPEP § 609, subsection “Time for Filing.” An IDS will be considered to have been filed on the date of mailing if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 CFR § 1.8. (D) is not correct. See MPEP § 706.07(h) Comparison Chart. An RCE is entitled to the benefit of a certificate of mailing or transmission under 37 CFR § 1.8. (E) is not correct. See MPEP § 1206. An appeal brief is entitled to the benefit of a certificate of mailing or transmission under 37 CFR § 1.8 because it is required to be filed in the Office within a set time period which is 2 months from the date of appeal.

### Question 5-3 (ap03pm 13a)

Prior to filing a patent application for a client, a registered practitioner determined that

the client was entitled to claim small entity status under 37 CFR 1.27. The practitioner filed a patent application for the client on November 1, 2017 together with a claim for small entity status under 37 CFR 1.27. On December 2, 2017, a Notice to File Missing Parts was mailed setting a two month period for reply and requiring the basic filing fee and the surcharge under 37 CFR 1.16(e). The practitioner timely submitted the small entity fees for the basic filing fee and the surcharge as required in the Notice. Shortly thereafter, the practitioner discovered that on October 31, 2017, the day before the application was filed, the client, without advising the practitioner, had assigned all rights in the invention that is the subject of the application to an entity that would not qualify for small entity status under 37 CFR 1.27. In accordance with the USPTO rules and the procedures set forth in the MPEP, which of the following actions would be the best action for the practitioner to take?

- (A) File a continuing application under 37 CFR 1.53(b) with the large entity filing fee and then file a letter of express abandonment under 37 CFR 1.138 in the original application after the continuing application has been accorded a filing date.
- (B) Promptly file a notification of loss of small entity status under 37 CFR 1.27(g) and, thereafter, pay large entity fees whenever any subsequent fees are required.
- (C) Wait until a Notice of Allowance is received and then timely submit the large entity issue fee along with a notification of loss of small entity status under 37 CFR 1.27(g).
- (D) File a notification under 37 CFR 1.27(g)(2) of the loss of entitlement of small entity status prior to or at the time of paying the issue fee.
- (E) Pay the difference between the large entity filing fee and small entity filing fee and the difference between the large entity surcharge and small entity surcharge within two months from the mail date of the Notice to File Missing Parts.

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ANSWER: (D) is the most correct answer. MPEP § 509.03, under the heading “Removal of Status,” states “Once small entity status is established in an application or patent, fees as a small entity may thereafter be paid in that application or patent without regard to a change in status until the issue fee is due or an any maintenance fee is due.”

(A), (B), (C), and (E) are not correct. Small entity status was not appropriate when the assertion of small entity status was filed with the application on November 1, 2002 and none of the actions recited in (A), (B), (C), and (E) would correct the error in claiming small entity status.

## **In-Depth Review of Chapter 5**

Chapter 5 from the MPEP, in its entirety, is on the selection bar at the top of this page. You are encouraged to familiarize yourself with the general format and structure of the MPEP. However, it is recommended that you quickly scan through most of the chapter - while reading only those sections that are highlighted in yellow.

[Chapter 5 MPEP](#)