

# Training Module for Chapter 6 of the MPEP

(Revised August 16, 2018)

## Summary

### Chapter 6: Parts, Form, and Content of Application

#### Section 601.05 – Bibliographic Data – Application Data Sheet

- An application data sheet (ADS) is a sheet or set of sheets containing bibliographic data, which is arranged in a format specified by the USPTO. An ADS may be submitted in a provisional or non-provisional patent application – but is not required.
- When an ADS is provided in a patent application, the ADS becomes a part of the application. The USPTO prefers the use of an ADS in all applications to help facilitate the electronic capturing of important data.
- To help ensure that the USPTO efficiently captures the data, the USPTO specifies a particular format to be used that is reflected in a filable form (PTO/AIA/14) that is available on the USPTO web site [www.uspto.gov](http://www.uspto.gov).

#### Section 602 –Oaths and Declarations

- Any document filed in the USPTO must be under [oath](#).
- A [declaration](#) may be used in lieu of an oath for any document to be filed in the USPTO.
- Whenever a [declaration](#) is used, the document must warn the [declarant](#) that false statements are punishable by fines or imprisonment or both.

**NOTE:** A Seal is usually impressed on an oath. Documents with seals cannot be adequately scanned for retention in an image form that is compatible with the USPTO's Image File Wrapper system. Hence, the USPTO strongly encourages the use of declarations rather than oaths.

- An oath or declaration by the inventor or each co-inventor must be filed as part of a [non-provisional application](#) (not required for [provisional applications](#)) and must:
    - (1) Be executed (signed)
    - (2) Identify the inventor or joint inventor by his or her legal name,
    - (3) Identify the application to which it is directed,
    - (4) Include a statement the person executing the oath or declaration believes the named inventor or joint inventors to be the original inventor(s) of the claimed invention.
    - (5) State that the application is being made or authorized to be made by the person executing the oath or declaration.
  - Unless not included elsewhere (such as in an application data sheet), the oath or declaration must also identify:
    - (6) a mailing address where the inventor or each joint inventor customarily receives mail, and
    - (7) a residence for each inventor or joint inventor who lives at a location which is different from where the inventor or joint inventor customarily receives mail.
  - The MPEP contains Declaration Forms in Chapter 6 on pages 600-70 to 73 and pages 600 74-75. The first of these two forms is to be used when the applicant chooses not to use an application data sheet (ADS) and the second is to be used in conjunction with an ADS. Please take a brief look at these forms now by clicking on Chapter 6 that is on the top bar of this training module. Then return here.
- \*\*\*\*\*
- A new or supplemental oath or declaration is required when new matter is added to an application (such as a new inventor).

## Section 608 – Disclosure

- In return for a patent, the inventor is required to make a complete disclosure of the invention to the public. **This disclosure is referred to as the *quid pro quo* (Latin for “something for something”) of patent protection.** In making a complete disclosure, the inventor gives up his/her proprietary knowledge of a new invention. In return, the inventor receives legal protection from others using his invention without permission for the term of the patent (typically 20 years).
- The disclosure must be written in English (but not necessarily “American English”) and contain the following 3 requirements:
  - (1) written description requirement
  - (2) the enablement requirement, and
  - (3) the best mode requirement.
- The disclosure generally comprises (A) the specification and (B) the drawings.

### Section 608.01 Specification

- The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery pertains, or with which it is most nearly connected, to make and use the same.
- The specifications generally contains the following sections:
  - (1) title of the invention
  - (2) cross-reference to related applications
  - (3) background of the invention
  - (4) brief summary of invention
  - (5) brief description of drawings

- (6) detailed description of the inventions
- (7) one or more claims, and
- (8) an abstract of the disclosure

## Section 608.01(n) – Dependent Claims

- Claims come in two forms:
  - (1) independent claims (which don't refer to any other claim), and
  - (2) dependent claims (which do refer to a previous claim).
- A dependent claim that refers to more than one other claim must make the reference in the alternative. This is called a “multiple dependent claim”. If the reference is not in the alternative, the claim is improper. For example: “A machine according to claims 3 or 4, further comprising ....” is allowed. But, “A machine according to claims 3 and 4, further comprising ....” is not permitted.

**NOTE: A multiple dependent claim shall not serve as the basis for another multiple dependent claim.**

## Section 608.04 - New Matter

- No amendment may introduce new matter into the disclosure of an application. (All amendments to an application must find a descriptive basis in the original disclosure, as filed.)

This restriction prevents an applicant from changing the invention from that which was originally disclosed.

Even amending an application to include an alternative structure in the specification is considered adding new matter. This would be rejected!

## Selected Questions and Answers for Chapter 6

Please make a serious effort to answer the following questions either by referring back to the **Summary**, above, or by searching for the answers in Chapter 1 of the MPEP. If you find the correct answer on your own, you will be likely to remember it. And even if you don't find the answer, you will have broadened your searching skills.

After you believe that you know the correct answer or you feel that you've invested a sufficient time searching for it, click on the **ANSWER** box.

### Question 6-1 (oct03pm-1a)

In accordance with the patent laws, rules and procedures as related in the MPEP, for a nonprovisional application to receive a filing date in the USPTO under 37 CFR 1.53(b), all of the following must be filed except:

- (A) The basic filing fee required by 37 CFR 1.16(a).
- (B) A specification as prescribed by the first paragraph of 35 USC 112.
- (C) At least one claim pursuant to 37 CFR 1.75.
- (D) Any drawing required by 37 CFR 1.81(a).
- (E) Both (A) and (C).

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ANSWER: (E) is the most correct answer. 35 U.S.C. § 111; 37 CFR § 1.53; MPEP § 601.01. As provided in MPEP § 601.01(a), the filing fee and claims for an application filed under 37 CFR 1.53(b) can be submitted after the filing date. (B) and (D) are incorrect because they are needed to obtain a filing date.

### Question 6-2 (Oct00pm-50a)

Which of the following is not a USPTO recommendation or requirement?

- (A) Claims should be arranged in order of scope so that the first claim presented is the least restrictive.
- (B) Product and process claims should be separately grouped.
- (C) Every application should contain no more than three dependent claims.
- (D) A claim which depends from a dependent claim should not be separated from that dependent claim by any claim which does not also depend from the dependent claim.
- (E) Each claim should start with a capital letter and end with a period.

ANSWER: (C). The USPTO does not require or recommend a minimum or maximum number of dependent claims. 37 C.F.R. § 1.75(c). (A) is a USPTO recommendation. See MPEP 608.01(m) (“Claims should preferably be arranged in order of scope so that the first claim presented is the least restrictive.”). (B) is a USPTO recommendation. See MPEP 608.01(m) (“Similarly, product and process claims should be separately grouped.”). (D) is a PTO recommendation. See MPEP 608.01(n), part IV. (E) is a USPTO requirement. See MPEP 608.01(m) (“Each claim begins with a capital letter and ends with a period.”).

## In-Depth Review of Chapter 6

Chapter 6 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**.

When reading the highlighted sections, you will see numerous references to various patent Laws and Rules. Unless you have a specific interest in a particular Law or Rule, it is recommended that you just read past the references, since the text that you will be reading has been prepared to explain those Laws and Rules.

**[Editor’s comment:** Life is too short to spend your time reading the MPEP from cover-to-cover. One of the main objectives of **PassPatentBar** is to help you avoid doing this. However, it is important for you to gain an early appreciation for the composition and style of this rather complex document. Some may develop a lack of fondness for the MPEP, yet everyone will come to embrace it because it contains all the answers that you will need to become a registered patent practitioner.

## [Chapter 6 MPEP](#)