

Certificates of Transmission and Priority Mail Express within the Legal Framework for USPTO Electronic Submissions

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I. INTRODUCTION

There has recently been a fair amount of debate about the legal effect of, and whether to use, a Certificate of Transmission when EFS (the USPTO's Electronic Filing System) filing documents. This article is a copy of a responsive email I sent to the corresponding list service, to clarify that point. The specific text of the comment to which I responded read "It sounds like we're discussing two different concerns: timeliness of a submission to PTO, and proving receipt by PTO."

II. LEGAL FRAMEWORK FOR USPTO ELECTRONIC SUBMISSIONS

I first noted that there is a legal framework providing the legal effect of USPTO Electronic submissions.

1. To avoid doubt, there are documents the USPTO has promulgated specifying the legal framework for electronic submissions. The current document is here:

<https://www.uspto.gov/sites/default/files/documents/2019LegalFrameworkPES.pdf>. The legal framework remains essentially unchanged since I first described it: "[Review of Legal Framework for Electronic Filing System-Web \(EFS-Web\), 74 FR 55200-211 \(2009\)](#)" Rick Neifeld, October 27, 2009.

III. THE LEGAL FRAMEWORK FOR "FOLLOW-ON" ELECTRONIC SUBMISSIONS

Next, I addressed the legal framework for follow-on submissions, that is what the USPTO defined to be the legal effect of certificates of transmission for electronic submissions that are follow-on submissions. (A follow-on submission is generally any submission that does not establish an application filing date or national stage entry completion date.)

2. The Legal Framework, at 14, addresses the rule 1.8 certificate of transmission issue, for follow-on documents, stating:

A follow-on document required to be filed in the USPTO within a set period of time (e.g., a reply to an Office action) will also be considered as being timely filed if the follow-on document is submitted in compliance with the procedure set forth in 37 CFR 1.8(a):

1. The follow-on document is submitted via EFS-Web prior to expiration of the set period of time in accordance with the requirements for EFS-Web; and

2. The document includes a certificate of transmission stating the date of transmission and signed by a person that has reasonable basis to expect that the document would be transmitted on or before the date of transmission. See 37 CFR

1.8(a)(1)(i)(C) and (a)(1)(ii).

So, yes, the electronic framework expressly recognizes the legal effect of a rule 1.8 certificate of transmission. And such a certificate would be effective for follow-on documents, but it would not be effective for original application filings.

IV. THE LEGAL FRAMEWORK FOR ESTABLISHING A FILING DATE USING PRIORITY MAIL EXPRESS

Next, I addressed the rule providing a legal submission date upon delivery of a paper document to the USPS (United States Postal Service) using the Priority Mail Express delivery service. This rule 1.10 option is applicable for all filings, and in contrast to the rule 1.8 certificate of transmission right, is legally effective to establish a filing date of a new application, as of the date of deposit of Priority Mail Express package with the USPS, when that date is marked by USPS personnel on the Priority Mail Express label.

3. The Legal Framework, at 14, also addresses the rule 1.10 application filing issue. I know that this issue has arisen when a user filed documents before the deadline date (aka at 11:59 PM) but completed payment of the fees after the deadline (aka 12:01 AM on the following day), and only elected to obtain an EAR after the payment was complete. As we know, from time to time, the fee payment has significant delays, thereby delaying the availability of an EAR showing both what was filed and what was paid. A west coast attorney at some big firm admitted they had that problem with some filing circa 2015, asking me for advice on how to attempt to secure the right to the pre deadline date. So I remember the problem.

The current legal framework document expressly addresses that issue, stating:

For example, if an applicant in California officially files a patent application with the USPTO through EFS-Web by clicking on the SUBMIT button at 10 p.m. Pacific Daylight Time in California on May 1, that application would be officially received by the USPTO at 1 a.m., local time (i.e., Eastern Daylight Time) on May 2. Accordingly, the application would receive a filing date of May 2. However, the applicant could alternatively file the application using Priority Mail Express® from the USPS in accordance with 37 CFR 1.10 in which case the applicant would have until midnight on May 1 in his or her local time zone to file the application and obtain a filing date of May 1.

So it would be good follow the Scouts BSA motto, "Be Prepared." Have some USPS Priority Mail Express labels and packages available, know the location and hours of "an employee of the USPS" capable of, and willing to, mark the "'date accepted' on the Priority Mail Express® label, in case EFS gives you a problem on new application filing. So you can save the date.

V. BEST PRACTICES TO AVOID ELECTRONIC FILING ISSUES

As I have stated, about 0.2% of patent applications are filed after a legal bar date, [see for example "Restoration of Priority" Rick Neifeld, January 29, 2014](#). This is a significant problem that arises because patent attorneys fail to appreciate the problem of its solution. The solution is to be aware of the problem and take actions to avoid the possibility of loss of rights. So, I provided an example, which acts as specific advice in the context of some deficiency in the ability to electronically file documents in the USPTO.

4. For me, the location and hours are of the USPS are 3601 Pickett Rd, Fairfax VA 22031, whose window hours are 8:30-5 PM M-F and 8:30-Noon Saturday, and I confirmed they will mark the "date accepted" on the label, upon request. And I can then take a picture of the marked label, for backup proof. My travel time there is 4 minutes. So in case of a new application unfiled the deadline date (god forbid), that I could not EFS file by 4 PM M-F or 11 AM Saturday, I can print and Priority Mail Express with a "date accepted" label. However, I advise clients expressly that there is a risk of loss resulting from untimely instructions and by not providing timely instructions they are accepting the risk of loss, and I provide that advise with sufficient specificity of dates to avoid all such risk for timely instructions.

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