PATENT SEARCHING GLOSSARY

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This compilation is based on glossaries found in the bibliography of this work.

A

Abandon: To relinquish (explicitly or implicitly) a potential patent right. An application becomes abandoned by failure to respond to an office action within the required time, or by formal ("express") declaration. A patent right can also be abandoned by simple inaction.

Abandoned Invention: An unexploited invention on which no patent application is filed for a long, unexplained time during which others may have entered the field.

Abandonment of Contest: In interference cases, the concession of priority or abandonment of the invention by a party, with the written consent of the assignee when an assignment has been made.

Abandonment of Invention: To relinquish rights in an invention. In the U.S., an invention is considered to be abandoned, if within a reasonable time after the invention is completed, no actions are taken to make the invention publicly known. MPEP 2134, MPEP 2138.03

Abandonment of Patent Application: To relinquish, either by express abandonment or by inaction, a patent application. Abandonment by inaction typically involves failure to take a required action (e.g., filing an incomplete response or not paying a fee) during the statutory period for taking the action. A U.S. patent application that was unavoidably or unintentionally abandoned can be revived by petition. When a device is abandoned, it is returned to the public domain. *See: Petition to Revive, Public Domain*. MPEP 711

Abridgement: A summary of the disclosure of a patent specification, formerly written by the U.K. patent Office Examiner. In the U.S., this is called an Abstract. *See Abstract of the Disclosure*.

Absolute Novelty: An invention must not have been sold or disclosed anywhere in the world (not simply the country where a patent application is to be filed) before a valid patent can be granted. This is a requirement of some patent offices, but not the U.S. Patent and Trademark Office.

Absolute Novelty creates an absolute bar to patentability in such countries.

Abstract of the Disclosure: A short description of the novel features of an invention. The abstract is written by the applicant, and appears on the front page of a patent. *See: Abridgement*. MPEP 608.01(b)

Acceptance: The formal decision by the U.K. Patent Office that a patent should be granted. *See: Allowance*.

Action: An official communication from a patent office, usually requiring some response by the applicant. MPEP 707

Action, Advisory: An action (U.S.) advising an applicant of the status of an application, typically advising him/her that the amendment filed just prior to the mailing of the advisory action does not place the application in condition for allowance of the claims. MPEP 714.13

Action, Examiner's: A written communication from a patent Examiner that contains requirements and/or documents the reasons behind the Examiner's patentability decisions and usually sets a time for response by the applicant. MPEP 707

Action, Final: An Office action that contains a final rejection of one or more claims or another final action. *See: Final Rejection.* MPEP 706.07, MPEP 706.07(a), MPEP 706.07(b)

Action, First: The first examination on the merits of the patent claims.

Action, Office (Official Action): Notice of an Examiner's decision sent to an inventor or his/her attorney, giving the position of the USPTO on a pending patent application. Also known as an “Official Letter” in terms of U.K. patents.

Action, Post-Granting: Actions that can be taken by the USPTO after issuance of a patent. Such actions include: Adverse decisions, certificates of correction, disclaimers, delayed fee actions, error corrections, expirations, extensions, suit actions, actions for reissue, reexamination, assignment or withdrawal actions.

Action, Quayle: An action requiring correction of informalities after an application is otherwise in condition of allowance. MPEP 714.14, MPEP 706.07(f), MPEP 710.02(b)

Active Inducement to Infringe: One may be held liable for patent infringement as a result of actively encouraging another to infringe even though the inducer has not made, used, sold, offered for sale, or imported the patented invention.

Adjacency Operator: A search operator that allows records to be found where terms are present and are within a specified number of words of each other or, are within a single sentence or paragraph. (Operators are e.g. 'ADJ', 'NEAR' or 'PARAGRAPH'.)

Admissions by Applicant: A statement by an applicant for a patent that can be used to deny the patentability of an invention. In some cases, the admission will be used regardless of whether the statement is true or not. MPEP 2129

Affidavit: A written, sworn statement that includes facts in support of the patentability of an invention. Under 37 CFR 1.131, an affidavit or declaration is used to "swear back" (or stand behind) a reference and an affidavit or declaration under 37 CFR 1.132 is used in traverse (or dispute) a rejection. *See: CFR, Declaration, Swearing Back, Traverse*. MPEP 715, MPEP 716

Agent: A person who provides professional services in patent matters; often an attorney.

Aggregation: A ground for rejection of a patent claim that is based on a lack of cooperation among the elements of an invention. This term is seldom used today. MPEP 2173.05(k)

Allowance: A decision by a patent office that an applicant is entitled to a patent on an invention. *See: Acceptance*. MPEP 1303

Allowance, Notice of: A written notice by a patent office that an applicant is entitled to a patent on an invention. In the U.S., an issue fee must be paid within the period for response or the application will become abandoned. *See: Fee, Issue*. MPEP 1303

Alpha Subclasses: In the U.S. patent classification system, this denotes a subclass that has an alphabetical suffix. MPEP 902.01

Amendment: A change in any part of a patent application made after it is filed. An amendment can also be communication made from the applicant to the patent office directing or requesting that a change be made to the application. Amendments are typically made to overcome rejections, objections or requirements issued by the patent office. MPEP 714

AND: A Boolean operator which requires all specified terms to appear in a record. *See: Boolean Logic*.

ANDNOT: A Boolean operator (sometimes specified as 'NOT') which requires a first term to be present and a second term to be absent from a record. *See: Boolean Logic*.

Annuity: An annual fee that must be paid to most patent offices to maintain a patent in force. In the U.S., the fee is called a maintenance fee. *See: Fee, Maintenance; Fee, Renewal*.

Answer Set: A collection of patent search results that contain the search terms requested.

Answer Set L Number: A numbered label that is applied to each collection of search results that has been assembled. The L numbers increase sequentially for each new search.

Anticipation: Prior art negates novelty. Anticipation exists when the prior art indicates that a patent application lacks novelty by fully describing something within a claim. MPEP 2131, MPEP 2131.01, MPEP 2131.02, MPEP 2131.03

Apparatus: *See: Machine.*

Apparatus Claim: This refers to a patent claim that describes the structure of a piece of equipment, and is embraced by the expression "machine." An apparatus is one of the statutorily recognized forms of patentable subject matter.

Appeal: A request that a higher authority review an adverse patentability decision (usually after a rejection of a claim) by an Examiner. In the USPTO, an appeal is first taken to the Board of Patent Appeals and Interferences. An appeal usually includes a Notice of Appeal and an Appeal Brief. *See: Appeal Brief, Notice of Appeal*. MPEP 1205

Appeal Brief: A written communication submitted to a higher authority reviewing an adverse patentability decision (rejection of a claim) by an Examiner. In the U.S., an appeal brief must set forth arguments and cite authorities (e.g., statutes and case law) in support of the patentability of the claim or claims under appeal. MPEP 1206

Appellant: A patent applicant who has appealed the decision of a patent Examiner to a higher authority. MPEP 1201

Applicant: The person or corporate body that applies for a patent and intends to 'work' the invention (to manufacture or license the technology). Under U.S. law the applicants must be the inventor(s), except under unusual circumstances. MPEP 605

Application (for Patent): A written document seeking patent protection that is filed with the patent office of the country where protection is sought. In the United States, the application must include a petition; specification; disclosure of the invention that would, without undue experimentation, enable a person of ordinary skill in the art to make and use the invention; at least one claim; drawings (if drawings are necessary to understand the invention); and disclosure of what the inventor views as the best mode for practicing the invention. Claims that define the invention and the scope of the coverage are also included. The specification is the narrative portion of the application, and includes the enabling disclosure and the description of the preferred embodiments, or best mode of practicing the invention. It may include a summary of the invention; a brief background on the invention, including prior art or the problem solved. *See: Best Mode, Claim, Drawing, Specification.* MPEP 605

Application, Continuation: A second (or subsequent) application directed to the same invention claimed in a prior co-pending application by the same applicant.

Application, Continuation-in-Part (CIP): An application by the same applicant repeating either a substantial portion or all of an earlier (regular or nonprovisional) application and adding matter not disclosed in the original application that is filed before the original application becomes abandoned or patented. Also called a CIP. The disclosure of the parent is usually amplified, and the CIP may make a claim either for the original, parent application, or a different invention. A CIP is accorded the benefit of the filing date of the parent application to the extent of the two applications' common subject matter.

Application, Co-Pending: A patent application that is pending (not abandoned or issued) at the same time another related patent application is pending.

Application, Divisional: If the patent office decides that an application covers too large an area to be considered as a single patent, then the application is split into one or more divisional applications. A divisional application shares the same specification as the "parent," but claims a different invention.

Application, Original: A patent application that is not a reissue application. An original application may actually be the first application, or it may be a continuing application. MPEP 201.04(a)

Application, Parent: An earlier regular (nonprovisional) patent application disclosing a given invention. MPEP 201.04

Application, Reissue: A reissue application is an application for a patent to take the place of an unexpired patent that is defective in some one or more particulars. MPEP 201.05(a)

Application Date: The date on which the application is filed at a patent office. In most countries, the date determines who will receive the patent when two or more inventors claim the same invention. This is not the case in the U.S., where determination is based on the first to invent, not the first to file.

Application Number: An identifying number assigned by a patent office to an application at the time of filing. In the U.S., a sequential system is

used, while some patent offices use an annual system; applications are numbered beginning with number one at the start of each year following the last two digits of the year of issue. For example, the number 99/16996 is the 16,996th application in 1999.

Application Series: A grouping of application serial numbers (the last six digits of the application number) having the same series code. MPEP 503

Apportionment of Profit: As a measure of damages in patent infringement litigation, apportionment generally refers to dividing the profits on the sale of a particular piece of apparatus or a product according to the percentage of cost or sale price attributable to the patented invention and a portion not so attributable. In instances where the entire product is patented or the patented component contributes essentially all of the market value, apportionment is not required.

Art: The field of technology.

Art Unit: A subunit of a patent examining group. Also called Group Art Unit or Examining Group. MPEP 502

Article of Manufacture: A product, a physical thing. There is no clear difference between an article of manufacture and a machine. Under U.S. law (35 USC 101), one of the statutory classes of invention. MPEP 2105, MPEP 2106, MPEP 2114

Assert: To attempt to prevent an unlicensed party from practicing an invention, by enforcing one's patent rights.

Assignee: The organization or entity that owns or has acquired the rights to a patent. This organization may license the patent to other organizations. MPEP 301

Assignment: The transfer by a party (the assignor) of all or part of its right, title and interest in a patent or patent application to another party (the assignee). In this regard, patents have the attributes of personal property. *See: License*. MPEP 301

Assignor: The owner of patent rights, who transfers all or part of those rights to another. MPEP 301

Attorneys' Fees Award: In exceptional cases in patent infringement litigation, the court may require the losing party to pay the attorneys' fees of the prevailing party.

Auslegeschrift: An examined German patent application (second publication) now eliminated. *See: Offenlegungsschrift, Patentschrift.*

Automated Patent System (APS): The automated search program created by the USPTO that has an online catalogue of patents that goes back to August 1971. Many other patent databases rely on this service.

B

Background of the Invention: A section heading in the specification of a U.S. patent application that includes a statement of the technical field of the invention and a description of related art. MPEP 608.01(d)

Backward Citation Searching: Searching for the patents that a patent query cites or references (e.g., searching for Gen -1 patents). *See: Citation, Citation Generation*.

Basic Patent: The first member of a patent family. This may or may not be the first published patent, merely the first patent that was documented by a particular patent database service such as the *Derwent World Patents Index*.

Belated Opposition: *See: Revocation*.

Best Mode: In the U.S., a patent application is required to disclose the best means known to the applicant (at the time of filing) of practicing the invention. MPEP 608.01(h), MPEP 2165, MPEP 2165.01, MPEP 165.02

Bibliographic Information: Data concerned with the publication of a patent document. Bibliographic information includes information found on the front page of a patent application, such as the publication number

and date, application number and date, priority details, names of the inventors and the applicant.

Biological Material: Material referenced in the disclosure of a patent application that is capable of self-replicating, either directly or indirectly. Examples include bacteria, fungi (including yeasts), algae, protozoa, eukaryotic cells, cell lines, hybridomas, plasmids, viruses, plant tissue cells, lichens and seeds. MPEP 2403, MPEP 2403.01, MPEP 2403.02

Biotechnology: The emerging field encompassed by genetic engineering, gene splicing, hybridomas, monoclonal antibodies, etc.

Board of Patent Appeals and Interferences (Board of Appeals): A board of senior Examiners that hears appeals of adverse patentability decisions. MPEP 1202, MPEP 1203

Boolean Logic: Named after nineteenth-century mathematician George Boole. Boolean logic is a form of algebra in which all values are reduced to either TRUE or FALSE. It provides a way to combine search terms using operators such as 'AND', 'OR', and 'NOT.'

Brevet: French for "patent."

Broader than the Invention: Coverage by a claim of more information than is disclosed in the application or patent.

C

Cancellation of Claims: Removal of claims from a patent application, usually by way of an amendment. *See: Amendment*.

Cancelled Matter: Matter that is removed from the specification or claims of a patent application.

CAS Registry: CAS, or the Chemical Abstracts Service, contains the largest and most current database of chemical substance information in the world, and is comprised of more than 21 million organic and inorganic substances and 32 million sequences. The CAS Registry

mostly covers substances identified from the scientific literature from 1957 to the present, with some classes (such as fluorine- and silicon-containing compounds) going back to the early 1900s. Each substance is identified by a unique numeric identifier called a CAS Registry Number.

CASSIS: The Classification and Search Support Information System. Found at most Patent and Trademark Depository Libraries, this system of CD-ROMs allows a patent or trademark searcher to easily comb through the records of the USPTO. CASSIS is updated by the USPTO six times a year. *See: Patent and Trademark Depository Library, U.S. Patent and Trademark Office*.

CCPA: *See: Court of Customs and Patent Appeals*.

Certificate of Correction: Issued upon patentee request due to a minor error made either by the U.S. Patent and Trademark Office or the applicant, such as printing, typographical, or clerical errors. *See: Action, Post-Granting.*

Certificate of Mailing, Express Mail: For certain actions before the U.S. Patent and Trademark Office, only an express mail filing by certificate according to 37 CFR 1.10 will be accorded the certified date of mailing. Examples of such mailings include: filing of a new patent application, or a request for continuation, CIP, or division.

Certificate of Mailing, Regular Mail: For certain responses to the U.S. Patent and Trademark Office (for example, an amendment or payment of the issue fee), a signed certificate of mailing will be effective under 37 CFR 1.8. The referenced response will be considered filed timely as of the certified date.

CFR (Code of Federal Regulations): The Code of Federal Regulations. Title 37 includes rules and regulations for patents, trademarks, and copyrights.

Characterizing Clause: The part of a German or European style claim which indicates the novel features of the invention.

Chartered Patent Agent: A British-qualified patent agent who is a fellow of the Chartered Institute of Patent Agents.

CIP: *See: Application, Continuation-in-Part*.

Citation: A list of references that are considered to be relevant prior art and which may have contributed to the "narrowing" of the original application. Citations may be made by the Examiner (usually appearing on the front page of a patent) or author (usually appearing in the Specification and/or Information Disclosure Statement). The Examiner can also cite references from technical journals, textbooks, handbooks and sources. *See: Front Page, Information Disclosure Statement, Specification*.

Citation Family Structures: Pre-defined citation generation relationship groupings.

Citation Generation: A set of citations/references either given or received by the patents in the initial set of records.

> Generation 0 ("Gen 0") -- Patents in the initial set of records
>
> Generation +1 ("Gen +1") -- The patents that cite/reference the patents in the initial set
>
> Generation -1 ("Gen -1") -- The patents that the initial set of patents cites/ references

Claim: What the inventor is stating to be unique about the invention. The claims become the actual monopoly granted to the invention. Claims define the scope of protection granted to the invention. MPEP 608.01(i), MPEP 608.01(k), MPEP 608.01(m), MPEP 1309.01

Claim, Base: A claim from which another claim depends, either directly or indirectly. MPEP 608.01(n)

Claim, Dependent: This is a claim that makes express reference to and depends on a prior claim and, thereby, incorporates by reference all of the recitals of the prior claim. This claim must be read as if it contained its own express recitals plus the recitals of every claim or claims from which it depends. Claims that do not depend from another are referred to as independent claims.

Claim, Generic: A claim to a generic invention, usually including within its scope the subject matter of subordinate (more narrow) claims. MPEP 806.04(d), (e)

Claim, Independent: This is a claim that stands by itself and is not dependent on another claim. MPEP 608.01(m)

Claim, Jepson: A form of a claim with a preamble that describes what is known in the art followed by a transitional phrase such as "The improvement comprising" and then a description of the claimed improvement. MPEP 2129

Claim, Markush: A form of a claim that allows claiming of members of a finite group by means of a phrase like "A member of the class consisting of" followed by a list of the members of the group linked by the word "and." The members of a Markush group must have at least one property that is mainly responsible for their membership in the group. MPEP 803.02, MPEP 2173.05(h)

Claim, Multiple Dependent: A claim that refers back to and depends from more than one other claim. The other claims may be referred to in the alternative only. MPEP 608.01(n)

Claim, Process: A claim that recites the steps of a process. The process may be a method of making something, a process of operating something or a process of using something. 35 USC 101.

Claim, Product: A claim that recites the elements or features of a product (e.g., a machine, an article of manufacture or a composition of matter). 35 USC 101.

Claim, Species: A claim that describes ("reads on") a species of an invention. A generic claim generally reads on all the claimed species of an invention. A single, distinct embodiment of an invention. Up to five species may be claimed in one application. A claim within the scope of, but not co-extensive with, another claim in the same patent or application. *See: Reads On*. MPEP 806.04(d), MPEP 806.04e

Claim, Specific: A claim setting forth details of an invention and usually to only one form thereof; may or may not be accompanied by a generic claim.

Claimed Invention: The process, machine, apparatus or creation that the inventor(s) claim to have invented and for which they seek patent protection.

Class and Subclass: These are the categories that a patent office would use to classify or sort the various types of patentable inventions.

Classification: A subdivision of technology (and hence, patents) by subject matter. MPEP 903.01

Classmark: A combination of letters and numbers that indicate a heading within a patent classification system.

Clear (Clean) Hands Doctrine: In the U.S., the principle that equitable relief only comes when the request is made in good faith.

Colorable Deviation: A small change (in a product or process) made from what is claimed, solely to avoid literal infringement of the claim.

Combining Prior Art: Under Section 102 of the U.S. Patent Statute, a claim must be identically disclosed in a single prior art reference in order to be rejected as being anticipated by prior art. Under Section 103 of the Patent Statute (which deals with the standard of obviousness), one is permitted to employ a single prior art reference or combine two or more references to render a claim obvious if such a combination would be apparent to one skilled in the art. Under either standard, a patent application claim may be rejected by a patent Examiner, or a patent claim may be ruled invalid by a court.

Commissioner of Patents and Trademarks: The highest appointed official (by the President and confirmed by the Senate) of the U.S. Patent and Trademark Office. All communications to the Office (or to the Patent Cooperation Treaty) are addressed to the Commissioner.

Completion of Invention: Conception and reduction to practice of an invention. This is also known as "making an invention." Conception is

considered the formation in the mind of the inventor of a definite and permanent idea. The reduction to practice may be a constructive reduction to practice (filing of a patent application containing sufficient disclosure to enable a person skilled in the art to make and use the invention), or an actual reduction to practice (making and testing the invention sufficiently to demonstrate to a person skilled in the art that it will work for its intended purpose). MPEP 2138.04, MPEP 2138.05, MPEP 2133.03(c), MPEP 2133.03(e) (3)

Composition of Matter: One of the statutory classes of invention in which the substance, not the form or shape, is the inventive subject matter. Chemical compositions may include new mixtures of ingredients as well as new chemical compounds. 35 USC 101. MPEP 2105, MPEP 2106

Comprising: A transitional phrase used in a claim that means to include, contain, or be characterized by. The term is inclusive and open-ended and does not exclude additional, unrecited elements or steps. *See: Consisting Of*. MPEP 2111.03

Compulsory License: A license that must be granted to a third party due to governmental or judicial requirements.

Computer Programs: Recently held to be patentable subject matter when included in a process of commands, as one of the process steps. An action step (requiring the computer to run the program) is required.

Conception: The formation in the mind of the inventor of a definite and permanent idea of the invention. MPEP 2138.04

Confirmation Patent: A patent granted in some countries on the basis of a previous patent granted in another jurisdiction.

Conflict: A contest in the Canadian Patent Office between rival inventors claiming the same or substantially the same invention.

Consisting of: A transitional phrase used in a claim that excludes any element, step or ingredient not specified in the claim. The claim is subject to avoidance if another element is added. A variation is

"consisting essentially of"; it usually allows for an inconsequential amount of another element to be added. *See: Comprising*. MPEP 2111.03

Constructive Reduction to Practice: A reduction to practice involves physical verification of the operability of the invention or its suitability for its intended purpose. When one files a U.S. patent application, one obtains a constructive reduction to practice as of the filing date.

Contemporaneously Witnessed: Observed or read and understood by a witness who was present at the time the event occurred, but who is not one of the inventors.

Continuation: Applicable mainly in the U.S., continuations are second or subsequent applications which are filed after the original patent, while the original is still pending. Continuations must claim the same invention as the original application to gain the benefit of the parent filing date. *See: Application, Continuation*.

Contributory Infringement: This involves someone supplying a component that is a material part of a product, apparatus, composition of matter, or process with knowledge that it is uniquely adapted for use in infringing a patent and is not a staple article of commerce suitable for substantial non-infringing use. Such person can be held liable as a contributory infringer if an infringement results.

Convention: The Paris Convention for the Protection of Industrial Property. The Paris Convention has been signed unto by most countries in the world. The 1883 Paris Convention provides that if an applicant files for a patent within a Convention country, they may file in another Convention country within 12 months and will receive the benefit of the earlier filing date. *See: Paris Convention*.

Convention, EPC: The European Patent Convention. *See: European Patent Convention (EPC)*.

Convention Country: A nation that is a member of the Paris Convention for the Protection of Industrial Property. 164 States have agreed to the Paris Convention. A list of those countries can be found at http://www.wipo.org/treaties/ip/paris/index.html. *See: Convention, Paris Convention*.

Convention Date: *See: Priority Date*.

Convention Year: A period of 12 months from a first application in a convention country, within which applications having the effective date of the original filing may be filed in other convention countries.

Co-Pending Application: *See: Application, Co-Pending*.

Copying: This generally refers to an infringer who duplicates a patented product, apparatus, composition, or process and may enhance evidence of infringement. *See: Infringe*.

Copyright: An intellectual property right that protects the expression of an idea, and not an idea itself.

Corresponding Foreign Application: An international patent application, regional or national patent application, or inventor's certificate filed in a country other than the U.S. that establishes a priority date for a later-filed U.S. application. MPEP 201.13

Corroboration: Evidence provided by persons other than an inventor that supports and proves the inventive acts. MPEP 2138.01

Count: A claim made in common by two or more opposing parties in an interference action to determine who was the first inventor, and, hence, who is deserving of a U.S. patent. The count defines the interfering subject matter between two or more patent applications or between one or more applications and one or more issued patents. *See: Interference*. MPEP 2301.02

Court of Appeals for the Federal Circuit (CAFC or Fed. Cir.): A U.S. court to which an applicant for patent can appeal a decision of the USPTO Board of Patent Appeals and Interferences. MPEP 1216

Court of Customs and Patent Appeals (CCPA): The historical court that reviewed USPTO decisions and decided customs cases. The CCPA has since been replaced by the U.S. Court of Appeals for the Federal Circuit (CAFC). MPEP 1216

Critical Date: This refers to the date of the initial placing on sale, publication, or public or commercial use of an invention. At the end of the one-year period, a U.S. patent application cannot be filed because the statute bars such filing.

Cross-License: A license between two patent owners of two or more patents, wherein each licenses its patent(s) or certain patent claim(s) to the other.

Cross-Reference: A reference (issued patent) in another class or subclass, or a reference made in a later-filed patent application to a related, earlier-filed application. MPEP 903.02(c), MPEP 202.01

Cross-Reference Art Collection: Found at the end of some schedules in the *Manual of Classification,* serving to group patents that would not otherwise be grouped together.

Crowded Art: This refers to an area of technology in which there have been a large number of prior inventions. In a crowded art, it takes less of an advancement to obtain a valid patent. Otherwise, one would have to conclude that there could be no further patenting in that art.

CSIR: The Classified Search and Image Retrieval system, a portion of the Automated Patent System, allows for rapid retrieval and browsing of any patent issued since 1790. However, CSIR only has the capability to look up patents provided the searcher knows the relevant patent number, or technology classification. *See: Automated Patent System*.

D

Declaration: A written statement made with the understanding that willfully providing false information is punishable by fines or imprisonment or both. In the U.S., declaration may be used instead of an oath (a sworn statement) to verify that information being submitted to the U.S. Patent and Trademark Office is true. *See: Oath*. MPEP 602, MPEP 715, MPEP 716

Dedication: An express or implied surrender to the public of an actual or potential patent right. MPEP 1490, MPEP 2138.03

Dedication to Public: A document signed by a patent owner filed in the U.S. Patent and Trademark Office giving up all patent rights. This is generally done when the owner believes the patent is invalid. *See: Dedication*.

Defensive Patent: A patent that does not cover fully what the patentee is doing, but which helps to keep competitors away from the area of interest.

Defensive Publication: A publication and dedication to the public of a pending patent application. The official program at the USPTO that allowed for defensive publication has been replaced by the Statutory Invention Registration (SIR) Program. *See: Statutory Invention Registration (SIR)*. MPEP 711.06, MPEP 1101

Deferred Examination: A system in which the examination of a patent application may be postponed by the applicant for several years until requested at a later time.

Definiteness: A characteristic of a patent claim in which claim language makes the scope of the claim clear to a person skilled in the art to which the invention pertains. MPEP 2173, MPEP 2173.02, MPEP 2173.05(a)

Delivery Up: A British court order compelling an infringer to deliver infringing goods to the patentee for alteration or destruction.

Delphion: Originally a for-free spin-off project developed in part by IBM and the Internet Capital Group (ICG), Delphion has since become a for-fee service providing a wide range of patent collections and services available to patent searchers around the world. Delphion offers comprehensive searchable bibliographic data, full text searching and complete patent images for patents issued from the USPTO. Delphion is one of the many database services that offer the patent consumer an option with where to invest their searching time and money.

Dependent Claim: *See: Claim, Dependent*.

Depositing Correspondence: Filing written papers with a patent office. MPEP 502

Deposition: The testimony of a witness taken under oath, reduced to writing and authenticated.

Derwent (Derwent World Patents Index): An important information source for foreign and U.S. Patents. Derwent compiles patent data from 40 patent-issuing authorities, including the E.U., China, and Japan. The Derwent World Patents Index is one of the many competing services that a patent searcher should be aware of.

Description of the Invention: The part of the specification that classifies the technical field in which an invention lies. The description includes a summary of the technical background of the invention and sets forth the features of the invention, making reference to any drawing(s) included in the invention. *See: Application, Specification*.

Design Patent: Ornamental design for an article of manufacture. Design patents only protect the appearance or shape characteristics of an article. Such patents also carry a separate series of numbers from other patents and are preceded by the letter D. MPEP 901.04, MPEP 1502, MPEP 1502.01

Designation: To name the countries where a European of Patent Cooperation Treaty (PCT) application is being filed.

DIALOG: Dialog, sometimes known as the supermarket of databases, offers users wide access to information in the scientific, technical, medical, business, news and intellectual property fields. Dialog also provides a diverse selection of knowledge management and competitive intelligence databases. Like the other databases, it is a system the patent searcher should be aware of.

Digests: The groupings of patents found in the *Manual of Classification.* These are undefined and inventoried groupings and are in the process of being replaced by Cross-reference Art Collections. *See: Cross-Reference Art Collections*.

Diligence: The activity required of an inventor and his attorney that must occur just prior to the entry into the field of another "inventor" and continue until the invention is reduced to practice, either by building and testing it or filing an enabling patent application. Diligence towards the building and testing of an invention typically includes such activities as ordering parts, fabrication of a prototype or working model, testing of a prototype under the expected conditions of normal use of the invention, etc. Diligence towards the filing of a patent application typically involves preparation of an invention disclosure, hiring a patent agent or patent attorney, with the patent agent or attorney taking up preparation of the patent application in chronological order. Diligence must be proven and, in interference proceedings, must be corroborated by a person who is not the inventor. MPEP 2138.06

Direct Infringement: Making, using importing or selling a patented invention in the jurisdiction where the patent is in force. MPEP 2501

Disclaimer: An express surrender to the public of an actual or potential patent right. An entire patent can be disclaimed, or any claim or claims in a patent or a terminal portion of the normal term of the patent. *See: Dedication*. MPEP 1490, MPEP 2138.03, MPEP 706.03(u)

Disclosure: This can refer to either an invention disclosure that is not in a patent application but is an oral or written communication of a development or it can refer to portions of a patent application. A disclosure must be sufficient enough for one skilled in the art to (1) understand what is being claimed (the description requirement) and (2) to enable the person to make and use the invention (the enablement requirement). Also, in the U.S., the best mode of the invention must be disclosed in the application. *See: Application, Description of the Invention, Enabling Disclosure*. MPEP 608, MPEP 608.01, MPEP 2161, MPEP 2162

Disclosure Document: The U.S. Patent and Trademark Office accept this document for retention, not examination, as evidence of date of conception of an invention.

Disclosure Document Program: A program of the U.S. Patent and Trademark Office wherein, for a small fee, the USPTO will maintain a written document which discloses the invention, and is signed by the

inventor in confidence for a period of two years as evidence of the date of conception. Diligent efforts to reduce the invention to practice must still occur from a period before the entry of another inventor into the field until the invention is completed. Many patent agents and patent attorneys recommend that it is better to disclose an invention in confidence to a person who is not an inventor in writing and then have the person sign and date the disclosure indicating that he/she has "read, discussed and understood the disclosure." The disclosure program does not create any patent protection. MPEP 1706

Discovery: An invention or, in litigation or interference proceedings, the process of retrieving pertinent information from the opponent's records under a court order.

Disposal: In some countries, such as the U.S., this refers to the end process after an application has been resolved by being withdrawn, rejected or granted. It can also have the connotation of being rejected only.

District Court: Any of the 10 federal district courts within the United States where a lawsuit for legal relief in a patent matter can be filed.

Divisional Application: *See: Application, Divisional*.

Doctrine of Claim Differentiation: This is a judicially created rule of construction that states that when two claims in the same patent have an apparently similar or identical meaning, an effort should be made to adopt an interpretation that will give them distinct meanings.

Doctrine of Equivalents: Under the judicially created doctrine of equivalents, one may be held liable as an infringer even if they do not literally infringe on a patent. In general, it is an equitable concept employed to prevent someone from getting the benefit of the invention by making only minor or inconsequential changes that would avoid literal infringement. *See: File Wrapper Estoppel*.

Dominated: Covered by one or more claims in a patent.

Dominating Patent: A prior patent having a claim or claims broad enough to encompass the subject matter of the claim or claims in a

subsequent patent. The patentee of a dominating patent can prevent the patentee of the subsequent patent from practicing his/her "improvement" invention. The patentee of the subsequent patent can prevent the patentee of the dominating patent from practicing the "improved" invention only, but not the original invention.

Double Patenting: An improper attempt to obtain more than one patent on the same invention or on an obvious variant of the same invention. MPEP 804, MPEP 804.01, MPEP 804.02

Double Patenting Rejection: The rejection of a patent claim on the grounds that it is an improper attempt to obtain more than one patent on the same invention or on an obvious variation of the same invention. *See: Terminal Disclaimer*. MPEP 804, MPEP 804.01, MPEP 804.02

Drawing: One or more specially prepared figures filed as a part of a patent application to explain and describe the invention. Drawings (or illustrations, where appropriate) are more commonly found with inventions for mechanical or electrical devices. As a rule, chemical patents will include chemical formulae in the description of the invention and/or in the examples. *See: Application*. MPEP 608.02, MPEP 608.02(a), MPEP 608.02(b)

Duty of Disclosure: This is a requirement imposed on all persons involved with the patenting process to disclose information (patents, articles, laboratory data etc.) to the patent Examiner that may affect the granting of a patent. *See: Fraud on the Patent Office, Inequitable Conduct*. MPEP 2001

E

Early Publication: The publication of an application before examination.

ECLA: European Classification, administered by the European Patent Office. ECLA is another standard of patent classification, distinct from the US Patent Classification system, or the International Patent Classification (IPC) system.

Effective Date: The date as of which a reference is available as "prior art" in determining the patentability of an invention. The effective date of a reference is usually something different from the Filing Date of a patent application. In the U.S., a patent is effective as of its filing date as a reference against another U.S. application, and is effective as a prior patent as of its issue date. *See: Priority Date*. MPEP 2126, MPEP 2126.01, MPEP 2128, MPEP 2128.02

Election: The choice made by the applicant, as to which distinct claim of a patent with multiple possible claims, is to be prosecuted. The other claims will be cancelled without prejudice to the applicant's right to re-file them at a later point in time. *See: Restriction.* MPEP 818, MPEP 809.02(a), MPEP 809.02(b), MPEP 818.03(b)

Element of Claim: One (usually intended) portion of the body of a patent claim that describes a feature of an invention and that interrelates the feature with the other features of the invention. MPEP 608.01(m)

Embodiment: A single (usually out of many possible) concrete form of an invention as described in a patent application or patent. *See: Preferred Embodiment*.

Enablement: Support within a disclosure of a claimed invention. Enablement occurs when a person skilled in the art to which the invention pertains is taught how to make and how to use an invention. MPEP 2164, MPEP 2164.01

Enabling Disclosure: In the U.S., a description sufficient to enable the person skilled in the art of the invention to carry it out.

Enforcement: Taking legal action to protect one's patent rights.

Enjoin: To direct or impose by court order.

Equivalent: A patent that relates to the same invention and shares the same priority application as a patent from a different issuing authority. Equivalents, when taken together, form a patent family. *See: Patent Family*.

Equivalents—Means-Plus-Function Claims: Rather than expressly reciting a component or feature in a patent claim, one may recite a feature as a means for accomplishing something such as "seal means for resisting passage of water between the bushing and the shaft."

Europatent: A patent in any member nation of the EPC, granted by the European Patent Office. *See: European Patent Convention*.

European Patent Convention (EPC): The European Patent Convention laid down the groundwork and foundations for the European Patent Office. Nineteen European countries are parties to the European Patent Convention.

European Patent Office (EPO): The European Patent Office, created under the European Patent Convention (EPC) offers a way to file a single patent application that will be applicable to all European countries that adhere to the EPC. While the European Patent Office has its historical origins in the European Union, coverage of patents may extend to countries outside of the E.U. (for example, Switzerland). *See: European Patent Convention.*

Examination: Review of a patent application to determine if a claimed invention is patentable. MPEP Introduction

Examiner: A patent office official who is appointed to determine the patentability of applications.

Example: 1) A worked, detailed, description of one aspect (embodiment) of the invention within the patent application.
2) Possible alternative embodiments of the invention within the patent application, with little detail provided. *See: Embodiment*. MPEP 608.01(p), MPEP 2164.02

Exceptional Case: In order to seek an award for attorney's fees as part of the relief granted to the prevailing party in patent litigation, it is necessary to show that the case has unusual circumstances. In general, it means that there has either been willful infringement on the part of the alleged infringer or that the patentee was reckless in bringing an infringement case.

Execute: To complete; with reference to a patent application, to sign an oath or declaration. MPEP 601.04, MPEP 602.01

Exhaustion of Rights: The principle that when patented goods have been sold by the patentee, he has no further control over them.

Exhibit: A physical embodiment of an invention; a model or specimen. *See: Embodiment*. MPEP 608.03, MPEP 608.03(a)

Ex Parte: A legal proceeding with no adversary, as in a normal patent prosecution.

Experimental Use: Under Section 102(b) of the Patent Statute, there are a number of statutory bars which state that one cannot file a U.S. patent application more than one year after making the invention available through sale, publication, or public use. However, if the applicant makes use of the invention for testing or experimental purposes (rather than for public or commercial purposes), such use is not considered when computing the one-year period. The experimentation must be to verify that the invention works for its intended purpose as distinguished from other factors such as marketing research. Experimental use is allowed in the U.S. and Japan, but not in most jurisdictions. MPEP 2133.03(e), MPEP 2133.03(e) (4), MPEP 2133.03(e) (6)

Expiry Date: The date when a patent has run its full term in a country and is no longer protected there. *See: Lapse, Withdrawal*.

Extension of Time: An extension of the "period for response" stipulated in an Office Action. MPEP 710.02(e)

External Patent: A patent assigned to a competitor or another outside organization.

F

Failure of Others: A secondary test of patentability relevant to the issue of whether an invention is obvious is whether others have failed to come

up with the solution previously. Failure of others also can be expressed by showing a long-standing and yet unsolved need. *See: Obviousness*.

Family: The group of specifications published by the same or different patent offices for the same invention.

Federal Circuit: *See: Court of Appeals for the Federal Circuit (CAFC)*.

Federal Regulations: The regulations of the departments and agencies of the U.S. Federal Government as published in the Code of Federal Regulations (CFR).

Fee, Delayed: When a required fee is postponed or not paid on time.

Fee, Filing: A fee required by the U.S. Patent and Trademark Office at the time of filing of the patent application, or shortly thereafter (with additional payment of a surcharge).

Fee, Issue: The fee, required by law, paid by an applicant to the patent office prior to the granting of a patent. Fee must be tendered within three months of allowance. MPEP 1306

Fee, Maintenance: Fees paid at three intervals during the life of a patent that keeps the patent in force for its entire 20-year life span. The U.S. fee is now payable at 3 ½, 7 ½, and 11 ½ years from the date of issue. A late fee is permitted, but a surcharge is imposed. *See: Fee, Renewal.*

Fee, Petition: A fee required by the U.S. Patent and Trademark Office for certain actions.

Fee, Renewal: Payments that must be made by the applicant to the patent office in order to keep the patent in force and prevent it from lapsing. In the U.S., these are termed maintenance fees. *See: Fee, Maintenance*. MPEP 2501, MPEP 2504, MPEP 509

Field Codes: At the USPTO website, these are characters that precede a keyword. The characters are used to limit the search for that keyword to certain sections of a patent. (Ex: PN = Patent Number, CCL = Current U.S. Classification).

Field of Endeavor: The area of technology that an inventor develops from. Also called technical field or field of the invention. MPEP 608.01(c)

Field of Invention: *See: Field of Endeavor*.

Field of Use: The technical field or market that an invention is licensed. The licensee may not sell the invention within other markets.

Figure Legend: An explanation of what the noted marks mean on a drawing. Patent drawings do not have legends.

File History: In the U.S., the dossier containing all papers relevant to the prosecution of an application. Also called the File Wrapper.

File Wrapper: The complete U.S. Patent and Trademark Office (USPTO) file on a certain patent including correspondence, original drawings, etc.

File Wrapper Estoppel: When an inventor amends their application by narrowing their claims during the course of patent prosecution to overcome a rejection, the inventor is precluded or estopped from asserting a broader interpretation after the patent has issued. This type of estoppel clearly exists in the face of a prior art rejection, but can also exist when the inventor makes representations in a writing that would cause the Examiner to rely on those representations when they granted the application. Under current law, while file wrapper estoppel does not preclude the use of the doctrine of equivalents, it does substantially limit the scope and application of this doctrine. File wrapper estoppel is also referred to as prosecution history estoppel.

Filing Date: The date when the application reaches the patent office in complete form.

Filing Fee: *See: Fee, Filing*.

Final Action: *See: Action, Final*.

Final Rejection: A rejection of a claim that is made final on a second or subsequent examination or consideration. After a rejection of a claim is

made final, an applicant must generally either agree with Examiner suggestions or appeal the rejection. The only other recourse an applicant has is to argue that the final rejection was premature, to appeal the rejection, or to amend the claim in accordance with any suggestion of the Examiner. The Examiner may allow the applicant to place the claim in better form for appeal. One interview with the Examiner will be allowed, if in the judgment of the Examiner, circumstances warrant the interview. *See: Rejection*. MPEP 706.07, MPEP 706.07(a), MPEP 706.07(b)

First Action: *See: Action, First*.

First to File: The applicant who is the first to file an application for an invention will be awarded the patent over all others. This law is becoming the standard for countries adhering to the Trade-Related aspects of Intellectual Property (TRIPs) guidelines.

First to Invent: In the United States, the applicant who is the first to invent will be awarded the patent over all others.

First Inventor: The person who has the earliest date for an invention that he or she has not explicitly or implicitly abandoned; the individual who first conceives, and first reduces the idea to practice.

Foreign Filing Date: The date a non-U.S. patent application was filed that establishes priority of invention. MPEP 201.13

Forfeited Application: An application that has been abandoned due to failure to pay the issue or maintenance fees within the designated period. *See: Fee, Issue, Fee, Maintenance*.

Forward Citation Searching: Searching for patents that provide citations/references to the patents in your original search set (i.e. searching for Gen +1 patents). *See: Citation Generation*.

Fraud on the Patent and Trademark Office: This is now frequently referred to as inequitable conduct. An applicant and the applicant's attorney have an obligation to acquaint the U.S. Patent and Trademark Office with any prior art known to be material to the patentability of the patent application claims. There is no requirement that the applicant perform a patentability search. The obligation is merely one of sharing

knowledge. If fraud is found, the entire patent in question is held unenforceable. Subsequently issued divisional or continuation applications may also be "tainted" and thus unenforceable. *See: Inequitable Conduct.*

Frequently Cited: Patents which are mentioned or cited numerous times by the patent Examiner on other issued patents.

Frivolous Invention: An invention that lacks utility because it serves no purpose or use. MPEP 706.03(a)

Front Page: The first page of a patent application which lists the patent number, description, specification and usually a drawing or illustration selected by the inventor.

Front Page Drawing: The drawing selected by the Examiner to appear on the front page of a U.S. Patent.

Full-Text: The complete text of a patent specification found during a search query.

G

Gebraughsmuster: A German utility patent.

General Agreement on Tariffs and Trade (GATT): The General Agreement on Tariffs and Trade signed by President Clinton on December 8, 1994. The GATT was created to comply with the TRIPS (Trade Related Aspects of Intellectual Property Rights) provisions agreed to by other industrialized nations. One resulting change is that a U.S. patent, if granted on an application filed on or after June 8, 1995, will have a term measured by 20 years from the filing date rather than the prior standard of 17 years from the date the patent was granted. Patents in force on June 8, 1995, and applications filed before that date will have a term that is the longer of these two terms. A secondary effect of the GATT was to create an allowance for the proof of date of an invention filed in a WIPO country for events after January 1, 1996. The GATT also provided for provisional patent applications. MPEP 2138.02

Geschmackmuster: A German design patent. MPEP 201.14(b)

Gist of the Invention: This may also be referred to as the "heart of the invention." It refers to what are the novel and unique features of the claimed invention.

Grace Period: A period of time before the filing date of an application, during which certain types of publication do not invalidate the application.

Grant: The issuance of a patent by the patent office, which creates a temporary right to exclude others from using the technology defined in the claims of a patent for a specified period of time. MPEP 2501

H

Harmonization: The proposed integration of patent laws in different countries to produce essentially one, worldwide body of patent law.

H document: An H document is a Statutory Invention Registration (SIR). An applicant for a U.S. patent may, if desired, give up the ability to obtain a patent and instead pay the U.S. Patent Office to publish it as an SIR. The main benefit of this is that it keeps others from getting a patent on the same invention. *See: Research Disclosure, Statutory Invention Registration*.

How to Make: This is part of the obligation to provide a disclosure in the patent application that would enable one skilled in the art to practice the invention without engaging in undue experimentation.

How to Use: This is a similar to the "how to make" standard and relates to the use aspect of an invention, if appropriate.

Hypothetical Person Skilled in the Art: The standard applied under Section 103 of the Patent Statute is whether the invention would have been obvious at the time the invention was made to one having ordinary

skill in the art. One must look at the nature of the technology and determine what sort of individual would be skilled in the art. There are no rigid standards that are employed in making such a determination. For example, if the invention involved an automobile transmission, a mechanical engineer working on transmission design, a mechanic working on automobile transmissions, a mechanical engineering professor, or others could be a "person skilled in the art."

I

IIB: The Institut International des Brevets, a patent search and examination office in The Hague.

Important Invention: Under the U.K. 1949 Patents Act, an invention known abroad but brought into the U.K. for the first time.

Improvement Patent: This generally refers to a patent that is issued on an application filed later in time than a prior application and tends to build upon the previously disclosed invention or the previous patent. In some instances, it means a patent that cannot be practiced without infringement of a prior patent. MPEP 2129

Incomplete Disclosure: Failure to include or acknowledge an essential element, step, or structural cooperative relationship of elements, in the claims of an invention.

In-Convention Filing: A filing made in a foreign country within 12 months of the original home filing, treated under the Paris Convention as having the priority date of the original filing. *See: Paris Convention, Priority Date*.

Incorporation by Reference: To supplement the disclosure of a patent application by making a specific statement in the application that other material is to be considered to be incorporated in the application. MPEP 608.01(p)

Indefiniteness of Claim: Section 112 of the Patent Statute requires that the claims be sufficiently definite so as to provide a standard by which a

third party could, with some degree of certainty, determine whether a given practice would or would not be an infringement of the claims. An indefinite claim is a claim that fails to particularly point out the claimed invention. *See: Definiteness.* 35 USC 112. MPEP 706.03(d), MPEP 2171 MPEP 2173

Indemnity from Suit: A situation in which one party has agreed (usually in writing) not to sue another party, e.g., for patent infringement.

Indents: The spaces (filled in with dots) found in the *Manual of Classification* used to delineate the arrangement of subclasses under a class. The number of indents is recorded by the number of dots shown. *See: Manual of Classification*.

Independent Claim: *See: Claim, Independent*.

Inducement to Infringe: An act that leads another to infringe. For example, a recommendation made to a customer to practice a patented method.

Inequitable Conduct: Improper action by a patentee or their attorney before the U.S. Patent and Trademark Office. If a breach of the duty of disclosure is found, the entire patent in question is held to be unenforceable. *See: Fraud on the Patent Office*.

Information Disclosure Statement (IDS): A list of all patents, publications and other information submitted by an applicant for patent to the USPTO, either to discharge their duty of disclosure, or to ensure that the Examiner considers the information. *See: Prior Art Statement*. MPEP 609

Infringe: To make, use or sell a patented item or process within the country covered by the patent without permission or license from the patentee. The alleged infringing object must contain every element of the claim before it is considered to infringe literally on the patented invention.

Infringed Literally: A situation wherein an issued patent is infringed (practiced without a license to do so) by a product or process that has all

of features of the invention claimed in the patent. *See: Literal Infringement*.

Infringement: The practice of a claimed invention without a license to do so.

Infringement by Equivalents: Infringement in the situation where the infringing product or process does not have exactly the same features as the invention claimed in the patent, but that any different feature performs the identical function as the one specified in the claim.

Infringement Opinion: An opinion made by an attorney judging the probable holding of a court on whether or not a specified product, process or apparatus would infringe one or more claims of an issued patent.

Infringement Under Doctrine of Equivalents: *See: Infringement by Equivalents*.

Inherency: Present in the essential character of something. MPEP 2173.05(v)

Inherent Disclosure: A basic property of something originally disclosed; may be explicitly described by amendment without introducing new matter.

Injunction: A writ granted by a court whereby one is required to do, or to refrain from doing a specified act.

Innocent Infringer: In the U.K., the legal concept that an infringer who could not be expected to know of the existence of the patent, should not be forced to pay damages. This type of infringement does not exist in the U.S., where the assumption is that an infringer must or should have known.

INPADOC: The International Patent Documentation Center, Vienna, Austria. A source of information concerning patents of more than 25 countries.

Insufficiency: A ground of invalidity on a patent if the description does not enable one skilled in the art to work (Does not teach) the invention. *See: Hypothetical Person Skilled in the Art*.

Insufficient Disclosure: A disclosure lacking such description and details as would enable a person skilled in the art to which the invention pertains to make and use the invention. *See: Hypothetical Person Skilled in the Art*. MPEP 608.01p

Intellectual Property: A product of the human mind. An intangible form of property. Patents, Trademarks, Trade Secrets and Copyrights fall under the category.

Interference: A priority contest in the U.S. Patent and Trademark Office to determine which of two or more parties was the first to invent commonly claimed subject matter. MPEP 2300.01

Internal Priority: The possibility of filing, within 12 months an application claiming priority from an earlier application in the same country.

International Application: An application made under the provisions of the Patent Cooperation Treaty.

International Patent Classification (IPC): The International Patent Classification (IPC) is an internationally recognized classification system, maintained by the World Intellectual Property Organization (WIPO) and assigned to patent documents by the various patent offices around the world. The IPC is widely used throughout the world (although less so in the U.S.). There are eight distinct sections of the IPC (lettered A-H) and these sections are further subdivided into classes. Each class consists of the section letter, followed by two digits. For example, section A21 is the class for Baking; Edible Goods, and G02 is the class for Optics. The International Patent Classification list is available online at http://classifications.wipo.int/fulltext/new_ipc/. *See: WIPO*.

International Patent Protection: Filing for patent protection in multiple countries.

Intervening Rights: A defense to an allegation of infringement. Intervening rights exist when a patent is later reissued with broader claims because of inadvertent errors in claim instruction on the original patent. Any person who practiced the broadened claims prior to the reissue may continue. For such a person, infringement would result only if he or she practiced the surviving, narrower claims. MPEP 1460

Invalid: Ineffective or void under the law. A patent can be invalidated if it was issued in error, or it has failed one or more statutory requirements of patentability (e.g., novelty, obviousness).

Invention: A solution to a technical problem (i.e., technology) that may or not be patentable.

Invention Disclosure: From a legal standpoint, a description of an invention that would enable a person skilled in the art to which the invention pertains to build and use the invention. Invention disclosure documents are used for a variety of legal and commercial purposes. *See: Disclosure*.

Inventive Entity: The inventor(s) named in the patent application. MPEP 2173.01, MPEP 804.03

Inventive Step: A requirement that an invention not only be new, but also unobvious as regards the relevant prior art. It is a requirement of patentability that an invention would not have been found merely as an ordinary extension of the art by one skilled in that art.

Inventor: The individual(s) who actually came up with the idea.

Inventor Name: In the U.S., inventors must be identified because of constitutional provision. In many other countries, inventors need not be identified as the individuals responsible for creating an invention.

Inventor's Certificate: A grant to former Soviet inventors, the rights of the invention being owned and maintained by the state.

Inventorship: The condition of being an inventor under the law. MPEP 2137.01

Issue: The grant of a patent by a patent office. *See: Allowance*.

Issue Fee: *See: Fee, Issue*.

J

Jepson Claim: *See: Claim, Jepson*.

Joint Application: A patent application in which the invention is presented as one conceived by two or more inventors. MPEP 201.02

Joint Invention: An invention conceived by more than one person. *See: Joint Inventor.*

Joint Inventor: A person who collaborates with another inventor in the conception of an invention. *See: Joint Invention*. MPEP 605.07, MPEP 2137.01

Junior Party: The party in an interference action who has the later U.S. filing date. *See: Senior Party*.

K

Kinds: A designation letter, often accompanied by a number, which indicates the level of publication of a patent. For example DE-A1 is the German Offenlegungsschrift (application laid open for public inspection) while a DE-C1 is the German Patentschrift (first publication of the granted patent).

Know How: Unpatented technical or commercial information.

Knowledgebase: An organized repository of knowledge about a particular subject. For example, a set of U.S. patentability rules is a knowledgebase.

Knowledge-Based Expert System: A computer program that uses knowledge and inference procedures for solving a problem that is sufficiently difficult as to require a significant amount of human expertise to arrive at the solution.

Kokai: An unexamined Japanese patent application. The first two digits of the application number indicate the year in the current emperor's reign. The first two digits plus 25 give the year of the publication in the Showa (Hirohito) Era (1925 to early 1989), for example, J59 – has a 1984 publication date. The first two digits plus 88 give the year of the publication of more recent patent applications, for example, J01 – has a 1989 publication date.

Kokoku: An examined and allowed Japanese patent application. The first two digits indicate the Gregorian calendar (not Imperial) year of publication.

L

Label License: When a composition or product is sold by the owner of a patent on the process of using the invention, he or she may include on the label notice to the purchaser that the price includes a license to practice that process.

Lapse (Lapse Date): The date when a patent is no longer valid in a country or system due to failure to pay renewal (maintenance) fees. Often the patent can be reinstated within a limited period. *See: Fee, Maintenance, Withdrawal*.

Letters Patent: Grant to an inventor of the right for a limited time to exclude others from using his or her invention; the certificate of the patent grant.

Level of Ordinary Skill: The level of skill in the art to which an invention pertains that is used in judging whether a disclosure or claim is enabling. *See: Enablement*. MPEP 2141.03

Lexis-Nexis: The Lexis-Nexis research system provides information to legal, corporate, government and academic markets, and publishes legal, tax and regulatory information, via online, hardcopy print and CD-ROM formats. Unlike other research systems, Lexis-Nexis does not focus on patents only, and provides a more broad-based system that a patent searcher should be cognizant of.

License: A transfer of patent rights that fall short of a full assignment. A license, which can be exclusive or non-exclusive, does not give the licensee legal title to the patent. *See: Assignment*.

License of Right: An endorsement on a patent to the effect that anyone may obtain a license upon reasonable terms.

Limitation: Language in a claim that constrains the breath of a claim.

Linking Claims: Claims joining otherwise separate species of the invention, such as a generic claim linking up to five species claims embraced thereby; a product-by-process claim linking product and process claims; and a means for practicing a process linking apparatus and process claims. MPEP 809, MPEP 809.2, MPEP 809.3(a)

Literal Infringement: This means that a product, process, apparatus, or composition of matter satisfies every recital of a claim completely. *See: Infringed Literally.*

Living Organisms: Now considered proper U.S. patentable subject matter under 35 USC 101.

Local Novelty: The principle that a patent can only be invalidated by prior publication if the publication was in the country granting the patent.

Long-Felt Need: A problem facing a particular technical area that has gone unsolved for a prolonged period. The presumption is if the solution had been obvious to those skilled in the art, they would have solved the problem. Long-felt need is a way to get past the obviousness requirement to patentability. *See: Obviousness*.

Lost Profits: This is a measure of damages and is generally tied to the profits that could have been the patentee's, but for the infringement. The

alternate standard, where the patentee is either not in the business or cannot prove that profits made by the infringer would have been his or hers, must employ the statutory standard of a reasonable royalty. *See: Infringement.*

M

Machine: A device, a product, a physical thing. Under U.S. law, one of the statutory classes of inventions. MPEP 2105, MPEP 2106, MPEP 2114

Maintenance Fee: *See: Fee, Maintenance*.

Manual of Classification: The *Manual of Classification* is the collection of all Classification Schedules, organized and created by the USPTO. The *Manual* organizes the various Classification Schedules based on the relationships between subclasses, and the connection between a class and subclass. The *Manual* can be found online at: http://www.uspto.gov/go/classification.

Manual of Patent Examining Procedure (MPEP): A document that contains a description of the practices and procedures of the U.S. Patent and Trademark Office.

Manufacture: A term used in the patent statutes to cover any material thing in between an unshaped composition of matter and a machine. One of the classes of patentable subject matter under U.S. law. MPEP 2105

Markush Group: A claim which recites the following: "Selected from the group consisting of …"; this statement creates a limited type of generic claim. To be permitted, the members of the designated group must have at least one property in common which is primarily responsible for their function in the claimed relationship.

Means for Claim: A patent claim that recites an element as a means to accomplish a particular function. MPEP 2181

Means-Plus-Function Claim: *See: Means for Claim*.

Means-Plus-Function Language: *See: Means for Claim*.

Mesne Assignment: To transfer one's patent rights through one or more intermediate assignees, rather than directly to a single assignee.

Method: One of the classes of patentable inventions (a process) under U.S. law. MPEP 706.01(a)

Micropatent: Micropatent, an online patent-searching directory, touts the world's largest collection of online, searchable full text patent documents for a variety of countries. This service also provides full-text searches of U.S. granted patent applications back to 1836, as well as U.S. Applications back to 2001. Micropatent provides yet another choice for patent searchers to choose from.

Misuse: Using a patent right inappropriately, for example, forcing a buyer to purchase a license for a secondary product not covered by the claims of the patent.

Model: *See: Exhibit*.

Multiple-Dependent Claim: *See: Claim, Multiple-Dependent*.

N

Negative Limitation: A claim limitation that is excusive, e.g., "other than X," "incapable of X." Also known as Negative Claim Limitation. MPEP 2173.05(i)

New Issue: A patentability issue or question that has not previously arisen in the examination of an application.

New Matter: Information not in the original specification, claims, or drawings, which the applicant attempts to add to the application, but is rejected for not being present, explicitly or implicitly, in the original disclosure. MPEP 608.04, MPEP 608.04(a), MPEP 608.04(b)

New Use: Discovery of a new use for a previous invention is considered patentable subject matter under U.S. law.

Nonassertion Letter: A written communication by the owner of patent rights stating that they do not wish at the time to assert or enforce their right to exclude others from practicing the specified claims on one or more patents.

Non-Convention Application: A patent application filed in a second or subsequent country that does not claim the priority of another, earlier application.

Non-Convention Equivalents: An application filed in a second or subsequent country that does not claim a priority application in another country. Usually this is a result of filing the application after the 12-month Convention period, but may be within that period by choice of the applicant. *See: Convention*.

Non-Convention Filing: *See: Out-of-Convention-Filing*.

Non-Human Mammal: Now considered a proper U.S. patentable subject under 35 USC 101.

Non-Obvious: The opposite of obviousness; that which is not clear or apparent. *See: Obviousness*.

Nonprovisional Patent Application: A type of U.S. utility patent application that must contain at least one claim and can issue as a patent. MPEP 201, MPEP 601, MPEP 601.01(a)

NOT: A Boolean operator (sometimes specified as 'ANDNOT') which requires the first term to be present and a second specified term to be absent from a record. *See: Boolean Logic*.

Notice (Marking): Placing the word "patent" with the patent number on articles made by the patentee or a licensee. If the patentee fails to mark his or her products, then the patentee may only recover damages for infringement that occurred after the infringer has received actual notice through a charge of patent infringement. *See: Patent Marking*.

Notice of Allowability: An action by a U.S. Patent Examiner that states that the patent application has been placed in condition for allowance, and specific claims are accepted or approved.

Notice of Allowance: A written communication from the U.S. Patent and Trademark Office indicating that a patent application has been approved. *See: Allowance*.

Notice of Allowance and Issue Fee Due: A notice by the USPTO that the application has been placed in a condition for allowance and that the issue fee must be paid within three months of the mailing date of the notice. *See: Allowance, Fee, Issue*. MPEP 1303

Notice of Appeal: A document filed by the applicant in the U.S. Patent and Trademark Office to initiate an appeal of an Examiner's rejection to the Board of Patent Appeals and Interferences. This reserves a right for the applicant to file an Appeal Brief. *See: Appeal Brief*. MPEP 1205

Novelty: One of the three statutory requirements of patentability. What is considered 'new' about the invention. The invention must never have been made public in any way, anywhere, before the date on the patent application. In the U.S., novelty is normally determined by the date of the invention. *See: Obviousness, Utility*. MPEP 2131

O

Oath: Notarized statement that declares that the applicant believes that they are the first and original inventor. *See: Declaration*. MPEP 602, MPEP 715, MPEP 716

Object Clause: The part of patent specification stating the purpose or meaning to be achieved by the invention.

Object of the Invention: A desired characteristic of an invention. MPEP 608.01(d)

Objection: The Examiner's disapproval of the phrasing or format of a part of a patent application.

Obvious to Try: The validity of a patent can be challenged by attempting to show that what the inventor did would have been obvious based on the prior art.

Obviousness: One of the three statutory hurdles of patentability. A characteristic that makes an invention predicable to a person having ordinary skill in the art, who has knowledge of the complete body of prior art. Obviousness implies that no "inventive step" was involved in conceiving of the invention. This statutory requirement is one of the most difficult terms in patent law to define and understand. *See: Novelty, Utility*. MPEP 2141, MPEP 2141.01, MPEP 2141.02, MPEP 2141.03, MPEP 2142

Octrooi: A Dutch or Flemish patent.

Offenlegungsschrift (OLS): A published (unexamined) German patent document (see Auglegeschrift).

Offer to Sell: An activity that can bar obtaining a patent in some jurisdictions if the offer occurs before a patent application is filed. MPEP 2133.03(b), MPEP 706.02(c)

Office Action: *See: Action, Office*.

Official Gazette (OG): A publication of the U.S. Patent and Trademark Office where new patents and trademarks are announced. The Official Gazette is published weekly in two editions, one for patents and one for trademarks.

Old Application: An application that, having been acted on by an Examiner, has in turn, been acted on by the applicant. MPEP 203.03

Omnibus Claim: A claim which asserts the invention noted is as described, with reference to the drawing or examples.

On Sale: If an inventor makes his or her invention available for commercial sale more than one year before a U.S. patent application is filed, a valid patent cannot be obtained. This is sometimes referred to as

the on sale bar to a patent. An invention is on sale where it has actually been sold or an offer of sale has been made. *See: One-Year Rule*.

One-Year Rule (One-Year Grace Period): Presently, a statutory rule of the U.S. Patent and Trademark Office which states that a valid patent can still be obtained on an application filed before or up to one year after public use or sale in the United States, or patenting or publication anywhere in the world, provided the invention has been reduced to practice before he public use, sale, patenting or publication by another. *See: Priority Date*.

Open to Public Inspection (OPI): The date when a patent application is first made available to the public to view. This is normally not less than 18 months from the priority date but patent offices vary in their treatment.

Opposition: The time period allowed for an interested party to post a challenge to the grant of a patent. For example, this may be up to nine months from the date of grant of a European patent. Opposition can also be the actual proceedings where a third party raises their objection to the grant of a particular patent.

OR: Boolean operator which requires either of two specified terms to be present in a record. *See: Boolean Logic*.

Ordinary Skill in the Art: The level of technical knowledge, experience, and expertise possessed by the run-of the-mill or ordinary engineer, scientist, or designer in the technology that is relevant to the invention. Obviousness is measured with reference to a hypothetical person having ordinary skill in the art to which the invention pertains. *See: Hypothetical Person Skilled in the Art*, *Obviousness*.

Out-of-Convention Filing: A foreign filing made more than 12 months after the original home filing and thus, unable under the terms of the Paris Convention to claim the original priority date. *See: Paris Convention*.

Parent Application: *See: Application, Parent*.

Paris Convention: The Paris Convention was established March 20, 1883, effective July 7, 1884, and amended June 2, 1934 and July 14, 1967. Signatories to the Paris Convention are allowed one year from first filing their patent application (usually in their own country) in which to make further applications in member countries and claim the original date as their filing date. *See: Convention*.

Patent: A document defining the rights conferred by the grant, but often used generally to mean any published specification. A patent gives the inventor the right to exclude others from making, using, selling, offering for sale or importing their invention.

Patent of Addition: A patent for an improvement in, or modification to, the subject of an earlier patent, which expires with the earlier patent.

Patent Agent: A person who is not an attorney, but has the ability under law to legally represent an inventor or applicant when dealing with a patent office. A patent agent must have the requisite scientific or engineering background or experience, and be registered to practice before the U.S. Patent and Trademark Office. Registration is obtained by passing a one-day written examination administered two times a year by the USPTO. Patent agents are required to abide by the same ethical rules and guidelines under the ABA that attorneys are subject to. MPEP 401

Patent Analytics: The process of reporting and visualizing patent mining results.

Patent Attorney: A lawyer who can legally represent an inventor or applicant when dealing with a patent office. Unlike a patent agent, the patent attorney does not necessarily have a scientific background, although many do. The patent attorney is usually, but not necessarily, admitted to practice before the USPTO. MPEP 401

Patent Cooperation Treaty (PCT): The PCT was signed in Washington D.C. on June 19, 1970, and entered into force January 24, 1978. It was amended with effective dates of May 3, 1984 and January 1, 1985. There

are more than 100 signatories to this treaty. Contracting states may file an international application designating member states. If an applicant wants to press for grant in any of their designated states, the patent application is moved to the national phase(s), but may carry the P.C.T. priority filing date. Chapter I of the PCT preserves these rights for 20 months from the earliest priority filing. A timely filed Chapter II Demand will preserve patent rights in designated foreign countries for up to 30 months from the earliest priority filing date.

Patent Cousins: Pairing of earlier patents that are referenced by the same later patent.

Patent Examiner: *See: Examiner*.

Patent Family: All equivalent patent applications that make reference to a single invention, but cover different geographical regions and jurisdictions. MPEP 905.06

Patent of Importation: A patent granted by certain countries on the basis of patents already granted elsewhere. These patents are limited, and protect local manufacture only.

Patent In-Licensing: Purchasing of rights within an organization, to use the technology covered in patents owned within the corporation as a whole.

Patent Landscape: The graphical representation of how large numbers of patents relate to each other based on keywords, citations, or patent classifications.

Patent Licensing: Selling or purchasing the right to use the technology covered in a patent.

Patent Mapping: A way to visualize patent mining results that involves clustering or otherwise orienting patent data on a page so that there is meaning in the spatial relationships among the data points.

Patent Marking: The marking of a patent-pending item "Patent Pending" or marking a patented item with one or more of the patent numbers it was granted. Marking gives a potential infringer notice of the

fact that a patent is pending or has issued. Marking an invention "Patent Pending" is not allowed in some countries. The individual patent mark may be either on the item itself or its packaging. *See: Notice*.

Patent Mining: The process of searching for meaningful trends, patterns, and relationships among patent records contained in patent databases.

Patent Misuse: *See: Misuse*.

Patent Number: The number assigned to an issued patent by a patent office.

Patent Out-Licensing: Selling of rights to use the technology covered in a patent.

Patent Owner: The owner of property rights conferred by a patent, such as the right to exclude others from use.

Patent Pending: A mark that may be placed on a product/package to indicate that an application has been filed with the U.S. Patent and Trademark Office.

Patent Portfolio: A collection of patents owned by an organization.

Patent of Revalidation: *See: Patent of Importation*.

Patent of the Same Age: Patents that were granted in the same year.

Patent Search: A review of the prior art, for example, the open literature and U.S. and foreign patents.

Patent Term: The period of time that a patent is valid.

Patent and Trademark Depository Library (PTDL): The Patent and Trademark Depository Library Program began in 1871 when federal statute (35 USC 13) first provided for the distribution of printed patents to libraries for use by the public. During the Program's early years, twenty-two libraries, mostly public and all but several located east of the Mississippi River, elected to participate. Since 1977 the PTDL network has grown to four times its original size. Currently, the majority of the

membership is shared between academic and public libraries. There are also several state libraries and one special research library. All libraries regardless of size or mission must meet the same PTDL requirements and obligations.

Patent Watch: The process of continuously monitoring newly published patent applications and issued patents in a particular field.

Patentability: The issue of whether an invention is capable of being patented in a particular jurisdiction.

Patentability Opinion: An opinion offered by a patent agent or a patent attorney as to whether a claimed invention is likely to be deemed patentable by a patent office in view of the prior art made available to him/her.

Patentable: Capable of being patented in a particular jurisdiction. The ability for an invention to satisfy the legal requirements for patentability in a particular jurisdiction.

Patentable Combination: A series of process steps, mechanical elements, or a mixture of materials that produce a desirable effect or result that is not an obvious summation of the effects of the different steps, elements, or materials.

Patentable Subject Matter: An invention that is capable of being patented.

Patentee: The inventor to whom the patent is granted and all persons to whom the patent is subsequently assigned. The term is slightly broader than the owner of the patent, as the inventor would still be considered a patentee even if he or she has assigned his or her invention to someone else.

Patentschrift: A granted German patent application.

Pending: The period in which the patent office has not yet decided whether to reject or to grant a patent application and the application has not yet been withdrawn.

Pending Patent Application: *See: Pending*.

Person Skilled in the Art: A fictitious person who has knowledge of all prior art and who possesses ordinary skill in the art to which the invention pertains. *See: Hypothetical Person Skilled in the Art*. MPEP 2141.03

Petition: 1) The portion of a patent application praying for the grant of a patent. 2) A request for the Commissioner of Patents and Trademarks to review and supervise the work of an employee of the Office. 3) A written communication to a higher authority within a patent office seeking review of a decision made by an Examiner, on any matter other than rejection of a claim. MPEP 1001.01, MPEP 1002, MPEP 1201

Petition for Certiorari: A petition to the U.S. Supreme Court to review the decision of a lower court.

Petition for Extension of Time: A petition requesting an extension of the time period for response to certain Office actions. Payment of a fee is sometimes required. MPEP 710.02(e)

Petition to Revive: A petition requesting that a patent application be revived from either unintentional or unavoidable abandonment. *See: Abandonment of Patent Application*. MPEP 711.03(c)

Petty Patent: *See: Utility Model*.

Picture Claim: A claim that sets forth an invention in great detail. Also called a Specific Claim.

Pioneer Invention: An invention that breaks new ground in a technological art or that creates a new art.

Pioneer Patent: A patent on an invention that breaks new ground in a technological art or that creates a new art.

Pith and Marrow: In the U.K., the essential features of an invention.

Plant Patent: A patent that is issued for any new asexually reproducing plant. Asexually reproduced plants are propagated by means other than

by seeds, such as, rooting of cuttings, by layering, budding, grafting, etc. MPEP 1601

Power of Attorney: Grant of authority to a patent attorney or patent agent to transact all U.S. Patent and Trademark Office business connected with a designated patent application.

Preamble: The formal introductory clause of a patent claim. Depending on the circumstances, the preamble may or may not define a narrowing element of the claim. The preamble usually only defines the setting or context in which the elements of the claim appear. The use of Jepson claim format results in an implied admission that what is recited in the preamble is known in the prior art. *See: Claim, Jepson*.

Precedent: A legal decision that serves as an example or rule upon which a subsequent decision can be based.

Precharacterizing Clause: The part of a German or European-style claim that recites the features of the invention which are already known.

Preferred Embodiment: An inventor's "best guess" version of the invention configuration, at the time the patent application was written. *See: Embodiment*.

Prejudgment Interest: In patent litigation, prejudgment interest is interest on monetary judgment against an infringer awarded to a prevailing party and measured from the date of the infringement to the date of the judgment. Prejudgment interest should be available on damages measured both by lost profits and reasonable royalty. *See: Lost Profits, Royalty*.

Preliminary Amendment: An amendment to a patent application filed simultaneously with the filing of the patent application or, an amendment filed before the Examiner mails the first action on the merits of the application. MPEP 608.04(b), MPEP 714.09

Preliminary Examination: The initial study of an application by an official in the patent office to check that the specification is properly arranged and for preparing search reports. Examinations of international

patents are done by the International Preliminary Examination Authority. *See: Substantive Examination*. MPEP 1860

Preliminary Examination Report: A report notifying an applicant of the results of an International Preliminary Examination. MPEP 1860

Preliminary Statement: In an interference proceeding, a statement made under oath that sets out the creator of a contested invention, and where and when it was made. MPEP 2321, MPEP 2322

Presumption of Validity: A presumption created by statute that a patent is legitimate and sound in law. The burden of establishing that a patent is invalid is always on the challenger. The burden of proof on the challenger is to prove invalidity by clear and convincing evidence.

Prima Facie: Latin for 'On its Face.' Sufficient evidence to raise the presumption of fact, unless rebutted. MPEP 2001

Printed Matter: A publication. MPEP 2128

Prior Art: The body of prior knowledge relating to the claimed invention, including prior use, publications, and patent disclosures. MPEP 2126, MPEP 2126.01, MPEP 2127, MPEP 2128, MPEP 2128.01, MPEP 2128.02

Prior Art Reference: A citation to prior art. *See: Prior Art*.

Prior Art Statement: Also known as an Information Disclosure Statement, this is a document timely filed in the U.S. Patent and Trademark Office by the applicant during the prosecution of a patent application. The statement lists the prior art known by the applicant and/or his or her attorneys that is thought by them to be material to the patentability of the claims. *See: Information Disclosure Statement*.

Prior Public Use: Display of an unpatented invention under circumstances in which the invention enters the public domain. MPEP 2133.01(a)

Prior Use: The use of an invention before the filing date of an application.

Priority: Claim to a patent based on an earlier application for a patent for the same invention (either in the same, or different countries.)

Priority Date: The initial date of filing of a patent application, normally in the applicant's domestic patent office. This date is used to help determine the novelty of an invention. This date is also used to determine the application date of foreign-filed applications, when done in a Convention country. *See: Application, Convention*. MPEP 201.13, MPEP 201.13(b), MPEP 1828

Priority Document: A certified copy of a patent application filed no more than 12 months before the filing date of the later filed application claiming the priority date of the earlier-filed application. MPEP 201.13, MPEP 201.13(b), MPEP 201.14, MPEP 1828

Priority Number and Date: The application number and date of the first-filed application. At the 1883 Paris Convention it was established that inventors had one year after the filing date of the first application to file application in other participating countries where they sought patent protection. In effect, the date of the first filing was recognized as the priority date of filing in all participating countries. *See: One-Year Rule.*

Process: An act or method, and primarily encompasses industrial or technical processes. 35 USC 101. MPEP 2106

Product: A machine, an article of manufacture or a composition of matter. *See: Article of Manufacture, Composition of Matter, Machine*. MPEP 2106

Product of Nature: A thing occurring naturally that is substantially unaltered by human intervention. An essentially pure culture of a microorganism does not occur in nature and is not, therefore, a product of nature. Neither is a genetically-engineered organism a product of nature. Products of nature are not patentable. MPEP 706.03(a), MPEP 2105

Product *per se* Claim: A claim to a product irrespective of how it is produced; a claim to the physical form of an invention.

Product-by-Process Claim: A patent claim that describes a product invention by describing the process that is used to make it.

Profits: Direct recovery of the patent infringer's profits is not possible in a case of infringement of a utility patent, but may, under proper circumstances, be employed as a measure of the patentee's damages.

Prolix Claim: A claim that contains long recitations or unimportant details that renders the claim indefinite. MPEP 2173.05(m)

Property: An object of ownership whereby the owner can exclude others from its use and/or enjoyment.

Proprietary Information: Information that is not generally known and that has competitive value, e.g., trade secrets and business knowledge not disclosed to others. *See: Trade Secret*.

Pro se Applicant: An applicant for patent (inventor) who is representing himself/herself. MPEP 401, MPEP 707.07(j)

Prosecution: The administrative process of obtaining a patent from the U.S. Patent and Trademark Office. Prosecution includes filing the application with the USPTO, office actions, amending the application in response to objections and rejections from the Examiner, responding to objections and rejections without amendment to the application, telephone and personal interviews with the Examiner, appeals, and timely payment of the appropriate fees.

Prosecution History: The history of the prosecution of a patent application. *See: Prosecution*.

Prosecution History Estoppel: *See: File Wrapper Estoppel*.

Protest: A communication by a member of the public to a patent office arguing and providing evidence that the granting of a patent on a particular invention would be improper. MPEP 1901

Provisional Application: Provides a means to establish an early filing date so that U.S. applicants have equal status with foreign applicants. This process also entails less paperwork and is less expensive than a

traditional application. The applicant is permitted to use patent pending on applied invention. A non-provisional application must be filed within 12 months. MPEP 201.04(b), MPEP 601, MPEP 601.01(b)

Provision(al) Specification: In the U.K., a brief description of the invention filed with an application, to be followed by the complete specification.

Proximate Function: The USPTO practice of classifying inventions that work in a like manner. Proximate in the sense of nearest to or adjacent.

Proximity Searching: A search which allows records to be found where terms are present and are within a specified number (/n) of words of each other or within a single sentence (/s) or paragraph (/p). A search may also use the operators 'ADJ' or 'NEAR.'

PTDL: *See: Patent and Trademark Depository Library*.

PTO: The U.S. Patent and Trademark Office. Also known as the USPTO.

Public Domain: A property right held by the public.

Public Sale: A sale or offer to sell an invention to a member of the public. A sale need not be public to bar a patent under U.S. law. *See: Statutory Bar*. MPEP 2133.03, MPEP 2133.03(b)

Public Use: The public or commercial use of an invention. This is the opposite of experimental use. *See: Statutory Bar*. MPEP 2133.03, MPEP 2133.03(a)

Publication: Documents, including the patents of most countries that are printed, and are actually or presumptively available to the public. MPEP 2128, MPEP 2128.01, MPEP 2128.02

Publication Date: The date on which a patent document is published.

Published Application: A patent application that has been published by a patent office during its prosecution (before issue).

Published Patent Application: *See: Published Application*.

Q

Questel Orbit: Questel-Orbit is a dedicated patent and trademark database that provides access to other major scientific and patent databases. Questel-Orbit offers international patent-searching capabilities as well as a detailed list of U.S. patents, some going back to the early 20th Century. This aggregator also offers access to the Chemical Abstract Service (CAS) and the Merged Markush System (MMS). Questel is one of many patent databases that a patent searcher can use. *See: CAS Registry*.

R

Rationale for Patentability: The reasoning behind a decision that a claimed invention is patentable. MPEP 1302.14

Reads On: A claim that includes more than the actual scope of an invention's use.

Reduction to Practice: The physical part of the inventive process that completes the process of invention. Until there is a reduction of practice, there is no invention. There are two forms of reduction: *Constructive Reduction* to practice occurs upon the filing of a U.S. patent application. The application must adequately disclose the invention. Constructive reduction to practice does not involve any physical construction. *Actual Reduction* to practice occurs when there is physical verification that the invention works for the intended purpose. This reduction must involve each and every element that is defined in the claim, as constituting the invention. The degree of physical verification required will depend on the nature and complexity of the invention. MPEP 2138.05

Reexamination: Examination of the patentability of an invention claimed in an issued U.S. patent at the request of the USPTO, the patent

owner or a third party, as a means to introduce newly discovered prior art and/or printed publications to evaluate the patentability of the subject material against the new materials. *See: Prior Art*. MPEP 2209, MPEP 2210

Reference: A document that discloses subject matter that is material to a determination of the patentability of a claimed invention. MPEP 2126, MPEP 2126.01, MPEP 2126.02, MPEP 2127, MPEP 2128

Reference Character: A numeral or letter used to identify an element on a patent drawing.

Registered to Practice: An attorney or agent who has passed the U.S. Patent bar, undergone and passed review as one morally qualified to practice, and has paid the necessary fees to be placed on the official USPTO Register.

Registration: A way of obtaining protection for an invention in certain British territories on the basis of an already granted British patent.

Reinstatement: Restoration of the enforceability of a patent after it has either lapsed in error or been revoked.

Reissue: An application filed by a patentee after a patent has issued to correct applicant's errors that rendered the patent wholly or partly inoperative due to a defective specification or drawings; or to correct an application which claimed more or less than the applicant had a right to claim. The applicant must provisionally surrender the previously issued patent. Reissues also can be utilized to seek reconsideration in view of newly found prior art. Any reissued patent that results will have the same expiration date as the original patent. MPEP 1401, MPEP 1402

Reissue Patent: A corrected U.S. patent that issues from an allowed reissue application. *See: Reissue*. MPEP 1401, MPEP 1402, MPEP 1403

Rejection: When a patent application or its individual claims are refused by the patent office. MPEP 706, MPEP 706.01

Request for Reexamination: A request filed by a patentee or a third party seeking reexamination of one or more claims of a patent based

upon an alleged substantial new issue of patentability due to printed prior art not considered by the U.S. Patent and Trademark Office Examiner who handled the application originally. MPEP 714.13, MPEP 818.03, MPEP 1214.01, MPEP 1214.03

Request for Reconsideration: Further argument submitted after a claim has been rejected. *See: Rejection*.

Research Disclosure (RD): A defensive-type publication which is published, often anonymously, to give companies and inventors "freedom of use" rather than legal protection. Once research disclosures are published, the invention described cannot be patented. *See: Defensive Publication, H Document.*

Restoration: Proceedings to revive a patent that has lapsed due to nonpayment of renewal fees. *See: Fees, Renewal*.

Restriction (Restriction Requirement): A requirement by an Examiner that an applicant choose which of multiple claimed, distinct inventions disclosed in a patent application that they wish to be examined. The nonelected claims may be pursued by a divisional application. *See: Application, Divisional*. MPEP 802, MPEP 802.02, MPEP 803

Reverse Doctrine of Equivalents: This concept is used infrequently. It refers to situations where one might literally infringe a patent claim, but due to the interpretation of the claim, would not be held to be an infringer. *See: Doctrine of Equivalents*.

Revival of Abandoned Application: To reinstate a patent application that has been abandoned (relinquished), either by express abandonment or by inaction. Abandonment by inaction typically involves failure to take a required action (e.g., filing an incomplete response or not paying a fee) during the statutory period for taking the action. A U.S. patent application that was unavoidably or unintentionally abandoned can be revived by petition. *See: Abandon, Petition*. MPEP 711

Revocation: 1) Termination of the protection given to a patent on one or more grounds, e.g. lack of novelty. 2) In British law, the application for revocation of a patent, sometimes known as “belated opposition.” The

proceedings before a patent office or a court to have a patent declared invalid.

Right of Priority: The right to priority on an invention established by filing the first patent application in an appropriate patent office. MPEP 201.13, MPEP 201.13(a), MPEP 201.13(b)

Routineer: A person having ordinary skill in an art. *See: Hypothetical Person Skilled in the Art*.

Royalty (Reasonable Royalty): A hypothetical royalty fee used as a measure of damages to compensate for the infringement of a patent. It is the statutory minimum amount of recovery for compensatory damages for patent infringement.

S

Schedules: A reference to the classification breakdown found in the *Manual of Classification.* Each of the schedules represents an art arranged in a hierarchy from the most complex inventions down to the least complex inventions. *See: Manual of Classification*.

Scope: The total field encompassed by a patent claim.

Search Class Cross Reference: A listing of additional classes that are related to the current subject matter. Located below the current subclass definition in the Classification Definitions of the *Manual of Classification*. *See: Manual of Classification*.

Search Report: A list of published prior art and other references (both from patent sources and non-patent literature), issued by the patent searcher or patent office Examiner, which presents an opinion as to the patentability of a particular application. MPEP 707.05, MPEP 707.05(a), MPEP 1844

Secondary Considerations: Objective evidence of the actual marketplace setting in which an invention was made. This evidence is relevant to deciding whether an invention is non-obvious. Categories of

such evidence would include commercial success of the claimed invention, long-felt need that was met by the invention, unexpected results achieved by the invention, failure of others to make the invention, and copying of the invention by others. *See: Obviousness*.

Senior Party: The party in an interference who has the earlier U.S. filing date. *See: Junior Party*.

Sequence Rules: Rules promulgated by a patent office that concern the form of disclosures of inventions that contain nucleotide sequence data and/or amino acid sequence data. MPEP 2420, MPEP 2421.01, MPEP 2421.02

Serial Number: An identifying number given to each patent application by the USPTO as of the day it is received or made complete. MPEP 503

Service Mark: A word, name, symbol device, or any combination thereof, used to identify and distinguish the services performed by a particular entity from those performed by its competitors.

Showing: Evidence to show unexpected superiority over other similar applications filed to overcome an objection of obviousness over prior art (in the U.S.).

SIR: *See: Statutory Invention Registration*.

Skilled in the Art: An ordinary level of proficiency in a particular technology in which an invention is made.

Small Entity: An independent inventor, a small business or a non-profit organization. The USPTO reduces the amount of certain fees that it charges small entities by 50 percent. MPEP 509.02, MPEP 509.03

Special Status: A status granted U.S. patent applications that have certain characteristics upon successful petition to the USPTO. Applications granted special statuses are given a higher priority for examination. MPEP 708.02

Specification: Part of the patent that precedes the claims and includes the drawings and written description of the invention and the claims. In the

U.K., the first publication after application is called a specification, being an "A" document. *See: Application*. MPEP 608.01, MPEP 608.01(a), MPEP 2161

State-of-the-Art: The total information in the relevant field known to the hypothetical person skilled in the art.

Statement of Invention: That part of the specification corresponding to the main claim, summarizing the broadest aspect of the invention.

Status: The legal standing of a patent or patent application, i.e. whether it is pending, lapsed or still protected, etc. MPEP 102

Statutory Bar: A bar to patentability established by law. Examples may include publication anywhere before application, or public use or sale before the first application. MPEP 2133

Statutory Invention Registration (SIR): Registration of an invention with the USPTO to place an invention in the public domain. The disclosure of an application for Statutory Invention Registration is equivalent to the specification and drawings of a patent application. A document registered in this manner is not reviewed, and is used merely to establish prior art. *See: Prior Art, Public Domain*. MPEP 1101

Statutory Period: The period of time within which a response must be filed with the USPTO if abandonment of the application is to be avoided. MPEP 710.01, MPEP 710.01(a), MPEP 710.02, MPEP 710.02(b)

Statutory Subject Matter: Patentable subject matter. MPEP 2105

STN: STN International is operated by the Chemical Abstracts Service (CAS), and is a comprehensive database system which covers a wide range of scientific and technological subjects such as biotechnology, chemistry, patents, physics and toxicology. They offer specialized search utilities to help scientists and technologists access over 200 databases pertinent to the scientific community.

Substantive Examination: The full examination of a patent application (substance or content) by a patent office Examiner to determine whether a patent should be granted. *See: Preliminary Examination*.

Substitute Patent Application: A patent application that is a duplicate of an earlier application by the same applicant abandoned before the filing of the later application. MPEP 201.09

Substitute Specification: A rewritten specification of a patent application filed after the filing date of the application, which corrects some error but that does not introduce new matter. *See: New Matter*. MPEP 608.01(q)

Supplementary Protection Certificate (SPC): The name given in Europe to an extension of term given to a pharmaceutical or plant protection patent as a result of losing part of the term while awaiting permission to use the product.

Surrender of Patent: An act that must occur concurrently with the filing of a reissue patent application in the USPTO. MPEP 1416

Swearing Back: Removing a reference (e.g., publication) from the prior art by providing evidence to the USPTO that either 1) conception of the invention occurred prior to the effective date of the reference and the inventor was diligent in reducing the invention to practice from just before the effective date of the reference until reduction to practice occurred; or 2) completion of the invention (reduction to practice) occurred before the effective date. *See: Affidavit*. MPEP 715, MPEP 706.02(b), MPEP 706.02(k)

T

Teach: To inform and instruct by way of the documents making up the prior art. The prior art references teach the technology disclosed in them or revealed by them.

Teaching Away: The situation in which a prior art reference suggests that a claimed invention is not possible, e.g., would not work. MPEP 2145

Teaching Toward: A prior art reference that suggests or points in the direction of the present invention is said to teach toward the invention and is evidence that the invention is obvious.

Technical Field: The field of art to which the invention pertains. MPEP 608.01(c)

Technology Manager: The person in a public or private sector organization who is responsible for managing the intellectual property of the organization. Various titles are used for the position, including Technology-Transfer Officer, Licensing Associate, etc. The Association of University Technology Managers (AUTM) has over 1,200 members. Another such organization, the Licensing Executives Society (LES), has over 6,000 members worldwide.

Term of Patent: The maximum number of years that the monopoly rights conferred by the grant of a patent may last. (20 years in most countries).

Terminal Disclaimer: A document filed with the U.S. Patent and Trademark Office by an applicant, assignee, patent attorney or agent wherein a terminal portion of the normal term of the patent is given up. This is usually required to overcome a judicially-mandated double patenting rejection. *See: Double Patenting Rejection*. MPEP 1490

Testimony: Evidence given by a witness, under oath, as distinguished from evidence derived from writings or other sources.

Title of Invention: A brief but technically accurate name for the invention. MPEP 606

That Which Infringes if Later, Anticipates if Earlier: A rule stating the equivalence between two tests under patent law (i.e., the test of infringement of a patent and the test of anticipation in the prior art to invalidate a patent). If the claim of a patent is literally infringed by a prior art reference, then the claim is anticipated by that prior art reference

and, therefore, is unpatentable. Note that there cannot be anticipation of a claim by equivalents. *See: Anticipation, Infringe, Prior Art*.

Thornhill Claim: In the U.K., a claim with exactly the same scope as a specific priority document.

Trademark: A word, name, symbol, device, or any combination thereof, used by a manufacturer or by a vendor in connection with a product.

Trade Name: A name used to identify a business entity.

Trade Secret: Information kept secret by an organization for the purpose of maintaining a competitive advantage. *See: Proprietary Information*.

Traverse: To dispute the decision of an Examiner. In proceedings before the USPTO, failing to traverse an Examiner's reliance on alleged "common knowledge" or information that is alleged to be "well known" in the art can result in the allegation becoming an admission, and hence, "fact" even though it is not true. MPEP 714.02, MPEP 2144.03, MPEP 818.03, MPEP 818.03(b), MPEP 818.03(c)

U

Undue Experimentation: An unreasonable amount of experimentation practiced on a disclosed invention. MPEP 2164.01, MPEP 818.03(c)

Unenforceable: A determination by a court that a patent cannot be enforced against a claim of infringement because the patent is defective.

United States Class (U.S. Class): The U.S. Patent and Trademark Office subject classification. The classification list available online at: http://www.uspto.gov/web/offices/ac/ido/oeip/taf/def/.

United States Code (USC): The codified laws of the United States.

United States Patent and Trademark Office (USPTO, PTO): The agency of the U.S. Federal Government responsible for administering the country's patent system.

United States Patent and Trademark Office Code of Federal Regulations (CFR): The regulations promulgated by the USPTO under section 35 USC. *See: CFR*.

U.S. Patent Citations (U.S. Patent References): Mentions of earlier patents that appear on the front page of a patent document when that patent is issued. Citations/references are placed on the front page by a patent Examiner and represent the most relevant prior art upon which the patent builds.

Unobvious: The state of a claimed invention's not being apparent to a person having ordinary skill in the art to which the invention pertains. Also called non-obvious. *See: Obviousness*.

Unreasonable Experimentation: *See: Undue Experimentation*.

Useful: An invention must have a constructive or functional purpose and must operate or perform as specified in the patent. MPEP 706.03(a), MPEP 2107, MPEP 2107.01, MPEP 2107.02

Utility: One of the three statutory requirements of an invention. A patented invention must be fit for some desirable, practical, or commercial purpose. *See: Novelty and Obviousness*. MPEP 706.3p

Utility Model: In some countries (e.g., Germany and Japan), a type of patent that is available that requires less inventiveness than necessary to obtain a traditional patent. Such patents generally have a shorter life. Also known as a petty patent.

Utility Patent: A patent that covers a new and useful process, machine, manufacture, or composition of matter, as opposed to plant and design patents.

Utility Statement: That part of the specification which states the usefulness of the invention.

V

Valid: Sound and justified; meeting the test of patentability.

Validity: The issue of whether a patent is valid. *See: Valid*.

Validity Opinion: An opinion offered by a patent agent or a patent attorney as to whether the claims of an issued patent would likely be upheld by a court in view of the facts made available to him/her.

Venue: County or district in which a legal action is to be performed.

Verified Statement/Showing: A verified statement is one made with the stated knowledge that false statements and the like are punishable by fine, imprisonment, or both, and may jeopardize the validity of the application or any patent that issues from it. A showing is evidence that the statement is true.

W

Westlaw: Westlaw, a division of the Thomson-West Corporation, is a comprehensive database provider of legal, business, news and other information. They offer coverage on a variety of patent databases and systems. Like other database systems, a legal researcher should be aware of this option as a means to fulfill their searching needs.

Whole Contents Approach: The principle that the whole contents (not just the claims) of an unpublished application may destroy the novelty of a later application.

Wildcard: An asterisk (*) or a question mark (?) that can be used to replace one or more characters or words in a keyword search.

Willful Infringement: Conduct that constitutes an illegal use of another's patented invention where the infringer has no reasonable basis for believing that their actions are legal (i.e., infringement when the infringer knew of the patent). A finding of willful infringement is a basis

for increasing damages up to treble the actual amount and/or granting an award of attorneys' fees to the prevailing party. Good-faith reliance on the advice of counsel can be relevant to the issue of whether an infringement was willful. *See: Fees, Attorneys', Infringement*.

WIPO (**World Intellectual Property Organization**): An agency of the United Nations, that acts as a coordinating body for patent systems and procedures, as well as for trademark and copyright matters. MPEP 1801

Withdrawal: The permanent abandonment of a patent application either before or after publication. Priority claims as well as elections of States and the Demand may also be withdrawn. MPEP 1859, MPEP 1880

Worked or Working: The condition of having met a country's requirement that an invention be put to use in some way. Most countries require "working" of a patent within a specified time after grant. Conditions for working requirements vary widely, from publication of availability of licenses, to actual manufacture or sale of a product that embodies the claimed invention. Depending on the country, a patent may be subject to compulsory licensing or lapse unless the invention is operated commercially.

Written Description: The disclosure of an invention, normally written in a patent application. This disclosure must clearly convey what the inventor(s) considered the embodiment of their invention to a person skilled in the art. *See: Embodiment*. MPEP 2163

X

X-art Collections: *See: Cross-Reference Art Collections*.

XOR: Boolean operator which requires either of two specified terms to be present in a record, but not both. *See: Boolean Logic*.

X-Series: U.S. patents issued between 1790 and July 4, 1836; these patents may only be found by searching for the patentee's name and date of issue.

Y

Z

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