

PATENT GLOSSARY OF TERMS

- A -

Abandoned Application -- where an applicant fails to respond to a requirement within the requisite period, the Patent Office considers the application to have been abandoned. Examples of abandonment include failure to timely pay the filing fee, respond to an outstanding Office action, and to submit revised drawing corrections. An application can also be expressly abandoned by the applicant (See, *express abandonment*).

Abstract of the Disclosure -- an abstract of the invention appearing on a separate page of the application (and on the front page of an issued patent and published patent application). The abstract is not allowed to exceed 150 words.

Accelerated Examination -- under the Accelerated Examination program, an application will be advanced out of turn if the applicant files a grantable petition to make special and meets the other requirements of the program, including limiting the number of claims, performing a pre-examination search, and providing commentary on the differences between the prior art found in the search and applicant's claimed subject matter.

Administrative Patent Judge -- a judge sitting on the Board of Appeals and Interferences (BPAI) who decides as part of a three judge panel appeals relating to issues of patentability.

Admitted Prior Art -- statements made in the application (usually in the Background of the Invention), during prosecution, or in a Jepson claim, that are construed as an admission of fact by the applicant.

Advisory Action -- an Office action that communicates to the applicant the status of an application. Most commonly, an advisory action advises that a previously filed after-final amendment will not be entered because it did not place the application in condition for allowance.

American Inventor's Protection Act -- among other things, provided for publication of patent applications, patent term extension for excessive delay caused by the Patent Office, and disclosure requirements for invention promotion companies.

Antecedent Basis -- in claim drafting, a strict rule of grammar that a definite term (such as "the") must not be used until an indefinite term (such as "a") is previously used in the same claim or another claim on which the claim depends. Failure to follow this rule results in a rejection of the claim under 35 USC 112, ¶2.

Anticipation -- a claimed invention is anticipated if it lacks novelty (it was disclosed by another prior to the effective filing date) or it was disclosed by the inventor more than a year prior to the effective filing date.

Apparatus Claim -- a claim directed to a machine; an apparatus claim must be structurally different from the prior art (not just functionally different).

Appeal (of patent application) -- an appeal from an adverse decision by a patent examiner may be made to the Board of Patent Appeals and Interferences (BPAI). The appeal is commenced by filing a Notice of Appeal, and then setting forth written arguments in an Appeal Brief. Oral argument before the BPAI is optional. Upon rendering a decision, the BPAI may reverse the examiner's rejection, uphold the examiner's rejection, or remand the case to the examiner. It is important to understand that only rejections can be appealed; objections to the specification, drawings, and claims and restriction / election of species requirements can only reviewed by filing an appropriate petition.

Appeal Brief -- written arguments in an appeal of a rejected patent application to the Board of Patent Appeals and Interferences (BNPAI) setting forth reasons for error.

Applicant -- the inventor(s) who file the patent application are the applicant(s). In the case of a deceased inventor, the applicant will be the legal representative of the inventor (e.g., executor, administrator, etc.).

Application Data Sheet (ADS) -- information provided to the Patent Office during filing on a form including information regarding inventorship, correspondence address, claim to priority, and assignment information.

Art Unit (or Group Art Unit) -- a group of examiners responsible for examining patent applications for a related set of patent art. A supervisory patent examiner (SPE) manages one or more art units.

Article of Manufacture -- one of the statutory categories of patentable subject matter, an article of manufacture is a physical object that is manufactured.

Assignee -- the party which is assigned the assignor's interest under an assignment agreement.

Assignment -- transfer of all rights and title to a property, such as the rights to an issued patent or patent application. Although not commonly done, an assignment can be limited as to a specified part of the United States.

Assignor -- the party which has assigned its interest to the assignee under an assignment agreement.

Assistant Patent Examiner -- a junior patent examiner who lacks signatory authority; an assistant patent examiner works under the supervision of a primary patent examiner.

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Background of the Invention -- a section of a patent application discussing the related prior art, including problems involved in the prior art that are solved by the applicant's invention.

Beauregard Claim -- a claim that covers a computer-readable medium (such as a CD or a floppy disc) having a program of instructions to perform a process on a computer. See: *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995).

Benefit Claim -- statement by the applicant claiming benefit to an earlier filing date. For example, an applicant of a non-provisional application may claim the benefit of an earlier-filed provisional patent application.

Best Mode -- an applicant is required to disclose what he or she considers to be the best way to carry out the invention, if such a best mode exists.

Bilski (Bilski v. Kappos) -- a Supreme Court decision rejecting the machine-or-transformation test as the sole test for determining patentability of a process.

Board of Patent Appeals and Interferences (BPAI) -- comprises several administrative patent judges who sit in three-person panels to review *ex parte* appeals from adverse decisions of examiners. BPAI judges also preside in interference proceedings to determine who is the first inventor.

Body (of claim) -- portion of a claim that sets forth the claim elements and limitations.

Brief Description of Drawings -- a section of a patent application that briefly describes each of the figures in the application.

Business Method -- type of patent which sets forth a method of doing business, such as a method related to ecommerce or financial services. Most business method patents are classified under Class 705.

- C -

CCPA -- stands for (United States) Court of Customs and Patent Appeals, the predecessor court to the United States Federal Court of Appeals for the Federal Circuit (usually called, simply, The Federal Circuit). The CCPA was abolished in 1982 and its jurisdiction was transferred to the Federal Circuit.

Certificate of Correction -- an addendum to an issued patent noting minor mistakes (usually clerical or typographical) together with the correction. A Certificate of Correction is usually requested by applicant (for a fee) but can also be issued by the Patent Office (no fee) if the errors were made by the Patent Office. New matter may not be added by way of Certificate of Correction.

Certificate of Mailing -- for correspondence with the Patent Office, a certificate stating the date of deposit or transmission signed by a person having a reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated. A certificate of mailing cannot be used to obtain a filing date. Instead, the application must be either mailed by US Postal Service "Express Mail" with label showing the mail date attached, filed by EFS (electronic filing system), or brought in person to the Patent Office.

Chapter I (of the Patent Cooperation Treaty) -- prosecution under the Patent Cooperation Treaty (PCT) prior to a demand under Article 31 is made. During Chapter I, the an international search report and written opinion is issued and the application is published.

Chapter II (of the Patent Cooperation Treaty) -- prosecution under the Patent Cooperation Treaty (PCT) after a demand under Article 31 is made.

Claim -- part of the application where the invention is defined and the boundaries thereof are set forth. The claims are set forth on separate pages at the end of the specification; each claim is written as a sentence.

Claim Cancellation -- deletion of a claim in a pending patent application. When a claim is cancelled, the applicant cannot renumber the remaining claims or re-use the claim number of the cancelled claim. Upon issuance, the examiner renumbers the claims.

Claim Construction -- refers to interpretation of claims, usually, by a judge (e.g., in a Markman Hearing) or by an examiner during prosecution.

Claim Differentiation -- this is a doctrine of claim construction in which it is presumed that claims in a patent do not have identical scope (meaning).

Claim Element -- a feature of the invention that is set forth in a claim; to literally infringe, each of the claim elements would have to be present in the infringing device or method.

Claim Scope -- what the claim covers; the boundaries of the invention, defined by the claims; the metes and bounds of the claim.

Classification, Cross-References -- related classes/subclasses for an invention (patent).

Classification, Current -- the current classification of the invention (patent).

Classification, Original -- the original classification of the invention (patent).

Clear and Convincing Standard -- Under §282 of the Patent Act, an issued patent is presumed to be valid. The courts have held that the presumption is a "strong presumption" and the evidence needed to overcome invalidity must be clear and convincing.

Clear Anticipation -- when prior art is exactly the same, or nearly so, to the applicant's claimed subject matter, applicant's claimed subject matter is sometimes said to be "clearly anticipated".

Clearance Search and Opinion -- prior art search and written opinion, usually by a patent attorney, for the purpose of determining whether an invention would infringe on an existing patent issued to someone else.

Code of Federal Regulation (CFR) -- codification of the rules published in the Federal Register by the executive departments and agencies of the Federal Government. Title 37 of the CFR covers rules governing patents, trademarks, and copyrights.

Co-inventor -- a joint inventor.

Combination of References -- to establish a *prima facie* case of obviousness, often examiners assert that it would have been obvious to combine certain features of several different pieces of prior art together, to form a single invention that would have covered the claimed subject matter.

Commercial Success -- where there is a nexus between the success of the product and the merits of the claimed invention; a secondary consideration used to establish that an invention was non-obvious.

Composed of -- a transitional phrase in a claim that usually is interpreted to mean the same as "consisting of".

Composition of Matter -- one of the statutory categories of patentable subject matter, a composition of matter includes chemical compositions and may include mixtures of ingredients as well as new chemical compounds.

Comprising -- a transitional phrase that is inclusive or open-ended and does not exclude additional, unrecited elements or method steps; synonymous with "including," "containing," or "characterized by."

Compulsory License -- permission is not needed to use the patent but a fee must be paid to the patentee; a compulsory license may be granted to remedy patent infringement, as was the case in *Finisar v. DirectTV Group* (E.D. Tex. 2006)

Conception -- the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice.

Concordance, Patent Classification -- conversion of a US patent classification code to an International Patent Classification (IPC) code.

Confirmation Number -- a four-digit number that is assigned by the Patent Office to an application upon filing, used in subsequent communication and filings with the Patent Office regarding the application.

Consisting Essentially of -- a transitional phrase in a claim that excludes any element, step, or ingredient not specified in the claim and those that do not materially affect the basic and novel characteristics of the claimed invention.

Consisting of -- a transitional phrase in a claim that excludes any element, step, or ingredient not specified in the claim.

Constructive Reduction to Practice -- filing a patent application that satisfies the requirements of 35 USC §112, ¶1. See, *reduction to practice*.

Continuation Application -- an application that is based on a parent patent application that adds additional claims for subject matter not previously claimed; a continuation application is accorded the same filing date of the parent patent application.

Continuation-in-Part (CIP) application -- an application that is based on a parent patent application that adds new subject matter to the specification and claims this newly added subject matter; a CIP application is usually used to claim improvements to the underlying technology covered by the parent application; claims in the CIP that are directed to the new subject matter are accorded an effective priority date of the filing of the CIP, and any other claims directed to subject matter disclosed in the parent patent application are accorded the same filing date of the parent patent application.

Contracting State (Patent Cooperation Treaty) -- a country which is a signatory to the Patent Cooperation Treaty (PCT). For a list of contracting states, see http://www.wipo.int/pct/guide/en/gdvol1/annexes/annexa/ax_a.pdf

Contributory Patent Infringement -- Under 35 U.S.C. 271(c), "whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination, or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial non-infringing use, shall be liable as a contributory infringer".

Co-pending Applications -- patent applications that are both pending at the same time. It is a requirement for a continuation application, continuation-in-part application, and a divisional application to have been co-pending with the parent application at the time of filing.

Count (examiner) -- under the Patent Examiner Count System, a count is a credit which the examiner receives during the examination process. Examiners receive counts for such things as completing a first action, a final office, an allowance, and an examiner's answer to an appeal brief.

Count (interference) -- in an interference proceeding, the scope of the subject matter that both parties claim as their own.

Cross-License -- an agreement in which each of the parties agrees to allow the other the right to use certain patents. Such an agreement is often entered into when each party has technology the other wants or needs.

Crowded Art -- an area of technology where there are already a large number of patents, and most tend to be relatively narrow in scope.

Customer Number -- a unique identification number assigned by the Patent Office to one or more patent practitioners (such as to a single law firm).

- D -

Deceased Inventor --if an inventor dies, his or her legal representative may apply for and be issued the patent on behalf of the deceased's estate.

Declaration Traversing Rejection -- to overcome a rejection, an applicant can submit evidence in the form of an affidavit

Dedication to the Public --subject matter that is disclosed but not claimed is dedicated to the public (forfeited).

Defensive Publication -- often used as part of an overall strategy, this is a publication that is written in such a way so as to be used as prior art to block others from obtaining a patent for the invention.

Definiteness -- claim language must be definite so that the public is informed as to the boundaries of what constitutes infringement of the claim.

Dependent Claim -- refers to and includes claim limitations of another claim (either another dependent claim or an independent claim) and recites additional limitations.

Deposit Account -- an account maintained by the Patent Office that contains funds deposited therein which can be drawn on when needed to pay various fees.

Design Around -- design of a product in such a way that it does not infringe on a particular set of patent claims.

Design Patent -- a patent covering the ornamental design of a functional item, not its functional or utilitarian features; a design patent has a term of 14 years from issuance.

Detailed Description -- a section of a patent application in which the invention is described adequately so as to evince that the inventor had possession of the invention and in such a way so as to enable one of ordinary skill in the art to make and use the invention without undue experimentation.

Diligence -- in an interference proceeding, an inventor who is a first conceiver but second to reduce the invention to practice must show diligence in working on the invention from the date of conception to the reduction to practice; diligence can be shown by affirmative acts or acceptable excuses, but the entire period must be accounted for.

Director (of US Patent and Trademark Office) -- officially, Under Secretary of Commerce for Intellectual Property, the head of the entire US Patent and Trademark Office.

Disclosure -- refers to an invention disclosure used by many companies to specify an invention and (sometimes) various embodiments thereof; a disclosure can also refer to a patent specification (application).

Disclosure Document Program -- a service of the Patent Office to accept and store invention disclosures for two years to provide proof of conception; discontinued as of February 2007.

Divisional Application -- a type of continuing patent application in which subject matter that was restricted or subject to an election of species in the parent application is claimed; a divisional application is accorded the same filing date as the parent application.

Doctrine of Equivalents -- an equitable doctrine whereby patent infringement occurs even though the claims are not literally infringed. The rule set forth in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 US 605 (1950) is: "If two devices do the same work in substantially the same way, ... they are the same, even though they differ in name, form, or shape." The Doctrine of Equivalents may be defeated, if during prosecution, the applicant amended the claims conceding the equivalent. See, *prosecution history estoppel*.

Dominating Patent -- a patent with a claim covering the subject matter claimed in an "improvement" patent; in such a case, the owner of the improvement patent must obtain the permission of the owner of the dominating patent to make or use the improved invention.

Double Patenting (statutory) -- under 35 USC §101, the Patent Office will not issue two patents by the same inventive entity that claim the same subject matter.

Double Patenting (obviousness type) -- a rejection of a patent application because a claim in the application recites subject matter that is obvious in view of claimed subject matter in an issued patent (or a pending application) by the same inventive entity; an obviousness-type double patenting rejection may be overcome by filing a terminal disclaimer which disclaims the portion of the later-issuing patent that extends beyond the term of the other patent.

Drawings -- whenever the nature of the case requires a drawing to understand the invention, one or more drawings must be filed with the application. Under 37 CFR §183(a), the drawings must show every claim feature.

Duty of Disclosure -- an applicant is required to submit to the Patent Office any prior art which is material to patentability; the proper way of submitting this information is to list it on an Information Disclosure Statement (IDS), filed with the Patent Office.

- E -

EAST/WEST -- Examiner Automated Search Tool (EAST) and Web-based Examiner Search Tool (WEST) are computer-based search tools used by examiners to search the prior art; public access to these search tools is available at the Patent Offices' Public Search Facility, located in Alexandria, VA.

Effective Filing Date (also called *priority date*) -- refers to the filing date of the earliest U.S. patent application filed by the inventor including a disclosure that supports the claimed invention.

Election of Species -- in response to an election of species requirement, applicant elects one or more species (variation of the invention) of the invention by indication of the figures associated with the elected species along with claims that read on these figures; once allowable subject matter is indicated, the examiner examines the non-elected species prior to allowance.

Electronic Filing System (EFS) -- a Web-based filing system used to file patent applications, amendments, and most other communication with the Patent Office.

Embodiment -- a concrete form of the invention described in the specification.

Enablement -- requirement that the specification disclose the invention in such a way to enable one of ordinary skill in the art to make and use the invention as claimed.

Enabling Disclosure -- to be used in a proper obviousness rejection or one based on anticipation, a prior art reference must teach how to make and use the invention.

Ex parte -- legal proceeding without a third party being able to participate; patent examination is an ex parte proceeding.

Examination -- process of ensuring that a filed patent application meets the requirements of the Patent Act and rules promulgated by the Patent Office; in particular, examination of patent application involves inquiry into whether the application is new, useful, and non-obvious.

Examiner's Docket -- a docketing system used by the examiner to keep track of applications assigned to the examiner.

Examiner Interview -- discussion with an examiner, either in-person or via telephone, regarding a pending patent application; substance of the examiner interview must be stated in writing after interview is completed.

Examiner's Answer (to appeal brief) -- after applicant files a Notice of Appeal and an Appeal Brief, the examiner is given the opportunity to respond in writing in the form of an Examiner's Answer.

Exemplary -- this means an example of; e.g., an exemplary widget means an example of a widget.

Exhaustion of Rights -- doctrine in which a patentee cannot restrict the use of its patented product once it is sold.

Experimental Use -- where public use or sale of an invention is incidental to experimental use, the usage or sale does not act as a bar to novelty.

Expired Patent -- at the end of the term of a patent, or for failure to timely pay a maintenance fee, a patent expires; the subject matter of an expired patent is in the public domain.

Express Abandonment -- a patent application abandoned by the applicant by an express written statement to that effect; to prevent publication of the patent, the applicant must file a petition under 37 CFR 1.138(c) for express abandonment to avoid publication of the application.

Extension of Time -- a request to extend the time required to take action during prosecution, such as to respond to an outstanding Office action, may be made by petition and payment of a fee; time limits set by statute, such as the requirement that a response to an Office action be made within six months, cannot be extended.

- F -

Failure of others -- a secondary consideration relevant to establishing that the claimed subject matter is non-obviousness, where others tried to solve the problem but failed.

Federal Circuit (United States Court of Appeals for the Federal Circuit) -- federal appeal court established in 1982 to hear (among other things) appeals in patent and trademark cases from district courts and from Board of Patent Appeals and Interferences and the Trademark Trial and Appeal Board.

Federal Holidays, effect on deadline -- whenever a deadline for filing falls on a federal holiday (or a weekend), the deadline is extended to the next business day; 5 U.S.C. 6103(a) lists the current federal holidays; 5 U.S.C. 6103(c) notes that Inaugural Day is also to be treated as a federal holiday for purposes of official filings.

Field of the Invention -- a section of a patent application which includes a statement as to the field of art to which the claimed subject matter pertains.

File Wrapper -- refers to the entire patent application file with the Patent Office, including any filings by applicant and responses by Patent Office personnel; the term also can refer to the actual folder that surrounds the patent application being examined.

Filing Date -- the date on which an item was officially filed with the Patent Office; an application is filed upon receipt by the Patent Office, if it is delivered by regular mail; if filed by USPS Express Mail or electronically filed, the date of filing will be the date of mailing / submittal.

Filing Fee -- a fee paid to file a patent application; the amount of the filing fee depends on whether the applicant is a small entity or a larger entity, the number and types of claims filed and the number of pages of specification.

Final Office Action -- an Office action finally rejecting a patent application; a final Office action can usually only be responded to by submitting a Request for Reconsideration, an appeal, or filing a Request for Continued Examination (RCE). Amendment to the claims can only be made in response to a final office action if the amendments put the case in condition for allowance or better form for appeal. Also, see, *non-final Office action*.

First to Invent -- where there are two or more people who invented the same thing, the first to invent can receive a patent for the invention even though he or she was not the first to file provided the first to invent actually or constructively reduced the invention to practice before the others or diligently worked to reduce the invention to practice before filing a patent application; see, *Interference*.

Flash of Genius Test -- test for patentability used by the courts based on the case of *Cuno Engineering v. Automatic Devices* (314 U.S. 84) (1941) that required a "flash of genius", not just ordinary skill in the art. The Flash of Genius Test was rejected by the 1952 Patent Act.

Forfeited Application -- an application for which the issue fee or an issued patent for which the maintenance fee has not been timely paid.

- G -

Gene Patent -- a sequence of DNA of a particular organism along with description as to how this can be used for diagnosis or therapy.

Generic Claim -- a claim that covers all of the species of the invention.

Graham Factors (also called secondary considerations) -- Graham v. John Deere (383 US 1) (1966) was an important Supreme Court case laying forth the factual inquiries required to make to resolve the issue of obviousness. The case also listed several secondary considerations that could serve as evidence of nonobviousness, including: commercial success, long felt need, and failure of others.

Group Art Unit -- see, Art Unit

Group Director -- a manager at the Patent Office responsible for managing a Technology Center.

- H -

Hindsight -- tendency to believe that something is obvious once it has been revealed; examiners sometimes succumb to impermissible hindsight reasoning in rejecting claims on obviousness grounds.

- I -

Improvement Patent -- a type of patent that covers improvements to an invention.

Incorporate by Reference -- in a patent application, non-essential material may be incorporated by referring to it within the specification; such material properly incorporated by reference is treated as if it was inserted into the application.

Independent Claim -- a claim which does not depend on another claim and sets forth explicitly all of the claim elements.

Inducement to Infringe -- Under 35 USC § 271(b), an act of actively inducing another to infringe a patent shall itself be treated as an act of infringement.

Inequitable Conduct -- a defense to patent infringement in which the plaintiff is alleged to have breached its duty of candor and good faith with the Patent Office, such as, for example, by failing to submit relevant prior art known to the applicant or making false statements to the examiner.

Informal Application -- where a patent application fails to comply with formal requirements (e.g., typed on both sides of the page, drawings are not in proper form), the application is deemed to be informal and the applicant is usually given an opportunity to correct the application within a specified time frame.

Information Disclosure Statement (IDS) -- a form on which the applicant lists known prior art references that may be material to patentability.
See: duty of disclosure.

Inherency (of a reference) -- in a rejection based on anticipation, a feature of a prior art reference is implicitly disclosed in the reference.

Inherency (of patent right) -- a license to patent rights includes the inherent right of a third party to make the patented product on behalf of the licensee without express permission of the licensor.

Interference -- an *inter partes* proceeding to determine the first inventor and who is entitled to the patent.

International Patent Classification (IPC) -- a patent classification scheme administered by the World Intellectual Property Organization (WIPO). The IPC is different from the classification system used by the US Patent & Trademark Office.

Intervening Rights -- a doctrine that allows one to rely on a patent as it was issued or as abandoned even though the patent is later either reissued and changes scope or was revived.

Invalidity opinion -- a legal opinion as to whether the claims of a patent are invalid. This type of opinion is often used to determine whether a competitor's patent is valid.

Invention Disclosure -- a document that describes the invention in detail, usually for internal corporate purposes.

Inventive Entity -- the inventors associated with a particular patent or patent application.

Inventor (or Inventorship) -- one who contributes to the conception of claimed subject matter.

Issuance of Patent -- grant of a patent by the United States Patent and Trademark Office. Each Tuesday of the week, newly issued patents are granted along with notices published in the Official Gazette.

Issue Date -- the date on which a patent was issued.

Issue Fee -- a fee required to be paid for issuance of a patent, which must be paid within three months from the Notice of Allowance.

- J -

Jepson Claim -- a claim in which the preamble sets forth features of the prior art and the body of the claim sets forth the points of novelty.

Jumbo Patent -- expression used in reference to a patent having a lengthy specification.

Junior Party -- in an interference proceeding, the party which filed after the senior party and bears the burden of proving it was first to conceive.

- K -

KSR v. Teleflex (127 S. Ct. 1727 (2007)) -- Supreme Court case rejecting the longstanding "teaching, suggestion, or motivation" (TSM) test developed by the Federal Circuit; a more flexible approach to obviousness is set forth in the opinion written by Justice Kennedy.

- L -

Large Entity -- with reference to the owner of the patent rights (e.g., the assignee), a large entity as defined in 37 CFR §1.27 must pay the full fee amounts set forth in the Patent Office fee schedule. See, also, *small entity*.

License -- a license provides permission from the licensor to use / make the invention as claimed under the terms of a license agreement (contract) between the licensor and the licensee.

Linking Claim -- a claim that includes features of two inventions, such as a process claim reciting a product set forth separately in an apparatus claim.

Literal Infringement -- where each claim element identically corresponds to a feature of the infringing product or process.

Long-Felt Need -- where an art recognized problem existed in the art for a long period of time without solution; a secondary consideration used to establish that an invention was non-obvious.

- M -

Machine-or-Transformation Test -- a test for determining whether a process recites patentable subject matter; under the machine-or-transformation test, a process is patentable if it is “tied to a particular machine or apparatus” or “transforms a particular article into a different state or thing”; the Supreme Court has ruled that the machine-or-transformation test is not the sole test for patentable subject matter. See, *Bilski (Bilski v. Kappos)*.

Maintenance Fee -- a post-issuance fee paid to keep a patent in force; maintenance fees are due 3 1/2, 7 1/2 and 11 1/2 years from the date of the original patent grant.

Manual of Classification -- a publication of the Patent Office that lists the current class schedules and related information regarding each class.

Manual of Patent Examination and Procedure (MPEP) -- a publication of the Patent Office that includes the procedures, rules, regulations, and guidelines for examining patent applications.

Markman Hearing -- a pretrial hearing in a federal district court in a case involving alleged patent infringement in which evidence and arguments regarding claims construction are heard; under *Markman v. Westview Instruments, Inc.*, 517 US 370 1996), claim interpretation was held to be a matter of law resolved by a judge.

Markush Group -- a claim in a special format in which a list of alternatives is provided; the format commonly used includes the phrase *selected from the group consisting of A, B, and C* (where A, B, and C are the alternatives.)

Mean-Plus-Function Claim - under 35 USC §112, ¶6, a claim in which function rather than structure is recited; when a means-plus-function claim is properly used, the recited function corresponds to structure recited within the specification. (Process claims that recite functional method steps are known *step-plus-function* claims).

Method Claim (also called Process Claim) -- a claim which sets forth steps of a process.

Motivation (to combine references) -- to establish obviousness the teachings of the prior art can be combined or modified where there is some teaching, suggestion, or motivation to do so.

Multiple Dependent Claim -- a dependent claim which refers back in the alternative to several claims.

- N -

National Stage Application -- stage of PCT practice in which the application is examined in one or more of the member states.

New Matter -- subject matter not disclosed when the application was originally filed.

New Use -- a new use for an existing product may constitute patentable subject matter; for example, the Federal Circuit found that applying a soluble form of Vitamin C lotion to treat sunburn damage was patentable even though the this form of Vitamin C was already used in other applications.

Non-Disclosure Agreement (NDA) (also called a Confidentiality Agreement) -- a contract wherein the parties agree to share certain confidential information but not to disclose it to third parties or publicly.

Non-Final Office Action -- an Office action that the applicant is given an opportunity to respond to within the statutory time period; the Office action can be responded to by filing an Amendment or a Request for Reconsideration; also, see, *final Office action*.

Nonfunctional Descriptive Material -- nonstatutory subject matter including data structures, computer programs, music, literary works, and a compilation or mere arrangement of data.

Non-Provisional Application -- a patent application that will be examined and, if allowed, issued as a utility patent.

Non-Responsive Amendment -- a reply to an Office action that fails to respond to every issue raised; where there is a *bona fide* attempt to advance the application to final action) but contains a minor deficiency, the examiner may accept the amendment as being timely filed.

Notice of Allowability -- usually contained in an Office action, a statement by an examiner indicating a finding that one or more claims recite allowable subject matter.

Notice of Allowance -- a formal notice that the patent application has been allowed and will be issued in due course provided that the issue fee is paid within three months of the mailing date of the notice.

Notice of Appeal -- notice by the applicant of an intent to appeal the case; the applicant must pay a fee for the Notice of Appeal and file an Appeal Brief within the statutory period; also, see, *Appeal Brief*.

Notice of Publication -- a notice by the Patent Office that an application will be published.

Novelty -- a requirement of patentability that the claimed subject matter be new (novel).

- O -

Objection -- notification by an examiner that an aspect of the specification is in improper form; usually refers a minor formality such as a misspelling or incorrect reference numeral; unlike a claim rejection, an objections is not reviewable by the BPAI.

Obviousness -- along with utility and novelty, a condition for patentability is that the claimed subject matter be non-obvious; under section 103 "[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

Obviousness to Try -- where a person of ordinary skill in the art would be led as a matter of course to try the claimed invention in the expectation that it might well produce a solution to the problem.

Offer to Sell -- subject to a commercial offer for sale under contract law as applied in the federal courts; under section 102(b) of the Patent Act, a patent may not be obtained if the invention was "on sale in this country more than one year before the date of the application for patent in the United States."

Office Action -- written communication from the Patent Office (usually from a patent examiner) regarding a pending patent application; most commonly, an Office action will include one or more claim rejection, and must be responded to within a set period.

Official Gazette (OG) -- official publication by the United States Patent and Trademark Office issued each Tuesday of the week listing the patents that were issued along with the classification, brief description and drawing.

Official notice -- statement by an examiner in an Office action that certain alleged facts are to be taken as being true without the necessity of providing evidence because they are beyond dispute or within common knowledge; analogous to the doctrine of judicial notice in the law of evidence.

Omnibus Claim -- a claim that references the specification or drawings without specifying the particular claim limitations; omnibus claims are not allowed under US patent practice.

On-Sale Bar -- under section 102(b) of the Patent Act, a patent may not be obtained if the invention was "on sale in this country more than one year before the date of the application for patent in the United States". See, *offer to sell*.

Ordinary Skill in the Art -- a person having ordinary skill in the art is a legal fiction used for various purposes in patent law, including to evaluate obviousness and whether a written description is enabling.

- P -

PAIR (Patent Electronic Business Center) -- a Web-based system to provide information regarding patent application, including on-line file histories and current status of the application.

PALM (Patent Application Location and Monitoring) -- a computer system used within the Patent Office to track, monitor, and report on pending applications.

Parent Application -- where one or more patents claim the benefit of one or more earlier filed non-provisional applications, the earliest filed non-provisional application is called the parent application; the entire collection of these patents is sometimes referred to as a *patent family*.

Paris Convention (for the Protection of Industrial Property) -- provides that where an applicant files a patent in one of the member countries, each of the other contracting states will honor this filing date as the priority date if the applicant subsequently files a patent application in the contracting state within one year (for utility patent applications) or six months (for design patent applications).

Patent -- the grant of a patent by the US government provides the patentee with the legal right to prevent others from making, using, and importing the invention for the length of the patent term; the term for a utility patent is measured as twenty years from the effective filing date of the patent application; to be patentable, an invention must be new, useful, and non-obvious. a "new" (or novel) invention is one which no one else previously thought of; "useful" refers to the invention having some use; "non-obvious" refers to the requirement that the inventiveness involved be more than merely that of the skilled artisan of ordinary skill in the relevant art.

Patent Act -- the Patent Act is found in Title 35 of the U.S. Code and contains the federal statutes governing patent law in the United States.

Patent Agent -- a patent practitioner registered with the Patent Office who is not an attorney; a patent agent is limited to practice before the US Patent and Trademark Office in patent matters.

Patent Ambush -- where a patent is issued after an industry standard is developed that reads on the industry standard, and is asserted against those who adhered to the standard.

Patent Attorney -- a patent practitioner registered with the Patent Office who is an attorney; a patent attorney may provide legal advice on a range of issues relating the validity of a patent, infringement of a patent, and may litigate in the federal courts.

Patent Classification -- every patent or patent publication is assigned a classification; a patent classification is a code that provides a method for categorizing an invention. The classification is typically expressed in the format 999/9; the first number represents the class of the invention, the number following the slash is the subclass of the invention within the class.

Patent Cooperation Treaty (PCT) -- provides a uniform set of procedures for filing applications in each of the contracting states; the filing date of an application filed under the PCT will be honored in any of the member states provided national state applications are filed within the time period set forth, usually 30 months from the priority date.

Patent Examiner -- a person assigned to examine patent applications and render decisions as to allowability; all patent examiners are required to have a technical educational background.

Patent Family -- where one or more patents claim the benefit of one or more earlier filed non-provisional applications, the collection of these patents, including the parent application, is referred to as a *patent family*.

Patent Infringement -- where one makes, uses, sells, and/or imports the claimed invention without permission of the owner of the patent, with or without knowledge of the existence of the patent.

Patent Mapping -- graphical visualization of patent families, competitor's patents, acquisition targets, etc.

Patent Mining -- process of discovering correlations, trends and opportunities in existing patent portfolios usually using statistical and other mathematical techniques.

Patent Misuse -- an affirmative defense to patent infringement where the defendant raises the issue of "unclean hands" such as because of the plaintiff's alleged inequitable conduct or antitrust violation.

Patent Number -- a consecutive unique number assigned to each issued patent.

Patent Pending -- where a patent application (provisional or non-provisional) has been filed but the final disposition of the case has not yet been determined (i.e., the application is "pending").

Patent Pool -- where several companies pool their patents and cross-license them to each other.

Patent Portfolio -- a group of patents owned by an entity.

Patent Prosecution Highway (PPH) -- an initiative used by various patent offices to accelerate examination where substantially the same application is being examined in more than one country; under the PPH, an applicant receiving a ruling from the Office of First Filing (OFF) that at least one claim filed in the OFF is patentable may request that the Office of Second Filing (OSF) accelerate examination of the application.

Patent Public Advisory Committee (PPAC) -- as authorized under 35 USC §5, a group of nine individuals selected to review the policies, goals, performance, and user fees of the Patent Office. The nine-member PPAC is on a three-year rotating schedule.

Patent Search -- a search of issued patents for some purpose; for example: a *novelty search* involves searching prior art to assess the novelty of an invention; a *validity search* involves searching the prior art to establish the enforceability of an issued patent; an *infringement search* involves a search of the prior art to determine whether there are any issued patents that would bar the manufacture, use or sale of a particular product, process, or service.

Patent Term -- for patents filed on or after June 8, 2005, the term of a utility patent is 20 years from the effective filing date (priority date); the term of a patent filed before June 8, 2005 is the greater of 20 years from the effective filing date or 17 years from the issue date; the length of a patent term is subject to any term extension and/or terminal disclaimer, and timely payment of maintenance fees.

Patent Term Extension -- under 35 USC 154(b), the term of a patent may be extended due to excessive delay by the Patent Office. The term of a patent may also be extended in the case where the delay is a result of lengthy FDA approval.

Patent Troll -- a term sometimes used to negatively describe a person or entity which aggressively asserts one or more patents against a company or entire industry where the patentee has no intention to produce or use the patented product itself.

Patentability Opinion -- a legal opinion as to the likelihood that an invention is patentable.

Patentable Subject Matter -- subject matter that can be patented; does not include abstract ideas, physical phenomena and laws of nature.

Patentee -- the person(s) for whom a patent was granted.

Petition -- a formal request to the Patent Office (or directly to the Director) to do something, such as to extend the period to respond to an Office action or revive an unintentionally abandoned application.

Petition to Make Special -- a petition requesting that the examination of a patent application be accelerated based on the applicant's advanced age or ill health; or that the invention will materially enhance the environment, contribute to the development or conservation of energy resources, or contribute to countering terrorism.

Pioneering Patent -- a patent for a revolutionary new invention changing an industry; for example, in 1794, Eli Whitney's patent for a cleaning and separating cotton from its seeds.

Plant Patent -- a patent granted to one who has invented or discovered and asexually reproduced a distinct and new variety of plant, other than a tuber propagated plant or a plant found in an uncultivated state.

Practitioner -- a person who is registered to practice in patent matters before the United States Patent and Trademark Office; see, *patent agent*, *patent attorney*.

Preamble (of claim) -- the introductory clause of a patent claim before the transitional phrase.

Preliminary amendment -- an amendment to a patent application submitted prior to the first Office action on the merits.

Presumption of Validity -- under 35 USC § 282 "[a] patent shall be presumed valid." The courts have held that the presumption is a "strong presumption" and the evidence needed to overcome invalidity must be clear and convincing.

Prima Facie Case (of non-obviousness) -- the examiner bears the initial burden of factually supporting a conclusion of obviousness (making a *prima facie* case) and must clearly articulate the reason(s) why the claimed invention would have been obvious.

Primary Patent Examiner -- an examiner who has signatory authority to sign Office actions.

Prior Art -- information that was publicly available prior to the priority date for the invention.

Pro se applicant -- an applicant not represented by either a patent attorney or patent agent.

Product of Nature -- a product of nature is not patentable; however, chemicals, gene sequences, and living organisms derivable from nature may be patentable.

Product-by-Process Claim -- a claim to a product that claims the product according to the process by which it is made.

Prolix Claim -- a claim with long recitations or unimportant details such that the scope of the claimed invention is rendered indefinite.

Prosecution -- process of drafting and filing a patent application and following pertinent procedures before the Patent Office until the final disposition of the application.

Prosecution History Estoppel (also called File Wrapper Estoppel) -- a presumption exists that when an applicant amends a claim to avoid an art-related rejection that the avoided limitation(s) are not within the scope of the amended claim.

Prosecution on the Merits -- prosecution of an application regarding the patentability of a claimed invention, as opposed to mere formalities or procedural matters.

Provisional Application -- a patent application that is not examined but whose filing date is preserved for the benefit of a later-filed non-provisional patent application; a provisional application expires 12 months from the filing date; a written description of the invention, complying with the requirements of 35 USC §121, ¶1 and any drawings necessary to understand the invention must be filed with the provisional application.

PTDL (Patent & Trademark Depository Libraries) -- a library designated by the U.S. Patent and Trademark Office to receive and house copies of U.S. patents and patent and trademark materials, to make them freely available to the public, and to actively disseminate patent and trademark information.

Public Use -- under the Patent Act, a patent application must be filed within one year of any public use of the invention.

Publication Number -- a number assigned by the Patent Office to a published patent application; the publication number is in the form YYYY/9999999 (where YYYY is the year of publication and 9999999 is a seven-digit number).

Published Application -- unless a request for non-publication is filed (along with a fee), a patent application will be published 18 months after the priority date of the application.

- Q -

Quayle Action -- an Office action informing the client that the application is in condition for allowance except for minor informalities which must be corrected within a shortened statutory time period.

- R -

Recordation of Assignment -- an assignment of the rights to a patent or application recorded with the Patent Office.

Reduction to Practice -- an actual reduction to practice occurs when there is an embodiment of the concept of the invention;
See, constructive reduction to practice.

Reexamination, *ex parte* -- a reexamination of an issued patent requested by a third party or the inventor to determine whether the patent claims are valid; where a third party makes the request, other than submitting additional prior art initially, the requestor is not involved in the reexamination.

Reexamination, *inter partes* -- a reexamination of an issued patent requested by a third party whereby the requestor is involved in the reexamination.

Reference Character (or Reference Numeral) -- a numeral or other character assigned to a part or feature of a patent drawing.

Reissued Patent -- a patent that has successfully been reexamined and is subsequently "re-issued".

Rejected Claim -- a claim in a patent application which has been rejected by an examiner.

Reply Appeal Brief -- a reply by the appellant to an examiner's answer to an Appeal Brief.

Request for Continued Examination (RCE) -- a request by application to continue prosecution after the application has been finally rejected.

Request for Reconsideration -- a response to an Office action that merely presents arguments without amendment of the specification or claims.

Restriction -- where a patent application contains more than one invention and it would be burdensome on the examiner to examine the application, the application can be "restricted" such that the applicant is required to choose one of the "inventions" to be initially examined.

Revival of Abandoned Application -- an unintentionally abandoned application can be revived by filing a petition to revive; where the abandonment was also unavoidable, the petition fee is considerably less but the requirements are more difficult to meet.

Royalty -- amount paid to owner of patent rights to license the patent, often calculated as a percentage of sales or net profit.

- S -

Sandor obviousness -- an obviousness rejection based on a single prior art reference.

Search Report -- a report which summarizes the findings of a patent search and usually lists relevant references found in the search.

Secondary Considerations -- considerations that could serve as evidence of nonobviousness, including: commercial success, long felt need, and failure of others; see *Graham Factors*.

Senior Party -- in an interference proceeding, the party which filed first and enjoys a presumption of being the first to conceive.

Sequence Listing -- a section of a patent application listing a genetic sequence listing.

Serial Number -- a unique number assigned by the Patent Office to a filed patent application; a serial number is in the form NN/999,999, where NN is the series code (currently 12) and the 999,999 is a number that is incremented for each filing.

Signatory Authority -- the authority delegated to a primary patent examiner to sign Office actions; see, *primary patent examiner*.

Small Entity -- with reference to the owner of the patent rights (e.g., the assignee), a small entity as defined in 37 CFR §1.27 may pay the reduced fee amounts set forth in the Patent Office fee schedule. See, also, *large entity*.

Software Patent -- a patent directed to a computer process or a computer system programmed in a particular manner.

Specification -- a written description of an invention provided for in a patent application.

Statutory Bar -- a requirement based in statute that cannot be waived or modified by the Patent Office

Statutory Disclaimer -- under § 253, a statutory disclaimer has the effect of canceling the claims from the patent and the patent is viewed as being dedicated to the public.

Statutory Invention Registration (SIR) -- a defensive document including a specification and drawings that is published by the Patent Office; in filing a SIR, the applicant gives up his or her right to obtain a patent on the disclosed subject matter.

Statutory Period -- period of time to take some specified action, such as, for example, reply to an Office action, set by statute and which cannot usually be extended by the Patent Office.

Step-Plus-Function Claim -- under 35 USC §112, ¶6, a process claim in which functional steps are recited; when a step-plus-function claim is properly used, the recited steps correspond to steps recited within the specification. (Apparatus claims that recite functional structures are known means-*plus-function* claims).

Submarine Patent -- a patent that is issued many years after being filed because the applicant has used various procedural mechanisms to cause the delay and to keep the pending application secret while pending; the motivation for a submarine patent is to obtain a patent on technology already widely used in an industry without anyone in the industry knowing that the application was pending for the purpose of suing or licensing technology to companies in the industry.

Substitute Patent Application -- an application that is essentially the same as one previously filed by the applicant but which has become abandoned; a substitute patent application does not receive the benefit of the earlier filed application.

Substitute Specification -- replacement copy of the specification submitted because the originally filed specification was informal or a poor translation.

Summary (of patent) -- a section of a patent application that summarizes the claimed invention.

Supervisory Patent Examiner (SPE) -- a manager of an Art Unit who oversees a group of patent examiners; see *Art Unit*.

Swear Behind -- where an inventor can show that he or she conceived of the invention and was diligent in reducing the invention to practice before the publication date of a reference applied by an examiner, the reference will no longer be considered as prior art (and cannot be used to maintain a rejection); the procedural mechanism for "swearing behind" a reference is to submit an affidavit or declaration under 37 CFR §1.131.

Teach -- to publicly disclose or instruct.

Teaching Away -- a prior art reference that suggests that the inventor's solution to the problem is not possible or practical.

Technology Center (TC) -- the Patent Office organizational structure is broken into nine separate technology centers, each involved in examining applications for a particular technology, e.g., Chemicals and Materials Engineering; Computer Architecture, Software, and Information Security.

Technology Transfer -- sharing technology developed by an entity with the wider public; usually refers to the use or commercialization of government or university generated technology.

Title of Invention -- title given to a patent application; the title should be short and descriptive.

Transitional Phrase -- in a patent claim, the phrase after the preamble and setting forth the body of the claim; the most common transitional phrases are "comprising", "including", "consisting of", and "consisting essentially of".

Traversal -- a traversal of a rejection is a statement that one contests (disagrees with) a rejection or restriction.

- U -

Undue Experimentation -- under the enablement requirement, the specification must disclose the invention in such a way that a person of ordinary skill in the relevant art can make and use the invention as claimed; the specification can leave out certain features which the person of ordinary skill would be able to figure out based on his or her skill and knowledge, but where undue experimentation would be required by the artisan to arrive at the claimed invention, the specification is said to be non-enabling.

Unexpected Result -- evidence that a combination is non-obvious based on achievement of a result that would not be expected by those skilled in the relevant art.

USPTO Contact Center (UCC) -- for general information and support, call 800-786-9199 (toll-free) | 571 272-1000 (local) | 571-272-9950 (TTY).

USPTO Web Site -- web site maintained by US Patent and Trademark Office: www.USPTO.gov.

Utility -- a statutory requirement that a patent have some usefulness; certain categories of invention are presumed to lack utility (e.g., a perpetual motion machine).

Utility Patent -- a patent that covers the way the invention functions or how it is composed; other types of patents include *design patents* which only cover the ornamental aspects of an invention and a *plant patent* which covers certain varieties of plants.

- V -

Vacated Office Action -- an Office action that is voided and is treated as if never issued.

Willful Infringement -- knowing infringement of a patent; in such a case, damages can be trebled and include attorney's fees.

Withdrawn Claim -- responsive to a Restriction Requirement (or Election of Species), non-elected claims that are to be withdrawn from consideration.

Withdrawn Finality -- a statement by an examiner that a previous final rejection is made non-final.

- W -

World Intellectual Property Organization (WIPO) -- a specialized agency of the United Nations involved in coordinating and harmonizing intellectual property throughout the world; WIPO is the agency charged with administering the Patent Cooperation Treaty (PCT); see *Patent Cooperation Treaty (PCT)*.

Written Description -- another name for a patent specification.

Written Description Requirement -- requirement that the specification and drawings describe the invention in such a way so as to convey that the inventor had possession of the claimed subject matter; the written description requirement is distinct from the *enablement* requirement.

- X -

X-patent -- patents issued prior to the July, 1836 fire at the Patent Office which destroyed all records of these patents

- Y -

- Z -

Zurko (Dickinson v. Zurko) -- a Supreme Court case holding that a federal court reviewing a decision by the Patent Office (e.g., the BPAI) must give factual findings deference under the Administrative Procedure Act (APA) (not take issue with unless "arbitrary and capricious" or an "abuse of discretion").