A Glossary of Patent Terms

An
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Island Patent
12 Rutgers Road
Farmingville, NY 11738

Voice: 631.698.2697 • Fax: 631.698.4977 • www.islandpatent.com

Introduction

This document presents a number of important patent terms. Any inventor who will be seeking to patent an invention, should understand the terms and expressions defined below.

Regardless of the order in which this kind of material is presented, its contents are rather circular in nature. It is often difficult to define one item without using other related terms that may also need to be defined. To aid the reader, terms that are shown in *italics*, are terms that are themselves defined in a separate entry under that (italicized) keyword. Further, advanced terms are preceded by an asterisk, *. These terms may be considered optional during your first reading. They can be included in your second (or subsequent) reading.

Note: *An alphabetical index is provided at the end of this Glossary, should you be looking for a specific invention related term or expression.*

Patent Terms and Definitions

Invention Any new item that has utility. Usually the invention is a process (method) or a product (manufacture) that is devised to solve a problem or fill some unfulfilled need. The creating of an invention typically is said to involve two steps: the conception of the invention, and the reduction to practice of the invention.

Patent A grant by the U. S. Government securing protection for an invention. A patent allows the inventor to exclude others from making, using, and selling his or her invention. Since a patent allows the inventor (or patent owner, if not the inventor) to exclude others from access to the invention, it is called an offensive form of protection.

Patentable Invention An *invention* that is new, useful and *non-obvious*. These are three essential requirements to *patent* any invention.

Improvement Patent A patent that is granted for building upon a previously known invention. For example, the new invention may be an addition or modification to a known product or item. Another example could be a non-obvious combining of two known items previously offered as single and separate units.

***Statutory Classes** Categories that an *invention* must fit into to be eligible for a *patent*. The *invention* must be a product, process of doing something, composition of matter, or machine. If an *invention* does not fit into at least one of these categories, it generally can not be patented. However, it is rare that an invention does not, in one way or another, fit into at least one of the statutory classes.

Patent Application A formal and complex written document that is filed with the United States Patent and Trademark Office when attempting to seek a patent for an invention. The application is carefully written to fully and completely describe the *invention* and how it works. Common sections included with a typical patent application are a background section, a summary and detailed description section, and one or more '*claims*'. The claims represent a most important section of the *patent application*, and are included to specifically indicate exactly what it that the inventor regards as his/her invention.

Utility Patent A type of patent that is sought to protect the function and associated structure of an invention. That is, how the invention works, how it is used, and the actual structure. To put it another way, a utility patent is capable of protecting how your invention operates via its disclosed and claimed structure. A utility patent may be issued to any person who invents a new, useful, and *non-obvious* process, machine, article of manufacture, composition of matter, or any new and useful improvement to any of these items. Once issued, the patent enables you to prevent others from making, using, or selling the patented invention within the United States.

Provisional Patent A type of patent application that may be initially filed in place of a utility patent application. Essentially, the provisional patent application is the equivalent of an interim patent application. Importantly, although the filing fee for a provisional is quite a bit less than that of a regular utility application, a provisional patent application is <u>not</u> examined or otherwise looked at by the U.S. Patent Office. As such, the provisional patent application must be converted to a regular utility application, or followed-up by the filing of a regular utility patent application, within one year of the provisional filing date. Island Patent generally recommends the direct filing of a regular utility patent application, whenever possible. However, there are times when the filing of provisional applications does make sense. For example, in the case of a complex invention that is

undergoing development and testing, a provisional application may be desirable and advantageous. Once the development is further along, and within the one-year time limit, a regular utility patent application may be drafted (using the provisional as a basis or starting point) that claims the benefit of the earlier provisional patent application filing date.

Specification A specification, or 'spec', along with any required drawings, must be written in a particular style and format. This portion of the *patent application* must describe the *invention* to the extent that an individual skilled in the area of the invention would be able to build the invention and make it operate properly.

Claims Special statements that indicate clearly and concisely what the *invention* is. The claims, which, must be properly supported by a detailed description, define the 'bounds' of protection provided by the patent.

PTO or USPTO An acronym for the United States Patent and Trademark Office. The unit of the government that determines if an *invention* is a *patentable invention*. All patent related matters in the United States are handled by the PTO.

***Best Mode** The best mode requirement is established by the patent statutes. The statutes specifically require inventors to disclose the most preferred version(s) of an invention - also known as the best version or best mode. This prevents the inventor from holding back from the public the best version or versions, and keeping them secret for private or personal use. It is important to note that an inventor must always be fully and completely forthright when dealing with the patent office. If fraud is uncovered, any resulting patent can be forfeited and or invalidated.

***Small Entity Status** A status available to small companies and individual inventors. If a company has less than 500 employees, then a 'small entity' status applies, and the fees levied by the PTO are reduced by 50%. For example, an independent inventor is charged a fee of about $500 to file an application. That same application, if filed by a company with more than 500 employees, would cost about $1000.

Prior Art The collection of available information that relates to a particular field. The Patent Office uses publications and patents as their primary references to define the prior art of a field.

***Critical Date(s):** One or more dates associated with an initial disclosing of the invention. The disclosure may be in any of a

number of forms including an offer to sell it, a description provided in a publication, a public use and or demonstration. Importantly, at the end of a one-year period from a critical date, U.S. patent statues prevent a patent for being obtained. That is, if a first critical date is established by an act that discloses the invention to the 'public', the inventor must file a patent application within one year of that critical date.

Search A process carried out using large databases to locate items (typically patents and patent publications) that relate to a particular field and to your *invention*. More particularly, the search is conducted to determine the *prior art* that relates to your invention. It also establishes the current state of a field and helps determine if your invention is 'new to the art'.

***Skilled in the Art** An expression used to indicate an individual is trained or schooled in an area of the *invention*. An individual with ordinary skill would possess an average level of skill.

Novelty The *novelty* stipulation requires that the *invention* has not previously existed before you made your invention. That is, the invention must represent an addition to the field (or art) that was previously unknown.

Non-Obvious Another condition and requirement necessary for an *invention* to be patentable. The non-obvious requirement, which is somewhat abstract in nature, is related to the *novelty* (newness) requirement. However, the *non-obvious* mandate indicates the invention must not only be new, it also must NOT be an obvious alteration or addition to something that already is known in the art. For example, a picnic table with casters, would not pass the non-obvious requirement. It would be obvious to a skilled furniture builder, that if you need to make an easy to move picnic table, one would add casters or wheels.

Pro-se Latin for 'himself' or 'on one's own behalf'. A term used to indicate a person is permitted to represent oneself in some kind of matter or situation without the aid of a counsel. For example, an inventor is permitted to be represented pro-se when filing a *patent application*. However, to do so is not advisable. An application for a *patent* is a complicated and detailed legal document. Even an experienced patent agent or attorney will require many hours to properly draft and refine an application before it is considered ready for filing in the Patent Office.

Patent Examiner An employee of the Patent Office that will

receive your application and place it on her or his docket. Typically it takes 9 to 24 months for an application to be examined by the Examiner.

Examination A thorough review by the Patent Office of a *patent application* in order to determine if the *invention* described by the *specification* and *claims* is patentable. The review, which is conducted by an Examiner who has been assigned your application, includes a thorough investigation of the *prior art* by doing a *search* for related inventions. The results of the examination are sent to an inventor's patent agent or patent attorney in a document called an *Office Action* or an *Examiner's Action*.

Office Action A document sent by an Examiner at the PTO after a thorough *examination* of a *patent application* has been conducted. The office action will outline the position taken by the PTO regarding the patentability of the *invention*. Often all claims filed in an application are initially 'rejected'. After certain alterations are made to the original application, the PTO may find the invention (as later claimed) to be patentable. An office action is responded to by your agent or attorney.

Amendment A document prepared by your patent practitioner to respond to issues and matters found during the *examination* of a *patent application*. A well drafted response to an *office action* can be essential if an *invention* is going to be found patentable

Allowance When the Patent Office finds an original or amended application contains patentable subject matter, the application is allowed and a *patent* will be printed and issued in due course. A fee called the 'issue fee' must be paid in order for the *patent* to be formally approved, printed and distributed to the various patent depositories located around the country.

Maintenance Fees After a patent application is allowed and issued as a U.S. patent, the Patent Office will require the inventor to pay periodic maintenance fees to keep the patent active. The maintenance fees come due at regular intervals measured from the issue date. Specifically, the three maintenance fees must be paid 3, 7, and 11 years after the issue date, respectively. The first maintenance fee is approximately $500, the second is approximately $1000, and the third and last one is approximately $1500.

***GATT** The **G**eneral **A**greement on **T**ariffs and **T**rade was signed by President Clinton on December 8th, 1994. One important aspect of this

agreement was that U.S. utility patents that were filed on or after June 8, 1995, will have an active patent term of 20 years, measured from the filing date - rather than 17 years from the Issue date.

***Infringement** A charge of infringement is made by a patent owner for unauthorized use of a patented *invention*. If warranted, a patent owner can sue the alleged infringer for damages and compensation.

***Interference** An interference action occurs within the *USPTO* when two or more patents are filed that claim the same subject matter. The resulting hearing is called to provide evidence as to the actual date the *invention* was conceived and completed. As with all matters concerning the U.S. Patent Office, an agent or an attorney can prosecute an interference hearing. It should be noted that interference hearings are quite rare.

***License** A written agreement in the form of a legal document permitting the *Licensee* to manufacture and sell items that might otherwise *infringe* the claims of a patent. The license agreement can be exclusive (only the Licensee can make and sell the invention) or non-exclusive (potentially allowing others to also license the invention).

Assignment - The assignment of a patent results in a partial or full transfer of the ownership of the patent from one individual or entity (the Assignor) to another (the Assignee). The assignment is equivalent to a 'sales agreement and receipt' of the ownership of a patent or patent application.

Patent Pending - An expression or phrase that may be applied to products and or product literature if one or more patent applications are filed with, and pending in the U.S. Patent and Trademark Office, which covers (claims) at least a portion of the product or item being marked. It may be noted that 'patent pending' status is available with the filing of either a provisional (interim) patent application or a regular utility or design patent application.

***Working Model -** Also known as a prototype or an actual reduction to practice. All are equivalent expressions used to describe a construction and implementation of an invention. For example, if the invention is a new boat hull design, then if a prototype boat is constructed with that hull design, a working model exists. The patent office, in general, does not require a working model of an invention. Rather the Patent Office requires a written description that 'enables' a skilled person to practice the invention.

Filing Date - The date a patent application is received for filing, with the proper forms and fees, by the U.S. Patent and Trademark Office (USPTO). In actuality, once the application is properly filed with the U.S. Postal Service, at a neighborhood Post Office, the application is considered filed.

Petty Patent - A type of patent available in some countries that provides patent-like protection for an invention. The exact level of protection varies from country to country, and often the patent applications are not examined or examined only for proper form and other formalities. These types of patents are not offered in the United States. However, a U.S. based inventor may opt for a *provisional patent* as an alternative to the filing of a full and complete *utility patent* application.

PCT, Patent Cooperation Treaty - An international treaty, and resulting set of rules and regulations, enables an inventor to file of a single 'international application', which may eventually be nationally filed in any member nation (of the Treaty). At the present time, virtually all nations having markets with economic value are member nations of the PCT. As such, the PCT path enables an inventor to file a single application that may eventually lead to the filing of that application in a large plurality of member countries.

Index of Glossary Terms

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