



GLOSSARY OF INTELLECTUAL PROPERTY TERMS

Abstract - a brief (150 word or less) summary of a patent, usually printed on the first page.

Absolute Priority - in most foreign countries, any publication before filing is prior art, even if it is the inventor's own publication. This contrasts with the grace period in the US (and a few other countries) where publications by the inventor during the grace period before the filing date of an application do not count as prior art.

All elements rule - an accused device only infringes a claim if it includes all elements of the claim.

Allowed, Allowance - When the Examiner decides that a claim in an application is patentable, it is "allowed". If all of the claims in the application are allowed, the Examiner will issue a "Notice of Allowance and Issue Fee Due", indicating that examination of the application is now over, and setting a deadline (three months, typically) for paying the issue fee. Often, this is accompanied by a document entitled "Reasons for Allowance", in which the Examiner explains why he/she thinks the claims are patentable. Once the issue fee is paid, the USPTO will issue the patent.

American Invents Act of 2011 - a/k/a "Leahy-Smith Act" - the "Patent Reform" law passed by the US Senate on September 8, 2011, and signed into law on September 16, 2011, which made significant changes to the US Patent Law, most significantly changing from "first to invent" to "first inventor to file".

Assignee - The person or legal entity to which the entire right, title and interest in the application has been assigned (sold or transferred) regardless of whether the assignee filed the application for patent or has taken over prosecution of the application to the exclusion of the inventor. *(definition from the August 14, 2012, USPTO rules implementing the American Invents Act).*

Assignment - (v) "selling" a patent or application (that is, transferring one's rights), and (n) the document evidencing the sale. See also "license."

Assignor - seller - that is, someone who has assigned (sold or otherwise transferred) his rights to someone else (the "assignee").

Business Development - Within the CRI, business development is a combination of strategic analysis, marketing and sales, with the objective of resulting in a commercial outcome (i.e. license, distribution partner, investment, etc.)

Claim - that part of the patent which defines the limits of the grant of rights. A claim may be "independent" or "dependent". Claims are written in a very odd legalistic form, in which every claim starts with a capital letter (the only capital letter permitted in the claim) and ends with a period (the only one permitted in the claim), and each element in the claim must be named before it is used (it must have "antecedent basis."

Claim Differentiation - a doctrine which says that if there is a dependent claim, the claims should be interpreted such that there is a difference between a dependent claim and the claim upon which it depends. For example, suppose a parent claim calls out "a frammis", and the dependent claim says "where the frammis is made of plastic". The principle of claim differentiation says that the parent claim must be interpreted to include frammises which are not plastic, or there would be no difference between the two claims.

Co-inventor - one of several people who contributed to the conception of an invention. Note that mere reduction to practice does not make one a co-inventor, it is contributing to the conception which is key.

Commercialization Assessment - This is a review of the market opportunity for the innovation, as well as an assessment of the commercialization business model most suited to the opportunity (i.e. license to an existing company, start up a new company, etc).

Conception - "getting the idea" of an invention. Must be followed by "reduction to practice" to complete the act of invention.

Continuation-in-Part (CIP) - a patent application filed to add new material to an earlier filed application, or to claim a new embodiment of an invention disclosed in an earlier application. Anything which was in the original application is given the benefit of the filing date of the original application, any new matter added in the CIP receives the actual filing date of the CIP. A CIP may be filed at any time during the pendency of an application (i.e. before it is abandoned or issues as a patent).

Date of invention - the date the invention is completed - that is, both conceived and reduced to practice, whether the reduction to practice was actual or constructive.

Design Patent - a special kind of patent which covers the ornamental appearance of a useful object. Design patents have a 14-year term, starting on the date of issue.

Divisional - A continuing application, which discloses and claims only an invention that was disclosed and claimed in a prior-filed application. If the Examiner feels that two (or more) embodiments disclosed and claimed in an application are, in fact, independently patentable inventions, s/he issues a restriction requirement requiring the applicant to select the claims directed to one of the inventions. The unelected claims will be withdrawn, and will be abandoned unless the applicant files "divisional" application(s) while the parent application is still pending. Each divisional application would then be examined separately, and might be issued as another patent (the later patents are called "divisionals" of the first).

Effective Filing Date - introduced by the 2011 America Invents Act, the Effective Filing Date is used to resolve conflicts and determine what is Prior Art under the First Inventor to File standard. The application filing date is normally the Effective Filing Date, but publications by the inventor, if less than a year before the application filing date, become the "effective filing date" for prior art purposes. So, a publication by someone else is "prior art" only if it is published before the effective date. In other words, if the inventor publishes, this "stops the clock" on prior art - anything published later is not prior art, even if it is published before the application filing date. It should be noted that this is only true in the US - in most (if not all) foreign countries, the inventor's own publication would prevent his getting a patent under the absolute priority rule.

EPO- European Patent Office - office that administers applications under the European Patent Convention (EPC).

Examiner - employee of the US Patent and Trademark Office (USPTO) who reviews patent applications. Each examiner is assigned to an Art Unit, and handles applications in one particular area of technology.

Examination - the review of a patent application by an examiner. The Examiner will review the application for conformity with regulations ("formality"), and will do a search of the prior art to see if there are any earlier patents or publications which might make the invention unpatentable. The results of the examination are reported to the applicant in an Office Action, in which the Examiner objects to parts of the application, and/or rejects claims. The applicant is given a time within which to respond to the Office Action by arguing or amending the application, after which the Examiner may allow the application or reject it again.

Figure - an individual drawing in a patent or application.

Filing Date - the date on which the application is filed in the USPTO. If the application is not complete when it is filed, the USPTO may refuse to assign a filing date until the missing parts are filed.

First Inventor to File - if two applications claim the same invention, the first inventor to file (that is, the application with the earlier effective filing date) will receive the patent. This change to "first inventor to file" in the 2011 American Invents Act eliminates the need to inquire as to date of invention, although the Act as passed does not go all the way to a pure "first to file" system, where nothing matters but when the application was filed. The applicant still needs to be an inventor - just anyone cannot get a patent simply by filing first - and the patent goes to the application with the earliest "effective date". Derivation proceedings resolve conflicts where a later-filing inventor believes that the earlier-filing inventor derived his invention from him. The effective date for an application will be its actual filing date or, if the inventor published less than a year before the filing date, the date of publication. The new rules will apply to any application that ever contains a claim that has an effective filing date on or after March 16, 2013.

First to Invent - if two applications claim the same invention, the first inventor will receive the patent. Conflicts over inventorship are resolved through Interference proceedings for First to Invent applications or patents. How "first to invent" worked involved complex sets of rules to decide who was actually first, especially if one inventor conceived first and reduced to practice later, and so on. "First to Invent" also affected what constituted "prior art" - in case of a publication or other prior art, an inventor could "swear behind" the prior art by showing he had invented before the publication. The America Invents Act changed the standard to "First Inventor to File", effective on March 16, 2013. The old rules continue to apply to applications filed before March 16, 2013, and to continuations and divisionals of those applications which are filed after March 16th.

Infringe - an accused device or method infringes a patent if it is within the scope of at least one claim of the patent. A patentee has the right to stop an infringer from making, using or selling an infringing device or method.

Inter-Institutional Agreement (IIA) - An agreement between at least two higher education or corporate institutions regarding the ownership and cost sharing associated with patenting a jointly owned invention.

Invention - (*n*) "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof", 35 USC 101.

Invention - (*v*) the act of making an invention, consists of two steps: conception and reduction to practice. Reduction to practice can be actual, or "constructive."

Inventive Step - In the US, an invention must be novel, useful and not obvious to be patentable. In PCT practice and in many foreign countries, the equivalent standards are novelty, industrial applicability and inventive step, respectively.

Issue Date - the date on which a patent becomes enforceable. All US patents are issued by the USPTO on Tuesdays.

License - a document permitting a Licensee to make, use or sell products or services which would otherwise infringe the claims of a patent (or application). A license can be exclusive or non-exclusive. If an exclusive license is granted, the patentee may not issue any other other licenses conflicting with the exclusive license. Licenses may be limited by geographical area or field of use. Most licenses involve periodic payment of royalties, although some are paid-up in advance. See also "assignment."

Novelty - in order to be patentable, an invention must be "novel". "Novelty" is defined in section 102 of the US Patent Law. Briefly, something is "novel" if it was not patented, described in a publication, in public use or on sale by others before you invented it, or by anyone (including you) more than a year before you applied for a patent.

Objection - The Examiner may object to the specification, drawings or claims for various reasons. Typically, claim objections deal only with very obvious errors - misspellings, duplicated or missing words, or incorrect punctuation.

Obvious - in order to be patentable, an invention must not be "obvious" to a "person having ordinary skill in the art to which the invention pertains" - sometimes referred to by the acronym "PHOSITA". Obviousness is defined in section 103 of the US Patent Law. Basically, "not obvious" is a way of saying "an invention must be more than just a simple development from what went before." The obviousness test is similar to the "Inventive Step" requirement in many foreign countries.

Office Action - Once a patent application is filed, it will be assigned to an Examiner, who will review it for format and wording, and do a search for prior art. Nearly always (85%+) the application will be rejected. The document which the Examiner provides to explain why the application is rejected is called an "Office Action."

Option - A right, which acts as a continuing offer, given for consideration, to purchase or license intellectual property at an agreed upon price and terms, within a specified time period.

Patent - the grant by the government of the right to stop others from making, using or selling an invention.

Patentability Analysis - This is a review of the disclosure to determine if it is in fact a novel and compelling innovation which is not only patentable, but defensible.

Patent Agent - Someone licensed to prosecute patent applications in the USPTO who is not a lawyer. A Patent Agent must have a degree in Engineering or one of the "hard" sciences and pass an examination given by the USPTO. A Patent Agent may not prepare or prosecute trademark applications, even though these, too, are in the USPTO. Since they are not lawyers, Patent Agents may not prepare contracts or other legal documents or give legal advice other than as part of prosecuting patent applications in the USPTO.

Patent Attorney - a Patent Agent who has been admitted to the Bar of at least one state or the District of Columbia. In other words, a Patent Attorney is a Patent Agent who is also a lawyer. Patent Attorneys may prepare and prosecute trademark applications in the USPTO and are licensed by their state (or DC) to prepare agreements and otherwise practice law unrelated to the USPTO.

Patent Cooperation Treaty (PCT) - international treaty allowing a national or resident of a member country to file a single application in his/her own country, which can be filed in any member country later.

"Patent Pending" - a product may be marked "patent pending" if at least one patent application covering the product is on file, and is not abandoned. A provisional application will support a "patent pending" marking. Under section 292 of the Patent Law – 35 USC 292-- - it is illegal to mark something "patented" or "patent pending", if it isn't.

Patent Review Committee - At Northeastern, this is a committee of faculty members who reviews intellectual property filings in order to assess their scientific merit.

PHOSITA - "*Person Having Ordinary Skill In The Art*" - a very extraordinary person, indeed, who has all possible knowledge of the prior art, but only in a given field of technology. The PHOSITA is the hypothetical person against whom "obviousness" is judged.

Plant Patent - a special kind of patent, which covers asexually reproduced plants, "including cultivated sports, mutants, hybrids, and newly found seedlings, other than a tuber propagated plant or a plant found in an uncultivated state." 35 USC 161

Preamble - the introductory part of a patent claim - "A widget for pre-polarizing frammistats in soda vending machines, comprising..." for an apparatus claim, or "A method for removing blemishes from gronkheiser armatures comprising the steps of ..." in a method claim. The preamble is meant to set forth the name and environment of the invention, and identify things which are not novel, but which need to be mentioned for "antecedent basis" purposes. Normally, the preamble should not be used to limit the claim, unless it is necessary to make sense of the claim.

Prior Art - "what went before" - publications, earlier patents, public use or sale - anything which is relevant to the patentability of an invention because it shows that the invention was known before the applicant invented it (or more than a year before he filed his patent application, in the US). "Prior commercial use" was added by the American Invents Act as a defense to infringement for all technologies, if the use was at least one year before the effective date of the application which issued as the patent. There is an exemption for patents owned by universities or their tech transfer offices.

Priority Date - sometimes, a patent application is given the effect of a filing date which is earlier than its actual filing date by effect of a law or international treaty such as the Paris Convention or PCT. The "priority date" is the filing date of some earlier application upon which the application is based - for example, if an applicant files an application in Japan on January 1, 1999, and follows up by filing a US application on December 15, 1999, he can claim a priority date of January 1, 1999, for the US application, even though it was not actually filed for nearly a year afterward.

Prosecution - the applicant's side of the Examination process, convincing the Examiner to issue a patent.

Prosecution History - the written record of the Examination Process. Also known as the "File Wrapper", because all of the papers involved in a patent application were once covered in a paper wrapper. Today, the "Image File Wrapper" contains much the same information in electronic form, accessible through the USPTO's PAIR website.

Provisional Application (for Patent) - a sort of "patent application lite", which reserves a filing date for the material in the application, but will never be examined or become a patent. Provisional Applications are automatically abandoned one year after filing, and a utility application must be filed within that year claiming benefit of the Provisional Application to preserve the filing date.

Public Disclosure - In the U.S., the publication, public use, offer for sale, or sale of an invention anywhere in the world is known as a barring event, because if a year passes between one of these events and the date when a patent application is filed on the invention, the inventor is barred from patenting the invention. The one-year anniversary of a publication, public use, sale, or offer for sale, is commonly referred to as a bar date. After this date passes, the inventor cannot receive a patent on the invention. For foreign patents, no grace period exists. The publication, public use, offer for sale, or sale of an invention immediately bars you from foreign patent rights.

Reduce to Practice - complete the process of invention by actually building the device (or practicing the method), or filing a patent application.

Returned to the inventor - Should the review process determine the prognosis for the invention is not favorable, the intellectual property rights are returned to the inventor to pursue as they wish.

Royalty - a payment by a licensee to the owner of a patent under the terms of a license. Royalties are usually either a percentage of the sales price of a product, or a fixed dollar amount per unit. Royalties are usually paid on a periodic basis - monthly, quarterly or annually.

Serial number - a number assigned by the USPTO to identify a patent application. The number is usually a two digit series number, followed by a slash and a six digit application number - 11/123,456.

Technology Readiness Level (TRL) - is a measure used by some United States government agencies and many of the world's major companies (and agencies) to assess the maturity of evolving technologies (materials, components, devices, etc.) prior to incorporating that technology into a system or subsystem. Generally speaking, when a new technology is first invented or conceptualized, it is not suitable for immediate application. Instead, new technologies are usually subjected to experimentation, refinement, and increasingly realistic testing. Once the technology is sufficiently proven, it can be incorporated into a system/subsystem.

Useful/utility - in order to be patentable, an invention must be "useful". That is, it must have some definable use, no matter how trivial. Most rejections for lack of utility are for applications claiming perpetual motion or antigravity, or for chemical compounds, drugs or DNA sequences with no known (or stated) practical application.

Utility Patent - a "regular" patent, as opposed to a Design Patents or Plant Patents.

USPTO - *United States Patent and Trademark Office* - branch of the Department of Commerce which is in charge of patent and trademark matters. Often called simply "the Patent Office". Since 2004, the USPTO has been located in Alexandria, Virginia. It was in Crystal City, Arlington, VA, from the 1960's, and in Washington, DC, before that (the old Patent Office building is now the Smithsonian's Museum of American Art and National Portrait Gallery, for what that's worth). Interesting bit of trivia - the Patent Office was the only government building in Washington which was not burned by the British when they occupied the city during the War of 1812, on the grounds that it was a repository of knowledge for all people, rather than a government building as such.