

Glossary of Selected Intellectual Property Terms¹

Amendment – A change to a patent or a trademark application, usually in response to a rejection (see “office action”) to overcome the rejection; often accompanied by an argument relative to the rejection; in connection with a patent application, typically makes a change to its claims, but sometimes to its description or drawings (collectively its “specification”); an amendment to a patent application may not add new teachings (“new matter”) to the application; rejections and amendments related to trademark applications usually involve the goods and services listing of the application.

Apparatus – A thing that may be defined by a claim; includes mechanical devices, software, systems, etc.

Assignment – A document signed by an inventor transferring ownership of a patent application (and usually any foreign counterpart applications, follow-on applications and patents that may issue therefrom) to another person or company, usually an employer; usually notarized.

Claim – Text that defines the metes and bounds of an invention in a patent or patent application; recited as a combination of elements and/or method steps; it is the recited *combination* (not the individual recited elements or steps) that must meet the legal requirements for patentability.

Conception – The formation in the mind of an inventor of a definite and permanent idea of a complete and operative invention, as it is thereafter to be applied in practice; requires sufficient detail to enable one of ordinary skill in the art to reduce the invention to practice, without extensive experimentation and without the exercise of inventive skill; must include all the features and limitations ultimately included in patent claims; requires *contemporaneous* recognition and appreciation of the invention by the inventor; *corroborated* evidence is required to prove a date of conception. (*Note: Effective March 16, 2013, the U.S. changes to a “first inventor to file” system, as a result of the America Invents Act. Under the first inventor to file system, conception date is not relevant, although contemporaneous evidence may be useful to prove a third party “derived” the subject matter from an inventor. This and related changes to the patent law are not described in detail in this document, but they are described in an accompanying document.*)

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Continuation patent application – A patent application that is filed after an earlier (“ancestor”) patent application and that contains no new teachings beyond the contents of the parent, but that is treated (with respect to prior art) as though the continuation application had been filed on the same day as the ancestor application (known as a “priority date”).

Continuation-in-part patent application (“CIP”) – A continuation patent application that *does include* new matter, i.e., some teaching beyond that of the ancestor application; treated as having two different filing dates, i.e., the priority date (for the earlier-disclosed matter) and the actual filing date of the CIP (for the added matter).

Contributory infringement – Selling, offering to sell or importing a *component* of a patented *device* or *composition*, or a *material* or *apparatus* for use in *practicing a patented process*, where the provided item is a *material part* of the invention and does not have a *substantial noninfringing use, knowing* the item is especially made or adapted for use in infringement.

Copyright – A set of exclusive rights (such as copying and displaying publicly), with respect to a “work of authorship” fixed in a tangible medium of expression, such as a story, painting, building (architecture), song, movie or computer source code. Unlike patents and trademarks, a copyright is obtained automatically the moment the work is fixed in a tangible medium, including storage in a computer.

Copyright notice – © or “Copyright” or “Copr.” followed by the year of first publication followed by the name of the copyright owner; not required, but provides procedural advantages.

Copyright registration – An optional procedure; necessary prior to suing for infringement; early registration (within three months of publication or prior to an infringement) can provide procedural advantages in a law suit, such as “statutory damages” and attorney’s fees, without having to prove actual damages or lost profits.

Copyright term – For works originally created on or after January 1, 1978: life of author (or last surviving co-author) plus 70 years; anonymous, pseudonymous and certain other works’ copyrights expire 95 years from publication or 120 years from creation, whichever is shorter.

Damages – An amount of money awarded by a court to a patent owner as a result of infringement and to be paid by an infringer; not less than a reasonable royalty; may include lost profits; “regular damages” sometimes tripled by the court and may include patentee’s legal costs (collectively “enhanced damages”) when infringement was willful, i.e., the infringer knew he/she was infringing; enhanced damages can usually be avoided if a favorable opinion of counsel is obtained *before* the infringement occurs.

Declaration – A document signed by an inventor to state under oath that the inventor believes himself/herself to be an original and first (co)inventor of the subject matter claimed in a patent application; required for filing with, or shortly after filing; the patent application. However, procedures allow for filing a patent application without a signed declaration, if an inventor is dead, unavailable or refuses to sign a declaration.

Dependent claim – A claim that includes all the recitations of another identified claim, as well as an additional recitation or limitation, as in “The automobile of claim 1, further

including a retractable roof.” The claim from which a claim depends is called its “parent” claim. The parent claim may be an independent or a dependent claim. Because a dependent claim includes more recitation or limitation than its parent claim, the dependent claim is necessarily *narrower in scope* than the claim from which it depends. (See “infringement (patent).”) Dependent claims form a hierarchical (tree) structure rooted at their independent claim.

Design around – Purposefully designing a product or method to avoid infringing a claim by omitting a recited element, limitation or step.

Divisional patent application – A continuation patent application filed in response to a restriction requirement. An applicant is not required to file any divisional applications. However, any divisional applications must be filed while at least one application in the family is pending, i.e., before the last member of the family issues as a patent or is abandoned.

Duty of disclosure (Rule 56) – A duty by everyone involved with a patent application (inventor, patent attorney, in-house counsel, etc.) to disclose to certain patent offices (including the US PTO) *known* prior art that may be relevant to examining the application; there is no duty to *search* for prior art, but if prior art is *known or learned* while a patent application is pending (i.e., until the application is granted or abandoned), it must be disclosed. As a rule of thumb, if a reasonable examiner would want to know about the art, it should be disclosed, even if the art does not, by itself, anticipate the invention or render it obvious.

Employment agreement – A contract between an employer and an employee specifying terms of employment; may include an *explicit obligation* to assign intellectual property developed by the employee to the employer; depending on the job description, may *imply* an obligation to assign such intellectual property; presumptions regarding ownership of intellectual property and obligations to assign vary by state and country.

European patent – A patent granted by the European Patent Office on a single application; must be validated in individual European countries, which may involve filing translations and paying fees to the individual countries.

Fair use – A defense against copyright infringement that permits some use of copyrighted material, such as for parody; factors include: the scope of infringement (i.e., how much of the work is copied), the effect of the infringement on the copyright owner’s rights (his or her ability to sell the work), the amount of the work copied and the purpose of the infringement.

File History – A set of documents maintained by a patent office as part of examining a patent application; includes all communications between the patent office and the applicant.

First to file – Where multiple patent applications by different inventors cover overlapping subject matter, a system in which the first inventor(s) in time to file a patent application may be issued a patent. (Contrast with “first to invent.”); in connection with trademarks, “first to file” jurisdictions grant trademark registrations and priority to applicants who file applications first, regardless of who the first user of the mark is (Contrast with “first to use”).

First to invent – Where multiple patent applications filed by different inventors cover overlapping subject matter, a system in which the first inventor(s) in time to invent, not necessarily the first to file a patent application, may be issued a patent. (Contrast with “first to file.”) Evidence of date of *conception* and *diligence* toward actually reducing the invention to practice or filing a patent application are necessary. (See “inventor notebook.”) The diligence must extend from before the second reducer-to-practice enters the field to when the first conceiver actually or constructively reduces to practice. Unique to the US. (*Note: Effective March 16, 2013, the U.S. changes to a “first inventor to file” system, as a result of the America Invents Act. This and related changes to the patent law are not described in detail in this document, but they are described in an accompanying document.*)

First to Use – Where different parties use similar trademarks in the United States, priority is given to the first user of the mark in a relevant geographic area (unregistered trademarks may be effective in limited geographic areas within the US).

Idea – A mental concept; not protectable as such; however, an *invention* based on the idea may be patented and an *expression* of an idea may be copyrighted.

Independent claim – A claim that does not refer to any other claim; a patent includes one or more independent claims

Inducing infringement – Acting in a way that causes actual infringement by another, while knowing and intending that the other will infringe. For example, providing a non-infringing device to the other with instructions to alter the device in a way that will make the device infringe, while knowing the alteration will cause infringement. A *bona fide* belief (see “opinion of counsel”) that the actions of the other will not infringe defeats a charge of inducing infringement.

Information Disclosure Statement (IDS) – A form by which an applicant discloses known prior art to a patent office (see “duty of disclosure”).

Infringement (copyright) – Unauthorized reproduction, preparation of derivative work (such as a translation), distribution of copies or phonorecords to the public, public performance (of literary, musical, dramatic works, etc.) or public display (of literary, dramatic, choreographic works, etc.).

Infringement (patent) – Making, using, selling, offering to sell or importing an apparatus that includes all the elements and limitations of an apparatus claim, or performing all the steps recited in a method claim. Patents are country-specific, so all acts must be performed in the country in which a patent was granted to be an infringement. Inducing another to infringe, or contributing to the infringement by another, is considered infringement.

Infringement (trademark or servicemark) – Use of a mark in a way that is likely to cause consumer confusion as to the source of a good or a service, relative to a trademark or servicemark of another; considerations include: similarities in the marks, similarities in the good or service on which the trademark or servicemark is used, channels of trade in which the good or service travels, conditions under which the product or service bearing the mark is purchased and sophistication of the likely consumer.

Injunction – An order by a court to stop infringing, such as by removing a product from

the market.

Intellectual property (IP) – An intangible property (i.e., similar to stocks) based on a discovery or a creative idea or expression of a human mind; typically has commercial value. (See: patent, copyright, trademark and trade secret).

Intellectual property right (IPR) – A right to exclude others from intellectual property; for patents, a right to exclude others from making, using, selling, offering to sell or importing a patented invention; for trademarks, a right to exclude others from using confusingly similar marks in the sale of goods or services; for copyrights, unauthorized use of a protected work that violates one of the copyright owner’s exclusive rights.

Intent-to-use trademark application – A trademark application based on an applicant’s *bona fide* intent to use a mark in commerce in the United States. If such an application is filed, applicant must file a Statement of Use within 36 months of a Notice of Allowance from the US PTO, otherwise the application will abandon.

Interference – A process carried out by the US PTO when two or more pending patent applications claim overlapping subject matter; used to determine which application to allow (see “first to invent” and “first to file”).

International patent – No such thing (see “national patent” and “regional patent”).

International phase – Time period during which an international (PCT) patent application is handled by an international authority.

International Preliminary Report on Patentability (IPRP) – Findings of the International Preliminary Examining Authority; prepared during the international phase in response to applicant’s Article 34 Amendment, if any; otherwise, typically a copy of the Written Opinion; available to national phase patent offices, but may be ignored.

International Search Report (ISR) – List of prior art found by an International Searching Authority (ISA) in relation to a PCT patent application; prepared during the “international phase” of an international (PCT) patent application.

Invalid – A claim that does not meet the legal requirements for patentability; an allowed claim in an issued patent that is later shown not to meet the legal requirements for patentability, such as because the examiner was not aware of relevant prior art.

Invention – An apparatus, method, composition of matter, plant or design defined by a claim.

Inventor – A person who contributed at least one of the elements, limitations or steps in at least one claim in a patent application; a claim or patent may have multiple co-inventors.

Inventor notebook – Documentation of ideas, experiments, descriptions, etc., relative to an invention; may be written or electronic; may be a collection of documents; must show *conception* and be *corroborated* by a non-inventor (corroboration means dated and read and understood by one of ordinary skill in the art); to win a first-to-invent fight, may be used to show *diligence* toward actual or constructive reduction to practice. (*Note: Effective March 16, 2013, the U.S. changes to a “first inventor to file” system, as a result of the America Invents Act. This and related changes to the patent law are not described*

in detail in this document, but they are described in an accompanying document.)

Law of nature – An inherent relationship between or among physical quantities, such as $F=ma$; not protectable as such; however, apparatus or methods of using a law of nature may be patentable.

Maintenance Fee – A progressively larger fee due 3 ½, 7 ½ and 11 ½ years after a patent is granted; failure to pay the fee causes the patent to expire.

Method – A set of steps performed to accomplish a stated objective; may be a *new use* for a known device or chemical compound.

Misappropriation (trade secret) – Unlawfully obtaining a trade secret, such as by breaking into an enterprise and making copies of confidential documents.

National patent – A patent granted by a country patent office; effective in only that country.

National phase – Time period during which an international (PCT) patent application is examined by a country/regional patent office for purpose of possibly granting a patent; generally, must be entered within 30 months of the earliest priority date; may involve zero or more office actions and corresponding responses.

Non-obviousness – A requirement for patentability that a claimed *combination* could not be readily deduced by a person of ordinary skill in the relevant art from the prior art. A rejection of a claim for obviousness typically includes a citation to a combination of references that, collectively, discloses the claimed combination, i.e., all the claimed elements, limitations and/or steps recited in the claim.

Non-provisional patent application – A patent application that may issue as a patent, if the claimed subject matter is new, useful and not obvious.

Novelty – A requirement for patentability that a claimed *combination* is not disclosed in any *single* prior art reference.

Office Action – A communication from a patent or trademark office either allowing a patent or trademark application or rejecting the application because the application does not meet a legal requirement (see “amendment”); in the case of a rejection, includes prior art references in support of the rejection or other reason for the rejection (such as unmet formal requirements).

On-sale bar (offer to sell) – A sale or offer (that can be accepted in the contract sense of the word) to sell an invention that is ready for patenting (i.e., for which enough information is known to prepare a patent application); a US patent application filed more than one year after such a sale or offer is invalid; most other countries require “absolute novelty,” i.e., they grant no such one-year grace period; *delivery* or otherwise *making the invention available* to the public bars filing a patent application in these countries, however mere *offers* to sell may not necessarily bar patent applications. (*Note: Effective March 16, 2013, the U.S. changes to a “first inventor to file” system, as a result of the America Invents Act. It is not clear if the one-year grace period after an offer to sell will be available after the first inventor to file system goes into effect.*)

Opinion of counsel – A reasoned opinion by independent, competent patent counsel

regarding whether a device or an action would infringe a valid patent; may include a reasoned opinion that the claim(s) at issue is (are) invalid and/or that the patent is unenforceable.

Ordinary skill in the art – The amount of training, knowledge and experience possessed by a typical person working in the field of an invention.

Patent (design) – IP that covers an ornamental industrial design (not the underlying apparatus, method or composition of matter) that is new, not obvious and ornamental.

Patent (plant) – IP that covers certain types of new and distinct plants (not discussed in detail here).

Patent (utility) – IP that covers an invention that has practical application, i.e., an apparatus, method or composition of matter (i.e., a chemical) that is new, useful and not obvious.

Patent agent – A person registered with the US Patent and Trademark Office (US PTO) to file and prosecute a patent application on behalf of an inventor; not necessarily a lawyer; required to have an appropriate technical degree, such as engineering, physics, chemistry, biology, etc.

Patent Application Information Retrieval (PAIR) – On-line system maintained by the US PTO; stores information about pending US patent applications and issued patents, including file histories; information about older patents and applications is limited; information about unpublished applications is accessible only by the prosecuting patent attorney (“private PAIR”); information about published applications and granted patents is publicly accessible (“public PAIR,” <http://portal.uspto.gov/external/portal/pair>).

Patent attorney – A lawyer who is also a patent agent; required to have an appropriate technical degree, such as engineering, physics, chemistry, biology, etc.

Patent Cooperation Treaty (PCT) patent application – A single international patent application that preserves an applicant’s right to later file national/regional patent applications in many jurisdictions, thus deferring costs (filing fees, translations and foreign patent lawyer fees), generally until after the applicant has received a list of found prior art and a written opinion regarding patentability issued by an International Searching Authority (ISA).

Patent marking – “Patent” or “Pat.” together with patent number, or an address of a posting on the Internet, accessible to the public without charge, that associates the patented article with the number of the patent or, if impractical, on packaging of the patented goods; absent a mark, no damages for infringement, unless infringer was notified of the infringement and continued to infringe.

Patent term (and patent term extension) – The lifetime of a patent; a patent generally expires 20 years from its priority date (not including an early priority date provided by a provisional patent application), although if the US PTO takes longer than certain prescribed amounts of time to examine an application, additional time may be added to the life of a resulting patent, assuming the applicant responds to Office Actions within prescribed timeframes; certain events or statements may make a patent expire early (see “terminal disclaimer” and “maintenance fee”).

Power of attorney – A document signed by an inventor granting a patent attorney or agent authority to file and prosecute a patent application on behalf of the inventor; usually combined with a declaration.

Prior art – Publicly-available information that is known (not necessarily by an inventor) before the conception of an invention by the inventor; includes printed publications (issued patents, published patent applications, books, product descriptions, trade journal articles, products, cataloged theses, etc.). A claim of a patent application is judged against the prior art.

Prosecute (patent application) – File papers with a patent office, amend the application and argue with the patent office for allowance of the application.

Provisional patent application – A patent application that: expires one year from filing; can not issue as a patent; but whose filing date may be used as an effective filing date by a subsequent non-provisional patent application that is filed before the provisional application expires and that claims subject matter disclosed in the provisional application.

Public disclosure – A disclosure of an invention, with enough detail so one of ordinary skill in the art could make and use the invention, where the disclosure is not covered by a non-disclosure agreement (NDA); a US patent application filed more than one year after such a disclosure is invalid; most other countries require “absolute novelty,” i.e., they grant no such one-year grace period.

Published patent application – Typically, a patent application is published by a patent office 18 months after its earliest priority date. An applicant can request the US PTO not to publish a patent application, if no foreign counterpart patent application has been filed and none will be filed.

Published trademark application – After the US PTO has examined a trademark application and corrected material that does not meet a legal requirement, the mark is published in an Official Gazette. A third party who believes its rights will be affected by the published mark has thirty days in which to oppose the registration of the mark by filing a Notice of Opposition.

Reduction to practice (actual) – Construction of an embodiment or performance of a process that meets every element of a claim, where the embodiment or the process operates for its intended purpose (but need not be ready for commercialization) and the inventor recognizes and appreciates the invention; may be done by another on behalf of the inventor.

Reduction to practice (constructive) – Filing a patent application that teaches how to make and use the invention and demonstrates that the applicant recognizes and appreciates the invention; filing a patent application can also be deemed a conception, if no other proof of a conception date is available.

Regional patent – A patent granted by a regional patent office, such as the European Patent Office, the Gulf Cooperation Council or the African Regional Intellectual Property Organization; regional patents may be recognized by member states of the region.

Renewed Patent – No such thing; after a patent expires, it may not be renewed.

Restriction requirement – A finding by a patent office that a patent application claims

more than one invention and requiring an applicant to elect only one of the inventions to prosecute in the pending application; the unelected inventions may be prosecuted in one or more “divisional applications;” a similar concept, referred to as a “lack of unity of invention,” is applied by many non-US patent offices

Service mark – Same as a trademark, except to indicate a source of a service (see “trademark”).

Small entity – A company with no more than 500 employees, a nonprofit organization or an individual, and that or who does not have an obligation to assign a patent application to a non-small entity; eligible for reduced government fees at the US PTO.

Terminal Disclaimer – A statement made by a patent applicant that causes a patent to expire earlier than its normal expiration date; used to overcome certain rejections of a patent application, where the rejected application covers subject matter similar or identical to subject matter covered by another patent or patent application by the same inventor(s); the terminal disclaimer causes the later-expiring patent to expire on the same day as the earlier-expiring patent.

Trade secret – Information, formula, practice, process, design, instrument, pattern or compilation of information that is not generally known or reasonably ascertainable, by which a business can obtain an economic advantage over competitors or customers who do not have the trade secret, and where the business takes steps to maintain the trade secret confidential. Sometimes referred to as “confidential information.”

Trademark – A mark, word, symbol, design, color, smell, etc. that indicates a source of a good; often also used to mean service mark.

Trademark / Service mark notice – TM or SM; ® only for registered marks; not required

Trademark application based on current use in the United States – A trademark application that alleges *current use* of a mark *in commerce* in the United States; filed with a *specimen* showing use of the mark.

Trademark application based on foreign registration – A trademark application claiming, as its basis for registration in the United States, an existing and valid registration for the mark in a foreign country.

Trademark Electronic Search System (TESS) – On-line system maintained by the US PTO; stores information about pending US trademark applications and registered marks; information about older trademark applications and registrations is limited (<http://tess2.uspto.gov>).

Unenforceable – A claim or patent that may not be enforced, such as because a person breached his/her duty to disclose known prior art to the US PTO (see “duty of disclosure”).

United States Copyright Office – Part of the Library of Congress (www.loc.gov); among other things, registers copyrighted works in support of the US Constitution, Article I, Section 8, Clause 8 (“to promote the progress of science and the useful arts, by securing for limited times to authors ... the exclusive right to their ... writings”); www.copyright.gov.

United States Patent and Trademark Office (“US PTO”) – A Federal agency for granting US patents and registering trademarks, fulfilling mandates of the US Constitution, Article I, Section 8, Clause 8 (“to promote the progress of science and the useful arts, by securing for limited times to . . . inventors the exclusive right to their . . . discoveries”) and Article I, Section 8, Clause 3 (the “Commerce Clause”); part of the Department of Commerce; www.uspto.gov.

Use in Commerce – Placing a trademark on goods, their containers or their associated displays, where the goods are sold or transported in commerce; using or displaying a servicemark in the sale or advertising of services, where the services are rendered in commerce or are rendered in more than one state; meets a threshold test for trademark or servicemark registration.

Utility – A requirement for patentability that a claimed combination has some practical use (a low threshold).

Work (copyright) – Writing, music, sculpture, visual art, etc. embodying at least some creativity, selection, arrangement, or the like, and fixed in a tangible medium.

Written Opinion (WO) – Reasoned opinion regarding patentability of each claim of a PCT patent application; prepared during the international phase. The applicant has *one* opportunity to respond to the Written Opinion with arguments and/or amendments to the application (an “Article 34 Amendment”) and to request reconsideration (“demand examination”) based on the arguments and amendments.

Selected Intellectual Property Web Sites

<http://www.google.com/patents> (Google patent search)

<http://patft.uspto.gov/> (US PTO patent and application search)

<http://portal.uspto.gov/external/portal/pair> (Public PAIR)

<http://www.uspto.gov/main/faq/> (US PTO FAQ)

<http://www.uspto.gov/faq/trademarks.jsp> (Trademark FAQ)

<http://www.copyright.gov/circs/circ1.pdf> (Copyright Basics)

<http://www.copyright.gov/help/faq/> (Copyright FAQ)

http://gb.espacenet.com/search97cgi/s97_cgi.exe?Action=FormGen&Template=gb/en/quick.hts (Search foreign and international patents and applications)

<http://tess2.uspto.gov/> (US PTO Trademark Search System)

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