
A Glossary of Patent Terms

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Introduction

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

Regardless of the order in which this kind of material is read, 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 should be considered optional during your first reading. They can be included in your second (or subsequent) readings.

Patent Terms and Definitions

Patent A grant by the 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.

Invention Any new item that has utility. Usually the invention is a process (method) or a product that is devised to solve a problem or fill some unfulfilled need.

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

***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 one or more 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 these groups.

Patent Application A formal and complex document that is written to describe an *invention*. It provides a detailed description of the invention and how it works. Also included are the ‘*claims*’, which are an important section of the *patent application*. The patent application is filed in the United States Patent and Trademark Office.

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.

***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 \$400 to file an application. That same application, if filed by a company with more than 500 employees, would cost about \$800.

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.

Search A process carried out using large databases to locate items (patents and 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’. A *search* may help to determine if an invention contains patentable subject matter and if it is *non-obvious*.

***Skilled in the Art** An expression used to indicate an individual is trained or schooled in the 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 document to prepare. Even an experienced patent agent or attorney will require many hours to properly draft and refine an application.

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 Patent Office always conducts a thorough investigation of the *prior art* by doing a *search* for related inventions. The results of the examination are sent to the inventor or his patent agent or attorney in a document called an *Office Action*.

Office Action A response sent by 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 an application is 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, to contain 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.

***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.