

# Patent Terminology

CAS<sup>®</sup>

---

# Overview

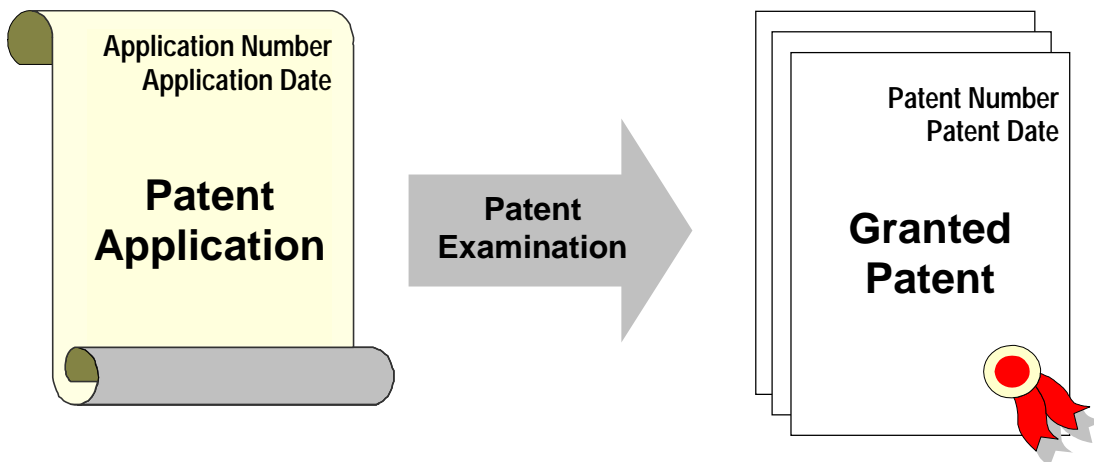
## Patent Definition

A **patent** is an agreement between an inventor and a country. The agreement permits the owner to exclude others from making, using or selling the claimed invention.

## The Patenting Process

An inventor or organization (the patent assignee) files a patent application in *each country* in which patent protection is sought. Each country's patent office puts the application through an examination process to determine if the invention meets that country's criteria for a patent. For example, in the U.S., a patent must represent an invention that is (1) novel, (2) non-obvious, and (3) has utility.

If the invention disclosed in the application meets the country's criteria for a patent, the patent is granted and the inventor has patent protection in that country.



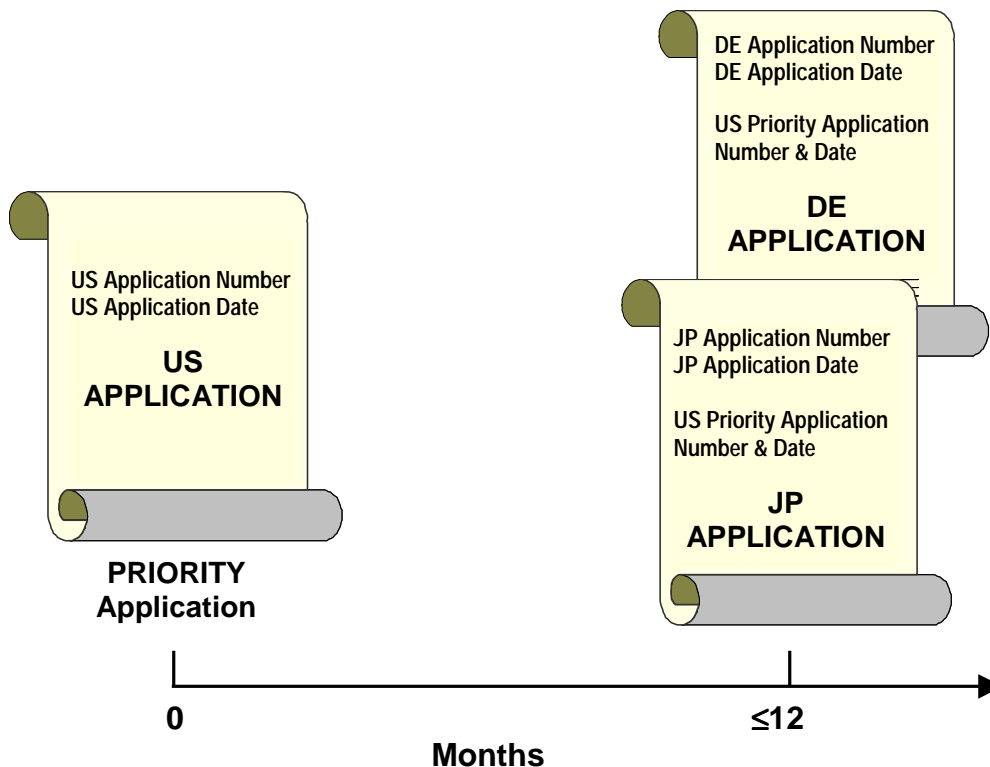
# Patent Applications

In each patent office in which an application is filed, an Application Number and an Application Date are assigned to the document. The first filing application is considered the **Priority Application** and the date of this application is the Priority Application Date.

## Filing Conventions

The Paris Convention for the Protection of Intellectual Property directs that

- Subsequent filings must be made within one year (6 months for design patents), to seek protection to the Priority Application Date
- Subsequent filings will include the Priority Application Number and Date, in addition to the new filing Application Number and Date
- The earliest publication (generally a published application) for public inspection will be 18 months from the priority filing



# Time Restrictions for Filing Applications

There are time limits for filing a patent application.

## **Date of public disclosure:**

In the U.S., the filing must occur less than 1 year after the invention was disclosed in any publicly available media, including meeting abstracts, or within 1 year of the invention being sold or offered for sale.

In other countries any public disclosure of the invention, irrespective of timing, may be a bar to being granted a patent.

## **“First to invent” versus “first to file”:**

The U.S. is one of the few countries that follow the “first to invent” doctrine. If two applicants seek protection for the same invention, priority may be established not by the filing date but by the invention date. The invention date may be established using materials such as the laboratory notebook.

In most other countries priority is established strictly by the filing date.

# International Filings

As an alternative to filing multiple applications at individual country patent offices, applicants seeking international coverage may make an initial single filing to one or both of two organizations:

- World Intellectual Property Organization (WIPO)
- European Patent Office (EPO)

For each of these filings an applicant indicates which member countries they wish to seek protection in by listing the appropriate designated states on their filing application.

## World Intellectual Property Organization

The World Intellectual Property Organization (WIPO), located in Geneva, Switzerland, is administrator of the Patent Cooperative Treaty (PCT), adhered to by over 100 countries worldwide.

See <http://www.wipo.int/pct/en/index.html> 

The process for making applications to member countries is streamlined. A single PCT application is made. It lists desired designated states; however, it *does not* lead to a single international patent.

### ***note***

→ An inventor must *eventually* make national filings to receive protection in those countries.

### ***Advantages of a PCT application:***

Filing a PCT application within 1 year of the priority date allows an applicant to postpone final filing decisions in designated states for up to 30 months from the priority date.

### ***note***

→ If a PCT application is not made, then applications to other countries, with translations, must be made within 1 year to claim the priority of the first application.

The applicant will receive an International Search Report approximately 16-17 months from the priority date, which may *reaffirm the novelty* of the invention. Optionally, the applicant may also request a Preliminary Examination Report, which would be received approximately 28 months after the priority date. An authority chosen by the applicant, usually the EPO or the USPTO, will conduct the search and examination and provides an indication of the *likelihood of successful examination* by a member country patent office.

***Cost considerations:***

Postponing national filings for up to 30 months gives an applicant time to establish the likelihood of successful examination in designated countries. This information may affect the number of foreign filings an applicant chooses to make and thus the filing costs.

## The European Patent Office

The European Patent Office (EPO), with headquarters in Munich, Germany, was formed in 1978, the result of the European Patent Convention.

A single EP application is made designating countries for which protection is sought. There are presently 20 contracting members of the EPO and 6 extension states:

Austria	Greece	Portugal	Latvia
Belgium	Ireland	Spain	Lithuania
Cypress	Italy	Sweden	Romania
Denmark	Liechtenstein	Switzerland	Slovenia
Finland	Luxembourg	Turkey	Albania
France	Monaco	United Kingdom	Macedonia
Germany	Netherlands		

See <http://www.european-patent-office.org/epo/members.htm>

The applicant may request examination leading to a granted patent, providing full protection in all designated states.

A granted EP patent is subject to opposition for 9 months after being granted.

***Advantages of an EPO application:***

The applicant receives a search report, which may affect their further action. Filing an EP application provides for consistent procedures in all member countries and leads to a strong patent.

***Cost considerations:***

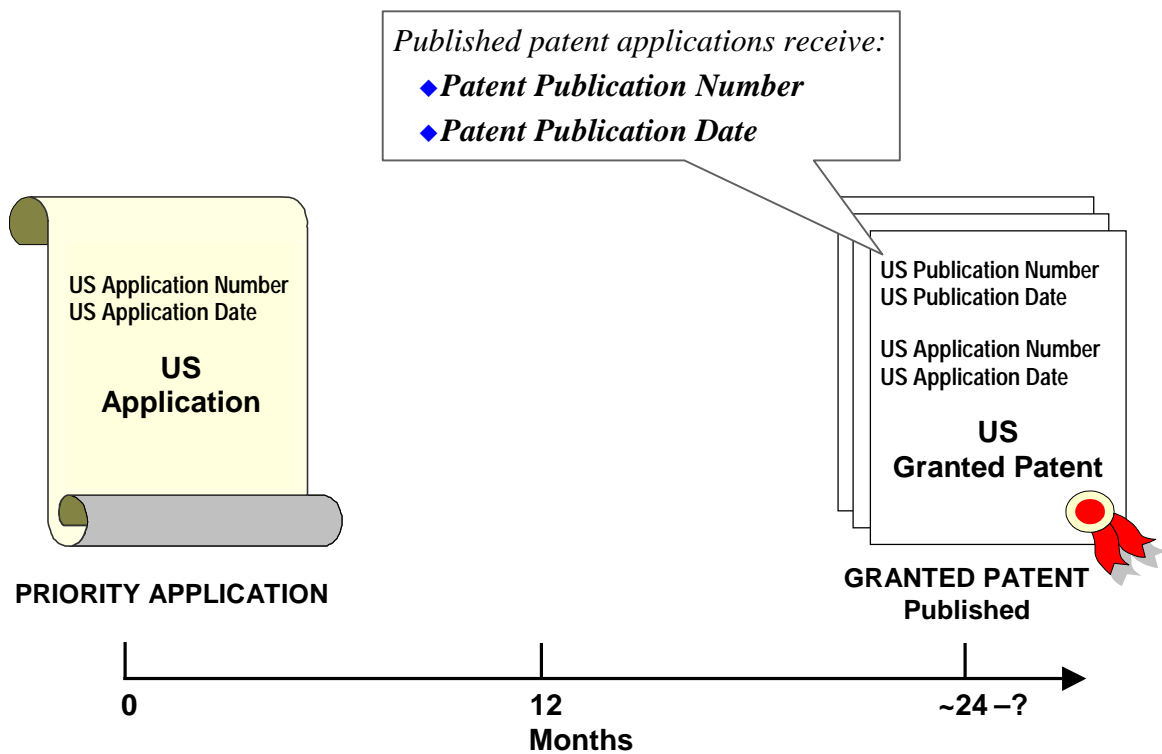
If protection is sought in more than 2-3 contracting members of the EPO there will be cost savings from filing an EP application.



# Slow-Publishing Countries

Slow-publishing countries publish *only the granted patent* approximately 24 months or more after the priority application is filed.

*Examples:* Austria, Israel, Switzerland, United States



## *note*

Patent laws in several countries, including the U.S., are undergoing changes that may eventually lead to the publication of applications in addition to the granted patent.

See [www.uspto.gov/web/offices/dcom/olia/aipa/pgpfr.pdf](http://www.uspto.gov/web/offices/dcom/olia/aipa/pgpfr.pdf) for the U.S. Federal Register record describing rule changes effective November 29, 2000, regarding published applications.

# Patent Families

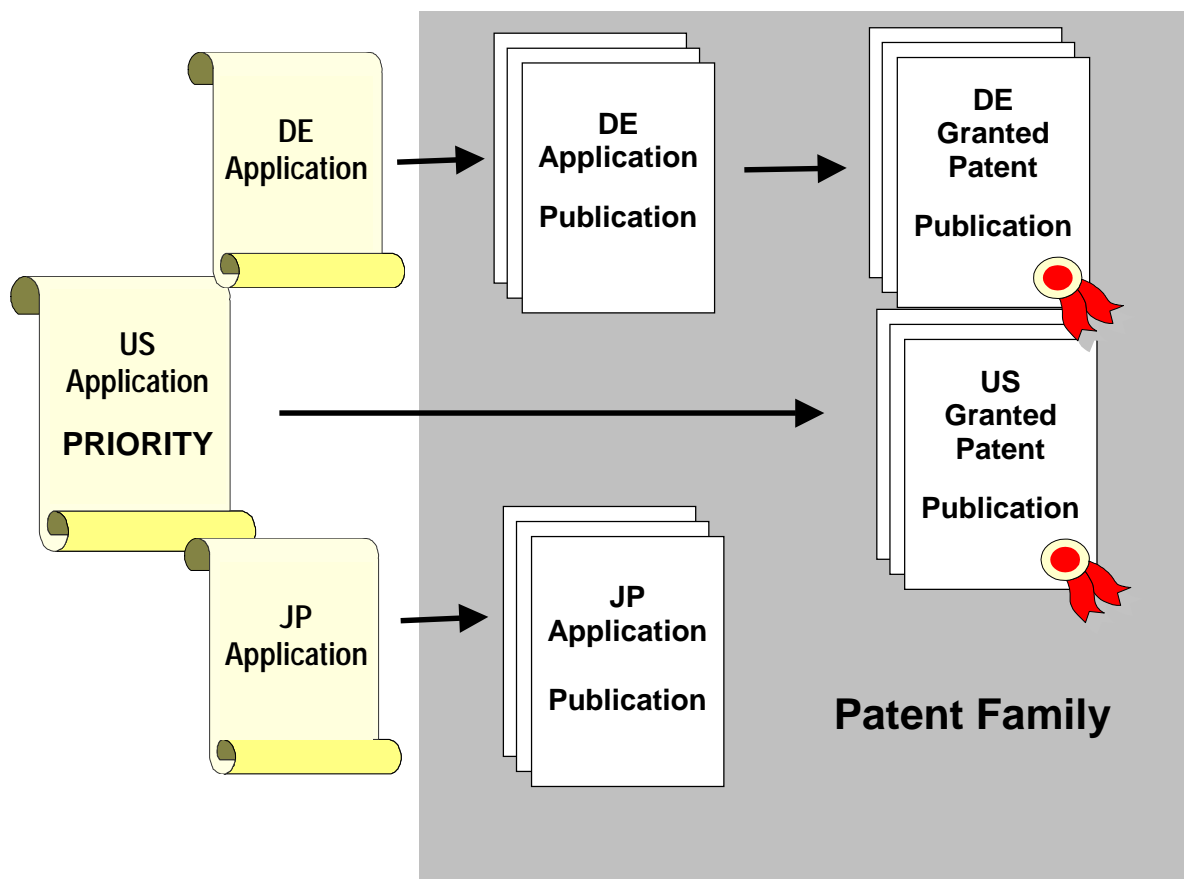
All of the published patent applications from various countries and the subsequently granted patents on an invention are commonly referred to as patent equivalents. Bear in mind, they are not true equivalents. Each patent-issuing authority may have different regulations for filing and a different interpretation of the invention.

## Patent Family with Closely-Related Members

A group of patent equivalents make up a patent family. Members of a closely-related patent family have a *common* priority application number and date.

These family members are usually included in a single record in the online database.

*Example of a patent family:*



## Patent Family with Extended Members

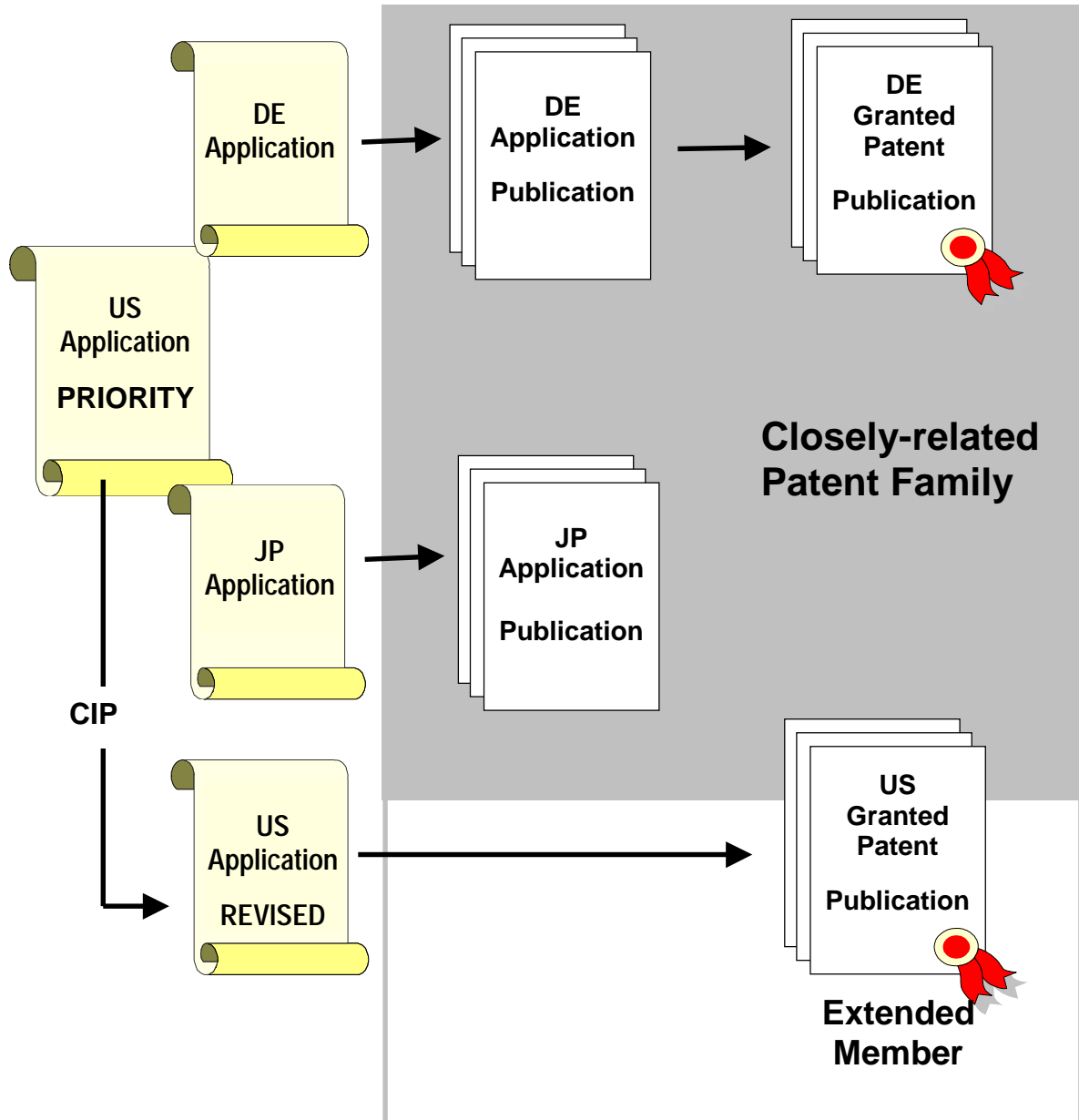
Extended patent family members typically result from complex relationships (such as multiple, yet at least one common, priority applications from different countries or relationships resulting from divisions, continuations, or continuations-in-part):

- Division Results when a patent office decides that an application's claims are too broad for a single patent and splits the application into divisional applications, each claiming a different invention
- Continuation Results from a second or subsequent application being filed while the original application is pending
- Continuation-in-Part (CIP) Results from a second or subsequent application being filed, which includes new material, while the original application is pending

A database producer may create additional records to capture any new information that may be reported in these family members.

**Example of a patent family with an extended member:**

The following example shows how a Continuation-in-Part of the priority application creates an extended patent family member.



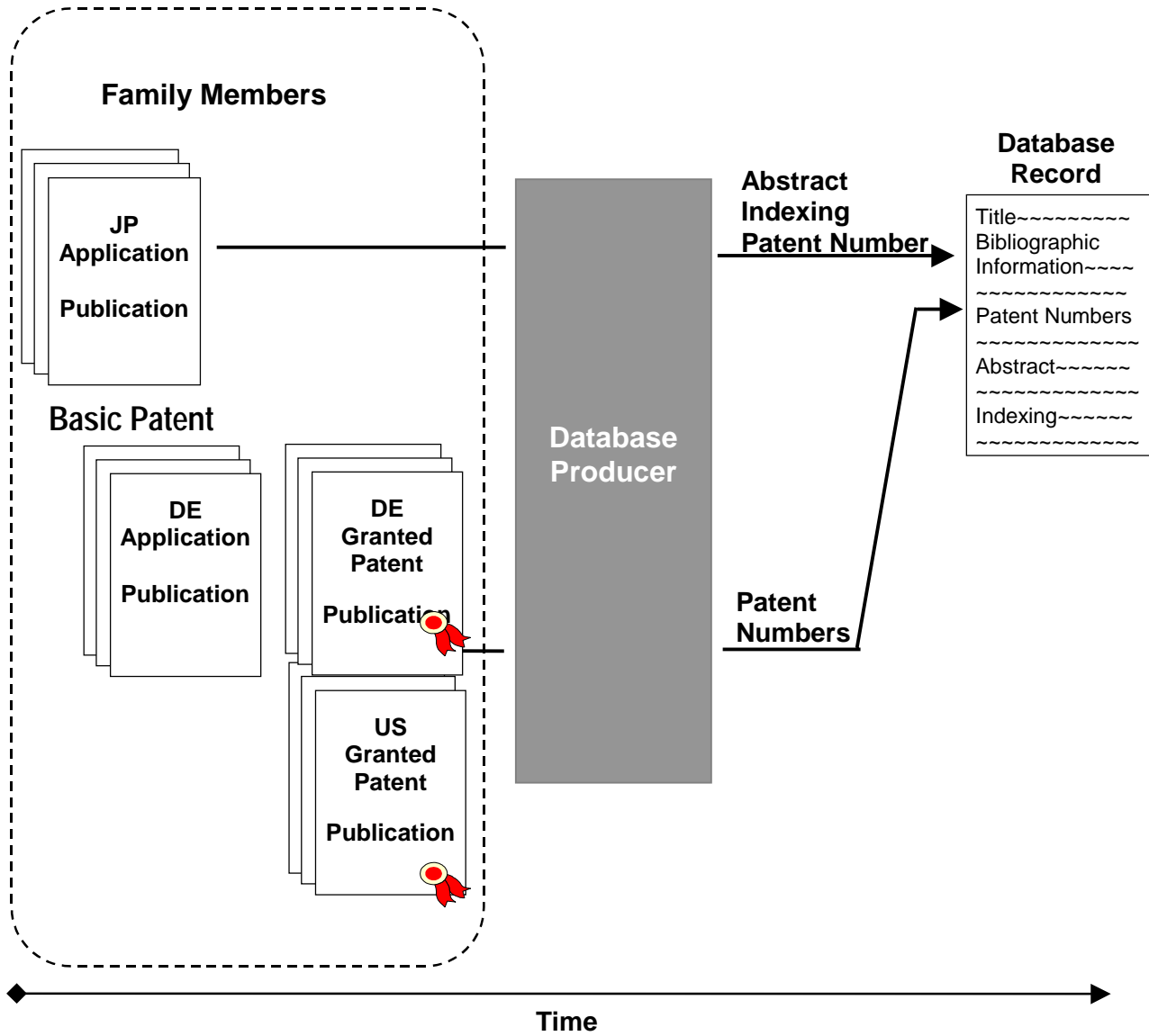
**note**

STN has search tools and display formats for identifying both closely-related and extended patent family members.

# The 'Basic Patent'

The Basic Patent is typically the first family member identified for abstracting and indexing into a database.

This term has no legal meaning; the basic for one database producer may not be the basic for another producer.



# Summary of Patent Terms

## Application

A document consisting of the specification of the invention and an oath in which the inventor declares that he believes himself to be the original and first inventor of the subject matter in the application.

## Claims

Brief descriptions, in legal terms, of the subject matter which the applicant regards as his invention.

## Continuation

In the U.S., a later application claiming the same invention filed while the original application is pending. The original filing date is used for determination of prior art.

## Continuation-in-part

In the U.S., a second application for the same invention, usually to introduce improvements not covered in the original application. The original filing date is used for prior art.

## Defensive publications

Publications of the details of an invention in the Official Gazette or in other publications to prevent others from obtaining a patent on the invention.

## Design patent

A type of patent issued in the U.S. for inventive designs of a purely ornamental or aesthetic nature.

## Designated states

In applications filed at the European Patent Office or the World Intellectual Property Organization, the countries in which the invention will be protected.

## **Division**

In the U.S., an additional application derived from an earlier application that claims two or more inventions, as determined by the patent examiner. The original filing date is used for determination of prior art.

## **Equivalents**

All the patent publications within a patent family relating to a specific invention.

## **Granted patent**

A legal document giving an inventor the right to exclude others from making, using, or selling the invention according to the laws governing patents in a country.

## **Kind codes**

Codes indicating the stage of the published patent document, e.g., unexamined application, examined application, granted patent.

## **Patent family**

A group of equivalent patents granted in several countries for the same invention usually citing priority applications in common.

## **Prior art**

What was previously known in a given area of technology that lead to the development of an invention

## **Priority application**

The application with the earliest date, when an inventor files for a patent in more than one country.

## **Reassignment**

The assignee transfers ownership of patent rights to another party.

## **Reissued patent**

In the U.S., the result of an application by the patent owner to make corrections in the specifications or claims of the patent. A new patent number is assigned, but the original expiration date is maintained.

## **Unexamined application**

In some countries, the first publication level for a patent document in which the application has not undergone full examination for novelty and non-obviousness.

## **Utility model**

In Japan and Germany legal protection for minor inventions that do not necessarily meet the novelty or non-obviousness criteria of regular patents.