

Glossary of Patent Terms

Abandon The explicit or implicit relinquishment of a potential patent right. Simple inaction may render a patent right abandoned.

Abstract A brief summary of an invention.

Abuse of patent Abusing one's patent rights by failing to make one's invention available in Canada on a commercial scale, without adequate reason.

Anticipation This is when the prior art indicates that a patent application lacks novelty.

Applicant The person or corporate body that applies for the patent and intends to 'work' the invention (to manufacture or license the technology). Under US law the applicants must be the inventor(s) except under exceptional circumstances.

Application (for Patent) Papers comprising petition, specification, drawings (when required), one or more claims, oath or declaration and filing fee, whereby an applicant seeks a patent.

Assignee The person(s) or corporate body to whom all or limited rights under a patent are legally transferred. Assignment Transfer of all or limited rights under a patent.

Assignor One who assigns a patent right.

Assignment [patent-trademark-copyright]. A transfer of rights in intellectual property. An assignment of a patent, for example, is a transfer of sufficient rights so that the recipient has title to the patent. The assignment can be a transfer of all rights of exclusivity in the patent, of an undivided portion (for example, a 50 percent interest), or of all rights within a specified location (for example, a certain area of the United States). Transfer of anything less is considered to be a "license." (See LICENSE, GOODWILL)

Basic Patent The first member of a Derwent patent family. This may or may not be the first published patent (which is usually the first to be documented by services such as Derwent World Patents Index).

Best Mode [patent]. A condition for the grant of a patent in the US. An inventor must describe the best method he or she knows for carrying out the invention.

Canadian Patent Office Record A journal published by the Canadian Patent Office.

Citations Citations may be made by the examiner or author. They comprise a list of references that are believed to be relevant prior art and which may have contributed to the "narrowing" of the original application. The examiner can also cite references from technical journals, textbooks, handbooks and sources.

Claim(s) The definition of the monopoly rights that the applicant is trying to obtain for the invention. The claims become the actual monopoly that is given when/if the patent is granted.

Community Trade Mark (Ctm) [trademark-international] A trademark registration granted by the European Community Trademark Office and enforceable throughout EC member nations.

Compilation [copyright]. A copyrightable work consisting of an assembly of preexisting material. The assembly must exhibit at least minimal originality in the selection, organization, and arrangement of the material without making any internal changes in it.

Compulsory licence The right granted by the Commissioner of Patents to one or more parties to produce a patented invention. These are granted, under certain circumstances as a measure against abuse of patent rights.

Contributory Infringement [patent-trademark-copyright]. Indirect infringement of intellectual property rights in which one person contributes to the direct act of infringement of another. Contributory infringement of a trademark, for example, occurs when a manufacturer of goods aids or encourages its distributors to pass off its goods as those of another manufacturer.

Continuation (see Continuing Applications) Applicable mainly in the US, continuations are second or subsequent applications which are subsequently filed while the original parent application is pending. Continuations must claim the same invention as the original application to gain the benefit of the parent filing date.

Continuation-in-part (see Continuing Applications) Generally referred to as a 'C.I.P' this is essentially the same as the continuation with the exception that some new material may be included. The disclosure of the parent is usually amplified and the C.I.P may claim the same or a different invention. A C.I.P application is accorded the benefit of the filing date of the parent application to the extent of the two applications' common subject matter. The C.I.P must be filed while the original parent application is pending for any disclosed material in common with the parent.

Continuing Applications There are three types of continuing applications: division, continuation and continuation-in-part

Convention priority An arrangement which allows inventors interested in applying for a foreign patent to have their filing date in one country recognized by other countries that have signed an international agreement called the Paris Convention.

Copies [copyright]. Is a noun, the material objects that store or fix copyrightable information other than sounds; as a verb, the act of copying.

Copying [copyright-patent-trademark]. In copyright law, "copying" denotes two separate but interrelated concepts. To constitute an infringement of copyright, a work must be a "copy" in the sense that it is substantially similar to a copyrighted work, and it must have been copied from the copyrighted work as opposed to being the result of coincidental, independent production or from

being taken from the same source as the copyrighted work. Legal standards for infringement of copyright differ from those for patents and trademarks; the latter do not require proof of copying.

Copyright Provide protection for literary, artistic, dramatic or musical works (including computer programs), and three other subject-matter known as: performance, sound recording and communication signal.

Defensive Publication A publication and disclosure to the public of a pending patent application.

Design Patent A type of patent covering the shape characteristics of an object.

Dependent Claim [patent]. A claim in a patent that refers back to a previous claim and defines an invention that is narrower in scope than that in the previous claim. A dependent claim is written so as to be more restricted than the technology defined in the previous claim.

Division (see Continuing Applications) If the patent office decides that an application covers too large an area to be considered as a single patent, then the application is split into one or more divisional applications. A divisional application has the same specification as the "parent" but claims a different invention.

Dilution [trademark]. A type of infringement of a trademark in which the defendant's use, while not causing likelihood of confusion, tarnishes the image or blurs the distinctiveness of the owner's mark. To possess the selling power and recognition protected by antidilution statutes, a mark must be relatively strong and famous, at least within a certain group of people, product line, or territory.

Disclosure The first public disclosure of details of an invention. This may be :

1. deliberately revealed outside the patent system to make the invention unpatentable, or
2. what is described in a patent application.

Disposal In some countries, such as the USA, this refers to where an application has been resolved by being withdrawn, rejected or granted. It can also have the connotation of being rejected only.

Division (see Continuing Applications) If the patent office decides that an application covers too large an area to be considered as a single patent, then the application is split into one or more divisional applications. A divisional application has the same specification as the "parent" but claims a different invention.

Drawing One or more specially-prepared figures filed as a part of a patent application to explain and describe the invention. Drawings (or illustrations, where appropriate) are more commonly found with inventions for mechanical or electrical devices. As a rule, chemical patents will include chemical formulae in the description of the invention and/or in the examples.

Duration [patent-trademark-copyright-trade secret]. The term or length of time that an intellectual property right lasts. A U.S. patent on an invention, for example, has a duration of 20

years from the date on which the patent application was filed, as does a plant patent. The basic duration of a U.S. copyright is the life of the author plus 70 years. Protection of information as a trade secret lasts as long as the information remains secret.

Duty of Disclosure This is a requirement imposed on all persons involved with the patenting process to disclose information (patents, articles, laboratory data etc.) to the patent examiner that may affect the granting of a patent.

Equivalent A patent entering the Derwent system which relates to the same invention and shares the same priority application as a patent from a different issuing authority already held in Derwent World Patents Index (see also non-convention equivalent).

Equivalents, Doctrine Of [patent]. A rule of claim interpretation under which a product or process, although not a literal infringement, is an infringement if it performs substantially the same function in substantially the same way to obtain substantially the same result as a patented product or process.

Essential Derivation Article 14.5(b) of the 1991 Act of the UPOV Convention states that a variety shall be deemed to be essentially derived from another variety, the initial variety, when

- i) it is predominantly derived from the initial variety, or from a variety that is itself predominantly derived from the initial variety, while retaining the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety;
- ii) it is clearly distinguishable from the initial variety and;
- iii) except for the differences which result from the act of derivation, it conforms to the initial variety in the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety.

Essentially derived varieties may be obtained, for example, by selection of natural or induced mutants, by selection of a somaclonal variant, by selection of variant individual plants in the initial variety, by backcrossing or transformation by genetic engineering.

European Patent Convention (EPC) Nineteen European countries are parties to the European Patent Convention. A patent application filed under this convention will, when granted, usually automatically be effective in each of the countries designated by the applicant.

Examination of an application The process by which the Patent Office determines whether a patent application warrants the granting of a patent.

Examiner A patent office official who is appointed to determine the patentability of applications.

Examples

1. A worked description of one aspect (embodiment) of the invention within the patent application.
2. Possible alternative embodiments of the invention within the patent application, with little detail provided.

Expiry Date The date when a patent has run its full term in a country and is no longer protected there (see also Lapse, Withdrawn).

Field Of Use Restriction [general intellectual property-antitrust]. A provision in an intellectual property license restricting the licensee to use the licensed property only in a defined product or service market.

First Sale Doctrine [copyright]. An exception to the exclusive right of a copyright owner to distribute copies or phonorecords of a copyrighted work. Under this principle, the copyright owner has the right to sell a copy of a book but not the right to control subsequent sales of that copy. (See DISTRIBUTION RIGHT)

Filing Date The date when the application reaches the patent office in complete form.

First to File The applicant who is the first to file an application for an invention will be awarded the patent over all others. This law is becoming increasingly the standard for countries adhering to Trade-Related aspects of Intellectual Property (TRIPs) guidelines. Most jurisdictions except USA.

First to Invent In some countries (USA), the applicant who is the first to invent will be awarded the patent over all others.

Forfeited Application An application on which the issue or maintenance fee has not been paid within the designated period.

Functionality [patent-trademark-copyright]. That aspect of design that makes a product work better for its intended purpose, as opposed to making the product look better or to identifying its commercial source.

Grant A temporary right given by a patent office for a specified period, to prevent anyone else from using the technology defined in the claims of a patent.

Infringe To make, use or sell the patented item or process within the country covered by the patent without permission or license from the patentee.

Infringement [general intellectual property]. An invasion of an exclusive right of intellectual property. Infringement of a utility patent involves making, using, or selling a patented product or process without permission. Infringement of a design patent involves fabrication of a design that, to the ordinary observer, is substantially the same as an existing design, where the resemblance is intended to induce the observer to purchase one thing supposing it to be another. Infringement of a trademark consists of the unauthorized use or imitation of a mark that is the property of another

in order to deceive, confuse, or mislead others. Infringement of a copyright involves reproducing, adapting, distributing, performing in public, or displaying in public the copyrighted work of someone else.

Intellectual Property [patent-trademark-unfair competition-copyright-trade secret-moral rights]. Creative ideas and expressions of the human mind that have commercial value and receive the legal protection of a property right. The major legal mechanisms for protecting intellectual property rights are copyrights, patents, and trademarks. Intellectual property rights enable owners to select who may access and use their property and to protect it from unauthorized use.

Intent-To-Use Application [trademark]. Since 1989 in the United States, an optional method of applying for federal registration of a trademark based on a declared intention to use the mark on specific goods or services.

Invention [patent]. The creation of a new technical idea and of the physical means to accomplish or embody it. To be patentable, an invention must be novel, have utility, and differ from what skilled users might expect.

Joint Inventors [patent]. Two or more inventors of a single invention who work together in the inventive process.

Lapse The date when a patent is no longer valid in a country or system due to failure to pay renewal (maintenance) fees. Often the patent can be reinstated within a limited period.

License A transfer of patent rights that does not amount to an assignment. A license, which can be exclusive or non-exclusive, does not give the licensee the legal title to the patent. A License is essentially an Agreement whereby the Licensor agrees not to assert the patent against the Licensee.

License [patent-trademark-copyright]. A permission to use an intellectual property right within a defined time, context, market line, or territory. In intellectual property law, there are important distinctions between “exclusive licenses” and “nonexclusive licenses.” An exclusive license is “exclusive” as to a defined scope; it is not the one and only license granted by a licensor. In giving an exclusive license, the licensor promises that he or she will not grant other licenses of the same rights within the same scope or field covered by the exclusive license. However, the owner of rights may grant any number of nonexclusive licenses of the same rights. In a nonexclusive license, title remains with the licensor. A patent license is a transfer of rights that does not amount to an assignment of the patent. A trademark or service mark can be validly licensed only if the licensor controls the nature and quality of the goods or services sold by the licensee under the licensed mark. Under copyright law, an exclusive licensee is the owner of a particular right of copyright, and he or she may sue for infringement of the licensed right. There is never more than a single copyright in a work regardless of the owner's exclusive license of various rights to different persons.

Non-Convention Equivalents An application filed in a second, or subsequent country which does not claim a priority application in another country. Usually a result of filing the application after the 12 month Convention period, but may be within that period by choice of the applicant.

Notice [patent-copyright-trademark]. A formal sign or notification attached to items that embody or reproduce an intellectual property right — for example, placing the word “patent” or its abbreviation, “pat.,” together with the patent number, on a patented article made by a patent holder or his/her licensees. The formal statutory notice of U.S. trademark registration is the letter R in a circle symbol -®, “Reg. U.S. Pat. & Tm. Off.,” or “Registered in U.S. Patent and Trademark Office.” Many firms use informal trademark notices, such as “Brand,” “TM,” “Trademark,” “SM,” or “Service Mark,” adjacent to words or other symbols considered to be protectable marks. Notice of copyright consists of the letter C in a circle symbol - © or the word “Copr.” or “Copyright,” the copyright owner's name, and the year of first publication.

Novelty The concept that the claims must be totally new. The invention must never have been made public in any way, anywhere, before the date on which the application for a patent is filed.

Obviousness The concept that the claims defining an invention in a patent application must involve an inventive step if, when compared with what is already known (i.e. prior art), it would not be obvious to someone skilled in the art.

Opposition The time period allowed for an interested party to post oppositions to the grant of a patent. For example, this may be up to nine months from the date of grant of a European patent.

Paris Convention The Paris Convention was established March 20 1883, effective July 7 1884, and amended June 2 1934 and July 14 1967. Signatories to the Paris Convention are allowed one year from first filing their patent application (usually in their own country) in which to make further applications in member countries and claim the original priority date.

Passing Off [trademark]. (1) The substitution of one brand of goods for another. (2) Trademark infringement in which the infringer intentionally means to mislead or deceive purchasers. (3) Trademark infringement in which there is no proof of intent to deceive but likelihood of confusion can be proven. (4) In British-law countries, acts illegal under the common law, apart from registered trademark law, involving the misrepresentation of one's goods or services as those of a competitor, usually by using a similar mark.

Patent [patent]. A grant by the federal government to an inventor of the right to exclude others from making, using, or selling his or her invention. There are three kinds of patents in the United States: a utility patent on the functional aspects of products and processes; a design patent on the ornamental design of useful objects; and a plant patent on a new variety of a living plant. Patents do not protect ideas, only structures and methods that apply technological concepts. Each type of patent confers the right to exclude others from a precisely defined scope of technology, industrial design, or plant variety. In return for the right to exclude, an inventor must fully disclose the details of the invention to the public so that others can understand it and use it to further develop the technology. Once the patent expires, the public is entitled to make and use the invention and is entitled to a full and complete disclosure of how to do so.

Patent Co-Operation Treaty (P.C.T.) The P.C.T. was signed in Washington D.C. on June 19 1970 and entered into force January 24 1978. It was amended with effective dates of May 3 1984 and January 1 1985. There are currently 96 signatories to this treaty. Contracting states may file an international application designating member states. If an applicant wants to press for grant in any of their designated states the patent application is moved to the national phase(s) but may carry the P.C.T. priority filing date.

Patent Family All the equivalent patent applications corresponding to a single invention, covering different geographical regions.

Patent Office action An official written communication by the Canadian Patent Office on the merits of an application.

Patent pending A label sometimes affixed to new products informing others that the inventor has applied for a patent and that legal protection from infringement (including retroactive rights) may be forthcoming.

Patent search A review of existing patents. Patent searches are conducted to determine whether an applicant can claim rights to an invention, or whether a patent has already been issued to someone else on the same or a similar invention. Patent infringement searches are made to ascertain whether a product or process can be produced without having to get permission or pay a royalty. Patent searches are also used as a form of research to gain information on existing technology.

Patentability The ability of an invention to satisfy the legal requirements for obtaining a patent, including novelty. In some countries certain types of inventions, e.g. computer software and plants, may be unpatentable.

Pending The period in which the patent office has not yet decided whether to reject or to grant a patent application, and it has not yet been withdrawn.

Plant Breeders' Rights (PBR). A form of Intellectual property protection that allows plant breeders to legally protect new varieties of plants in Canada and many other countries. Plant varieties, both sexually and asexually reproduced, may be covered under the legislation for a period of up to 18 years (Canada). All plant species, except algae, bacteria and fungi, are eligible for protection. The owner of a new variety who receives a 'Grant of Rights' has exclusive rights over the use of the variety, and will be able to protect his/her new variety from exploitation by others. The intent of the legislation is to stimulate plant breeding, to provide producers better access to foreign varieties and to facilitate the protection of varieties in countries other than their country of origin.

Preferred embodiment An explanation, in a patent application, of the most appropriate and useful practical applications of an invention. See also Best Mode.

Preliminary Examination The initial study of an application by an official in the patent office to check that the specification is properly arranged and for preparing search reports.

Prior Art The existing body of technological information against which an invention is judged to determine if it is novel and nonobvious and can thus be patented.

Priority Date The initial date of filing of a patent application, normally in the applicant's domestic patent office. This date is used to help determine the novelty of an invention.

Process Claim [patent]. A claim of a patent that covers the method by which an invention is performed by defining the steps to be followed, in contrast to a product claim or an apparatus claim, which covers the structure of a product.

Product-By-Process Claim [patent]. A patent claim in which a product is claimed by defining the process by which it is made. The product-by-process form of claim is most often used to define new chemical compounds, since many new chemicals, drugs, and pharmaceuticals can practicably be defined only by describing the process of making them.

Product Claim [patent]. A claim of a patent that covers the structure, apparatus, or composition of a product, in contrast to a process claim, which covers a method or process.

Prosecution All the steps involved in following through on a patent application.

Public Domain [general intellectual property]. The status of an invention, creative work, commercial symbol, or any other creation that is not protected by some form of intellectual property. Items that have been determined to be in the public domain are available for copying and use by anyone. The copying of such items is not only tolerated but encouraged as part of the competitive process. (See COPYING, INTELLECTUAL PROPERTY.)

Publication Documents, including patents of most countries that are printed (published) in and are actually or presumptively available to the public.

Reinstatement Restoring a patent to protection after it has apparently lapsed by error or been revoked.

Reduction To Practice [patent]. The physical part of the inventive process that completes and ends the process of invention. After a reduction to practice, the invention is complete for patent law purposes.

Registered patent agent A specialist entitled to prepare and prosecute patent applications.

Rejection When a patent application is refused by a patent office.

Renewal fees Payments that must be made by the applicant to the patent office in order to keep the patent in force and prevent it from lapsing. In the USA, these are termed maintenance fees.

Research Disclosure Defensive-type publications which are published, often anonymously, to give companies and inventors "freedom of use" rather than legal protection. Once research disclosures are published the invention described cannot be patented.

Reverse Engineering [trade secret]. A method of obtaining technical information by starting with a publicly available product and determining what it is made of, what makes it work, and how it was produced. This method goes in the reverse direction of usual engineering efforts, which start with technical data and use them to produce a product. If the product or other material that is the subject of reverse engineering was properly obtained, the process is legitimate and legal.

Revocation Termination of the protection given to a patent on one or more grounds, e.g. lack of novelty.

SDI Selective Dissemination of Information

Search Report A list of published items (both patent and non-patent literature), issued by the patent examiners checking the novelty of the patent application, which are relevant to the subject of the invention.

Skill In The Art [patent]. An ordinary level of proficiency in the particular technology in which an invention is made. (See OBVIOUSNESS.)

Special order examination A request to the Canadian Patent Office for early consideration of a patent application.

Specification Part of the patent application. It includes a detailed description of the invention, claims specifying the aspects of the invention for which protection is sought, and the extent of the protection being sought. The description, drawings and claims of an invention prepared to support a patent application. The term does not imply that the invention is necessarily new or was ever protected.

Status The legal standing of a patent or patent application, i.e. whether it is pending, lapsed or still protected etc.

Substantive Examination The full examination of a patent application substance or content by a patent office examiner to determine whether a patent should be granted.

TechSource TechSource is an electronic patent system which holds the scanned image of over 1.4 million Canadian patent documents dating back to 1920 and the text version of the documents from 1978.

Term of patent The maximum number of years that the monopoly rights conferred by the grant of a patent may last.

Trademark [trademark]. 1. A word, slogan, design, picture, or other symbol used to identify and distinguish goods. 2. Any identifying symbol, including a word, design, or shape of a product or container, that qualifies for legal status as a trademark, service mark, collective mark, certification mark, trade name, or trade dress. Trademarks identify one seller's goods and distinguish them from goods sold by others. They signify that all goods bearing the mark come

from or are controlled by a single source and are of an equal level of quality. And they advertise, promote, and generally assist in selling goods. A trademark is infringed by another if the second use causes confusion of source, affiliation, connection, or sponsorship.

Trade Name [trademark]. A symbol used to identify and distinguish companies, partnerships, and businesses, as opposed to marks used to identify and distinguish goods or services.

Trade Secret [trade secret]. Business information that is the subject of reasonable efforts to preserve confidentiality and has value because it is not generally known in the trade. Such confidential information is protected against those who gain access to it through improper methods or by a breach of confidence. Infringement of a trade secret is a type of unfair competition. (See UNFAIR COMPETITION)

Unfair Competition [general intellectual property]. Commercial conduct that the law views as unjust, giving a civil claim against a person who has been injured by the conduct. Trademark infringement has long been considered to be unfair competition. Other recognized legal categories of unfair competition are false advertising, trade libel, infringement of a trade secret, infringement of the right of publicity, and misappropriation.

Utility Fitness for some desirable practical or commercial purpose.

Utility Model In some countries, a type of patent which is available involving a simpler inventive step than that in a traditional patent. Such patents generally have a shorter life.