

COMMON PATENT TERMINOLOGY

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CONTENT ACKNOWLEDGMENT

The terms in this document are a subset of the glossary found in the document: "What Every Chemist Should Know about Patents" published by the American Chemical Society. This source [document](#) is available from the ACS website.

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Revised 1988, 1997, 2002

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DISCLAIMER

The purpose of this document is to provide you with an overview of some common patent terminology. This booklet is for information only and is not meant to replace legal advice. We recommend that you direct legal questions to a patent attorney or patent agent.

COMMON PATENT TERMINOLOGY

ACRONYMS

ACRONYM	MEANING
EPO	European Patent Office
ESPACENET	Patent search site of the EPO: https://worldwide.espacenet.com/
IP	Intellectual property
PCT	Patent Cooperation Treaty
PTO	Patent and Trademark Office
USC	U.S. Code
USPTO	U.S. Patent and Trademark Office
WIPO	World Intellectual Property Organization

GLOSSARY OF TERMS

Abstract

The section of a patent that provides a brief summary of the invention described in a patent.

Amendment (of part of application)

A modification of a portion of an application, which may be in the specification, the claims, or the abstract.

Annuity

A fee required to be paid annually to the patent-granting organization of a country to maintain a patent application or a patent. See **Maintenance Fee** (for U.S. patents.)

Application

A document submitted to the patent office of a country to describe an invention for which a patent is sought.

Application publication

The publication by the patent office of a country or by WIPO of an application submitted by an applicant for patent. The publication ordinarily occurs 18 months after the filing date of the application, or 18 months after the earliest claimed priority date.

Claim

A statement that defines the invention protected by a patent.

An independent claim

Defines an invention without referring to another claim, for example, “Claim 1. A compound represented by the following formula (I)..”

A dependent claim

Further defines the invention recited in another claim to which the dependent claim refers, for example, “Claim 2. A compound according to claim 1, wherein X is hydroxyl.”

A multiply dependent claim

Depends on more than one claim, for example, “Claim 3. A compound according to any one of claim 1 or 2, wherein Y is a heterocyclic aromatic five-membered ring structure.”

Continuing Application (or continuation application)

An application that contains the same description of the invention as a prior filed application and claims the benefit of the filing date of the prior application. See also **Request for Continued Examination**.

Design patent

A type of patent protecting the ornamental designs of an article having a practical utility for a term of 14 years from the date of issue of the patent.

Disclosure

Description of the invention in a patent application or a patent. **Disclosure** is often used interchangeably with **Specification** in referring to a patent or patent application. See also **Duty of disclosure** and **Invention disclosure**.

Divisional application

An application that contains the same description of the invention (or inventions) as a prior filed application and claims the benefit of the filing date of the earlier application, but contains claims that are related to only a portion of the original disclosure.

Drawings (or figures of drawings)

Line drawings or photographs submitted as part of a patent application to help describe the invention.

File wrapper; also prosecution history

The physical file at the PTO that contains the official record of the examination of the application.

Filing receipt

A document issued by the PTO formally acknowledging the filing of a patent application and informing the applicant of the filing date and serial number of the application. Since 2001, the filing receipt also indicates the confirmation number that serves as a cross-check for identifying the application.

Final office action (or final rejection)

A formal written communication from the PTO that maintains on a “final” basis a rejection stated in a prior office action. After the issuance of a final office action, the applicant has the right to appeal the examiner’s decision immediately to the PTO’s Board of Patent Appeals and Interferences, and the option of submitting another written response to the rejection.

Grant or issue (of patent)

Publication of the formal grant of a patent, on which date the patentee can begin enforcing the patent.

Information material to patentability

Information that compels a conclusion that a claim of a patent application is unpatentable.

Infringement

The trespass on the rights of the owner of a patent by another party.

Intellectual property

A generic description encompassing patents, trademarks, copyrights, and other available forms of protection for the products of mental work. In some countries, industrial property is used interchangeably with intellectual property.

Issue fee

A fee to be paid to the PTO after a patent application has been allowed, to prompt the PTO to issue (grant) the patent by publishing it. An allowed application becomes abandoned if the issue fee is not paid in a timely manner.

License (of patent)

An agreement, usually in writing, in which the owner of a patent grants to another party the right to practice the patented invention without giving up ownership of the patent. A license may be granted to the party on an exclusive or non-exclusive basis.

Maintenance fee

Fee required to be paid periodically to the PTO to maintain an issued patent.

Non-obviousness

A basic requirement for a claimed invention to be patentable under U.S. laws. The claimed invention must not be obvious from previously known technology.

Novelty

A basic requirement for a claimed invention to be patentable. See **Anticipation**. In the United States, a claim lacks novelty if it is anticipated by a reference.

Obviousness

A basis for rejecting a claim in a patent application because the subject matter claimed is considered by the PTO examiner to be obvious from the technology described in a reference (or references) cited by the examiner.

Office action

A formal written communication from a PTO examiner, usually containing a rejection of the claims of a patent application.

Patent

A grant by a government to a patentee, as evidenced by an official document, of exclusive rights to the subject matter or invention claimed in the patent.

Prior art; prior art reference

A document or other evidence of previously known technology against which the patentability of an invention is assessed.

Priority (claim to priority)

The claim in a patent application to the benefit of the filing date of an earlier filed patent application for the same invention. Priority may be claimed under the Paris Convention based on the filing date of an earlier foreign application. Priority may also be claimed domestically in the United States based on a prior filed U.S. application.

Provisional application

A relatively new form of U.S. patent application requiring a much smaller filing fee and less stringent formalities than for a regular patent application. A provisional application automatically expires 1 year after its filing date and must be followed by the filing in the PTO, and in other appropriate patent-granting organizations as desired, of a regular patent application that claims priority based on the provisional application.

Provisional rights

A new form of patent rights created under the AIPA to grant limited protection to a patentee for the period between the publication of a patent application and the date of issue of a patent.

Rejection (of claim)

A statement by an examiner that a claim in a patent application is not patentable for a reason specified by the examiner.

Specification

The portion of a patent application that describes in writing the invention, including the background of the invention.

Utility

A basic requirement for an invention to be patentable under U.S. law. All applications, whether for utility, plant, or design patents, must describe an invention that has utility for it to be patentable.