Patent Law Words-Of-Art

Anticipation **– When an invention is not novel due to a prior art reference (e.g. book or journal article) the invention is referred to as having been anticipated by the prior art.**

Application **– A patent application is an original document written either by an inventor pro se or by a registered patent attorney on behalf of the inventor. The document must conform to various statutory sections of the patent law and various rules promulgated by the Patent & Trademark Office. The application ultimately becomes an issued patent if it is found allowable by the Patent & Trademark Office.**

Art **– Art refers to the technology area involved. For example, patents in the electronic technology area are referred to as part of the electronic arts.**

Claims **– Patent claims are the most important part of a patent because they define the legal rights granted to a patent owner by setting out the precise boundaries of the patented invention. This is sometimes referred to as peripheral claiming because the claims provide the outer limit of the invention covered by the patent. Claims are generally written in a highly specialized format dictated primarily by rules that have historically developed. As a result, claims can be very difficult to comprehend. Generally, a patent will contain a set of claims of varying scope from very broad to very narrow. This is done because each individual patent claim stands on its own so that even if one claim is invalidated the other claims may still be valid.**

Conception **– An inventor has a conception of her invention when she knows how to make the invention but she hasn't done it yet. Under the old patent law (which was based on the first inventor getting a patent) conception was relevant to proving the date of invention. Under the new patent law which is based on the first inventor to file conception has little importance.**

Constructive reduction to practice **– Even if an invention has not been reduced to practice, an invention is considered constructively reduced to practice when a valid patent application is filed. The majority of patent applications are filed before the claimed invention is actually reduced to practice.**

Drawings **– A patent typically includes various drawings (called figures) which include reference numbers that correspond to the information in the patent specification. The numbers enable someone to refer to the drawings while reading the patent specification which facilitates understanding the patented invention.**

Enablement **– The statutory requirement that a patent discloses sufficient information about the patented invention so that a person with ordinary skill in the relevant technology area can make and use the patented invention.**

Infringement **– Patent infringement occurs when a third party without authority makes, uses, offers to sell, sells or imports an invention that is covered by the claims of a patent. Typically, the infringing device (called the accused device) must contain all of the elements and limitations contained in the infringed claim.**

Markman hearing **– A hearing held in federal district court to determine precisely what the patent claims at issue mean. The meaning of claims is considered a question of law.**

New use **– A new use of a known process, machine, manufacture, composition of matter or material is not patent-eligible subject matter. However, it is permissible to claim the new use as a process. For example, assume drug X is patented and it is used to treat high blood pressure. Subsequently, Sally discovers that drug X can also be used to treat knee injuries if a 500 mg oral dose is given twice a day over a three month period. Sally can't seek a patent on this new use per se – treating knee injuries. However, she could seek a patent on a therapeutic method of treating knee injuries by administering a specific dose of drug X over a specified time period.**

Non-Practicing entity (NPE) **– Entities which own patents but do not engage in any manufacturing or commercializing of the patented invention. Typically, the entities solely use the patents to bring infringement lawsuits against third parties. NPE is the neutral term for these enterprises. However, they are also referred to as patent trolls by people who view them as problematic.**

Paper patents **- Issued patents that cover inventions that have never been manufactured or put into commercial use are called paper patents.**

Patent Examiner **– Once a patent application is filed it is assigned to an employee of the Patent & Trademark Office called a patent examiner. Typically, an examiner works in a specific technology area. Patent applications are assigned to an examiner based on the particular type of invention in the application. Generally, the applicant and the patent examiner interact throughout prosecution of the application.**

Prior art **– A patent can only be issued on a novel (new) invention. Inventions and technology that predate a patent applicant's invention are referred to as prior art.**

Prosecution **- Patent prosecution means preparing and filing a patent application and then responding to the Patent & Trademark Office, as required, in order to have the application issue as a patent. The patent applicant (or his or her patent attorney) engages in an adversarial process with the Patent & Trademark Office that is primarily conducted in writing. If the process does not lead to an issued patent the applicant can dispute this result via administrative proceedings in the Patent & Trademark office and/or via going to federal court.**

PTO **– The U.S. Patent & Trademark office is referred to as the PTO or the USPTO. This office handles both patents and federal registration of trademarks. The office is an agency of the U.S. Department of Commerce.**

Reduction to practice **– An invention is reduced to practice when it is actually build or created for its intended purpose and it works. This was important under the old patent law which is based on giving a patent to the first inventor because reduction to practice related to establishing a date of invention. Under the new patent law reduction to practice is of much less importance because the new paw grants a patent to the first inventor to file an application.**

Specification **– A patent typically includes a detailed written section (called the specification) which describes the invention as required by the patent statute, drawings which aid in understanding the invention, and claims which set out the legal metes and bounds of the invention covered by the patent.**

Statutory subject matter **– refers to inventions that are within the statutory categories eligible to be considered for a patent. These categories include a process (method), machine, manufacture, composition of matter, or any improvement of something within the preceding categories. Statutory subject matter is also referred to as patent-eligible subject matter. An invention that is patent-eligible may or may not be granted a patent based on other requirements which must be satisfied, such as novelty and nonobviousness.**

Utility **– Patent law section 101 requires that an invention must be "useful" to be patentable. This useful requirement is generally referred to the "utility" requirement.**

Validity **– When a patentee brings an action in federal court for patent infringement the alleged infringer will often counterclaim that the patent is not valid because it fails to satisfy the legal requirements for a patent and therefore the Patent & Trademark Office should not have issued the patent. If the court finds that the patent is invalid it is effectively**

extinguished and the patent owner no longer has any rights under the patent. A patent owner asserting infringement must satisfy the typical preponderance of the evidence standard. However, an issued patent is legally presumed to be valid so the party asserting invalidity must meet the higher clear and convincing evidentiary standard.

Working requirement **– Some countries require that a patent is worked by actually making and/or using the invention in the country granting the patent. U.S. Patent law has never included a working requirement for patents.**

Written description **– The statutory requirement that a patent discloses sufficient information which establishes that the inventor was in possession of the claimed invention when the patent application was filed.**