

## **GLOSSARY of patent related terms in the IP5 STATISTICS REPORT 2018 EDITION**

### **Disclaimer:**

The explanations in this glossary are given in order to help readers of the IP5 Statistics Report understand the patent related terminology that appears there. This is a supplement to definitions already given in the report (see particularly Chapter 1 and Annex 2). The IP5 Offices offer no guarantee as to the legal correctness of the definitions that appear in the glossary. Readers are recommended to consult the official web-sites of the individual offices for more detailed information about the respective patent systems.

### **Glossary:**

#### **Abandonment**

EPO see *Withdrawal*

JPO/KIPO losing the right to obtain or to receive a patent right by applicant's free will.

CNIPA after the patent is granted, the patentee can abandon his or its patent right by a written declaration.

USPTO abandonment of a pending patent application refers to a change in status of the application whereby the application is removed from the office docket of pending applications through a formal abandonment by the office or by failure of applicant to take appropriate action within a specified time at some stage in the prosecution of the application; additionally, the failure to pay periodic maintenance fees to keep an issued patent in force sometimes is referred to as an abandonment of the patent grant.

#### **Allowance**

EPO n.a.

JPO/KIPO/CNIPA see *Grant*

USPTO an allowance refers to a non-provisional application that has been reviewed

(examined) by an examiner who has determined that the whole application meets all formal and substantive (i.e., statutory - novelty and non-obviousness) requirements and that the language of the claim(s) is enabled by, and finds adequate descriptive support in, the application disclosure as originally filed.

### **Amendment**

the applicant is allowed to make adjustments such as reduction of the scope of right, correction of errors or mistranslations, and clarification of an ambiguous description.

**CNIPA** the applicant is allowed to make adjustments such as reduction of the scope of right and corrections of errors or mistranslations or clarify an ambiguous description. During the preliminary examination, if an application has defects that can be eliminated through rectifications, the applicant shall rectify the application documents according to the *Notification to Make Rectification* issued by CNIPA.

**USPTO** see also *Reissued patent*

### **Amended form**

**EPO** new version of the patent when the description, claims and/or drawings of a patent are amended after an opposition or an appeal procedure.

**JPO/KIPO/CNIPA** the documents which reflected amendment.

### **Appeal**

**EPO** an ex parte appeal is filed against a decision taken by an examining division;  
an inter partes appeal is filed against a decision taken by an opposition division, where two or more parties are involved;

there also exist PCT protest (see *PCT protest*) legal, disciplinary appeals, and Appeals before the Enlarged Board (petition for review and referral).

**JPO/KIPO** procedures to examine and make a decision for appeal or trial when the decision of the examiner is questioned: a) an appeal against examiner's decision of refusal (ex parte), b) an appeal of invalidation when an interested person makes an appeal to invalidate a patent on the basis that the patent lacks patentability (inter partes), c) a

trial for correction demanding corrections on scope, description or drawing of claims after grant (ex parte).

**CNIPA** CNIPA has reexamination and invalidation procedures. Where an applicant for patent is not satisfied with the decision of the CNIPA rejecting the application, the applicant may, within three months from the date of receipt of the notification, request the Patent Reexamination Board to make a reexamination. Where any entity or individual considers the grant of a patent right is not in conformity with the relevant provisions of the Patent Law, it or he may request the Patent Reexamination Board to declare the patent right invalid.

**USPTO** an appeal refers to a process for reviewing a decision affecting patentability, as made during the examination process; every applicant, any of whose claims have been twice rejected, may appeal the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal accompanied by the fee within a specified time period. Appeals may also be made in reexamination proceedings. In an ex parte reexamination, an appeal is taken against a decision made by a primary examiner to reject one or more claims. In an inter partes reexamination, an appeal may be requested by a third party on any proposed ground of rejection not adopted by an examiner. Third party requesters may also be a party to any patent owner appeal.

Beginning in September 16, 2012, *inter partes* reexamination was replaced by *inter partes* review which is conducted at the Patent Trial and Appeal Board (Board). An appeal may be taken by petitioner to the United States Court of Appeals for the Federal Circuit (CAFC) once the Board issues a final written decision.

### **Applicant**

**EPO** the natural or legal person filing the patent application.

**JPO/KIPO** the inventor or the natural or legal person who has been assigned the right of filing a patent application from the inventor.

**CNIPA** the natural person or entity filing the patent application.

**USPTO** the legal entity applying for a patent; prior to the adoption of AIA, the applicant always consisted of the name or names of the actual inventor or inventors.

## **Claim**

EPO/CNIPA	defines the matter for which protection is sought in a clear and concise way supported by the general description.
JPO/ KIPO	refers to each item describing the invention to be protected in the scope of claims; multiple listing is permitted including statements of various facets of the identical same invention and of related inventions. Each statement in claims has an effect on independent patent right.
USPTO	a portion of the patent or application particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery. Each claim must conform to the invention as set forth in the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

## **Collaborative Search Pilot (CSP)**

CSP provides those cross-filing their patent applications internationally with search results from multiple Offices early in the examination process so the applicant can determine their next steps in patent prosecution. CSP is designed to accelerate examination and provide the applicant with more comprehensive prior art by combining the search expertise of examiners at the USPTO and JPO or KIPO before issuing an office action in the patent application. The USPTO will consider partner Office's references in the First Action on the Merits (FAOM) to reduce the applicant's IDS burden.

## **Common citation document**

EPO	this creates a list of patent applications which constitute a simple patent family, and a list of citations (from the search report and from the applicant) is arranged on screen together with their corresponding patent applications.
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## **Converted Application**

JPO	a converted application is an application which is filed by mutually converting a form of application among patent, utility model, and design applications under certain conditions.
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KIPO a patent applicant may convert an application for utility model registration to a patent application within the scope of matters stated in the description or drawing initially attached to the patent application.

### **Cooperative Patent Classification (CPC)**

CPC is the product of a joint partnership between USPTO and EPO to develop a common, internationally compatible classification system for technical documents used in the patent granting process that incorporates the best classification practices from both offices. CPC includes approximately 250,000 classification symbols and is compatible with the International Patent Classification (IPC) system. CPC thus enables examiners and patent users worldwide to conduct searches by accessing patent document collections classified with a finer granularity. See also *IPC*. <http://www.cooperativepatentclassification.org/>

### **Deferred Examination**

KIPO a system by which an applicant can ask for examination to take place at a date not less than 18 months after the date of the examination request and not more than three years after the filing date.

### **Design patent**

CNIPA any new design of the shape, the pattern, or their combination, or the combination of the color with shape or pattern, of a product, which creates an aesthetic feeling and is fit for industrial application.

USPTO legal protection that may be granted for a new, original, and ornamental design embodied in or applied to an article of manufacture.

### **Designation**

an indication of the contracting state or regional office in which protection for the invention is desired (for a regional application or for an international application).

### **Euro-direct filing**

EPO a patent application filed directly with the European Patent Office under the

European Patent Convention.

### **Divisional Application**

**EPO** the usual reason for filing a European divisional application is that the parent application does not satisfy the requirements as to unity of invention and the applicant is not content with limiting it.

A divisional application may be filed only for subject-matter which does not extend beyond the content of the parent application as filed. If it complies with this provision and with the formal requirements for according a date of filing, it is deemed to have the same date of filing and priority date as the parent application.

All the states designated in the parent application at the time of filing of the divisional application are deemed to be designated in the latter. However, contracting states the designations of which have been withdrawn or are deemed to be withdrawn in respect of the parent application at the time of filing the divisional application cannot be designated in respect of the divisional application. The same applies to extension and validation states.

**JPO** divisional application(s) is/are one or more new patent application(s) which is/are filed by dividing a part of the patent application that includes two or more inventions under certain conditions.

**KIPO** a divisional application is filed to divide a patent application (known as the parent application) into two or more applications.

**USPTO** a later application for an independent or distinct invention that is carved out of a pending application; it discloses and claims only subject matter disclosed in the earlier or parent application and is sometimes referred to as a "*division*."

### **Documentation Database (DOCDB)**

a reference database that contains records for all worldwide patent publications, as far as data are made available. In most patent offices, there is a publication of the application followed by a publication of the grant (if any). Other special publications also appear. DOCDB is maintained by the EPO.

### **Early certainty for search**

**EPO** the aim to produce a search report with a written opinion on patentability within six months

from filing, to increase legal certainty for applicants.

### **EPC contracting states**

EPO European states parties to the European Patent Convention and therefore members of the European Patent Organization. (See also *European Patent Convention*). These states have agreed that patents granted by the European Patent Office have the same effects as national patents.

### **Euro-PCT application – regional phase**

EPO a PCT application for which the European Patent Office is designated and the applicant has made an explicit request to the European Patent Office for processing the application by that Office under the European Patent Convention, and fulfilled the requirements in the PCT Article 22(1) or Article 39(1).

### **European Patent Convention (EPC, EPC 2000)**

EPO in 1973, the European Patent Convention (that applies in 38 *EPC contracting states* as of 31 December 2015) established the European Patent Organization that enables patent applicants to obtain a patent in some or all of the contracting states by the means of a single procedure. A revised version of the convention (EPC 2000) entered into force on December 13th, 2007.

### **European Patent Office (EPO)**

one of the two organs of the European Patent Organization, it grants European patents for the *EPC contracting states*.

### **European Procedure**

EPO a patent process involving the European Patent Office.

### **European search**

EPO search carried out by the European Patent Office on an application for a Direct European filing. This also contains a written opinion on patentability. See *Search report*.

## Examination

- EPO the European Patent Office conducts substantive examination on European patent applications on written request after the search has been completed.
- JPO/KIPO/CNIPA on a request for examination within three years for the JPO, KIPO and the CNIPA after filing date, a patent examiner examines the patent application on novelty, inventive step, utility and so on (substantive examination).
- USPTO the thorough study of an application (which includes the claimed invention) including a thorough investigation (search) of the available prior art relating to the subject matter of the claimed invention. The examination is complete with respect both to compliance of the application with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

## Field of technology

refers to a field of technology identified in the WIPO technology concordance table that links the International Patent Classification (IPC) symbols with thirty-five fields of technology. See also *International Patent Classification*.

## Final action

- EPO the last decision taken by the examining division in the European granting procedure, meaning either to refuse or to propose to grant the patent application.
- JPO/KIPO the final decision taken by a patent examiner meaning to grant or to refuse the patent application. Disposal of withdrawal or abandonment of the patent application is also included.
- CNIPA the final decision taken by a patent examiner meaning to grant or to refuse the patent application. Disposal of withdrawal of the patent application is also included.
- USPTO an office action based upon the second or any subsequent examination or consideration by an examiner that closes the prosecution of a non-provisional patent application.



### **First office action**

EPO first communication of the examiner to the applicant on patentability during the granting procedure.

JPO/KIPO/CNIPA the notification of the first examination result after the request for examination including reasons for refusal or granting a patent.

USPTO an office action based upon the first examination of the non-provisional application by an examiner.

### **Five blocs patent family**

*see IP5 patent family*

### **Five Offices**

the European Patent Office, the Japan Patent Office, the Korean Intellectual Property Office, the State Intellectual Property Office of the People's Republic of China, and the United States Patent and Trademark Office.

### **Four blocs patent family**

a Four blocs patent family is part of a filtered subset of patent families for which there is evidence of patenting activity in all the Four blocs (EPC states, Japan, R. Korea, and the U.S.).

### **Four Offices**

the European Patent Office, the Japan Patent Office, the Korean Intellectual Property Office, and the United States Patent and Trademark Office.

### **Four Office Statistics Report**

*see IP5 Statistics Report*

### **Global dossier**

*see IP5 Global Dossier*

## **Grant**

see *Patent granted*

## **Industrial applicability**

EPO is fulfilled for any patent application if it can be made or used in any kind of industry, including agriculture.

JPO/ KIPO means that the invention itself is industrially exploitable.

USPTO see *Utility*

## **Industrial Design Five (ID5)**

the Industrial Design 5 is a partnership of the five largest design patent offices, which includes the USPTO, CNIPA, European Union Intellectual Property Office (EUIPO), JPO, and KIPO. The goal of ID5 is to improve consistency in registration policies for industrial designs and to facilitate progress on a range of matters that global stakeholders would like to see addressed. This goal is achieved through collaboratively working on various industrial design based projects.

## **International Finance Reporting Standards (IFRS)**

EPO accounting standards that are designed as a common global language for business affairs so that company accounts are understandable and comparable across international boundaries. They are a consequence of growing international shareholding and trade and are particularly important for companies that have dealings in several countries. They are also applicable in the public sector, so can be used by patent offices. Some other accounting standards that have been used in the public sector are converging with IFRS.

## **Intellectual property (IP)**

creations of the mind: inventions, literary and artistic works, and symbols, names, images, and designs used in commerce.

Intellectual property is divided into two categories: Industrial property, which includes inventions (patents), trademarks, industrial designs, and geographic indications of source; and Copyright, which includes literary and artistic works such as novels, poems and plays, films, musical works, artistic works such as drawings, paintings,

photographs and sculptures, and architectural designs. Rights related to copyright include those of performing artists in their performances, producers of phonograms in their recordings, and those of broadcasters in their radio and television programs.

### **International application**

see *PCT application*

### **International Patent Classification (IPC)**

the IPC “is a hierarchical classification system used primarily to classify and search patent documents (patent applications, specifications of granted patents, utility models, etc.) according to the technical fields to which they pertain. It therefore serves as an instrument for an orderly arrangement of the patent documents, a basis for selective dissemination of information and a basis for investigating the state of the art in given fields of technology.” There are eight major technology sections which are further broken down into about 70,000 subdivisions. <http://www.wipo.int/classifications/ipc/en/>

### **International phase**

the procedure where a PCT international application is processed under the PCT by the International Authorities (the Receiving Office, the International Bureau, the International Searching Authority, and upon the applicant’s request, the International Preliminary Examining Authority).

### **International Preliminary Examination (IPE)**

the (optional) examination for PCT international applications carried out by a competent International Preliminary Examining Authority, leading to the establishment of a report indicating whether the subject matter claimed in the application meet the requirements of novelty, inventiveness, and industrial applicability.

### **International Preliminary Examining Authority (IPEA)**

the national or regional patent offices that are designated by the PCT Assembly for carrying out the international preliminary examination. Each receiving office should specify at least one International Preliminary Examining Authority that is competent for the applications filed with that office.

### **International preliminary report on patentability (IPRP)**

a preliminary non-binding opinion established by an IPEA at the request of the applicant, on whether the claimed invention appears to be novel, to involve an inventive step (is not obvious) and to be industrially applicable. Prior to January 1, 2004, this report was known as the “*International Preliminary Examination Report.*”

### **International Search**

see *PCT international search*

### **International Searching Authority (ISA)**

the national or regional patent offices that are designated by the PCT Assembly for carrying out the PCT international search. Each receiving office should specify at least one International Searching Authority that is competent for the applications filed with that office.

### **International Search Report**

the report established as the result of the PCT international search listing all relevant documents and other types of disclosures that may affect the patentability of the claims in the PCT international application. For international applications filed on or after January 1, 2004, the report is accompanied by a written opinion established by the same Searching Authority indicating whether the subject matter claimed in the application meets the requirements of novelty, inventiveness, and industrial applicability.

### **Invalidation**

CNIPA where, starting from the date of the announcement of the grant of the patent right, any entity or individual considers the grant of the said patent right is not in conformity with the relevant provisions of the Patent Law, it or he may request the Patent Reexamination Board to declare the patent right invalid. The Patent Reexamination Board shall examine the request for invalidation of the patent right promptly, make decision on it and notify the person who made the request and the patentee. The decision declaring the patent right invalid shall be registered and announced by the CNIPA.

### **Inventive step**

EPO/JPO/KIPO an invention shall be considered as involving an inventive step if, having regard to the state

of the art, it is not obvious to a person skilled in the art.

CNIPA as compared with the prior art, the invention has prominent substantive features and represents a notable progress and the utility model has substantive features and represents progress.

USPTO the equivalent term is non-obviousness and it is a requirement for patentability. This means that the available prior modification of the available prior art must be one which would not have been obvious to one of ordinary skill in the art at the time the invention was made. For applications filed on or after March 16, 2013 containing a claim having an effective filing date that is on or after March 16, 2013, the time frame for this inquiry will be before the effective filing date of the claimed invention.

### **IP5 Global Dossier**

a set of services that are being developed from an IP5 their vision for retrieval of patent information and for patent prosecution at the IP5 level. Tools are provided to retrieve information about patents at an IP5 level (for example dossier content of an entire family of applications from a single source) and to develop approaches to allow simplified subsequent filing of applications at other IP5 Offices.

In 2014, the first Global Dossier public service for file wrapper viewing was delivered by the EPO with the support of CNIPA. By the end of 2015, all IP5 Offices were providing file wrapper data in a standardized format allowing the viewing of all IP5 file wrapper documents from any one IP5 Office.

Further developments that are being pursued are: These include:

- alerting (EPO led): delivering file change information at IP5 patent family level;
- XML (JPO led): providing applicants with documents in XML format;
- applicants name standardization (KIPO led): standardizing applicants' names for better prior art searches and improved patent file administration;
- legal status (CNIPA led): providing legal status at IP5 level;
- inter office document sharing (USPTO led): seamless exchange of forms between Offices for given business processes.

See <http://www.fiveipoffices.org/activities/globaldossier.html>

### **IP5 Offices cooperation**

an initiative that was started in 2007, involving the world's five largest patent offices – the European Patent Office, the Korean Intellectual Property Office, the Japan

Patent Office, the State Intellectual Property Office of the People's Republic of China, and the United States Patent and Trademark Office - and aimed at creating an international patenting framework.

### **IP5 patent family**

an IP5 patent family is part of a filtered subset of patent families for which there is evidence of patenting activity in all the IP5 blocs (EPC states, Japan, R. Korea, P.R. China, and the U.S.).

### **IP5 Patent Prosecution Highway**

under the IP5 PPH pilot program a PPH request can be based either on the latest PCT work product (written opinion of the ISA (WO-ISA) or international preliminary examination report (IPER)) established by one of the IP5 Offices as ISA or IPEA, or on the national work product established during the processing of a national application or a PCT application that has entered the national phase before one of the IP5 Offices, where this work product determines one or more claims to be patentable/allowable.

Where the work product contains one or more claims that are determined to be patentable/allowable, the applicant may request participation in the PPH pilot program at one of the IP5 partner offices. The procedures and requirements for filing a request with the IP5 offices are available from their respective websites.

### **IP5 Statistics Report**

a report on patent statistics published for the first time in November 2012 that is published jointly each year by the European Patent Office, the Japan Patent Office, the Korean Intellectual Property Office, the State Intellectual Property Office of the People's Republic of China, and the United States Patent and Trademark Office. The report is available both in paper copy form and on the web (IP5 web server, at <http://www.fiveipoffices.org/statistics.html>).

The web version contains additional annexes with information on historical statistics and this glossary of terms. The IP5 Statistics report contains many similar statistics to the *Four Office Statistics Report* and the *Trilateral Statistical Report* that were previously published annually by the same offices excluding the State Intellectual Property Office of the People's Republic of China, in the case of the *Four Office Statistics Report*, and excluding the Korean Intellectual Property Office and the State

Intellectual Property Office of the People's Republic of China, in the case of the *Trilateral Statistical Report*.

### **IP5 Statistics Website**

<http://www.fiveipoffices.org/statistics.html>

### **Japan Patent Office (JPO)**

Japanese authority responsible for industrial property matters as patents, trademarks, utility models, and designs. See also *Intellectual property*.

### **Key IP5 statistical indicators**

a short publication on numbers filings and grants at IP5 offices that appears at the IP5 statistics website from spring to autumn of each year, to report on provisional counts of filings and grants from the previous calendar year.

This is a useful timely update, because the *IP5 Statistics Report* is not usually published until the autumn.

### **Korean Intellectual Property Office (KIPO)**

Korean authority responsible for industrial property matters as patents, trademarks, utility models, and designs.

### **Limitation**

EPO the patentee may request to have the claims of his granted patent limited (or to have the whole patent revoked for all the designated states – see *revocation*). The limitation procedure offers an opportunity to obtain a limitation of a European patent in a short and straightforward procedure.

The request can be filed at any time after grant, after opposition proceedings, or even after expiry of the patent.

### **Maintenance**

a patent can be maintained after an opposition procedure or an interference proceeding or a reexamination proceedings, possibly in an amended form. Patents can be maintained up to their terms by payment of renewal fees.

EPO twenty years from the date of filing. During examination, yearly renewal fees are due to

the EPO at the beginning of the patent years from the 3<sup>rd</sup> year onward. After grant, renewal fees are payable to national offices of the EPC contracting states instead, under terms specified by statutes in each country.

**JPO/KIPO** twenty years from the date of filing. At the time of grant, a minimum patent fee for the 1<sup>st</sup> to 3<sup>rd</sup> years must be paid at one and the same time. The annual fees for the 4th year onward may be paid in the amount equivalent to a single year or several years in a lump sum.

**CNIPA** twenty years from the date of filing. When the applicant goes through the formalities of registration of the grant of patent right, it or he shall pay a registration fee for the grant of patent right, printing fee for the announcement of grant of patent right and the annual fee of the year in which the patent right is granted. The annual fee of the patent right after the year in which the patent is granted shall be paid before the expiration of the preceding year.

**USPTO** most utility patents are subject to a maximum term of twenty years from the date of earliest filing; maintenance fees are fees required to be paid for all utility patents based on applications filed on or after December 12, 1980, to maintain a patent in force beyond 4, 8, and 12 years after the date of grant. Maintenance fees are not required for any plant patents or for any design patents.

**NB** *maintenance is also an accounting term for costs arising from maintaining buildings etc.*

### **National application**

a patent application filed with a national office under the national procedure.

### **National office**

a national authority responsible for intellectual property matters in one country (e.g. patents, trademarks, copyright, utility models, designs).

### **National (regional) phase**

the procedure where a PCT international application is processed by a national patent office or regional patent organization, which is designated in the PCT international application, under its national law or treaty, following an explicit request by the applicant and on condition that the requirements in the PCT Article 22(1) or Article 39(1) are fulfilled. The above procedure is referred to as “*regional phase*” when the PCT



application is processed by a regional patent organization.

See also *Euro-PCT application-regional phase*.

### **National procedure**

patent examination and granting procedure in a single country.

### **National Center for Industrial Property Information and Training (INPIT)**

JPO            the INPIT works with the JPO to support various activities such as access to gazettes, consultation, information dissemination, training and development of human resources. The center also manages the database for industrial property information which is called "J-PlatPat" to supply online industrial property information for free.

### **Non-obviousness**

see *Inventive step*

### **Novelty**

EPO            an invention shall be considered to be novel if it does not form part of the state of the art, which comprises everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the application.

JPO/KIPO      an invention is novel when its content of invention is not known at the time of filing, and if known at such time, the patent cannot be granted.

CNIPA          the invention or utility model does not form part of the prior art, nor has any entity or individual filed previously before the date of filing with the patent administration department under the State Council an application relating to the identical invention or utility model disclosed in patent application documents published or patent documents announced after the said date of filing.

USPTO          a requirement for patentability, a claimed invention lacks novelty if each and every element as set forth in a claim is found, either expressly or inherently described, in a prior art reference.

## **Opposition**

EPO	within nine months of the publication of the mention of the grant of a European patent in the European Patent Bulletin, any person may give notice to the EPO of opposition to the European patent granted, invoking lack of patentability, e.g. lack of novelty or inventive step or lack of sufficiently clear and complete disclosure of the invention, or the fact that the granted patent extends beyond the application as filed. The oppositions for European patents are dealt with by opposition divisions of the EPO.
JPO	within six months from the date of the publication of the gazette containing the patent, any person may file an opposition to grant of the patent to the JPO, invoking lack of patentability, e.g. lack of novelty or inventive step, or violation of enablement, support or clarity requirement, or addition of new matter beyond the application as filed. The oppositions are dealt with by the Trial and Appeal Department of the JPO.
KIPO	n.a. (Patent opposition system was deleted on March 3, 2006.)
CNIPA	n.a. (Patent opposition system has been deleted since July 1, 2001.)
USPTO	any party may provide evidence that is adverse to a patent application or to publication, within two months of publication (third party submission in published applications), after publication if accompanied by the written consent of the applicant (a protest) or during the period of enforceability of a granted patent (a reexamination). Beginning in September 16, 2012, this time period for third party submission was changed to the later of 6 months after publication or the date of a first rejection of any claim in an office action.

## **Paris Convention**

an international convention, established in 1883, which is currently administered by the World Intellectual Property Organization. It set up the basic characteristics of the modern international patent system, allowing in particular for subsequent filings, which claim the priority of the first filing, to be made at other patent offices within the following twelve month period. The convention also concerns other matter such as equal treatment, territoriality of patents, and other sets of common rules.

## **Patent Cooperation Treaty (PCT)**

an international treaty, established in 1970, administered by the World Intellectual Property Organization, participated in by 148 contracting states (as of December 31,

2013), providing an alternative system whereby the applicants can file patent applications in foreign countries.

### **Patent granted**

- EPO** when the examining division or the examiner is of the opinion that the application and the invention to which it relates meet all requirements set, it decides to grant the patent. The grant is effective from the date it is mentioned in the European Patent Bulletin.
- JPO** when the examination is completed by an examiner and there is no reasons for refusal to be found, a copy of decision to grant a patent is mailed to the applicant, who then has got 30 days for payment of the patent fee. After this payment, the patent right is registered to the Patent Register in JPO and an exclusive right is granted for a specific period.
- KIPO** when the examination is completed by an examiner and there is no reasons for refusal to be found, a certified copy of decision to grant a patent is mailed to the applicant, who has then got 3 months for payment of the patent fee. After this payment, the patent right is registered to the Patent Register in KIPO and an exclusive right is granted for a specific period.
- CNIPA** after CNIPA issues the notification to grant the patent right, the applicant shall go through the formalities of registration within 2 months from the date of receipt of the notification. If the applicant completes the formalities of registration within the said time limit, CNIPA shall grant the patent right, issue the patent certificate and announce it.
- USPTO** may occur only after the issue fee is paid and all other requirements have been met (e.g., drawings) within the time allowed by law; the application is forwarded to the printer for Final Data Capture (FDC) and final issue preparation. At this point, the application can only be retrieved if it is withdrawn from issue. The application is assigned a patent number and issue date about ten days before the application issues as a patent. An Issue Notification is mailed to inform the applicant of the patent number and issue date. A bond paper copy of the patent grant is ribboned, sealed, and mailed by the Office of Data Management.

### **Patent Prosecution Highway or PPH**

a set of initiatives for providing accelerated patent prosecution procedures by sharing

information between some patent offices. It also permits each participating patent office to benefit from the work previously done by the other patent office, with the goal of reducing examination workload and improving patent quality.

### **Patent right**

protection in a sovereign state provisionally conferred by a patent application and confirmed by a later grant. In a supranational procedure, (e.g. PCT, EPO) a single application can confer multiple patent rights in different countries by means of multiple designations.

### **PATSTAT**

EPO Worldwide patent statistical database.

### **PCT application**

international application filed under the Patent Cooperation Treaty.

### **PCT Chapter II**

a chapter in the Patent Cooperation Treaty specifying the procedure where the applicant can request that an international preliminary examination be carried out by a competent International Preliminary Examination Authority.

### **PCT international search**

search carried out on a PCT international application to discover the documents or other types of disclosures that may affect the patentability of the claims.

### **Pendency**

time taken to achieve certain actions of the granting procedure, measured from a reference date to the date of completion of the specified action. This can be the time taken by the office to complete an action or the time taken to complete a sequence of actions. Generally pendency statistics indicate an average duration for a given action from a specified reference date.

### **Plant patent**

USPTO legal protection that generally can be granted for a new and distinct, invented or discovered asexually reproduced plant.

### **Prior Art**

the complete information publicly available related to matter for which protection is sought in a patent application. Also known as state of the art. See also *PCT International search*.

### **Priority**

under the terms of the Paris Convention of 1883 and its later amendments, an applicant may make a subsequent filing for the same invention in another jurisdiction within 12 months of a first filing, quoting the priority of the first filing.

### **Provisional patent application**

USPTO U.S. national application for patent that does not require a patent claim, oath or declaration, or any information disclosure (prior art) statement. Provisional patent applications provide the means to establish an early effective filing date in a non-provisional patent application, automatically become abandoned after one year, and cannot claim priority to, or the benefit of, another application.

### **Publication**

the event where the content of the patent application is disclosed to the public. In most jurisdictions, the patent applications are published promptly at 18 months after the earliest priority date (or filing date where no priority is claimed), subject to certain conditions. Another publication is made at grant.

EPO the European search report is published by the EPO if possible together with the application. At the same time as it publishes the mention of the grant of the European patent, the EPO also publishes a specification of the European patent containing the description, the claims, and any drawings. International applications, for which the European Patent Office is the designated office are, when published, also mentioned in the European Patent Bulletin.

JPO the application is published 18 months after filing to ensure that no duplication of research and application is made. In addition, in case of a request for early disclosure by the applicant, the application is published earlier than 18 months. After a patent application is registered as a patent right, its patent gazette will be published about three months later from its registration date. It contains patent number, registration date, application number, filing date, patentee, inventor, specification, claims,

drawings and other necessary information.

**KIPO** the application is published 18 months after filing to ensure that no duplication of research and application is made. In addition, in case of a request for early disclosure by the applicant, the application is published earlier than 18 months.

**CNIPA** where, after receiving an application for a patent for invention, CNIPA upon preliminary examination, finds the application to be in conformity with the requirements of the Patent Law, it shall publish the application promptly after the expiration of 18 months from the date of filing. Upon the request of the applicant, CNIPA publishes the application earlier.

**USPTO** except in limited circumstances, non-provisional applications are published at 18 months after the earliest filing date for which a benefit is sought.

### **Re-examination proceedings**

*see Opposition and Revocation*

**CNIPA** *see Appeal*

**USPTO** refers to the USPTO process for conducting a second examination of any claim of the patent on the basis of prior art patents or printed publications which the requester states to be pertinent and applicable and to have a bearing on the patentability. The request may be filed at any time during the period of enforceability. A request for ex parte re-examination (under 35 U.S.C. 302) or inter partes reexamination (under 35 U.S.C. 311) may be filed.

### **Receiving Office**

The office at which a patent application is filed, even though patent protection may be sought in other jurisdictions. This is particularly relevant for international phase PCT applications, since a single application automatically designates a wide range of jurisdictions.

### **Refusal**

**EPO/JPO/KIPO** if an application does not fulfill the necessary requirements, it will be refused by the office.

**CNIPA** *see Rejection*

**USPTO** n.a. (this does not apply to patent applications; however, a defined set of submission

documents is required before the submission can be considered to be a complete application).

### **Regional application**

patent application filed under a supranational patent system covering several countries of the same geographical zone.

European Patent Organization (38 European countries as of December 31, 2016), Eurasian Patent Organization (9 East European and Asian countries), African Intellectual Property Organization (17 African countries), African Regional Industrial Property Organization (19 African countries), Gulf Cooperation Council (6 countries).

### **Reissued patent**

EPO/JPO            *see Amended form*

KIPO                new version of the patent in which an amendment of the description, claims and/or drawings is reflected after an invalidation trial

CNIPA             n.a.

USPTO            may be issued by the Director whenever any patent is, through error without any deceptive intention, drawing, or by reason of the patentee, claiming more or less than he had a right to claim in the patent. On the surrender of such patent and the payment of the fee required by law, the patent may be reissued for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue. The phrase “*without any deceptive intention*” was deleted from 35 U.S.C. 251 on September 16, 2012.

### **Regional phase**

EPO                *See Euro-PCT application-regional phase.*

### **Rejection**

EPO                if an opposition or an appeal does not fulfill the necessary requirements, it will be rejected by the office.

JPO/KIPO        *see Refusal*

CNIPA if an application does not fulfill the necessary requirements, it will be rejected by the office.

USPTO a written statement by an examiner that explains why a claimed invention is not considered patentable.

### **Request for Continued Examination (RCE)**

USPTO a USPTO procedure under which an applicant may obtain continued examination of an application by filing a submission and paying a specified fee, even if the application is under a final rejection, appeal, or a notice of allowance.

### **Revocation**

EPO if the opposition division considers that the grounds for opposition prejudice the maintenance of the patent, it shall revoke the patent. The patentee may request to have the whole patent revoked for all the designated states. The request can be filed at any time after grant, after opposition proceedings, or even after expiry of the patent.

JPO/ KIPO the patent will be revoked when the appeals collegiate comes to the agreement that a patent should be revoked on the basis of the reason for the appeal.

CNIPA see *Invalidation*

USPTO at the conclusion of a reexamination proceedings, any patent claims that are determined to be unpatentable are cancelled.

### **Search report**

EPO a report on the results of the search drawn up by the search division after the patent application has been accorded a date of filing and is not deemed to be withdrawn. See *European search*.

JPO/KIPO/CNIPA n.a.  
/USPTO

### **Sector of technology**

the fields of technology associated with the International Patent Classification (IPC) are



grouped into five main sectors of technology (see *Field of technology*).

### **State Intellectual Property Office of the People's Republic of China**

Chinese authority responsible for industrial property matters as patents, utility models, and designs.

### **State of the Art**

see *Prior art*

### **Supplementary search**

- EPO search carried out by the European Patent Office on a Euro-PCT application in the regional phase for which the International Search Authority was not the European Patent Office.
- JPO/KIPO n.a.
- CNIPA an updated search
- USPTO to locate prior art that was unavailable at the time of the original search, such searches may be performed, as necessary, during the pendency of an application.

### **Supranational procedure**

either a regional procedure: the European Patent Convention, the Harare Protocol, the Eurasian Patent Convention, the Gulf Cooperation Council or the Patent Cooperation Treaty. See also *Regional application*.

### **Technical appeal**

- EPO an appeal on a decision taken during the patent procedure.

### **Technical field**

a level of aggregation within a patent classification. See also *International Patent Classification*.

### **Third party**

EPO/JPO/KIPO /CNIPA party other than the party concerned with the patent application.

USPTO this term usually refers to a requester in a reexamination proceedings, other than the patent owner or its privies.

### **Trilateral Offices**

the European Patent Office, the Japan Patent Office, and the United States Patent and Trademark Office.

### **Trilateral patent family**

a Trilateral patent family is part of a filtered subset of patent families for which there is evidence of patenting activity in all Trilateral blocs (EPC states, Japan, and the U.S.).

### **Trilateral Statistical report**

*see IP5 Statistics Report*

### **Unitary patent**

EPO in Europe, this “European patent with unitary effect” will be another option for users besides already-existing nation patents and classical European patents. A unitary patent will be a European patent granted by the EPO under the provisions of the European Patent Convention to which unitary effect for the territory of the 26 participating states is given at the patentee’s request. The unitary patent will thus not affect the EPO’s day-to-day search, examination and granting work.

### **United States Patent and Trademark Office (USPTO)**

as an agency of the United States Department of Commerce, the primary services provided by the USPTO are examining patent and trademark applications and disseminating patent and trademark information.

### **U.S. patent classification system**

an official patent classification system used and maintained by the United States

Patent and Trademark Office (USPTO), that contains more than 400 classes. USPTO is in the process of transitioning to the cooperative classification system (CPC) that will be jointly administered by EPO, and USPTO. See *CPC*.

## Utility

EPO/JPO/KIPO see *Industrial applicability*

USPTO an invention has a well-established utility if (i) a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention (e.g., properties or applications of a product or process), and (ii) the utility is specific, substantial, and credible. Utility is a requirement for patentability.

## Utility model

an exclusive right granted for an invention, which allows the right holder to prevent others from commercially using the protected invention, without his authorization, for a limited period of time. In its basic definition, which may vary from one country (where such protection is available) to another, a utility model is similar to a patent. In fact, utility models are sometimes referred to as "*petty patents*" or "*innovation patents*."

## Utility patent

USPTO legal protection that can be granted for any new, useful, and non-obvious process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof. The USPTO utility patent has similarities to patents (not utility models) issued by EPO, JPO, KIPO, and CNIPA.

## Validation agreement

EPO an agreement by a country or organization that is not itself currently one of the *EPC contracting states*, that European patents are valid within its jurisdiction.

## Withdrawal

EPO/CNIPA an application is withdrawn either on request of the applicant or by decision of the office to consider the application to be withdrawn because the applicant fails to reply in due time to a communication by the office or fails to pay a fee. Under some conditions, the proceedings may be resumed.

JPO/ KIPO an applicant can withdraw his/her application voluntarily.

**USPTO** usually refers to non-provisional applications that have been withdrawn from issue at the initiative of the office or upon a grantable petition by an applicant. In a separate withdrawal process, a PCT application also may be withdrawn and processing of the PCT application may be discontinued, either upon written notice by the applicant or by virtue of a declaration by the relevant office or authority. See also *Abandonment*.

**World Intellectual Property Organization (WIPO)**

an international organization dedicated to helping to ensure that the rights of creators and owners of intellectual property are protected worldwide and that inventors and authors are, thus, recognized and rewarded for their ingenuity.

WIPO administers the Patent Cooperation Treaty (PCT).