

GLOSSARY of patent related terms in the TRILATERAL STATISTICAL REPORT 2005 EDITION

Disclaimer: The explanations in this glossary are given in order to help readers of the Trilateral Statistical Report in understanding the patent related terminology that appears there. The Trilateral 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 Trilateral Offices for more detailed information about the respective patent systems.

Glossary:

Abandonment

EPO *see Withdrawal*

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

USPTO an abandoned application is one which is removed from the Office docket of pending applications through a formal abandonment or by failure of applicant to take appropriate action within a specified time at some stage in the prosecution of the application.

Allowance

EPO *n.a.*

JPO *see Grant*

USPTO a nonprovisional application that has been reviewed (examined) by an examiner to make certain that the whole application meets all formal and substantive (i.e., statutory- *novelty* and unobviousness) 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 and corrections of errors or mistranslations or clarify an ambiguous description.

USPTO See also *Reissue*

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 the documents which reflected amendment.
- USPTO amendments in nonprovisional applications, other than *reissue* applications, are made by filing a correspondence, in compliance with the appropriate U.S. laws and regulations, directing that specified amendments be made.

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;
- a *PCT protest* is filed by an *applicant* if he/she does not agree with the request to pay an additional fee following a decision on lack of unity of invention taken during either the *international search* or the *international preliminary examination*;
- there also exist legal, disciplinary appeals and appeals before the Enlarged Board.
- JPO 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 partes*).
- USPTO every *applicant*, any of whose *claims* has been twice rejected, may appeal from 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 a *reexamination proceedings*.

Applicant

- EPO the natural or legal person filing the patent application.
- JPO the natural or legal person, including the inventor, who has been assigned the right of filing a patent application from the inventor.

USPTO a patent is applied for in the name or names of the actual inventor or inventors.

Bringing Examination and Search Together (BEST)

EPO the application is searched and examined by the same examiner or examining division.

Claim

EPO defines the matter for which protection is sought in a clear and concise way supported by the general description.

JPO 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 the specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the *applicant* regards as his invention or discovery, wherein each claim must conform to the invention as set forth in the remainder of 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.

Design patent

USPTO may be granted to anyone who invents a new, original, and ornamental design for an article of manufacture.

Domestic application

a patent application filed by a resident of the country in which the application is filed.

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*).

Direct European filing

EPO patent application filed directly with the *European Patent Office* under the *European Patent Convention*.

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.

EPC contracting states

EPO European states parties to the *European Patent Convention* and therefore members of the European Patent Organisation. (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 - international phase

EPO a PCT international application wherein the European Patent Office is designated upon filing.

Euro-PCT application - regional phase

EPO a *PCT application* wherein 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). See also *national (regional) phase*.

Examination

EPO the *European Patent Office* examines European patent applications on written request after the search has been completed.

JPO on a request for examination within three years after filing date, a patent examiner examines the patent application on *novelty*, *inventive step* and so on (substantive examination).

USPTO the examiner shall make a thorough study of an application (which includes the claimed invention) and shall make a thorough investigation of the available *prior art* relating to the subject matter of the claimed

invention. The examination shall be 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.

Euro-direct application

EPO see *Direct European filing*.

European Patent Convention (EPC)

EPO in 1973 the European Patent Convention (at present concerning 31 contracting states) established the European Patent Organisation that enables patent applicants to obtain a patent in some or all of the contracting states by the means of a single procedure.

European Patent Office (EPO)

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

European search

EPO search carried out by the *European Patent Office* on an application for a Direct European filing. See *Search report*.

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 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.

USPTO an Office action based upon the second or any subsequent examination or consideration by an examiner that closes the prosecution of a nonprovisional patent application.

First office action

EPO first communication of the examiner to the *applicant* in the examining phase of the granting procedure.

- JPO 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 nonprovisional application by an examiner.

First filing

a patent application which does not claim the *priority* of an earlier one for the same invention, and which can be used as a basis for claiming *priority* in a *subsequent filing* within the *priority year* (one year from the first-filing date).

Foreign application

a patent application filed by a non-resident *applicant* of the country where the application is filed.

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 means that the invention itself is industrially exploitable.

USPTO *See utility.*

Intellectual property (IP)

Intellectual property refers to 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)

all published patent applications and patents are classified under this internationally recognised classification system by technical areas, the purpose of which it is to enable efficient searching in existing patent documents. The system is administered by the *World Intellectual Property Organisation*.

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 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 1 January 2004, the report is accompanied by a written opinion established by the same Searching Authority indicating whether the subject matter claimed in the application meet the requirements of *novelty*, *inventiveness* and *industrial applicability*.

Inventive step

EPO/JPO 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.

USPTO the equivalent term is *unobviousness*. This means that the available *prior art* must somehow be unable to be modified in order to meet the *claims*, wherein any 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.

Japan Patent Office (JPO)

JPO Japanese Authority responsible for industrial property matters as patents, trademarks, *utility models* and designs. See also *intellectual property*.

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, yearly renewal fees due at the beginning of the patent years from the 3rd year onward up to the time of *grant*. After *grant*, renewal fees are payable to national offices of the *EPC contracting states* under terms specified by statutes in each country.

JPO twenty years from the date of filing. At the time of *grant*, a minimum patent fee for the 1st to 3rd 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.

USPTO twenty years from the date of earliest filing, maintenance fees are fees required to be paid in all 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 such as e.g. patents, trademarks, copyright, *utility models*, designs in one country.

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.

National procedure

a patent examination and granting procedure in a single country.

National Center for Industrial Property Information and Training (NCIPI)

JPO the NCIPI works with the JPO to support various activities such as access to gazettes, consultation, promotion of patent licensing, information dissemination, training and development of human resources. The center manages the Industrial Property Digital Library (IPDL) via the internet, which supplies industrial property information for free.

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 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 can not be granted.
- USPTO 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 single *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, eg 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 *n.a. (Patent opposition system was deleted on 1st January 2005)*
- USPTO any party may provide evidence that is adverse to a patent application or granted patent. Such evidence may be presented during pendency of an application prior to publication, or 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*).

Patent Cooperation Treaty (PCT)

an international treaty, established in 1970, administered by the *World Intellectual Property Organisation*, participated in by 133 contracting states (1 September 2006), providing an alternative system whereby the *applicants* can file patent applications in foreign countries.

Patent family

a group of patent filings that claim the *priority* of one and the same first filing, including the original *priority* forming filing itself and any *subsequent filings*.

Patent granted

- EPO when the examining division or the examiner is of the opinion that the application and the invention to which it relates meets 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.
- USPTO when 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, and 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 Patent Publication.

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*.

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* in the PCT *international application*.

- EPO SA.E is a PCT international search on a *Euro-PCT application*, SA is a PCT international search on a *PCT application* where the EPO is not designated office.
- JPO when a *PCT application* is filed in Japanese or English and JPO is designated as the *international searching authority*, the international search report describing the *prior art* based on the search result will be sent to the applicant.
- USPTO the purpose of the international search is to discover relevant *prior art* for *international applications* filed under the *Patent Cooperation Treaty*. *Prior art* is defined in PCT Rule 33.

PCT Protest

a reasoned statement filed, together with the additional search or examination fee, by the *applicant* opposing a decision of lack of unity of invention made by the *International Searching Authority* or the *International Preliminary Examining Authority*.

Pendency

Time taken to achieve one action of the granting procedure, measured from a reference date to the date of completion of the 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 may be granted to anyone who invents or discovers and asexually reproduces any distinct and new variety of 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*.

Publication

the event where the content of the patent application is disclosed to the public. In most jurisdictions, the patent applications are published promptly after expiration of 18 months from 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.

USPTO except in limited circumstances, nonprovisional applications are published after the expiration of 18 months from the earliest filing date for which a benefit is sought.

Reexamination proceedings

See *opposition* and *revocation*.

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

Refusal

EPO if an application does not fulfil the necessary requirements it will be refused by the Office.

JPO if an application does not fulfil the necessary requirements, it will be refused by the Office.

USPTO n.a. (this does not apply to patent applications).

Regional application

patent application filed under a supranational patent system covering a limited number of countries of the same region.

European Patent Organisation (31 European countries), EurAsian Patent Organisation (9 east European countries), African Intellectual Property Organisation (16 African countries), African Regional Industrial Property Organization (15 African countries).

Reissue patent

EPO/JPO See *amended form*.

USPTO whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent 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.

Rejection

EPO if an *opposition* or an *appeal* does not fulfil the necessary requirements, it will be rejected by the Office.

JPO See *refusal*.

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

Revocation

EPO if the *opposition* division considers that the grounds for *opposition* prejudice the *maintenance* of the patent, it shall revoke the patent.

JPO 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*.

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 *n.a.*

USPTO the end product of a *PCT international search* is a listing of relevant references together with a written opinion that indicates whether the claimed invention appears to be *novel*, to involve an *inventive step*, and to be *industrially applicable*.

State of the Art

see prior art.

Subsequent filing

a patent application filing that claims the *priority* of a *first filing*.

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 *n.a.*

USPTO an updated search performed by an examiner as necessary throughout the *pendency* of an application to locate *prior art* that was unavailable at the time of the original search.

Supranational procedure

either a regional procedure: the *European Patent Convention*, the Harare Protocol, the Eurasian Patent Convention 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 someone, who is not the *applicant* of the application in question, for whom a search is carried out by the *European Patent Office*.

JPO a 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 Statistical Report (TSR)

a report on patent statistics that is published jointly each year by *European Patent Office*, *Japan Patent Office* and *United States Patent and Trademark Office*. The report is available both in hard copy form and on the web (trilateral web server). The web version (only) contains additional annexes with information on historical statistics and this glossary of terms.

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.

Utility

EPO/JPO 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 model

A utility model is 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 may be granted to anyone who invents or discovers any new, useful, and nonobvious process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof.

Withdrawal

EPO 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 an *applicant* can withdraw his/her application voluntarily.

USPTO nonprovisional applications may be withdrawn from issue at the initiative of the Office or upon a grantable petition by an applicant. A *PCT application* becomes withdrawn, and processing of the application is 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 Organisation (WIPO)

an international organisation 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, recognised and rewarded for their ingenuity. WIPO administers the *Patent Cooperation Treaty (PCT)*.

ACRONYMS

BEST	B ringing E xamination and S earch T ogether
DOCDB	DOC umentation DataB ase
EPC	E uropean P atent C onvention
EPO	E uropean P atent O ffice / E uropean P atent O rganisation
EP	E uropean P atent
IPC	I nternational P atent C lassification
IPE	I nternational P reliminary E xamination
IPEA	I nternational P reliminary E xamining A uthority
IP	I ntellectual P roperty
ISA	I nternational S earching A uthority
JPO	J apan P atent O ffice
NCIPI	N ational C enter for I ndustrial P roperty I nformation and T raining
PCT	P atent C ooperation T reaty
TSR	T rilateral S tatistical R eport
USA	U nited S tates of A merica
USPTO	U nited S tates P atent and T rademark O ffice
WIPO	W orld I ntellectual P roperty O rganization