
Graduate Certificate in Intellectual Property Law

Patent Law And Practice

Abstract – Related terms: summary, disclosure, specification. The abstract is a concise, non-technical summary of the invention placed at the beginning of a patent document. It must enable a quick understanding of the technical problem solved and the core solution. Example: In a biotechnology patent, the abstract may state “A method for producing recombinant insulin using a novel expression vector.” Practical application: abstracts are used by patent examiners and search databases to assess relevance. Challenge: drafting an abstract that is both comprehensive and within the word-limit (typically 150 words) without revealing unnecessary detail.

Application – Related terms: filing, docket, prosecution. A patent application is the formal request submitted to a patent office that seeks protection for an invention. It includes a specification, claims, drawings, and required fees. Example: An inventor files a utility application for a new solar panel coating. Practical application: the application initiates the examination process and establishes a filing date, which is critical for establishing priority. Challenge: ensuring completeness and compliance with jurisdiction-specific formalities to avoid abandonment.

Applicant – Related terms: inventor, assignee, proprietor. The applicant is the natural or legal person who files the patent application. The applicant may be the inventor, an employer, or a third-party assignee. Example: A university researcher files an application in the name of the university as applicant. Practical application: the applicant controls the initial prosecution and may later assign rights. Challenge: determining the correct applicant when multiple inventors and contractual obligations are involved.

Assignment – Related terms: transfer, conveyance, deed. An assignment is a legal instrument that transfers ownership of patent rights from one party to another. Example: A start-up assigns its pending patent portfolio to a larger corporation in exchange for funding. Practical application: assignments are recorded in the patent office to provide public notice of ownership change. Challenge: ensuring the assignment language covers all claims, future continuations, and foreign filings to avoid gaps in protection.

Attorney-in-Fact – Related terms: power of attorney, representative, proxy. An attorney-in-fact is a person authorized by a power of attorney to act on behalf of the applicant or owner in patent matters. Example: A foreign inventor appoints a U.S. patent attorney-in-fact to file and prosecute a U.S. application. Practical application: the attorney-in-fact can sign documents, receive office actions, and make amendments. Challenge: maintaining accurate and up-to-date power of attorney filings in multiple jurisdictions.

Amendment – Related terms: modification, correction, continuation. An amendment is a formal change to the specification, claims, or drawings filed during prosecution. Example: After receiving a rejection, the applicant amends claim 1 to narrow the scope and overcome prior art. Practical application: amendments

can rescue an application from abandonment or broaden protection. Challenge: balancing claim breadth with examiner objections while respecting the prohibition on adding new matter.

Appeal – Related terms: reconsideration, board of appeals, judicial review. An appeal is the process by which an applicant challenges a final examiner decision before a higher authority, such as a Patent Trial and Appeal Board (PTAB) or a national court. Example: An applicant appeals a final rejection on the ground of improper claim construction. Practical application: appeals can overturn adverse decisions and lead to grant. Challenge: appeals are costly, time-consuming, and require a strong factual and legal record.

Art. 1 (Patentability) – Related terms: novelty, inventive step, industrial applicability. Article 1 of many patent statutes sets out the basic criteria for patentability: the invention must be new, involve an inventive step, and be capable of industrial application. Example: In the European Patent Convention, Art. 1 defines “patentable inventions.” Practical application: the article guides examiners and courts in assessing eligibility. Challenge: interpreting abstract concepts such as “inventive step” across diverse technological fields.

Artificial Inventor – Related terms: AI-generated invention, non-human authorship, patent eligibility. The term refers to inventions created by artificial intelligence without direct human conception. Example: An AI system proposes a novel alloy composition. Practical application: jurisdictions are debating whether AI-generated inventions can be patented and who should be listed as inventor. Challenge: statutory language typically requires a “natural person” as inventor, leading to legal uncertainty.

Background Art – Related terms: prior art, state of the art, references. Background art comprises all publicly available information that predates the filing date and may affect patentability. Example: Scientific articles describing similar gene editing techniques constitute background art. Practical application: examiners cite background art to assess novelty and inventive step. Challenge: exhaustive searching can be resource-intensive, and inadvertent omission may result in later invalidity.

Baseline Patent – Related terms: foundation, core patent, strategic filing. A baseline patent is a foundational patent that defines the core technology around which a portfolio is built. Example: A baseline patent on a semiconductor manufacturing process underpins subsequent improvement patents. Practical application: baseline patents anchor licensing negotiations and defensive strategies. Challenge: ensuring the baseline claims are sufficiently broad without encroaching on prior art.

Benefit of Priority – Related terms: Paris Convention, priority date, first filing. The benefit of priority allows an applicant to claim the filing date of an earlier application (the priority application) when filing later in another jurisdiction. Example: A U.S. filing claims priority to a PCT application filed six months earlier. Practical application: this preserves the earliest possible date for novelty and inventive step analysis. Challenge: strict time limits (usually 12 months) and accurate claim of priority are essential; any error can forfeit the benefit.

Best Mode – Related terms: disclosure, enablement, US law. Best mode is a requirement (in U.S. law) that the specification disclose the preferred way of carrying out the invention known to the inventor at filing.

Example: An inventor must describe the optimal catalyst concentration even if alternative concentrations work. Practical application: satisfying best-mode avoids allegations of concealment. Challenge: the requirement is difficult to enforce, and failure to disclose may be deemed inequitable conduct.

Biotech Patent – Related terms: gene, protein, recombinant DNA, utility. A biotech patent protects inventions in the biological sciences, such as isolated genes, genetically modified organisms, or diagnostic methods. Example: A patent on a CRISPR-Cas9 delivery system. Practical application: biotech patents enable recouping high R&D costs and incentivize investment. Challenge: ethical considerations, patent-eligibility debates, and complex regulatory landscapes.

Bill of Rights (Patent) – Related terms: patent holder, protection, due process. Though not a formal legal document, the phrase “patent holder’s bill of rights” refers to statutory provisions that protect applicants from arbitrary actions, such as the right to be heard and to receive written reasons for rejections. Example: The right to appeal a final rejection. Practical application: ensures procedural fairness. Challenge: interpreting the scope of these rights in emerging technologies.

Broadening Amendment – Related terms: claim expansion, prohibition, new matter. A broadening amendment attempts to enlarge claim scope after filing, which is generally prohibited because it introduces subject matter not originally disclosed. Example: Adding a new functional feature to a claim after examiner objection. Practical application: may be permissible in limited circumstances (e.g., under the doctrine of “re-opening” in some jurisdictions). Challenge: risk of rejection for introducing new matter and potential invalidity.

Business Method Patent – Related terms: software, abstract idea, US §101. A business method patent protects a novel method of conducting business, often involving software or financial processes. Example: A patented online payment clearing system. Practical application: provides competitive advantage in fintech. Challenge: heightened scrutiny under abstract-idea jurisprudence, especially after landmark U.S. cases.

Claim – Related terms: scope, limitation, independent, dependent. Claims define the legal boundaries of the patent protection; they are the most critical part of a patent document. Example: Claim 1 may recite “A method comprising steps A, B, and C.” Practical application: claims are used by courts to determine infringement. Challenge: drafting claims that are broad enough to deter competitors yet narrow enough to survive examination.

Claim Construction – Related terms: interpretation, Markman, infringement analysis. Claim construction is the judicial process of determining the meaning and scope of patent claims. Example: In a Markman hearing, the court interprets the phrase “means for” in a claim. Practical application: guides both infringement and validity analyses. Challenge: differing interpretations between courts can create legal uncertainty.

Claim Differentiation – Related terms: restriction, examiner, prosecution. Claim differentiation occurs when an examiner treats identical claims as distinct, often to create a restriction requirement. Example: Two claims

that differ only in a trivial feature may be split into separate applications. Practical application: can force applicants to file divisional applications. Challenge: strategic handling to avoid unnecessary cost.

Claim Drafting – Related terms: language, clarity, breadth. Claim drafting is the art of composing claim language that accurately captures the invention while providing maximal protection. Example: Using “consisting essentially of” to allow limited equivalents. Practical application: well-drafted claims reduce the risk of invalidation and simplify licensing. Challenge: balancing technical accuracy with legal enforceability.

Co-Inventor – Related terms: joint inventorship, contribution, ownership. A co-inventor is any individual who contributed to the conception of the claimed invention. Example: Two engineers jointly develop a new battery chemistry. Practical application: all co-inventors must be listed to avoid ownership disputes. Challenge: determining inventorship when contributions are incremental or collaborative across departments.

Continuation – Related terms: continuation-in-part, divisional, same disclosure. A continuation is a patent application filed from the same specification as an earlier (parent) application, keeping the same priority date, and typically used to pursue additional claim sets. Example: After a first office action, the applicant files a continuation to pursue broader claims. Practical application: enables strategic claim diversification. Challenge: must not introduce new matter and must comply with filing limits.

Continuation-in-Part (CIP) – Related terms: new matter, priority, partial benefit. A CIP adds new subject matter to the parent specification while retaining the original filing date for the common parts. Example: Adding an improved substrate to a chemical patent while keeping original claims. Practical application: allows incremental innovation to be protected. Challenge: the new matter receives a later priority date, which may affect novelty relative to intervening publications.

Divisional Application – Related terms: restriction requirement, separate patent, parent. A divisional is filed when the examiner requires the applicant to split claims into distinct inventions. Example: A parent application containing both a device and a method is divided into two separate applications. Practical application: preserves the original filing date for each invention. Challenge: managing multiple families and ensuring each divisional meets unity of invention standards.

Doctrine of Equivalents – Related terms: infringement, literal, substitution. The doctrine of equivalents permits a finding of infringement even when the accused product or process does not fall within the literal wording of the claims but performs substantially the same function in the same way to achieve the same result. Example: A competitor uses a slightly different polymer but achieves identical performance. Practical application: broadens the protective scope of patents. Challenge: courts may vary in applying the doctrine, leading to uncertainty.

Drawings – Related terms: figures, illustration, enablement. Drawings are visual representations required for many patent applications to aid in understanding the invention. Example: A schematic diagram of a circuit board. Practical application: drawings help satisfy enablement and best-mode requirements. Challenge:

must comply with strict formal standards; errors can lead to rejections.

Enabling Disclosure – Related terms: enablement, sufficiency, specification. An enabling disclosure must teach a person skilled in the art how to practice the invention without undue experimentation. Example: Providing detailed synthesis steps for a chemical compound. Practical application: ensures the public receives the benefit of the monopoly. Challenge: balancing sufficient detail with protecting trade secrets.

Examination – Related terms: search, office action, prosecution. Examination is the process by which a patent examiner evaluates a pending application for compliance with statutory requirements. Example: An examiner issues a non-final office action citing prior art. Practical application: determines whether a patent will be granted. Challenge: navigating examiner objections and managing timelines.

Ex Parte Appeal – Related terms: PTAB, final rejection, appeal brief. An ex-parte appeal is an appeal filed without the participation of the examiner, typically after a final rejection. Example: The applicant submits an appeal brief to the PTAB. Practical application: allows the applicant to argue errors in the examiner's decision. Challenge: limited opportunity to introduce new evidence; reliance on the existing record.

Experimental Use Exception – Related terms: research exemption, non-commercial, infringement. The experimental use exception permits limited use of a patented invention for experimental or research purposes without constituting infringement. Example: A university researcher uses a patented compound to study its pharmacology. Practical application: fosters scientific progress. Challenge: the scope varies by jurisdiction and may not cover commercial research.

Exhaustion (Doctrine of) – Related terms: first sale, patent exhaustion, downstream use. Exhaustion limits the patent holder's rights after the authorized sale of a patented item, preventing control over its resale or use. Example: A patented smartphone sold by the manufacturer exhausts the patent holder's rights, allowing the buyer to resell it. Practical application: facilitates market circulation. Challenge: distinguishing authorized sales from licensing arrangements.

Extension of Time – Related terms: deadline, grace period, USPTO. An extension of time is a request to lengthen a statutory deadline, such as response to an office action. Example: Filing a petition to extend the response period by three months. Practical application: provides flexibility in prosecution schedules. Challenge: extensions may be granted at the examiner's discretion and often require payment of fees.

Family (Patent Family) – Related terms: priority, PCT, national phase. A patent family is a set of patent documents that share a common priority date and disclose the same invention. Example: A PCT application that enters national phases in the US, Europe, and Japan constitutes a family. Practical application: enables strategic global protection. Challenge: managing coordination across jurisdictions and tracking divergent grant statuses.

Fee Schedule – Related terms: maintenance, filing, renewal. The fee schedule outlines the various fees payable to a patent office for filing, examination, and post-grant maintenance. Example: Paying the 3-year

maintenance fee to keep a US patent in force. Practical application: budgeting for patent costs. Challenge: fee increases and differing timelines across jurisdictions can lead to inadvertent lapse.

First-to-File – Related terms: priority, race, filing date. First-to-file awards the patent right to the applicant who first files a complete application, regardless of who was the first inventor. Example: The United States adopted a first-to-file system in 2013. Practical application: encourages prompt filing. Challenge: creates a “race” that may disadvantage small entities lacking resources for rapid filing.

Filing Date – Related terms: priority, effective date, docket. The filing date is the date on which a patent application is officially received by the patent office; it determines the priority for novelty and inventive step analyses. Example: An application filed on 1 January 2024 has that date as its priority. Practical application: establishes the timeline for prior art cutoff. Challenge: ensuring accurate time stamping and avoiding inadvertent early disclosures that could jeopardize novelty.

Foreign Filing License – Related terms: export control, national security, USPTO. In some jurisdictions, inventors must obtain a license before filing abroad, especially when the invention has potential national security implications. Example: A US inventor seeking to file a defense-related patent overseas must secure a foreign filing license. Practical application: compliance with export-control regulations. Challenge: delays and possible denial of the license can impede global protection strategies.

General-Purpose Computer – Related terms: software patent, abstract idea, eligibility. The term refers to a standard computing device that is not specially designed for a particular function, often used in discussions of patent eligibility. Example: Courts may deem a claim directed to a general-purpose computer as abstract unless it provides a specific technical improvement. Practical application: informs claim drafting for software inventions. Challenge: navigating evolving jurisprudence on abstract ideas.

Grace Period – Related terms: public disclosure, priority, US law. A grace period allows an inventor to disclose the invention publicly without losing novelty, provided a patent application is filed within a specified time (e.g., 12 months in the US). Example: Publishing a paper on a new sensor and filing a US application six months later. Practical application: affords flexibility for academic disclosures. Challenge: grace periods are not recognized in many jurisdictions, requiring careful coordination.

Invention Disclosure – Related terms: internal filing, invention reporting, IP management. An invention disclosure is an internal document submitted by an employee or researcher to the organization’s IP department, describing the invention and prompting further action. Example: A scientist submits a disclosure form for a novel catalyst. Practical application: triggers assessment of patentability and commercialization potential. Challenge: ensuring completeness and timely submission to preserve priority.

Inventive Step – Related terms: non-obviousness, obviousness, patentability. Inventive step (or non-obviousness) requires that the invention not be obvious to a person skilled in the art at the filing date. Example: Adding a surprising synergistic effect between two known compounds may satisfy inventive step. Practical application: central hurdle in examination. Challenge: subjective nature; requires robust evidentiary

support such as secondary considerations.

International Search Report (ISR) – Related terms: PCT, prior art, examiner. The ISR is a document generated during the PCT process that lists relevant prior art identified by an International Searching Authority. Example: The ISR for a PCT application cites 30 publications. Practical application: informs applicants of potential obstacles before entering national phases. Challenge: the ISR is not binding; national examiners may find additional prior art.

International Preliminary Examination Report (IPER) – Related terms: PCT, Chapter II, written opinion. The IPER, also known as the International Preliminary Examination Report, provides an opinion on the patentability of the invention after a Chapter II demand. Example: The IPER suggests claim amendments to overcome lack of inventive step. Practical application: helps applicants refine claims before national filings. Challenge: additional costs and time; not all applicants elect Chapter II.

International Publication (WO) – Related terms: PCT, 18-month rule, public disclosure. The International Publication, designated WO, is the publication of a PCT application 18 months after the earliest priority date. Example: WO 2023/123456 is published on 1 July 2023. Practical application: provides worldwide notice of the invention and establishes prior art. Challenge: early publication may affect subsequent confidentiality agreements.

Inventor – Related terms: co-inventor, attribution, ownership. The inventor is the natural person who actually conceives the invention. Example: A software engineer who devises a new encryption algorithm. Practical application: correct inventorship is required for valid grant; mis-attribution can lead to invalidation. Challenge: distinguishing between conceptual contribution and mere implementation.

Joint Research Agreement (JRA) – Related terms: collaboration, ownership, IP clause. A JRA is a contract between two or more parties that outlines the terms of collaborative research, including IP ownership and licensing. Example: Two universities sign a JRA to develop a joint vaccine platform. Practical application: clarifies rights to resulting inventions. Challenge: negotiating equitable ownership and future commercialization pathways.

Laboratory Notebook – Related terms: record keeping, evidence, inventorship. A laboratory notebook documents experimental procedures, data, and observations, serving as evidence of conception and reduction to practice. Example: A chemist's bound notebook with dated entries. Practical application: supports claims of priority and inventorship disputes. Challenge: maintaining contemporaneous, tamper-evident records.

License Agreement – Related terms: royalty, exclusivity, cross-license. A license agreement grants permission to use, manufacture, or sell a patented invention under specified terms. Example: A biotech company licenses a patented antibody to a pharmaceutical firm for \$5 million upfront plus royalties. Practical application: monetizes IP assets. Challenge: drafting clear scope, field-of-use restrictions, and enforcement mechanisms.

Limitation (Patent Term) – Related terms: duration, expiration, 20-year rule. The limitation of a patent is the period during which exclusive rights are enforceable, typically 20 years from the filing date for utility patents. Example: A patent filed on 1 January 2020 expires on 1 January 2040. Practical application: timing of product launch and licensing strategies. Challenge: maintaining the patent through timely payment of maintenance fees.

Litigation – Related terms: infringement suit, declaratory judgment, settlement. Patent litigation involves legal actions to enforce or defend patent rights, including infringement suits and validity challenges. Example: A company files a suit alleging infringement of its patented nanotech coating. Practical application: protects market share and deters competitors. Challenge: high costs, lengthy timelines, and uncertainties of court rulings.

Maintenance Fee – Related terms: renewal, annuity, lapse. Maintenance fees are periodic payments required to keep a granted patent in force. Example: In the US, maintenance fees are due at 3, 7, and 11 years after grant. Practical application: ensures continued exclusivity. Challenge: missed payments result in automatic lapse, potentially losing valuable rights.

Non-Obviousness – Related terms: inventive step, obviousness, secondary considerations. Non-obviousness is the legal standard that an invention must not be obvious to a skilled artisan, based on prior art, at the time of filing. Example: Combining two known devices in an unexpected way may satisfy non-obviousness. Practical application: central criterion for patent grant. Challenge: requires persuasive arguments and evidence such as commercial success.

Novelty – Related terms: newness, prior art, absolute novelty. Novelty requires that the invention be entirely new; no single prior art reference may disclose all elements. Example: A prior publication that teaches the same chemical composition destroys novelty. Practical application: early search to avoid rejection. Challenge: hidden disclosures, such as conference presentations, can jeopardize novelty.

Office Action – Related terms: examiner communication, response, amendment. An office action is a written communication from a patent examiner indicating objections or rejections. Example: A non-final office action citing lack of inventive step. Practical application: triggers a response deadline and possible amendment. Challenge: interpreting examiner language and crafting effective replies.

Opposition – Related terms: third-party challenge, post-grant, European Patent Office. Opposition is a procedure allowing third parties to challenge the validity of a granted patent within a set time frame, typically nine months after grant. Example: A competitor files an opposition to a newly granted pharmaceutical patent. Practical application: provides a post-grant avenue to invalidate weak patents. Challenge: opposition proceedings can be costly and require substantive evidence.

Patent Cooperation Treaty (PCT) – Related terms: international filing, national phase, Chapter II. The PCT provides a unified filing procedure for seeking patent protection in multiple jurisdictions. Example: An applicant files a PCT application to later enter US, EP, and JP national phases. Practical application:

streamlines global filing and defers costs. Challenge: managing the transition from international to national stages and differing substantive requirements.

Patent Eligibility – Related terms: statutory subject matter, abstract idea, 35 U.S.C. 101. Patent eligibility determines whether a claimed invention falls within the categories of patentable subject matter defined by law. Example: A method of data analysis may be ineligible if deemed an abstract idea without an inventive concept. Practical application: guides claim drafting to avoid ineligible subject matter. Challenge: evolving case law creates uncertainty, especially for software and biotech inventions.

Patent Family (Continuation Family) – Related terms: parent, child, lineage. A continuation family consists of a parent application and all continuations, continuations-in-part, and divisionals derived from it. Example: A parent US application generates three continuations and two divisionals, forming a family. Practical application: allows strategic claim pursuit across multiple filings. Challenge: tracking priority dates and ensuring consistent disclosure.

Patent Pending – Related terms: provisional, pending status, notice. “Patent pending” indicates that an application has been filed but not yet granted. Example: A product label displays “Patented technology – Patent pending.” Practical application: deters copying and signals forthcoming protection. Challenge: does not confer enforceable rights until grant.

Patent Prosecution – Related terms: examination, amendment, appeal. Patent prosecution encompasses all interactions with the patent office from filing to grant or abandonment. Example: Responding to office actions, filing amendments, and appealing rejections are part of prosecution. Practical application: effective prosecution can secure broader claims. Challenge: requires strategic planning, timely responses, and cost management.

Patent Portfolio – Related terms: asset management, licensing, strategic filing. A patent portfolio is a collection of patents owned by an entity, representing its technological assets. Example: A telecom company maintains a portfolio of patents covering 5G standards. Practical application: portfolios are leveraged for cross-licensing and defensive strategies. Challenge: maintaining relevance, avoiding orphaned patents, and aligning with business goals.

Patent Search – Related terms: prior art search, novelty search, freedom-to-operate. A patent search investigates existing patents and publications to assess novelty, inventive step, and potential infringement. Example: Conducting a freedom-to-operate search before launching a new product. Practical application: informs filing strategy and risk assessment. Challenge: databases may be incomplete; search quality depends on skill and resources.

Patent Term Extension (PTE) – Related terms: regulatory delay, supplemental protection certificate, USPTO. PTE compensates for time lost during regulatory approval, extending the effective patent term. Example: A pharmaceutical patent receives a 5-year extension after FDA approval. Practical application: prolongs market exclusivity for drugs. Challenge: eligibility criteria vary, and extensions are limited to specific industries.

Patent Troll (NPE) – Related terms: non-practicing entity, litigation, licensing. A patent troll is an entity that acquires patents solely to enforce them through licensing or litigation, without manufacturing products. Example: An NPE sues multiple startups for alleged infringement of a broad software patent. Practical application: NPEs can generate revenue from licensing. Challenge: they are criticized for stifling innovation and imposing costly settlements.

Patentability Search – Related terms: novelty search, prior art, patentability opinion. A patentability search focuses on identifying prior art that may affect the novelty or inventive step of an invention. Example: Searching scientific literature for similar gene editing techniques before filing. Practical application: helps determine whether to proceed with filing. Challenge: incomplete searches can lead to unexpected rejections.

Patentable Subject Matter – Related terms: statutory categories, exclusions, 35 U.S.C. 101. Patentable subject matter refers to the categories of inventions that statutes allow to be patented, such as processes, machines, manufactures, and compositions of matter. Example: A new alloy is patentable subject matter, whereas a mathematical formula alone is not. Practical application: informs claim drafting to stay within permissible categories. Challenge: distinguishing abstract ideas from technical applications.

Prior Art – Related terms: background art, references, public use. Prior art comprises all information made available to the public before the filing date that may be relevant to the patentability of an invention. Example: A conference presentation disclosing a similar sensor design constitutes prior art. Practical application: used by examiners to assess novelty and inventive step. Challenge: identifying hidden disclosures and international publications.

Provisional Application – Related terms: temporary filing, 12-month period, priority. A provisional application is a lower-cost filing that secures a priority date without a formal claim set. Example: An inventor files a provisional for a new battery chemistry and later files a full utility application within 12 months. Practical application: provides early filing while allowing additional development time. Challenge: must convert to a non-provisional within the deadline; failure results in loss of priority.

Public Disclosure – Related terms: publication, presentation, prior art. Public disclosure is any communication of the invention to the public, including publications, presentations, or sales. Example: Publishing a research article before filing can destroy novelty in many jurisdictions. Practical application: inventors must control disclosures before filing. Challenge: coordinating with academic collaborators and managing timing of conference abstracts.

Reexamination – Related terms: post-grant review, re-issue, invalidation. Reexamination is a proceeding where a patent's validity is reconsidered by the patent office, often initiated by a third party. Example: A competitor requests reexamination of a granted patent alleging prior art. Practical application: can narrow claims or confirm validity. Challenge: the process can be lengthy and may lead to unexpected claim changes.

Reference – Related terms: prior art, citation, examiner's document. A reference is any document cited during examination to assess patentability. Example: A European examiner cites a US patent as a reference. Practical application: references help define the scope of protection. Challenge: managing numerous references and addressing each objection.

Restriction Requirement – Related terms: unity of invention, divisional, election. A restriction requirement is an examiner's demand that an application be limited to a single invention; the applicant must elect one invention to pursue. Example: An examiner issues a restriction requirement separating a device claim from a method claim. Practical application: forces filing of divisionals for unselected inventions. Challenge: strategic election and potential loss of coverage.

Royalty – Related terms: license fee, percentage, payment schedule. A royalty is a recurring payment made by a licensee to a patent holder for the use of patented technology. Example: A 5 % royalty on net sales of a product incorporating a patented component. Practical application: provides ongoing income from IP. Challenge: negotiating fair rates and monitoring compliance.

Search Report – Related terms: examiner's search, ISR, prior art. A search report lists the prior art found by the examiner and is issued with the first office action. Example: The USPTO issues a search report citing three publications. Practical application: informs the applicant of potential obstacles. Challenge: the search may be incomplete; applicants often conduct independent searches.

Specification – Related terms: description, enablement, claims. The specification is the written description of the invention, including background, summary, detailed description, and drawings. Example: The specification of a pharmaceutical patent describes the synthesis route, formulation, and dosage. Practical application: must enable a skilled person to practice the invention and support the claims. Challenge: providing enough detail without revealing trade secrets and avoiding new matter.

Standard Essential Patent (SEP) – Related terms: FRAND, standards body, licensing. An SEP is a patent that claims technology essential to a standard, such as 4G or Wi-Fi, and must be licensed on fair, reasonable, and non-discriminatory (FRAND) terms. Example: A patent covering a key LTE modulation scheme. Practical application: SEPs are crucial for industry interoperability. Challenge: disputes over FRAND rates and injunctions.

Statutory Bar – Related terms: loss of rights, prior public use, grace period. A statutory bar is a legal provision that prevents patentability if certain conditions are met, such as a public use before filing. Example: In the US, a public use more than one year before filing creates a bar. Practical application: drives careful timing of disclosures. Challenge: differing bars across jurisdictions complicate global strategies.

Substantive Examination – Related terms: search, office action, patentability. Substantive examination evaluates the merits of the application, including novelty, inventive step, and compliance with statutory requirements. Example: An examiner conducts substantive examination after the search report is issued. Practical application: determines grant or rejection. Challenge: responding to substantive objections can be

resource-intensive.

Supplemental Examination – Related terms: post-grant, correction, USPTO. Supplemental examination allows a patent owner to request correction of the record after grant, often to mitigate inequitable conduct allegations. Example: The owner files a request to correct an omitted best-mode statement. Practical application: can strengthen enforceability. Challenge: limited to certain types of errors; cannot be used to add new subject matter.

Survival Period – Related terms: post-grant, challenge, re-examination. The survival period is the time frame after grant during which certain post-grant proceedings, such as opposition or re-examination, may be initiated. Example: In Europe, opposition can be filed within nine months of grant. Practical application: provides a window for third parties to contest validity. Challenge: timing constraints require rapid action.

Technical Effect – Related terms: inventive concept, software patent, eligibility. The technical effect refers to a concrete, technical