# INTELLECTUAL PROPERTY GLOSSARY

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## A

**Abandoned application:** An application that has been declared abandoned is "dead" and no longer pending. Abandonment occurs under several circumstances. The most common reason is when the USPTO does not receive a response to an Office action letter from an applicant within 6 months from the date the Office action letter was mailed. Another instance is when the USPTO does not receive a statement of use (or request for an extension of time to file a statement of use) from an applicant within 6 months from the issuance of a Notice of Allowance). Applications abandoned for failure to respond to an Office Action or a Notice of Allowance can be revived or reinstated in certain circumstances.

**Abstract:** A concise statement of the technical disclosure including that, which is new in the art to which the invention pertains.

**Amendment:** A change in any part of a patent application made after it is filed. Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with §1.52, directing that specified amendments be made. Amendments are made to correct accidental entry, answer an office action by a United States Patent and Trademark Office Examiner, to correct excess claims, abandonment, after all claims allowed to modify either the body of the application or drawings.

**Anticipation:** A condition that exists when claimed invention is not novel in view of the prior art. To anticipate a claimed invention, a prior art reference must teach every element of the claim.

**Annuity:** An annual fee that must be paid to most patent offices to maintain a patent in force. In the U.S., the fee is called a maintenance fee.

**Attorney:** (May be referred to as a practitioner or representative) - an individual who is a member in good standing of the bar of any United States court or the highest court of any State and who is registered to practice before the Office.

**Art:** All subject matter (patents, publications, uses, etc.) bearing on the novelty and nonobviousness of a claimed invention.

**Application (patent):** A nonprovisional utility patent application must include a specification, including a claim or claims; drawings, when necessary; an oath or declaration; and the prescribed filing fee.

**Applicant:** Inventor or joint inventor who are applying for a patent on his or her own invention, or the person who is applying for a patent in place of the inventor.

**Appeal:** A request that a higher authority (in a patent office or a court) review an adverse patentability decision by an Examiner. In the USPTO, an appeal is first taken to the Board of Patent Appeals and Interferences. An applicant who wants to contest a final refusal from an examining attorney may file an appeal to the Trademark Trial and Appeal Board. An appeal is taken by filing a Notice of Appeal and paying the appeal fee within six months of the mailing date of the action from which the appeal is taken.

**Appeal, Notice Of:** A written communication to a patent office indicating that an adverse patentability decision by an Examiner will be appealed.

**Absolute Novelty:** A requirement of some patent offices (but not the USPTO) that public disclosure or sale of an invention anywhere in the world cannot occur prior to the filing of a valid patent application.

**Author:** This is the person who actually created the work or, if the work was made for hire, the employer or other person for whom the work was prepared.

**Arbitrary Marks:** Comprise words that are in common linguistic use but, when used to identify particular goods or services, do not suggest or describe a significant ingredient, quality or characteristic of the goods or services (e.g., APPLE for computers; OLD CROW for whiskey).

**Application (Trademark):** A document by which a person requests a federal trademark registration. To receive a filing date, an application must include (1) the applicant's name, (2) a name and address for correspondence, (3) a clear drawing of the mark sought to be registered, (4) a list of the goods or services, and (5) the application filing fee.

## B

**Background of the Invention:** A section of a patent application pointing to the pertinent prior art and how the instant invention relates to the prior art.

**Bar:** A destruction of an action or a claim in law

**Best Mode:** A third requirement of the first paragraph of 35 U.S.C. 112 is that: The specification . . . shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Biological Material:** Material that is capable of self-replication either directly or indirectly. Representative examples include bacteria, fungi including yeast, algae, protozoa, eukaryotic cells, cell lines, hybridomas, plasmids, viruses, plant tissue cells, lichens and seeds. Viruses, vectors, cell organelles and other non-living material existing in and reproducible from a living cell may be deposited by deposit of the host cell capable of reproducing the non-living material.

**Board of Appeals:** An adverse decision of a patent examiner is subject to review by the Board of Appeals, which is formed from a panel of members that includes the Commissioner of Patents, the deputy commissioner, the assistant commissioners, and examiners-in-chief. At least three members of such panel must hear each appeal. As a general rule, the Board upholds the decision of the examiner in about seventy per cent (70%) of all cases. This is roughly the same rate as all appeals in all areas of law.

**Berne Convention:** The Convention for the Protection of Literary and Artistic Works, signed at Berne, Switzerland, in 1886, and all acts, protocols, and revisions thereto. The member countries constitute a Union for the protection of the rights of authors in their literary and artistic works. Authors shall enjoy, in respect of works for which they are protected in their own country the same protection in member countries.

**Brand Name:** A name or symbol that identifies a seller's goods or services, and differentiates them from competitors. A trademark may be issued for a product or company brand name

## C

**Canceled Claim:** A claim that is canceled or deleted. "Canceled" is the status identifier that should be used when a claim is canceled in an application.

**CIP (Continuation-in-Part):** An application filed during the lifetime of an earlier nonprovisional application, repeating some substantial portion or all of the earlier nonprovisional application and adding matter not disclosed in the earlier nonprovisional application

**Certificate of Mailing:** A certificate for each piece of correspondence mailed, prior to the expiration of the set period of time for response, stating the date of deposit with the U.S. Postal Service and including a signature

**Claims:** Claims define the invention and are what are legally enforceable. 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. The claim or claims 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. (See § 1.58(a)).

**Claim, Closed:** The preamble of a claim using a phrase such as "consisting of" and of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.

**Claim, Dependent:** A claim that refers back to and further limits or restricts the breadth of another claim. The other claim may be an independent claim or another dependent claim.

**Claim, Generic:** A claim that describes ("reads on") a generic form of an invention. A generic claim generally reads on all the claimed species of an invention.

**Claim, Independent:** A claim that does not reference (depend from) another claim.

**Claim, Jepson:** A form of a claim with a preamble that describes what is known in the art followed by a transitional phrase such as "the improvement comprising" and then a description of the claimed improvement.

**Claim, Markush:** A form of a claim that allows claiming of members of a finite group by a claim that recites members as being "selected from the group consisting of A, B and C." The members of a Markush group must have at least one property that is akin to the group.

**Claim, Multiple Dependent:** A claim that refers back to and further limits another claim or claims and depends from more than one other claim. The other claims may be referred to in the alternative only.

**Co-Inventor:** An inventor who is named with at least one other inventor in a patent application, wherein each inventor contributes to the conception of the invention set forth in at least one claim in a patent application.

**Common Law Rights:** Property or other legal rights that do not absolutely require formal registration in order to enforce them.

**Composed Of:** Used when defining the scope of a claim. A transitional phrase that is interpreted in the same manner as either "consisting of" or "consisting essentially of," depending on the facts of the particular case.

**Comprising:** A transitional phrase that is synonymous with (means the same thing as) "including," "containing" or "characterized by;" is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. Comprising is a term of art used in claim language, which means that the named elements are essential.

**Consisting Essentially Of:** A transitional phrase that limits the scope of a claim to the specified materials or steps and those that do not materially affect the basic and novel characteristics of the claimed invention. For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent (without) a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed (understood) as equivalent to "comprising."

**Consisting Of:** A transitional phrase that is closed (only includes exactly what is stated) and excludes any element, step, or ingredient not specified in the claim.

**Continuation:** A second application for the same invention claimed in a prior nonprovisional application and filed before the first application becomes abandoned or patented.

**Convention (PCT):** The PCT convention operates as a "holding pattern" to preserve rights in designated countries for a specified time. Comprised of different countries than the EPC except in such instances where a country belongs to both conventions.

**Collective Work:** A work, such as a periodical issue, anthology, or Encyclopedia, in which a number of contributions, constituting separate independent works in themselves are assembled into a collective.

**Compilations and Abridgments:** Compilations and abridgments may be copyrightable if they contain new work of authorship. When the collecting of the preexisting material that makes up the compilation is a purely mechanical task with no element of editorial selection, or when only a few minor deletions constitute an abridgment, copyright protection for the compilation or abridgment as a new version is not available.

**Copyright: In general - § 102 of Title 17 of the United States Code**

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) literary works;

(2) musical works, including any accompanying words;

(3) dramatic works, including any accompanying music;

(4) pantomimes and choreographic works;

(5) pictorial, graphic, and sculptural works;

(6) motion pictures and other audiovisual works;

(7) sound recordings; and

(8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

**Copyright Claimant:** The copyright claimant is defined in Copyright Office regulations as either the author of the work or a person or organization that has obtained ownership of all the rights under the copyright initially belonging to the author. This category includes a person or organization that has obtained by contract the right to claim legal title to the copyright in an application for copyright registration.

**Copyright Protection:** Copyright law protects creative expression, not fact, idea system or method of process or operation. Expression may be found in product design, written expression, traditional artistic works, and other original works such as literary, dramatic, musical, and artistic works such as poetry, novels, movies, songs, computer software and architecture. Copyright law prevents copying of expression. Facts and ideas are not protectable under copyright law. Copyright laws protect against copying. The copying does not need to be exact for infringement to be found. A substantial similarity is enough. Independent development is a defense.

**Certification Mark:** Any word, name, symbol, device, or any combination, used, or intended to be used, in commerce by someone other than its owner, to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services, or that the work or labor on the goods or services was performed by members of a union or other organization.

**Counterfeit:** A counterfeit is a spurious mark that is identical with, or substantially indistinguishable from, a registered mark. Counterfeits are infringements, but counterfeits are also subject to criminal penalties and seizure.

**Confidentiality Agreement:** An agreement whereby an organization that has access to information about the affairs of another organization makes an undertaking to treat the information as private and confidential. A potential buyer of a company who requires further information in the process of due diligence may be asked to sign a confidentiality agreement stating that the information will only be used for the purpose of deciding whether to go ahead with the deal and will only be disclosed to employees involved in the negotiations. Such agreements are also used where information is shared in the context of a partnership or benchmarking program.

## D

**Declaration:** Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration. Such declaration may be used in lieu of the oath otherwise required, if, and only if, the declaring is on the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

**Dependent Claim:** A claim that refers back ("depends on") to and further limits a preceding dependent or independent claim. A dependent claim shall include every limitation of the claim from which it depends.

**Disclaimer:** A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer (give up all or part of the owner's rights to enforce claims) of any complete claim , stating therein the extent of their interest in such patent. Such disclaimers are required to be in writing and recorded in the USPTO, and are considered as part of the original patent to the extent of the interest actually possessed by the disclaimant and by those claiming under him. Any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term (from a certain point in time through the projected end of the entire term), of the patent granted or to be granted. There are two types of disclaimers: (1) statutory disclaimer and (2) terminal disclaimer.

**Disclosure:** In return for a patent, the inventor gives as consideration a complete revelation or disclosure of the invention which protection is sought.

**Divisional Application:** A later application for an independent or distinct invention disclosing and claiming (only a portion of and) only subject matter disclosed in the earlier or parent application.

**Double Patenting:** A judicially created doctrine intended to prevent improper time wise extension of a patent right by prohibiting the issuance of claims in a second patent that are not "patentably distinct" from the claims of a first patent. The doctrine prohibits claims in a second patent that are merely an obvious variation of the claims of a first patent. If the patent applicant cannot convince the patent examiner that the claims of the

second patent are not merely an obvious variation of the earlier claims, the remedy is to file a Terminal Disclaimer.

**Drawing:** Patent drawings must show every feature of the invention as specified in the claims. Omission of drawings may cause an application to be considered incomplete but are only required if drawings are necessary for the understanding of the subject matter sought to be patented.

**Derivative Work:** A work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications that, as a whole, represent an original work of authorship, is a "derivative work". The copyright in a derivative work covers only the additions, changes, or other new material appearing for the first time in the work. It does not extend to any preexisting material and does not imply a copyright in that material. One cannot extend the length of protection for a copyrighted work by creating a derivative work. A work that has fallen in the public domain, that is, which is no longer protected by copyright, may be used for a derivative work, but the copyright in the derivative work will not restore the copyright of the public domain material. Neither will it prevent anyone else from using the same public domain work for another derivative work. In any case where a protected work is used unlawfully, that is, without the permission of the owner of copyright, copyright will not be extended to the illegally used part.

**Distribution Rights:** An author, other copyright claimant, or owner of exclusive right(s) can transfer collateral rights to distribute copies or audio recordings to the public by sale, lease, or rental with out giving up the entire right in the intellectual copyright property.

**Descriptive Mark:** A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. If a mark is merely descriptive or deceptively misdescriptive of the goods or services to which it relates, the mark will be refused registration on the Principal Register under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). Examples of descriptive marks include: MEDICAL GUIDE for website services featuring medical guides, DENIM for jeans, and SPICY SAUCE for salsa.

## E

**Enablement:** The specification in a patent application must describe the invention in a manner that would enable one with ordinary skill in the art to make and use the invention without an undue amount of experimentation.

**Exclusive License:** an agreement granted by a patent owner to one party, exclusive right of usage. The licensee is said to "own" the rights granted in the license as long as the licensee holds up to the agreement as stated within the licensing contract.

## G

**Goodwill:** By marketing goods, or providing services under a trademark, the trademark owner acquires certain protectable intangible property rights, referred to as "goodwill." It takes time and effort to build goodwill, and it can sometimes be destroyed overnight. Goodwill becomes associated with the trademark and must be included when the trademark is sold or the transfer is void. However, there is more to transferring goodwill than making a recital, and the business or tangible assets associated with the trademark should be transferred as well. If the purchaser is already in business, then less is required from the assignor. The key is for the public to receive the same quality goods before and after the sale. The responsibility is the buyer has to get whatever assets are required to achieve this goal.

## H

**Harmonization:** Harmonization is the name given to the effort by industry to replace the variety of product standards and other regulatory policies adopted by nations in favor of uniform global standards.

## I

**Independent Claim:** A claim that does not refer back to or depend on another claim.

**Infringement:** Unauthorized making, using, offering to sell, selling or importing into the United States any patented invention.

**Intellectual Property:** Creations of the mind - creative works or ideas embodied in a form that can be shared or can enable others to recreate, emulate, or manufacture them: inventions, literary and artistic work, symbols, names, images and designs used in commerce. There are four ways to protect intellectual property - patents, trademarks, copyrights or trade secrets.

**Inventor:** One who contributes to the conception of an invention? The patent law of the United States of America requires that the applicant in a patent application must be the inventor.

**Information Disclosure Statement (IDS):** For patent applications filed under 35 U.S.C. § 111(a), applicants and other individuals who are substantively involved in preparing or prosecuting a patent application must submit to the Office information which is material

to patentability (could render a claim unpatentable) as defined in 37 CFR § 1.56. The provisions of 37 CFR § 1.97 and 37 CFR § 1.98 provide a mechanism for compliance with the duty of disclosure provided in 37 CFR § 1.56. The IDS must include a list of all patents, publications, U.S. applications, or other information submitted for consideration by the Office. The USPTO provides forms for use in the submission of an IDS, the PTO/SB/08a and PTO/SB/08b.

## L

**License:** A grant of the right to use some intellectual property such as a patent, trademark or copyright. The contractual terms of the agreement usually allow for a payment in the form of a royalty from the grantor/ licensor to the grantee/licensee of the license in exchange for the right to use the intellectual property.

**Lanham Act:** Title 15 of the U.S. Code and contains the federal statutes governing trademark law in the United States. However, this act is not the exclusive law governing U.S. trademark law, since both common law and state statutes also control some aspects of trademark protection.

## M

**Multiple Dependent Claim:** A dependent claim, which further limits and refers back in the alternative to more than one preceding independent or dependent claim. Acceptable multiple dependent claims shall refer to preceding claims using the terms "or, any one of, one of, any of, either." A multiple dependent claim may not depend on another multiple dependent claim, either directly or indirectly. b

**Madrid Protocol:** The "Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks" (Madrid Protocol) is an international treaty that allows a trademark owner to seek registration in any of the countries that have joined the Madrid Protocol by filing a single application, called an “international application.”

## N

**Non-Disclosure Agreement:** A contract in which the parties promise to protect the confidentiality of secret information that is disclosed during employment or another type of business transaction.

**Novelty:** 35 USC 102 establishes requirements for patentability. An invention must be new, useful and non- obvious. If it is not new it lacks novelty.

**Nullity:** Something that may be treated as nothing, as if it did not exist or never happened. This can occur by court ruling or enactment of a statute.

## O

**Oath:** A swearing to tell the truth, the whole truth and nothing but the truth, which would subject the oath-taker to a prosecution for the crime of perjury if he/she knowingly lies in a statement either orally in a trial or deposition or in writing. The Director may by rule prescribe that any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration in such form as the Director may prescribe, such declaration to be in lieu of the oath otherwise required. Whenever such written declaration is used, the document must warn the declarant that willful false statements and the like are punishable by fine or imprisonment, or both.

**Objections:** If the form of the claim (as distinguished from its substance) is improper, an "objection" is made by the examiner. If the substance of the claim is in question it is rejected.

**Obviousness:** An invention is patentable if it would not have been obvious to one of ordinary skill in the art at the time the invention was made.

**Office Action:** An official communication from a patent office.

**Omnibus Claim:** Some applications are filed with an omnibus claim, which reads as follows: A device substantially as shown and described. This claim should be rejected under 35 U.S.C. 112, second paragraph because it is indefinite in that it fails to point out what is included or excluded by the claim language.

**Ordinary Skill in the Art:** The "hypothetical 'person having ordinary skill in the art' to which the claimed subject matter pertains would, of necessity have the capability of understanding the scientific and engineering principles applicable to the pertinent art

**Owner Of Exclusive Rights:** Under the law, any of the exclusive rights that make up a copyright and any subdivision of them can be transferred and owned separately, even though the transfer may be limited in time or place of effect. The term "copyright owner" with respect to any one of the exclusive rights contained in a copyright refers to the owner of that particular right. Any owner of an exclusive right may apply for registration of a claim in the work.

## P

**Provisional Patent Application:** A provisional application for patent is a U. S. national application for patent filed in the USPTO under 35 U.S.C. §111(b). It allows filing without a formal patent claim, oath or declaration, or any information disclosure (prior art) statement. It provides the means to establish an early effective filing date in a non-provisional patent application filed under 35 U.S.C. §111(a) and automatically becomes abandoned after one year. It also allows the term "Patent Pending" to be applied.

**Prosecution:** The process of making amendments, statements, arguments, and representations to the USPTO for the purpose of obtaining a patent is usually referred to as patent prosecution.

**Prior Art:** Prior art references include any source from anywhere such as patents, publications and the like. If there is prior that teaches, motivates or suggests an invention the invention is not patentable

**Paris Convention:** The Paris Convention, established as a result of the efforts of inventors and industrialists, is an example of an attempt at uniform treatment of trademark owners and international trademark law. The initial objective of the convention was "the creation of a union which, without encroaching on the municipal law of the contracting countries, would lay down a number of general principles securing the interests of industrial property in the interior of a country as well as abroad." Ladas, Stephen P., Patents, Trademarks, and Related Rights, National and International Protection, Harvard University Press, 1975, p. 63.The two key principles set by the Paris Convention are the right of national treatment (Article 2) and the right of priority (Article 4). The right of national treatment obligates each country to which the Convention applies ("countries of the Union") to accord to the nationals of all other countries of the Union treatment no less favorable than the treatment it accords to its own nationals. The right of priority permits applicants to claim the benefit of a filing date (called the priority filing date) in one Paris country with regard to applications filed in another country of the Union within the applicable period. This permits the applicant to avoid the effects of actions that may have occurred subsequent to the priority filing date.

**Patent:** A property right granted by the Government of the United States of America to an inventor “to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States” for a limited time in exchange for public disclosure of the invention when the patent is granted.

**Patent And Trademark Office (USPTO):** The PTO promotes industrial and technological progress in the United States and strengthens the national economy by: Administering the laws relating to patents and trademarks; Advising the Secretary of Commerce, the President of the United States, and the administration on patent, trademark, and copyright protection; Advising the Secretary of Commerce, the President of the United States, and the Administration on the trade-related aspects of intellectual property. The United States Patent and Trademark Office (USPTO or Office) is the government agency responsible for examining patent applications and issuing patents. A patent is a type of property right. It gives the patent holder the right, for a limited time, to exclude others from making, using, offering to sell, selling, or importing into the United States the subject matter that is within the scope of protection granted by the patent. The USPTO determines whether a patent should be granted in a particular case. However, it is up to the patent holder to enforce his or her own rights if the USPTO does grant a patent.

**Patent Application:** A non-provisional utility patent application must include a specification, including a claim or claims; drawings, when necessary; an oath or declaration; and the prescribed filing fee.

**Patent Application Publication:** Pre-Grant Publication of patent application at 18 months from priority date.

**Patent Disclosure:** The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Patent Pending:** A phrase that often appears on manufactured items. It means that someone has applied for a patent on an invention that is contained in the manufactured item. It serves as a warning that a patent may issue that would cover the item and that copiers should be careful because they might infringe if the patent issues. Once the patent issues, the patent owner will stop using the phrase "patent pending" and start using a phrase such as "covered by U.S. Patent Number XXXXXXX." Applying the patent pending phrase to an item when no patent application has been made can result in a fine.

**Publication:** The distribution or disclosure in a form, which is readily accessible or distributed to the public of copies, audio recordings or any creative work.

**Proprietor:** An individual, corporation, partnership, or other entity, as the case may be, that owns an establishment or a foodservice or drinking establishment, except that no owner or operator of a radio or television station licensed by the Federal Communications Commission, cable system or satellite carrier, cable or satellite carrier service or programmer, provider of online services or network access or the operator of facilities therefore, telecommunications company, or any other such audio or audiovisual service or programmer now known or as may be developed in the future, commercial subscription music service, or owner or operator of any other transmission service, shall be under any circumstance be deemed to be a proprietor.

**Petition To Revive An Application:** A formal request for the USPTO to return an abandoned application to active status. These petitions are handled by the Office of the Commissioner for Trademarks, and must be received in the USPTO within two (2) months from the issue date of the notice of abandonment. The standard used for deciding a petition to revive is unintentional delay, that is, whether the applicant’s delay in responding to an Office action or Notice of Allowance was unintentional. There is currently no form for filing a petition to revive.

**Principal Register:** When applications are filed on the Principal Register, there is automatic statutory notice. This precludes anyone from adopting and using the mark in

good faith. Also, marks on the Principal Register can become incontestable after five years of continuous use. When a registration becomes incontestable, it cannot be attacked based on prior use or descriptiveness. Finally, marks on the Principal Register are presumed to be valid.

## Q

**Quality Control:** If the goods or services are provided directly by the trademark owner, quality control is inherent, because the owner purchases the raw materials, manufactures the products, and does the design work, advertising, and marketing. If a wholly owned subsidiary is involved, control by the parent is assumed. If a trademark is used by an affiliate or licensee, there should be a formal license agreement. The affiliate or licensee produces and markets the goods, and the owner exercises quality control by setting standards and performing inspections. The owner should have control over the mark on paper and also exercise actual onsite control.

## R

**Reissue:** An application for a patent to take the place of an unexpired patent that is defective in one or more particulars.

**Rejection:** The examiner reads the application to make a determination if the claims should be accepted or rejected. I n order to make this decision the examiner should understand the claimed invention and then make a prior art search for the claimed invention. With the results of the prior art search, including any references provided by the applicant, the patent application should be reviewed and analyzed in conjunction with the state of the prior art to determine whether the claims define a useful, novel, nonobvious, and enabled invention that has been clearly described in the specification. The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. The examiner then reviews all the evidence, including arguments and evidence responsive to any rejection, before issuing the next Office action. Where the examiner determines that information reasonably necessary for the examination should be required from the applicant, such a requirement should generally be made either prior to or with the first Office action on the merits.

**Reverse Engineering:** The art of extracting know-how or knowledge from an article of manufacture or a composition of matter to determine of how to make or use it

**Registration:** In general, copyright registration is a legal formality intended to make a public record of the basic facts of a particular copyright. However, registration is not a condition of copyright protection. Even though registration is not a requirement for

protection, the copyright law provides several inducements or advantages to encourage copyright owners to make registration.

**Registered Mark:** A mark may be considered to be a trademark without being registered. To achieve "registered" status a trademark owner must file the mark, symbol or designating emblem with the USPTO according to their guidelines and pay the registration fee.

**Renewals:** Trademark registrations last as long as they are maintained. Renewal is required every ten years. The owner pays a fee and provides proof of use during the six-month period before the expiration of the term, or by paying an additional fee, within three months after the expiration date. If the renewal is not made, the registration will lapse. However, this does not mean the trademark is abandoned. If the mark is still in use, the party will still have common law usage rights. If desired, the same or another party can register, since trademarks, unlike patents, are recyclable, and rights can be created anew.

## S

**Scope:** What is included in the claim; as in the scope of a claim.

**Skill In The Art:** Where no single prior art patent discloses the functional subject matter or appearance of an invention, a government patent examiner will frequently argue that someone with ordinary skill in the art is already in possession of the cumulative information and knowledge shown in two or more patents, and that person will then know how to combine the knowledge of these several prior art patents so as to make the subject invention “obvious” and therefore unpatentable. In resolving the obviousness issue, the law requires that the invention was non-obvious to an individual with ordinary “skill in the art” at the time the invention was made. Thus, the law creates a hypothetical "skilled mechanic" with the knowledge of the entire pertinent prior art in the world. The question, then, is whether the prior art references, considered individually or collectively, contain sufficient teaching, suggestion or motivation, such that the inventive subject matter would have been obvious to a person “skilled in the art” at the time the invention was made.

**Status:** The official condition of a patent or application. The status of an application is defined by action and time. The status of a patent is often referred to as new, rejected, amended, Allowed or in Issue, Abandoned, Incomplete, Abandonment for Failure to Pay Issue Fee, lapsed, pending, protected, expired, re-issued and the like. "Status Letters" or inquiries as to the status of applications by persons entitled to the information, can be directed to the USPTO.

**Statutory Bar:** Any public disclosure, publication or offer for sale of an invention more than one year before a patent application is filed will serve as a Statutory Bar to obtaining

a patent. Any sale of the invention or publication or disclosure of the invention before a United States patent application is filed will destroy the possibility of obtaining foreign patent protection in most foreign countries.

**Service Mark:** A word, name, symbol or device that is to indicate the source of the services and to distinguish them from the services of others. A service mark is the same as a trademark except that it identifies and distinguishes the source of a service rather than a product. The terms "trademark" and "mark" are often used to refer to both trademarks and service marks.

**Term Of A Patent:** Subject to the payment of fees as mandated by the United States Patent and Trademark Office, a patent grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications, from the date on which the earliest such application was filed. A design patent has a term of fourteen (14) years from the date of grant.

**Trade Secret:** Information that companies keep confidential to give them an advantage over their competitors. Also referred to as proprietary information or confidential information.

**Transfer of Copyright Ownership:** An assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation of a copyright or any other of the exclusive rights comprised in the copyright, whether or not it is limited in time or place of affect, but not including nonexclusive license.

**Treaty Party:** A country or intergovernmental organization other than United States that is a party to an international agreement.

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## U

**Unfair Competition:** A legal action addressing different forms of competition that illegally interfere with the legitimate commercial interests of competitors in the marketplace. It covers such diverse activities as passing off, false advertising, commercial disparagement, misappropriation, trademark dilution, trademark infringement and theft of trade secrets. The modern-day legal action for “unfair competition” has developed from the common-law action for “unfair competition” that sought relief against a competitor because of misrepresentation of the source of goods or services.

**Utility:** 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.

**United States Copyright Office (USCO):** An organization operating under the Library of Congress "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries" (U.S. Constitution, Article I, Section 8).

**Visual Art Works:** A painting, drawing, print or sculpture, existing in a single copy, and the Limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, and multiple casts, carved, or fabricated sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author; or a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or a limited edition 200 copies or fewer are signed and consecutively numbered by the author. Copyright registration is available for pictorial, graphic, or sculptural work, including 2-dimensional and 3-dimensional work of fine, graphic, and applied art. A work of visual art does not include any poster, map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work, book, magazine, newspaper, periodical, data base, electronic information service, electronic publication, or similar publication; any merchandising item or advertising, promotional, descriptive, covering, or packaging material or container; any work made for hire; or any work not subject to copyright protection under the copyright statute.

## W

**WIPO:** The WIPO Copyright Treaty concluded in Geneva, Switzerland on December 2, 1996.

References

1. http://www.patenthome.com/patent_terms001.htm

2. http://dictionary.law.com/

3. http://dictionary.reference.com/browse/IP

4.http://www.legalhelpmate.com/legal-dictionary-result.aspx?legal=Intellectual-Property-Issues

5. http://www.sice.oas.org/dictionary/IP_e.asp

6. http://www.hg.org/law-dictionary.html