

Patent glossary

Glossary

Accepted/acceptance:	Refers to the status of a patent application which has been examined by the receiving office (in New Zealand, the Intellectual Property Office of New Zealand or IPONZ) and given conditional approval. The application will then typically be advertised in the Patent Office Journal for a brief period to enable third parties to lodge an objection to grant (known as an opposition).
Annuity:	See Renewal Fees
Anticipation:	<p>An invention is said to have been anticipated if it has been disclosed or used by others before the patent application priority date, or disclosed by the inventor or applicant more than 12-months before the complete specification filing date.</p> <p>Under current New Zealand legislation, anticipation of a patent application can occur by either prior publication or prior use.</p> <p>“Published” means available to the public. A document will be deemed available to the public if it can be inspected as of right at any place by members of the public (upon payment of a fee or otherwise), including in libraries of Government departments and public institutions/authorities.</p> <p>“Prior use” means use in a public manner except by an applicant within 12 months of the complete application filing date.</p> <p>There are certain exceptions to prior publication and prior use under New Zealand legislation.</p>
Apparatus:	A term often used in a patent claim to define a physical device or piece of equipment in a non-limiting sense.
Application:	In most jurisdictions patent applications are subjected to an examination process to determine whether the subject matter is novel and inventive. The terms “application”, “pending” or “patent application” are used to describe the status of the application up to grant.
Assignee:	The party receiving a legal transfer of rights (from the assignor).
Assignment:	The legal transfer of rights from one party (assignor) to another party (assignee). In many cases a specific assignment document is required to register the transfer of rights with a patent office.
Assignor:	The party legally transferring rights (to the assignee).
Claims:	Numbered paragraphs at the end of a patent complete specification which define the scope of the invention protected by the patent. The purpose of the claims is to define clearly and with precision the monopoly for which protection is sought so that others

	know the exact boundaries of protection.
Commercialisation/commercially worked /commercial dealings:	Refers to the process of introducing a new product or service to the marketplace (whether in New Zealand or overseas). For the purposes of a patent application commercial working can include taking orders for a product or service (even if in confidence). It is important to understand that commercial working of an invention before a patent application is filed may invalidate that patent application (see validity below).
Complete specification:	A document which contains a complete written description of the invention which the applicant seeks to protect. Under current New Zealand practice the complete specification must end with one or more claims defining the scope of the invention. To be valid it must also contain sufficient details to enable a skilled reader to put the invention into practice and disclose the best method for implementing the invention known to the patent applicant at the time the application is filed. It is the complete specification which is subjected to the examination process. A complete specification is generally filed 1 year after filing a provisional specification.
Deed of Assignment:	See Assignment.
Deed of Letters Patent:	The official document which is issued when a patent application has been granted as a patent. This document gives the patentee the exclusive rights to make, sell, use or import the invention described in the patent.
Disclosure:	<p>Refers to the description of the invention provided in the specification accompanying a patent application. For a patent to be valid, the invention must be described in enough detail to enable a person who is skilled in the field of the invention to put it into practice.</p> <p>Refers to making an invention known publicly through any means. This can include publication of the details of the invention or public use. Great care should be taken with disclosing an invention prior to filing a patent application because it may affect the validity of the granted patent. New Zealand has a grace period for public disclosure by an inventor or applicant within 12-months of the filing date of a New Zealand complete patent application. However, in general, any disclosure prior to filing should be avoided.</p>
Divisional application	Refers to a patent application that is split out from another application. The original is referred to as a 'parent application'. A patent is only allowed to protect one invention. If an application is deemed by IPONZ to relate to more than one invention then a divisional application can be filed so applications for each invention can be pursued. In New Zealand, a divisional application can also be used to extend the time by which the application must be accepted.
Examination:	The process by which the receiving office (in New Zealand this is the Intellectual Property Office of New Zealand or IPONZ) determines whether the subject matter of a patent application discloses a valid invention and is patentable. Under current New Zealand law the examiner will ensure that the subject matter meets the definition of "invention" and is novel. Under legislation proposed to be introduced in late 2010, examination will determine whether the subject matter is novel, involves an inventive step, is useful and is not excluded subject matter.

Execute/executed:	Completion of a document by the party or parties to which the document relates to legally validate the document. Usually includes signing and dating (often in front of a witness).
Extension/extension of time	Deadlines given to respond to matters in a patent prosecution can often, but not always, be extended. Obtaining an extension to a deadline may be useful for a number of reasons, including to delay costs or to keep competitors in the dark as to your intentions. Your IP advisor can tell you what extensions are available for any given deadline.
Formalities	Formalities refer to the compulsory documentation required by a country's Patent Office during a patent prosecution. This includes any necessary forms, fees and authorisations that must be submitted with an application. Formalities are said to be complete once all appropriate documentation/information has been submitted.
Freedom to operate:	Typically used in respect of a search performed on granted patents or pending patent applications to determine if a product or process infringes any of the claims. If the search determines that there are no relevant granted patents then someone may be said to have freedom to operate (ie to operate a business making and selling the product or using the process). Pending patent applications may affect freedom to operate in the future if granted. Note that the search may be expanded to include registered designs.
Grant/granted patent:	Refers to the status of an application which has proceeded through examination, acceptance and publication to grant. At grant, the Deed of Letters Patent issues and it is possible to assert patent rights against third parties.
Infringement:	Refers to the commission of a prohibited act with respect to a patented invention without permission from the patentee. In New Zealand, the Deed of Letters Patent confers on the patentee a monopoly to make, use, vend or exercise the invention in New Zealand. Performing any of these acts without the permission of the patentee will amount to an infringement if the patent is current and in force. Permission will typically be granted in the form of a license. Remedies for infringement can include an injunction to restrain further infringement, payment of damages suffered by the patentee as a consequence of the infringement or payment by the infringer of any profit he/she/it made by virtue of the infringement, and legal costs.
Intellectual property/IP:	Refers to the ownership of an intangible thing – the innovative idea behind a new technology, product, process, design or plant variety, and other intangibles such as trade secrets, goodwill and reputation, and trade marks. Although intangible, the law recognises intellectual property as a form of property which can be sold, licensed, damaged or trespassed upon. Intellectual property encompasses patents, designs, trade marks and copyright.
Intellectual Property Office/IPONZ:	The Intellectual Property Office of New Zealand. IPONZ (formerly called the Patent Office) is a Government agency that is part of the Ministry of Economic Development and is responsible for the examination, granting/registration and administration of registrable intellectual property rights such as patents, designs and trade marks.
International phase:	Refers to part of the process of filing a PCT application. In the international phase a PCT application is assessed for patentability by an international examiner and the applicant is given the opportunity to make amendments. During this phase the PCT application is effectively pending in all countries that have signed up to the PCT. See also National phase.

Invention:	The product of the creative process of inventing. In intellectual property law “invention” is a legal term usually describing patentable subject matter. Under current New Zealand legislation that subject matter includes any manner of manufacture which is new and involves an inventive step. However, certain types of invention are excluded from patentability. They include inventions which are contrary to morality (for example weapons of mass destruction) and methods of medical treatment (on public policy grounds that such methods should be available for health practitioners to use to the benefit of all society).
Inventive step:	A legal term to describe a non-obvious improvement over known technologies. In New Zealand, inventive step is currently tested by asking two questions. First, is the claimed invention different from what is already known and/or used in New Zealand (i.e. is it novel or has it been anticipated, refer to anticipation above). Second, is that difference non-obvious to a skilled person in the same field of technology? Both questions will need to be answered ‘yes’ for there to be inventive step.
Inventor:	The developer of an invention. In the field of intellectual property the word “inventor” is a legal term to describe the person (or group of people) who made the inventive step to arrive at the invention. It is important to understand that this will not necessarily be the person who developed the invention to proof of concept or prototype stage. If the concept itself is inventive then the inventor will be the person who conceived the concept. Ascertaining the correct inventor(s) is important as he or she will need to be named in any patent application and there could be adverse consequences for omitting an inventor or adding someone who is not a true inventor.
IP advisor	The bloody excellent team at James & Wells Intellectual Property.
Lapse:	For a granted patent to remain in force, regular renewal fees (sometimes called maintenance fees or annuity fees) need to be paid. If these fees are not paid the rights given by a patent will no longer be enforceable; the patent is said to have lapsed. Once a patent lapses, anyone is free to use the invention described. However, renewal fees can sometimes be paid late so it is possible for a lapsed patent to be revived.
Licence:	A legal document granting another party permission to use an invention that is the subject of a granted patent. The details of a licence depend on the arrangement agreed by the parties, but normally a licence fee and/or royalties will be payable.
Monopoly:	A patent grants the patentee a monopoly in the invention that is the subject of the patent. The monopoly extends to the exclusive rights to make, sell, use or import the invention.
National phase:	Refers to part of the process of filing a PCT application. After the international phase a PCT application enters the national phase which begins when patent applications are filed in each country protection is required in. The advantage of filing a PCT application is that this step can be delayed by up to 18 months. Examination of the application will then proceed in each country separately. Some countries will base examination on the assessment performed by the PCT examiner.
Novelty/novel:	One of the requirements for patentability and the first part of the test for inventive step. In patent law “novel” simply means new or not previously known. New Zealand currently has a “local novelty” requirement for patentability. This means that the

subject invention will not be novel (and therefore will not be patentable) if it was known or used in New Zealand before the date on which the application for a patent was filed. There is a proposal to amend our legislation in late 2010 to move to an "absolute novelty" standard. This means that the subject matter must not be known or used anywhere in the world before the date of application in New Zealand. If the subject matter is known or used before the date of application, this is known as "anticipation", refer to anticipation above.

Obviousness/obvious:	For a New Zealand patent to be valid, it must not be obvious, and must involve an inventive step, over known technologies. See novelty, anticipation and inventive step for further details.
Opposition/opposition period:	<p>In New Zealand, once a patent application has been accepted, it will be published in the Intellectual Property Office Journal. There is then a three month period where the application may be objected to (or opposed), by a third party. If no opposition is made the patent application will proceed to grant.</p> <p>Any party that has an interest in the subject matter of the patent can oppose acceptance. The grounds that can be used to oppose a patent application include lack of novelty, lack of inventive step and insufficient disclosure of the invention. Not all countries have an opposition period on patent applications. For country specific information, contact your IP advisor.</p>
Opposition proceedings:	<p>An opposition proceeding involves the submission of arguments and supporting evidence from both the applicant and the opponent and may be resolved in a hearing.</p> <p>Once an opposition has been lodged against a patent application, the parties involved will present arguments to the Commissioner of Patents. The Commissioner will determine, based on the evidence and arguments presented by both sides, whether or not the patent application will proceed to grant. Opposition proceedings may run from a few months to several years.</p>
Owner:	A legal term to describe a person entitled to make an application for a patent. In New Zealand this includes any person claiming to be the true and first inventor, the assignee of the inventor, or the legal representative of a deceased inventor or his/her assignee.
Patent:	A proprietary right in an invention which provides the owner with an exclusive right for up to 20 years to make, sell, use or import the invention. In exchange for this monopoly the patent is published so that others can see how the invention works and build on that knowledge. The patented invention may also be used by the public once the patent lapses.
Patentability:	The extent to which an invention is able to satisfy the legal requirements to be the subject of a granted patent. This is dependent on those aspects of the invention for which protection is sought, as defined by the claims of a patent application. In general, the claims of a patent must include at least one feature that is novel, involves an inventive step and is useful to be patentable. A patent search can be carried out to assess whether an invention is patentable in view of known technology.
Patentee:	The party to which the rights of a granted patent are given. In other words, the owner of a patent. The patentee may be the inventor(s) of the invention or the party to whom rights in the invention have been assigned.

PCT / PCT application:	The Patent Co-operation Treaty is an international law treaty establishing a single procedure for filing a patent application in many countries. During the international phase of the application it is assessed for patentability by an international examiner and the application can be amended as a result. After the international phase is the national phase, in which applications are filed and examined in individual countries in which protection is required. Filing a PCT application delays the filing of multiple individual applications in many countries by up to 18 months. Not every country is a member of the PCT so you should always check with your IP advisor.
Pending:	See Application.
Prior art:	The collective term for information (documents and prior used products, processes etc) that has been made available to the public before a given date that might be relevant to the novelty of the subject matter of a patent application.
Priority date:	The date at which the novelty and obviousness of a patent application are assessed. Typically, this is the earliest date of filing, although if an application is amended the priority date can only be the earliest date of filing if the contents of the application remain consistent with the contents when it was first filed. Generally it is better to have as early a priority date as possible to reduce the amount of prior art that could affect the novelty of the invention.
Prosecute/prosecution:	The carrying out of a legal proceeding. The prosecution of a patent application refers to the process of filing the documents constituting the application and the process of examination of the application.
Provisional specification:	A document which typically describes an invention in broad terms. Under current New Zealand practice, where a provisional specification is filed, the applicant will have 12 months to file a complete specification which contains a more complete description of the invention and includes one or more claims defining the scope of the invention the applicant seeks to protect. It is this complete specification which is subjected to the examination process.
Publication/Published:	At some point a patent application is published, meaning its contents are available for anyone to read. In New Zealand publication occurs when a patent application is accepted. However, in most countries publication occurs 18 months after the application is filed.
Registrability:	See Patentability.
Renewal fees:	Regular payment is required to maintain a granted patent. In New Zealand, fees must be paid by the 4th , 7th , 10th and 13th year after the filing date. Non-payment of the fees will result in a patent lapsing and rights will be lost. In certain circumstances renewal fees can be paid late.
Revocation:	A procedure in which the validity of a granted patent is contested. Any party that has an interest in the subject matter of the patent can apply to revoke (annul) the patent. Revocation can be applied for at IPONZ or the High Court, depending on the circumstances. A revocation proceeding involves the submission of arguments and supporting evidence from both the patentee and the party seeking revocation and will usually be resolved in a hearing. The grounds that can be used to revoke a granted patent include lack of novelty, lack of inventive step and insufficient disclosure of the invention. The procedure for challenging a patent application is known as an opposition.

Search:	A review of patent databases to look for relevant published patent specifications. Typically the search will be performed with respect to particular jurisdictions. Patent searching can be carried out for a number of reasons. The most common reason is to determine whether a party has freedom to operate in particular countries, in which case the search will only be concerned with patent applications and granted patents which remain in force in those countries. Patent searching may also be conducted to identify relevant prior art which can be used to support a patent opposition/revocation, or by an examiner during examination of a patent application.
Specification:	The document that accompanies a patent application. It defines the scope of the invention in the claims and provides a detailed description of the nature, use and purpose of the invention. A specification may be provisional or complete and there are different rules applying to each.
Useful / Utility:	To be patentable, an invention must be useful. If it is useful it is said to possess utility. In some countries this requirement is expressed as being 'capable of industrial application'. The invention simply needs to have some purpose or achieve something. Generally this purpose must be expressed in the specification.
Validity:	A patent is valid if it is legally enforceable. This means that it must fulfil the criteria of patentability and not be able to be invalidated by a patent revocation proceeding. It is possible that a granted patent may not be valid, or at least its validity could be questionable. Ultimately, only the Courts can judge the validity of a granted patent.