

APPENDIX B

GLOSSARY OF PATENT TERMS¹

The following are definitions for patent terms that you will hear in this case:

Application - The initial papers filed by the applicant in the United States Patent and Trademark Office (also called the Patent Office or PTO).

Claims - The numbered sentences appearing at the end of the patent that define the invention. The words of the claims define the scope of the patent holder's exclusive rights during the life of the patent. Claims can be independent or dependent. An independent claim is self-contained. A dependent claim refers back to an earlier claim and includes the requirements of the earlier claim.

License - Permission to use or make the patented invention, or perform any of the other exclusive rights granted by the patent, which may be granted by a patent holder (or a prior licensee) in exchange for a fee called a "royalty" or other types of payment.

Office Action - Communication from the patent examiner regarding the patent application.

Ordinary Skill in the Art - The level of experience, education, and/or training that those individuals who worked in the area of the invention ordinarily possessed at the time of the effective filing date of the patent application.

Patent Examiners - Personnel employed by the PTO who review (examine) patent applications, each in a specific technical area, to determine whether the claims of a patent application are patentable and whether the specification adequately describes and enables the claimed invention.

¹All glossary terms except "references" are adapted from the NJIP Model Patent Jury Instructions § 1.6 (2009).

Prior Art - Prior art is not art as one might generally understand the word art. Rather, prior art is a technical term relating to patents. In general, it includes things that existed before the claimed invention and might typically be a patent or a printed publication. I will give you a more specific definition of prior art later.

Prosecution History - The written record of proceedings between the applicant and the PTO, including the original patent application and later communications between the PTO and applicant. The prosecution history of the patent may also be referred to as the “File History” or “File Wrapper” during the course of this trial.

References - Any item of prior art used to determine patentability.

Specification - The information that appears in the patent and concludes with one or more claims. The specification includes the written text and the drawings (if any). In the specification, the inventor should provide a description telling what the invention is, how it works, and how to make and use it so as to enable others skilled in the art to do so, and what the inventor believed at the time of filing to be the best way of making the invention.