This topic is presented on behalf of the Section of Intellectual Property Law of the American Bar Association ("ABA"). The views have not been approved by the House of Delegates or the Board of Governors of the ABA and, accordingly, should not be construed as representing the position of the ABA.

Proposal for study: A quality search results in prosecution focused on the invention, shorter timeline to issuance and higher quality issued patents.

Explanation: Initial searches that do not turn up the most relevant references often result in more relevant references found in a later search being applied after one or more office actions. New grounds of rejection relying on the later found references delay prosecution, increase cost to applicants necessitating more amendments and RCE's. Measuring the number of second or later office actions containing new grounds of rejection which apply a new reference when there has been no claim amendment may provide insight into the quality of original searches. The results of measurements of RCE filings may also be indicators. Any correlation between search quality and extended prosecution may identify process changes for search procedures resulting in reduced timelines, decreased costs to applicants, and improved quality of issued claims.

-----

Mike Winkler
Section Director
ABA Section of Intellectual Property Law
321 N. Clark St., 19th Fl.
Chicago, IL 60654
312-988-5639
www.americanbar.org/iplaw
mike.winkler@americanbar.org