

Proposal for Case Study:  
Analysis of Additional Examiner Cited Art Subsequent to First Office Action

Summary:

This study seeks to measure how often new prior art is cited by the Examiner subsequent to the first office action, when no significant changes have been made to the claims. That is, prosecution histories will be examined to determine when during the prosecution the primary art cited against an applicant was first cited, as long as no significant changes to claims have been made. Of particular significance are situations where references previously utilized as primary references in a rejection are no longer utilized in favor of newly cited references. Ideally, applications are also considered where the applicant has made minor but not substantive changes to the claims. Also, if a substantive amendment to the claims is made and the cited art changes between the next office action and a subsequent office action, this will also be considered.

Discussion:

The reason this data is interesting is that it is suggestive that incomplete searches were performed. There may be reasonable explanations in some cases. For example, sometimes this may be because an initial reference is determined to be not prior art to the application due to its priority date. In other cases, arguments made by the applicant may cause the Examiner to have a better understanding of the pending claims. Understanding the timeline of when a reference is first cited in an application would be useful for all parties to get a better understanding of typical prosecution histories. If the frequency of new art is very low, it would give confidence to the practitioner community that original searches are usually sufficient. If the frequency of new art is significant, this may be helpful to the USPTO in pinpointing why the references were not found on an initial search.

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