

To Whom It May Concern:

We propose the USPTO conduct a case study on Examiner practices for searching the nonpatent literature. Examiners seem to have broad discretion on whether NPL is searched. There is a special unit of searchers they can call on to search nonpatent literature should they elect to do so. Perhaps the USPTO could study the issue by looking at the variability in NPL searching and determine differences in outcome to arrive at a recommendation that the examiners could follow to ensure greater thoroughness and consistency. This would result in greater patent quality. Perhaps the study would result in the MPEP being updated to require/strongly suggest that the examiners do or ensure a minimum amount of NPL searching in particular sources. Here are some thoughts on the scope of such a study:

1. Develop statistics by art unit on how frequently NPL references are identified through PTO searching.
2. Develop statistics by art unit on how frequently an NPL reference was relied on for a 102 or 103 rejection.
3. Develop statistics on how frequently claims are rejected based in whole or in part on an NPL reference vs solely based on patent references.
4. Develop statistics from IPR proceedings how frequently patents are invalidated based in whole or in part on an NPL reference vs. those based solely on patent references.
5. Compare the ratios from 3. and 4.
6. Identify and rank technical areas according to whether NPL searching is useful (measured by numbers of NPL references that are cited in examinations).
7. Identify and rank NPL sources according to how frequently they are cited in PTO examinations (could be due to submissions from applicants and/or the result of PTO searching).
8. Consider whether any of the above would suggest changes in the MPEP concerning NPL searching. Consider whether examiners should be required to conduct NPL searching, and if so what are appropriate metrics.

This would make an excellent area for study, aimed at improving the USPTO examination quality for both PCT applications (as an International Searching Authority ISA) and US applications.

Please note that our topic submission is being made personally and may not reflect the views of our employer.

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