

Date: Feb. 8, 2016

To: Mail Stop Comments Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Michael Cyan, Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

From: Andrea C. Walsh, PhD., JD
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Personal View

Title: "Late-stage comprehensive prior art searches conducted under AIA standards to enhance examiner examination and clarify prosecution record."

Proposal for Study: Late-stage prior art searches conducted under AIA standards is an effective means for the applicant to identify relevant prior art to the examiner which was not uncovered in the pre-filing patentability search, and more importantly, reach a mutual understanding regarding the quality and validity of the claims should the examiner grant a patent in view of the art now of record. As sustained by the Federal Circuit, such an opportunity bolsters PTAB determinations in refusing to enforce an invalid patent. Late-stage prior art searches enables the examiner a more efficient and confident prosecution determination. The USPTO should study what effect late-stage prior art search has on applications that are issued as patents to see if the state of the prosecution history file and the reduced number of prior art references available to challengers correlate with with post-grant proceedings, particularly inter partes review. Discovery of such correlations could lead to USPTO and/or applicant process changes in approach to prior art identification throughout prosecution that could improve the overall efficiency and effectiveness of patent procurement and litigation and renew the dignity of the US patent system.

Regards,

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