

O.G. Notice

Executive Summary – Search Template Project

Currently, U.S. patents are sorted into approximately 600 classes based upon technology and subject matter of the claimed invention. A patent examiner is responsible for reviewing prior patent documents, both U.S. and foreign, and other printed literature related to an application's subject matter during the examination process. This review, called the search, is performed by consulting the appropriate classes, and their respective subclasses, in the U.S. classification scheme, other patent document databases, and any other printed media (also known as “non-patent literature” or NPL), which might disclose the invention disclosed/claimed in a pending application for a patent. This search may include the use of various search tools or methodologies in the process. Once the search is performed, the examiner determines the patentability of a claimed invention in light of the prior art uncovered by this search.

When determining the appropriate field of search for an invention, the examiner must consider three sources of information: domestic patent documents, foreign patent documents, and NPL. The current requirements for conducting that search are set forth in the Manual of Patent Examining Procedure (MPEP) section 904.02. An examiner may not eliminate any of these resources from consideration unless the examiner can justify to a reasonable certainty that no more pertinent references will be found in a further search. Although the general guidance set forth in the MPEP is accurate, it provides little information on what resources should be searched, and which of the available search tools or methodologies, for a particular field of subject matter should be consulted. Detailed guidance on the choice and use of specific search tools were left to each Technology Center (see MPEP § 904.02(b)).

The Office is preparing to publish “search templates” for each of the approximate 600 classified areas of science and technology found in the USPTO Manual of Classification. A search template will define the search field and resource areas of general subject matter, classes/subclasses, patent documents (both US and foreign) and NPL that an examiner should consider each time a patent application is examined in that classification area. Additionally, the search template will indicate what search tools or methodologies should be considered when performing the search. These search templates are based upon input from patent examiners and other searchers at the USPTO and represent an attempt to capture their institutional

knowledge of what are the most relevant prior art searches for determining the patentability of subject matter in the area of technology.

In an effort to ensure that each art area has an appropriately structured field of search and search strategy, the Office will begin publishing each of the search templates at an appropriate Internet website so as to gather public feedback on their adequacy and completeness. This website is located at <http://www.uspto.gov/web/patents/searchtemplates/>. The website includes means for submitting comments and the identification of the other resources that could be added to the described field of search and search methodologies. The website also includes criteria by which suggestions for additional resources to be included in the search template will be evaluated. The Office will respond to any comment or suggestion in writing. Through this mechanism, the Office will incorporate public comments and will make adjustments on how to refine each search template. This will not be a one-time event. As technologies evolve, so too will the search templates; and the public will have an on-going opportunity to comment on how to improve them. This process may require several iterations before the contents of these search templates become more settled and complete.

Through this new tool, the Office anticipates patent examiners will be able to focus their searches and will be able to locate the most pertinent prior art in their field when evaluating an application for obviousness or anticipation. It will give more structure and a better standard to measure the completeness of any search. It is also believed the public will benefit because these search templates can be used by applicants for their own pre-examination searches prior to the filing of a U.S. patent application or the submission of a petition to make special based on MPEP § 708.02, subsection VIII. – special examining procedure for certain new applications - accelerated examination. In addition, the USPTO plans to use these search templates for a pilot program to outsource U.S. patent searches for PCT applications.

Prior art searching is a highly unique activity that is dependent upon the knowledge and skills of the individual performing it or reviewing it for completeness and accuracy. The creation and use of these search templates are not intended to limit the professional discretion that any searcher, including patent examiners at the USPTO, employs in performing prior art searches. Rather these search templates are intended to capture the institutional knowledge and expertise of these searchers for the benefit of others who may desire or be required to perform prior art searches in any given technology area. A search is not expected to include a search of all of the listed resources, to use all of the listed tools, or employ all of the listed

search techniques in every prior art search to be performed. Rather by relying upon the information contained in the search templates and the expertise of the individual performing the search, these materials will assist the individual in finding the most relevant prior art for the search being conducted in the art area.

A long-term objective of this effort is to generate discussion, and ultimately consensus, with respect to what should constitute a proper field of search and use of search tools in conducting a search of various subject matter for purposes of an initial examination process in the USPTO. The Office will provide periodic updates on the number of published search templates and the status of the evaluation of public comments.

_____/s/
John J. Doll
Commissioner for Patents

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