Prior Art

Frequently Asked Questions

Search Strategies

1. How does the USPTO train examiners to search?

   During the initial four months of a new patent examiner's career, the examiner receives in-depth topical training in the Patent Training Academy (PTA). Topics include effective use of search tools, review of the classification systems, text search strategies, and Non-Patent Literature (NPL) search strategies. After the initial training, examiners continue to receive extensive coaching from their supervisors and training assistants.

2. How do examiners develop search strategy techniques?

   An examiner begins by reading the specification and claims to understand the invention. Based on their knowledge of the field and their understanding of the invention, the examiner will develop both a list of relevant search terms and a field of search in the classification system. The examiner performs an initial search using classification and a combination of classification and text. The results of this initial search are reviewed and modified to fully search the invention and claimed subject matter. Additionally, the examiner may search various Non Patent Literature (NPL) databases or contact the Scientific and Technical Information Center (STIC) for specialized NPL search assistance. See http://www.uspto.gov/products/library/ptdl/services/step7.jsp for search guidelines and Manual of Patent Examining Procedures (MPEP) chapter 904 "How to Search" at http://www.uspto.gov/web/offices/pac/mpep/index.html.

3. What is a classification search?

   A classification search is a search technique that uses codes from a classification system to retrieve a collection of references for review. The USPTO currently uses several classification systems: the United States Patent Classification (USPC), the International Patent Classification (IPC), and the Cooperative Patent Classification (CPC). Each of these classifications systems has a classification schedule that sorts documents using different criteria. Further information may be found at http://www.uspto.gov/patents/resources/classification/index.jsp.

4. What is a text search?

   A text search is a search technique that uses keywords chosen by the examiner to search patent and NPL databases. Examiners may use a combination of Boolean operators, synonyms, and wildcards to broaden or narrow the results.

5. After receiving response to an Office action, do examiners search again?

   Yes. MPEP 904.03 states that when a response is received an update of the original search shall occur.

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6. What are EAST and WEST? How are they different?

   Examiner's Automated Search Tool (EAST) and Web Examiner Search Tool (WEST) are the two most commonly-used tools used for searching prior art. Typically, an examiner searches a collection of U.S. and foreign patents and patent application publications using EAST and WEST based on a predetermined search strategy and then reviews the references for relevance, as well as any appropriate NPL databases. The examiner may review thousands of references for a given application, tagging any promising references during an initial review and then following up with an in-depth review of the most promising references. Information regarding training for the public using these tools is available at http://www.uspto.gov/products/events/index.jsp.

   o EAST is the search tool most commonly used for patent examination at the USPTO. EAST provides access to U.S. patent applications, U.S. patents dating back to the late 1700's, and selected foreign patent material. In EAST users can perform text and numerical searches and view document results as images or text, and

   o WEST is a web-based alternative to EAST. WEST, like EAST, provides access to U.S. patent applications, U.S. patents dating back to the late 1700's, and selected foreign patent material.

7. What databases are available in EAST/WEST?

   In both EAST and WEST, examiners can search U.S. Patents Full-Text, U.S. Pre-Grant Publication Full-Text, EPO Abstracts, JPO Abstracts, Derwent World Patents Index, IBM Technical Disclosure Bulletin, and U.S. Patents OCR Backfile.

8. What NPL databases are available for examiners to search for software/computer-related inventions?

The following software-related NPL databases are used by examiners to search. This is not an exhaustive list.

- IEEE Xplore
- ACM
- Inspec
- Ei Compendex
- Dissertation Abstracts
- Research Disclosure
- IP.com
- Safari Books
- MathSciNet
- ProQuest
- EBSCOHost
- ScienceDirect

Additional information regarding prior art resources may be found here: http://www.uspto.gov/patents/resources/priorart.jsp.

9. What additional search services are available to examiners?

USPTO's Scientific and Technical Information Center (STIC) provides a variety of prior art information services to examiners. To complement their own prior art searches, examiners can request additional searching from STIC search staff. STIC also provides an extensive collection of foreign patents and NPL, as well as translation services and document delivery services.

10. What resources are available to examiners to enhance their searching skills?

The USPTO provides examiners with a number of in-house resources that enhance their search effectiveness. Some of the in-house training resources include:

- Quality Enhancement Meetings (QEMs) are peer-centered collaborative meetings for examiners of all experience levels to meet, discuss patent applications, and share search strategies,
- The Scientific and Technical Information Center (STIC) hosts 15-minute demos and Lunch & Learn sessions for examiners, providing information on prior art resources such as databases, eBooks, and other search tools. Examiners can also schedule one-on-one

sessions with a Search Strategy Expert (SSE) for assistance with search strategy formulation for a particular application, and

- o Technology Fairs (full day events where invited industry speakers lecture examiners on cutting-edge technologies).

11. How do examiners use International Worksharing programs?

USPTO examiners leverage search results from other Intellectual Property Offices on international family applications to reduce duplication of search efforts and/or enhance their search on the U.S. application. Additional Worksharing resources can be found at http://www.uspto.gov/ip/global/patents/ir_pat_worksharing.jsp

12. How can examiners obtain translations of foreign language documents?

STIC on-site translators offer translation services in 25 languages. External translators are used for additional languages. Machine translations are also available, and patent family searches are used to identify English language family members of foreign applications.

13. Does the USPTO currently use any knowledge management systems?

Yes. The USPTO provides examiners with two internally-developed systems to facilitate capturing, developing, and sharing knowledge collaboratively.

- o NORTH (Online Relational Training Hierarchy) is a Microsoft SharePoint repository that is integrated with the examiner collaboration tools. It is used as a repository where training materials, search strategies, and prior art can be uploaded, accessed, and shared by examiners. NORTH also facilitates "just in time" training/collaboration by promoting the availability of topical experts that are available to provide real-time assistance.

- o E2D2 (Examiner's Electronic Digest Database) is an internal database developed for examiners to capture and share key NPL references. E2D2 contains over 13,000 records and includes art and class-specific keywords, examiner annotations, and U.S. class and subclass information. Resources available through E2D2 include book excerpts, catalogs, handbooks, manuals, journal and newspaper articles, reports, and translated foreign patents.

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14. How do examiners record prior art searches?

"In order to provide a complete, accurate, and uniform record of what has been searched and considered by the examiner for each application, the U.S. Patent and Trademark Office has established procedures for recording search data in the application file. Such a record is of importance to anyone evaluating the strength and validity of a patent, particularly if the patent is involved in litigation." MPEP 719.05. Examiners must record the subclasses, databases, and queries that comprise the search and the dates on which the search was conducted.

15. How can the public access the examiner's search history in an application?

Application file documents, including the examiner's search history, are scanned into the Image File Wrapper (IFW) system as electronic image files. Public users can electronically access those documents belonging to public applications (patents, published applications, and applications to which a patented or published application claims domestic priority) via Public Patent Application and Information Retrieval (Public PAIR). For information on Public PAIR, visit: http://portal.uspto.gov/pair/PublicPair.

Applicants may electronically access documents of their applications via "Private PAIR". For information on Private Pair, visit: http://www.uspto.gov/patents/process/status/private_pair.

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16. What resources are available to the public for searching and learning to search?

The USPTO offers a Public Search Facility at its headquarters in Alexandria, VA that provides public access to patent and trademark information in electronic, microfilm, and print formats. The Public Search Facility also provides training with online examiner search systems including Examiner's Automated Search Tool (EAST), Web Examiner Search Tool (WEST), and Trademark X-Search. Trained staff is also available to help public users. For information on the Public Search Facility, visit: http://www.uspto.gov/products/library/search/index.jsp#heading-3.

The USPTO also offers remote access of patent and trademark references materials through the nation-wide network of Patent and Trademark Resource Centers (PTRCs). For information on PTRCs, visit: http://www.uspto.gov/ptrc.

The public can also search patent data through the USPTO Patent Full-Text and Image Database (PatFT), USPTO Patent Application Full-Text and Image Database (AppFT), Global Patent Search Network (GPSN), the Patent Official Gazette, the Common Citation Document (CCD), the International Patent Offices, the Publication Site for Issued and Published Sequences (PSIPS), and the Patent Assignment Database. For more details, visit http://www.uspto.gov/patents/process/search/index.jsp#heading-3.

17. What are third-party submissions?

The Leahy-Smith America Invents Act (AIA) provides for preissuance submissions by third parties. Any member of the public may file a third-party submission, including private persons and corporate entities. However, the third party may not be the applicant or any individual who has a duty to disclose information with respect to the application under § 1.56. A third party may file any patents, published patent applications, or other printed publications of potential relevance to the examination of a patent application. Further information regarding how and when to submit prior art for a pending application can be found at http://www.uspto.gov/patents/init_events/preissuance_submissions.jsp.

18. How can members of the public help to train examiners?

The USPTO is taking steps to make it easier for experts from industry and academia to provide relevant technical training to examiners by building upon existing programs and creating a regional presence through the opening of our four regional satellite offices:

- o Technical Training Programs
  - The Patent Examiner Technical Training Program (PETTP) seeks volunteer scientists and experts to provide lecturers to patent examiners updating them on technical developments, the state of the art, emerging trends, maturing technologies, and recent innovations in their fields, and

- The Site Experience Education (SEE) Program provides patent examiners the opportunity to visit real-world sites, such as universities or businesses, to learn about new technology and experience how technologies operate in the field. This program seeks to put experts such as innovators, scientists, and engineers together with the examiners at the places where innovation is happening.

  - Regional Satellite Offices
    - The four regional offices in Dallas, Denver, Detroit, and Silicon Valley will be permanent locations for USPTO operations, allowing stakeholders to provide on-site training to examiners in-person or virtually.

For more information on these programs, visit

http://www.uspto.gov/patents/init_events/executive_actions.jsp#heading-7.