

GAO Highlights

Highlights of [GAO-16-479](#), a report to the Chairman, Committee on the Judiciary, House of Representatives

Why GAO Did This Study

USPTO examines patent applications to ensure that inventions are, among other requirements, novel and not obvious. USPTO patent examiners accomplish this by comparing applications to “prior art”—existing patents and applications in the United States and abroad, and nonpatent literature, such as scientific articles. Thorough prior art searches help ensure the validity of granted patents.

GAO was asked to identify ways to improve patent quality through use of the best available prior art. This report (1) describes the challenges examiners face in identifying relevant prior art, (2) describes how selected foreign patent offices have addressed challenges in identifying relevant prior art, and (3) assesses the extent to which USPTO has taken steps to address challenges in identifying relevant prior art. GAO surveyed a generalizable stratified random sample of USPTO examiners with an 80 percent response rate; interviewed experts active in the field, including patent holders, attorneys, and academics; interviewed officials from USPTO and similarly sized foreign patent offices, and other knowledgeable stakeholders; and reviewed USPTO documents and relevant laws.

What GAO Recommends

GAO is making seven recommendations, among them, that USPTO develop a strategy to identify key sources of nonpatent literature, establish goals and indicators for prior art search quality, and collect sufficient information to assess prior art search quality. USPTO concurred with GAO’s recommendations.

View [GAO-16-479](#). To view an e-supplement with data from a survey of patent examiners, see [GAO-16-478SP](#). For more information, contact John Neumann at (202) 512-3841 or neumannj@gao.gov.

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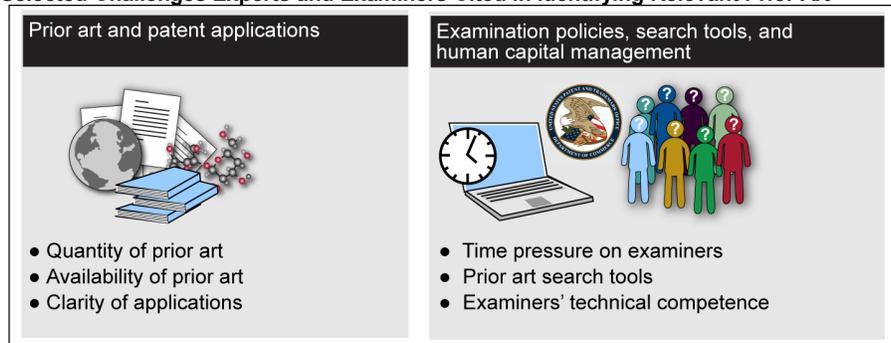
INTELLECTUAL PROPERTY

Patent Office Should Strengthen Search Capabilities and Better Monitor Examiners’ Work

What GAO Found

Experts and U.S. Patent and Trademark Office (USPTO) examiners described a variety of challenges in identifying information relevant to a claimed invention—or “prior art”—that can affect examiners’ ability to complete a thorough prior art search in the time allotted and their confidence in their search efforts. These challenges include, among others, the quantity and availability of prior art, the clarity of patent applications, and USPTO’s policies and search tools.

Selected Challenges Experts and Examiners Cited in Identifying Relevant Prior Art



Source: GAO analysis of interviews with experts and survey of patent examiners. | GAO-16-479

The European Patent Office and Japan Patent Office face similar challenges to USPTO in identifying prior art and use various approaches to help address them, such as leveraging work of other patent offices on related patent applications and integrating nonpatent literature into their search tools. In some cases, these approaches are coordinated with, similar to, or could inform USPTO actions.

USPTO has taken actions to address challenges in identifying prior art, but some actions have limitations. For example, USPTO is in the process of upgrading its search tools. However, examiners will still need to access a variety of external sources to meet USPTO’s requirement to consider nonpatent literature. Federal internal control standards call for controls to evolve to remain effective and USPTO officials noted that the new search system can be expanded to include more nonpatent literature as the European and Japan patent offices have done. However, USPTO does not have a documented strategy for identifying additional sources. Without such a strategy, USPTO cannot be assured that its information technology investment will improve examiners’ searches. USPTO is also taking steps to augment the number of, and consistency with which, reviews of examiners’ work are conducted and documented, which could improve USPTO’s monitoring of examiners’ work. However, USPTO still faces limitations in assessing the thoroughness of examiners’ prior art searches, because, for example, the agency has not established goals or indicators for search quality and may not be collecting sufficient information on examiners’ searches to assess prior art search quality. Without monitoring examiners’ prior art searches, the agency cannot be assured that examiners are searching all relevant sources of prior art and may not be able to develop appropriate responses as called for by federal internal control standards.