

The Path to Higher Quality U.S. Patents for Less Overall Cost

Presenter: Christopher Holt

Applicants commonly assume all pending applications will be similarly handled.



For example, companies assume all pending applications are facing:

- The same likelihood of allowance
- The same amount of time/money required to obtain allowance
- The same likelihood of granting with excellent claim quality
- The same amount of time between prosecution events
- The same likelihood to win on appeal
- Etc.

Few Companies Account for Significant Variability in Examiner Approach

There is a limit to how much control an attorney can have over an examiner's natural tendency to grant claims at a certain rate, quality and frequency.



Examiner A: **Paul A Thatcher**

- Art Unit: **2172**
- Allowance Rate: **5%**
- Average time to allowance:
1 year, 10 months
- Average # of Office Actions:
2.5
- Percent of cases with an appeal cycle: **5%**

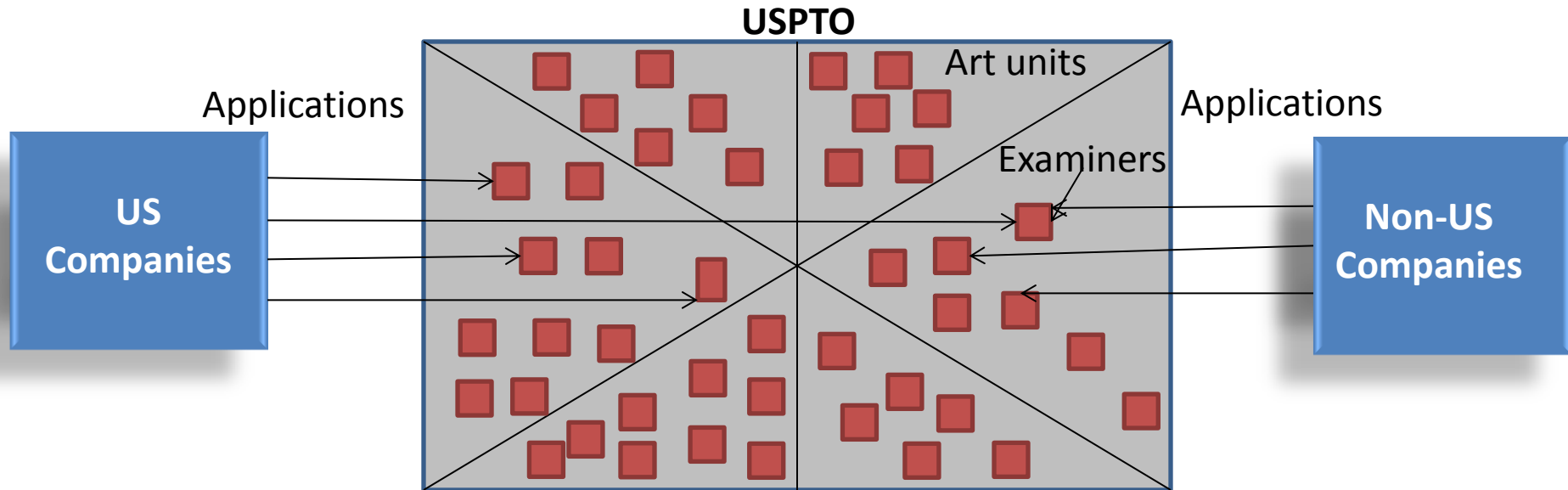


Examiner B: **Matthew Ell**

- Art Unit: **2172**
- Allowance Rate: **58.8%**
- Average time to allowance:
5 years, 4 months
- Average # of Office Actions:
3.4
- Percent of cases with an appeal cycle: **12.3%**

This is significant because two Examiners from the same group will often manage prosecution very differently.

In reality, it is as if there are 8000+ different patent offices in the U.S. instead of just one office.



Each of the 8000+ examiners have:

- A different likelihood of allowance
- A different amount of time/money required to obtain allowance
- A different likelihood of granting with excellent claim quality
- A different amount of time between prosecution events
- A different likelihood to win on appeal
- Etc.



Reduced
Cost

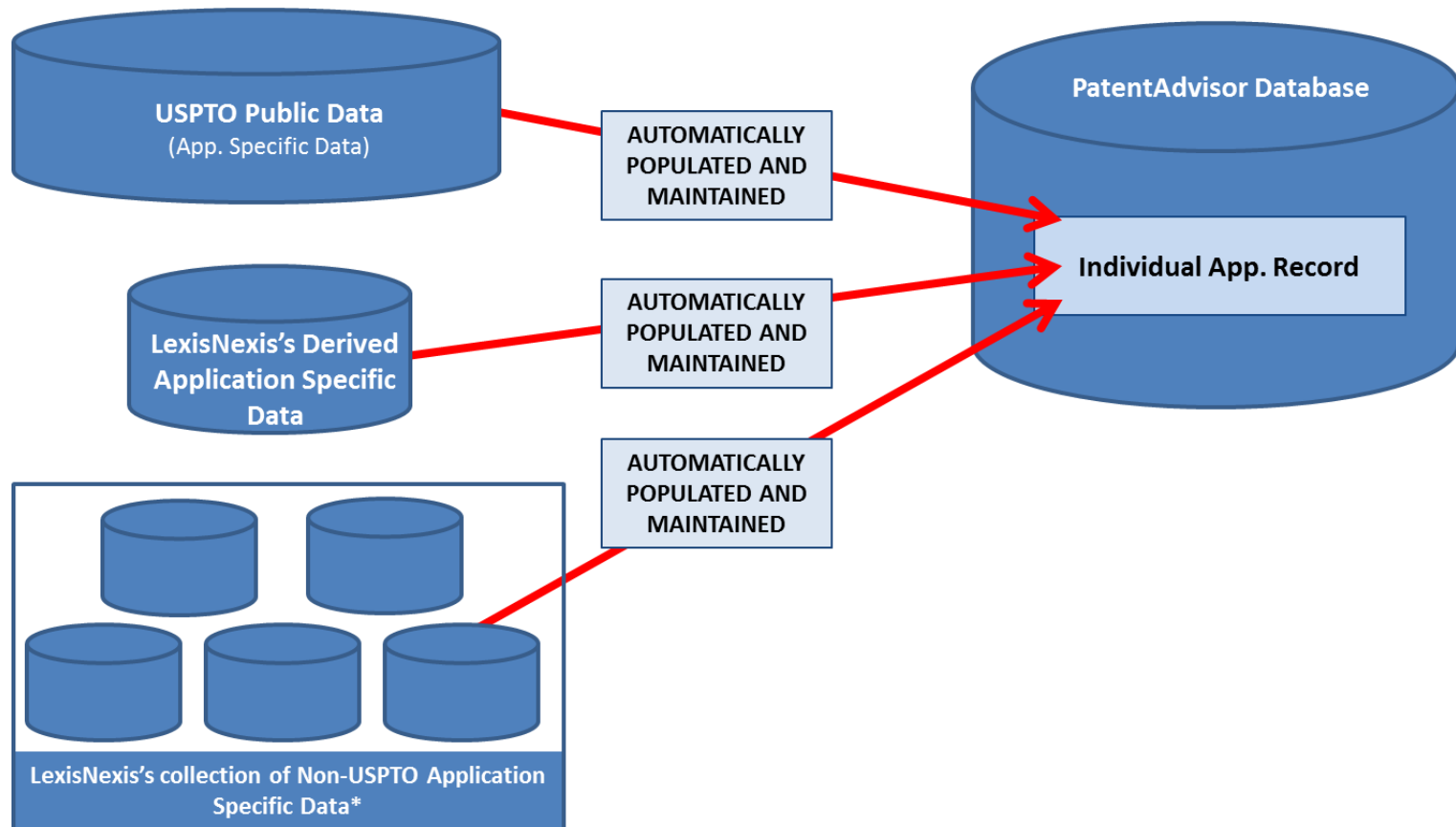
FACT: Adjusting prosecution management to account for patent office variability will enable higher quality U.S. patents for less overall cost.

Increased
Quality



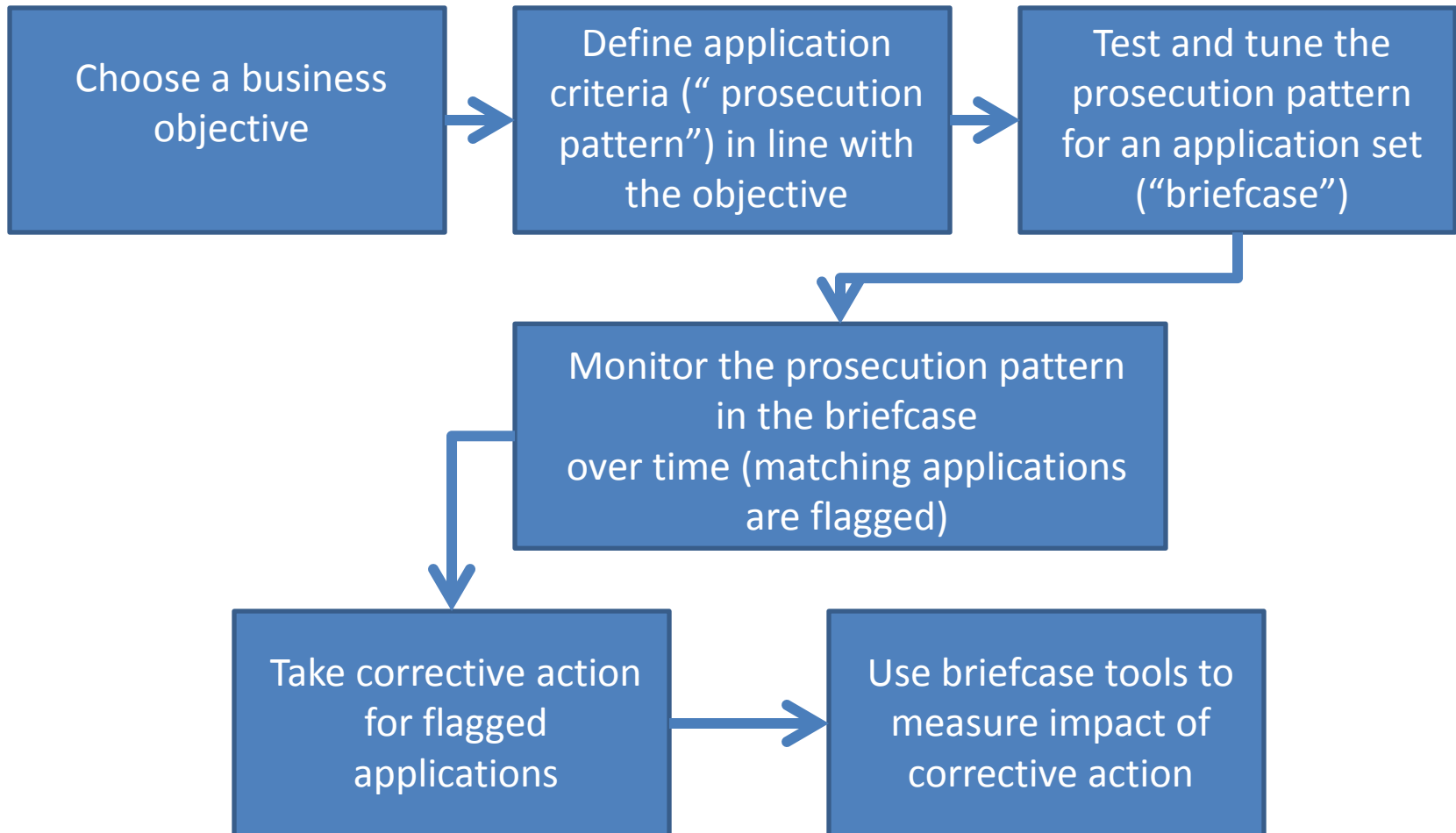
LexisNexis® PatentAdvisorSM Database

PatentAdvisor automatically collects thousands of unique attributes of every published U.S. application.



*foreign patent data, litigation data, economic data, licensing data, valuation data, etc.

PatentAdvisor Prosecution Management Tools: suggested approach



Example Business Objectives:

- Obtain higher quality patents
- Reduce prosecution spend
- Reduce prosecution time
- Compare law firm performance
- Monitor company portfolio
- Monitor competitor portfolios
- Minimize high risk behavior
- Prune portfolio

Example:

Prosecution Pattern Monitoring

APPLICABLE BRIEFCASE

Troller Inc. ▼

NAME

Claims unlikely to change

DESCRIPTION

This monitor flags applications where the Examiner has a high allowance rate and often allows applications without any RCE.

ADD CONDITION

-- choose condition -- ▼

EXAMINER'S ALLOWANCE RATE

Examiner allowance rate is ▼ than %



PERCENTAGE OF APPLICATIONS ALLOWED WITHOUT ANY RCE

Examiner has ▼ than % of applications allowed without any RCE



☐ ACTIVE

SAVE


SAVE AND GO BACK TO LIST

CANCEL

CREATE CLONE

Example:

Monitor the prosecution pattern monitor output over time

 **LG DISPLAY**
LOWALLOWRATE+LONGPROS (CLONE)

Click on headings to sort by column

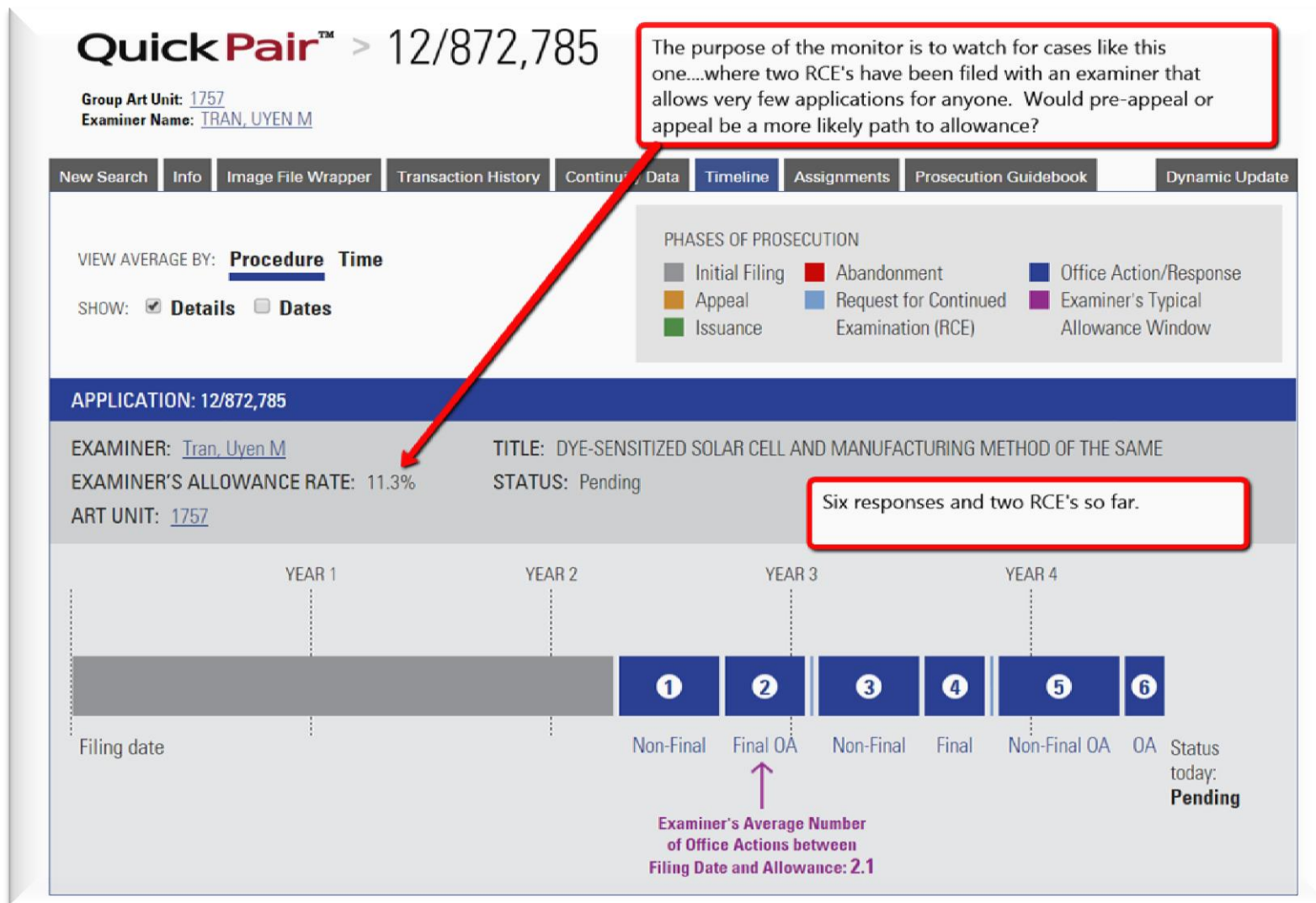
Results: Viewing items 1-4 of 4.

PREVIOUS **1** Next

Application ▾	Google File Number	Trigger date ▾	
12/318,289	n/a	2015-04-15	●
12/119,468	n/a	2015-04-15	●
12/435,717	n/a	2015-04-15	●
13/516,840	n/a	2015-04-15	●

This table of matching apps will be on your home screen after monitor is set. A check is made for new matching apps every few hours.

Take corrective action for applications flagged by the filter



Additional Example: Monitor for competitor activity

Prosecution Pattern Monitoring

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EXAMINER'S ALLOWANCE RATE

Examiner allowance rate is than %



PERCENTAGE OF APPLICATIONS ALLOWED WITHOUT ANY RCE

Examiner has than % of applications allowed without any RCE



☐ ACTIVE

SAVE

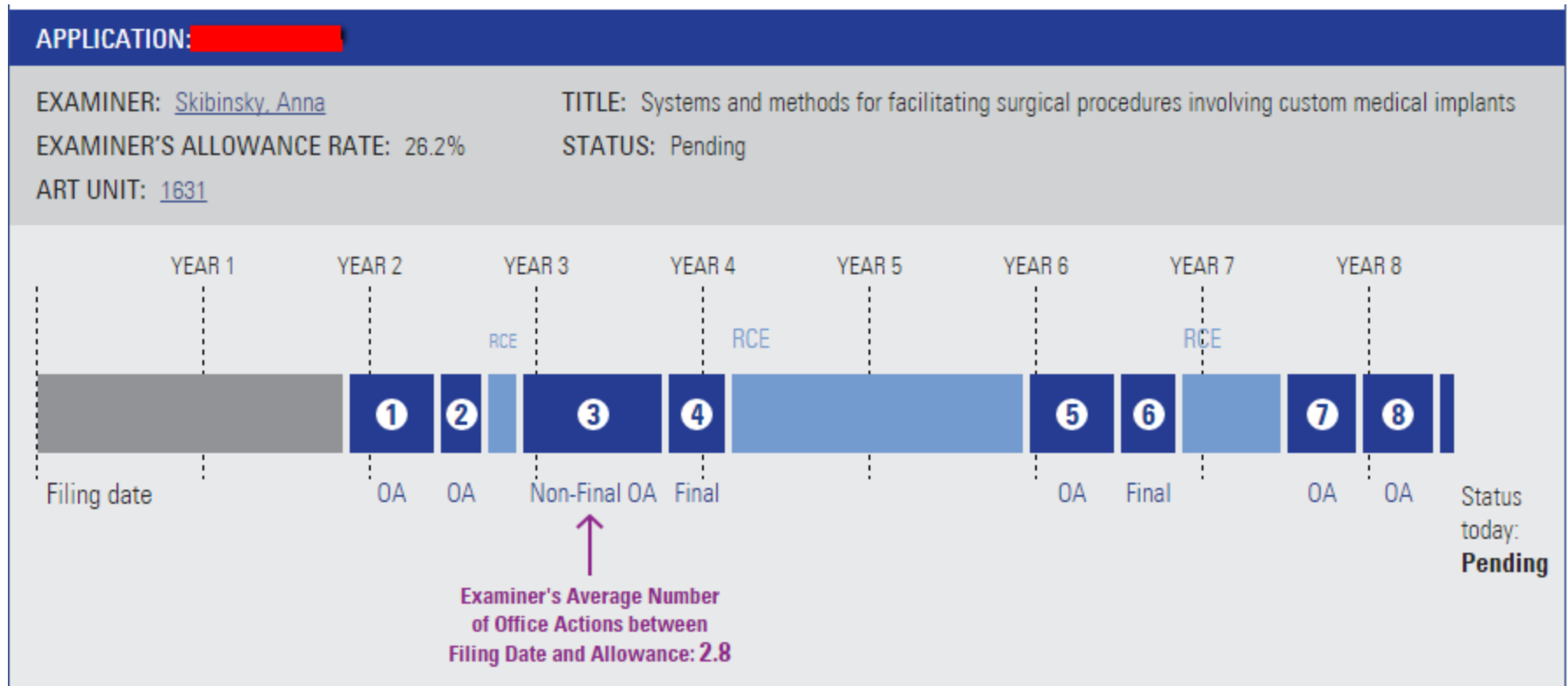
SAVE AND GO BACK TO LIST

CANCEL

CREATE CLONE

Case Study #1: When to Appeal?

Situation: A large U.S. automobile company had a rule that rarely allowed outside counsel to appeal a case. The result was cases like this:



This case had stretched out for 8 years, during which the company had filed 8 Office Action responses and 3 Requests for Continued Examination.

Case Study #1: When to Appeal?

Solution: With PatentAdvisor's help, the company set up a Patent Prosecution Monitor to flag cases where:

- 1) the Examiner had a very low allowance rate, and
- 2) the overall likelihood of winning on appeal was high.

Appeal was permitted for any case flagged by the monitor. For example, a case with the following Examiner could be appealed:

BREAKDOWN OF ANALYZED APPLICATIONS

Allowance rate: 17.1%

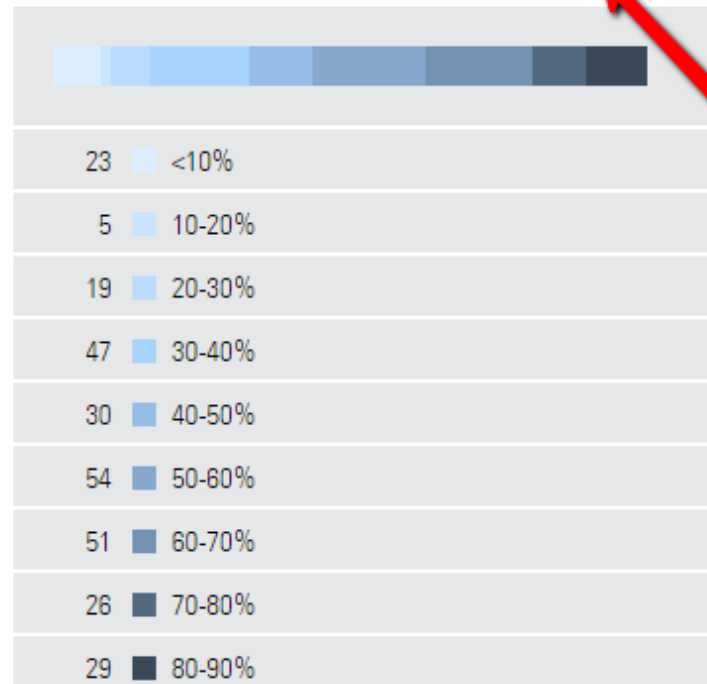
Applications with Electronic File Histories*	
53	Patent Granted Applications
257	Abandoned Applications ⚠
148	Pending Applications
458	Total Applications ⚠

Appeal statistics:

Total Applicant Wins	21
Total Applicant Losses	5

Case Study #2: Ensuring Quality Claims

Situation: An international company hired a U.S. law firm to handle their U.S. patent portfolio. After working with the firm for some time, the company noticed that many of the firm's allowed claims were lengthy and narrow. The company had already set aside a large sum of money for patent prosecution, and had come in under budget in the last calendar year.



High allowance
Examiners can raise a
red flag for low quality
claims

Case Study #2: Ensuring Quality Claims

Solution: With PatentAdvisor's help, the company set up a Patent Prosecution Monitor to flag cases that were likely to be allowed, but with low quality claims. Specifically, the monitor flagged cases where:

- 1) the Examiner had a high allowance rate, and
- 2) The Examiner's allowed claims are typically lengthy (e.g., over 150 words)

For any case flagged by the monitor, the law firm was instructed to draft broader claims and to expend additional resources to ensure that the claims stay broad throughout prosecution.

Case Study #3: When to Interview?

Situation: A major law firm had a policy of interviewing every U.S. case with the Examiner after every Office Action. However, they discovered that while the interviews were very helpful in some cases, in others the interview did not appear to make any difference.

Solution: PatentAdvisor set up a PPM to monitor every case handled by the law firm and flag cases where:

- 1) the Examiner had a high allowance rate, and
- 2) the Examiner often allowed cases without requiring an RCE.

Such Examiners are usually willing to work quickly with Applicants to bring cases to allowance. Therefore, interviews were conducted only for cases flagged by the monitor.

Case Study #3: When to Interview?

Prosecution Pattern Monitoring

APPLICABLE BRIEFCASE

Troller Inc. ▼

NAME

Interview Candidates

DESCRIPTION

ADD CONDITION

-- choose condition -- ▼

LIMIT TO APPLICATIONS BY STATUS

Limit to Pending ▼ cases only



EXAMINER'S ALLOWANCE RATE

Examiner allowance rate is more ▼ than 60 %



PERCENTAGE OF APPLICATIONS ALLOWED WITHOUT ANY RCE

Examiner has more ▼ than 50 % of applications allowed without any RCE



☐ ACTIVE