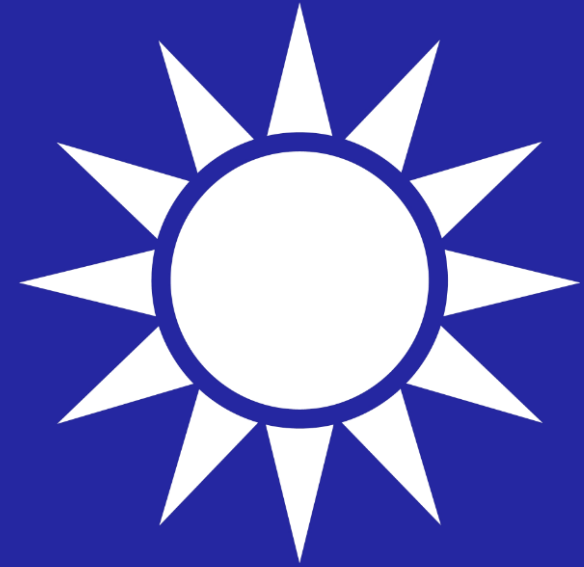


Proven Strategies for Leveraging USPTO Outcome Predictability to Optimize Patent Prosecution Management



Taiwan

Proven Strategies for Leveraging USPTO Outcome Predictability to Optimize Patent Prosecution Management

SOUTH

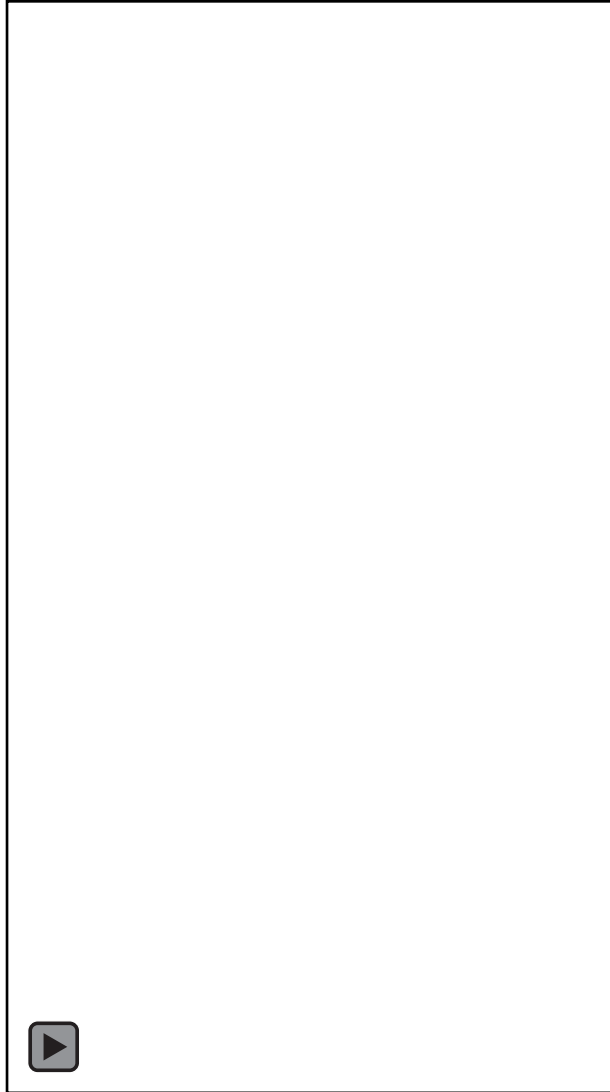


KOREA

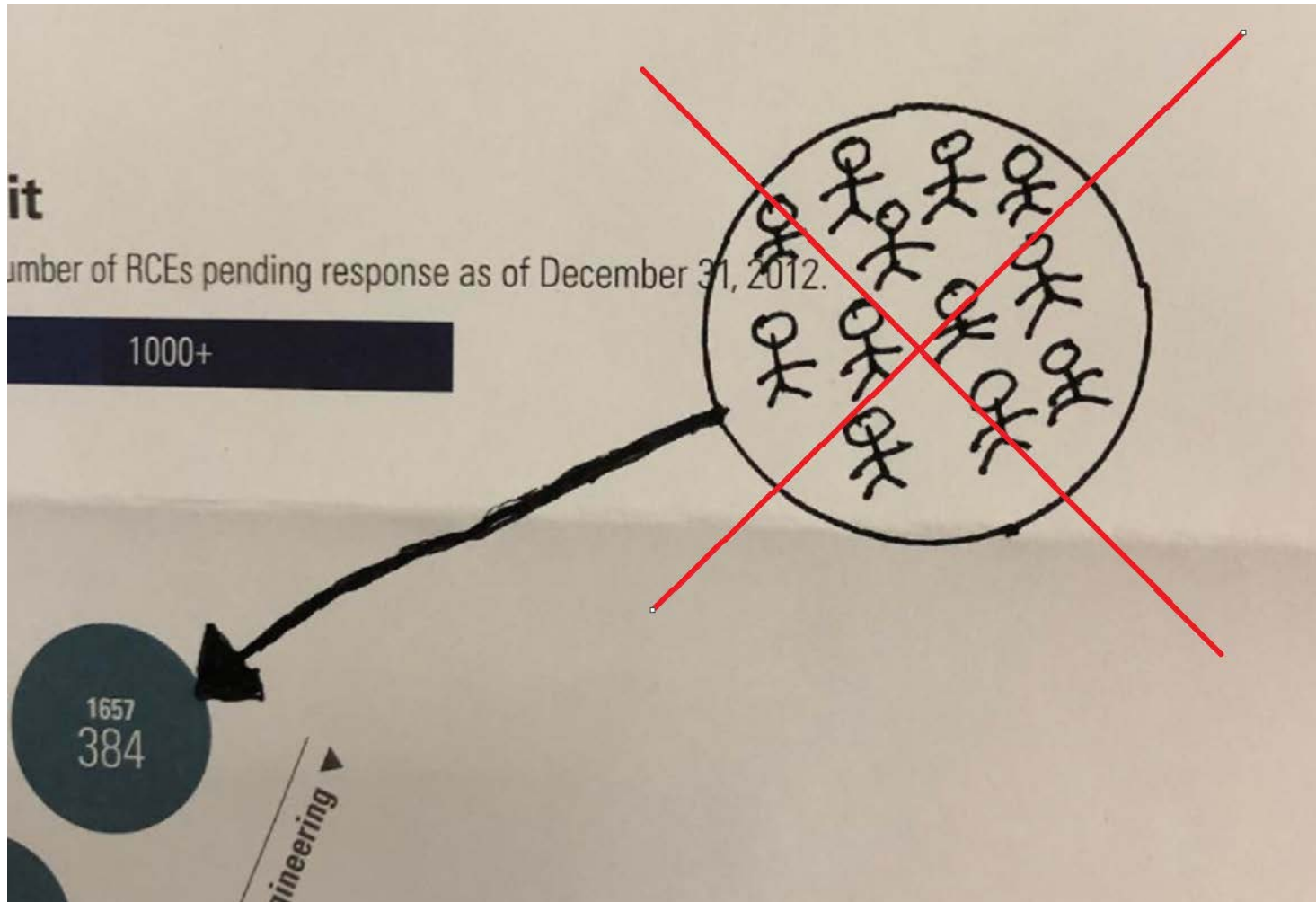
The USPTO BIG Picture



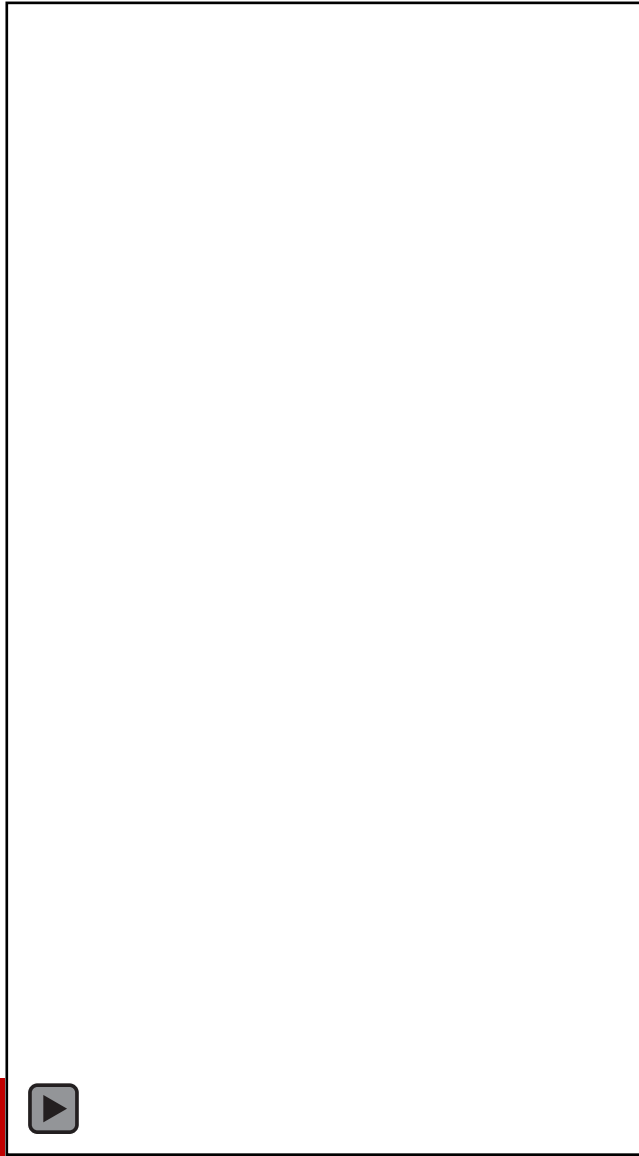
MISTAKE = Expecting Consistency within an Art Unit



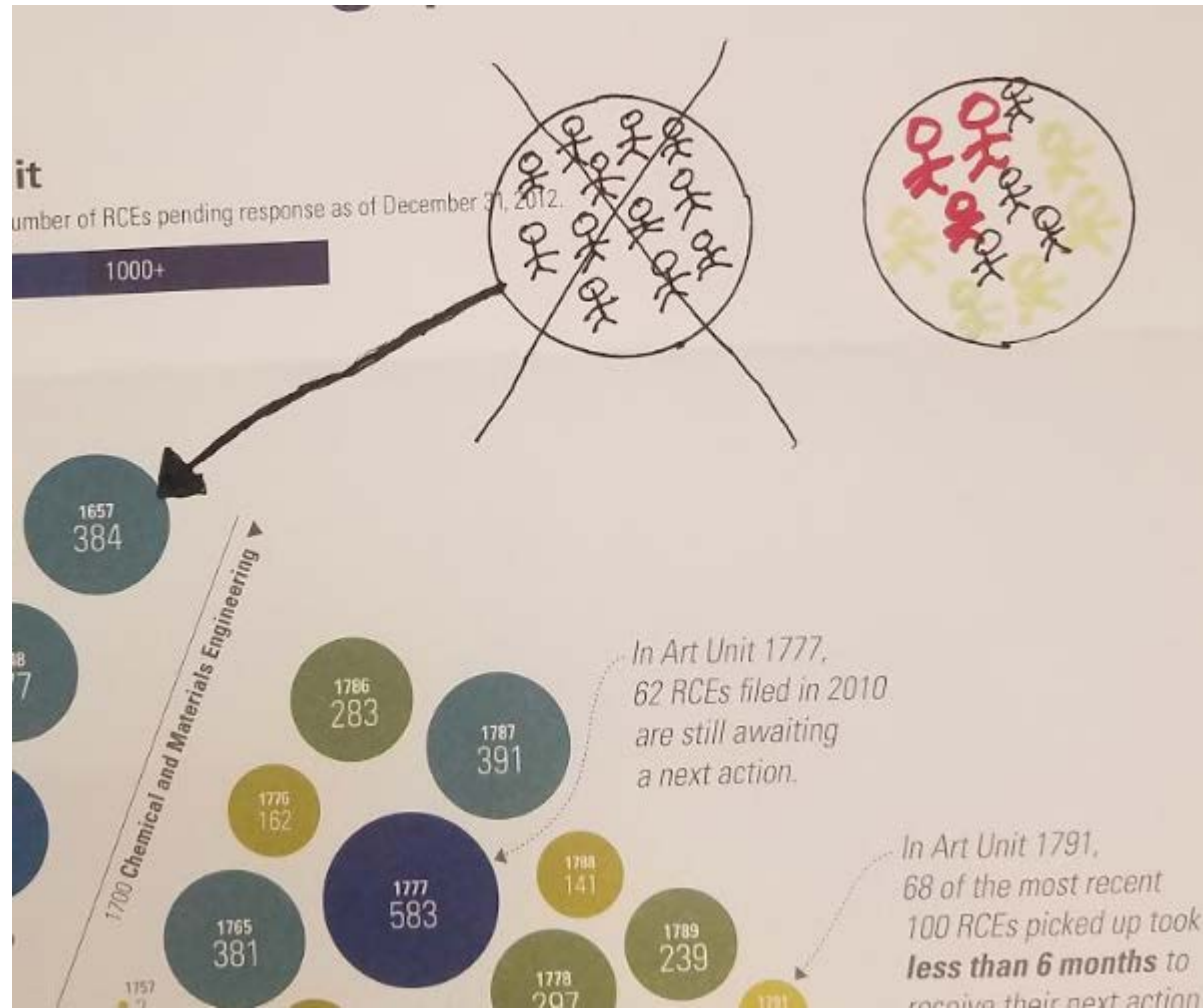
MISTAKE = Expecting Consistency within an Art Unit



OPPORTUNITY = Accounting for Consistency within an Art Unit

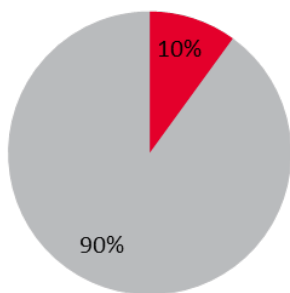


OPPORTUNITY = Accounting for Consistency within an Art Unit

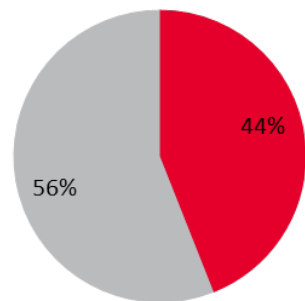


There are two very different kinds of examiners at the USPTO.

Category A

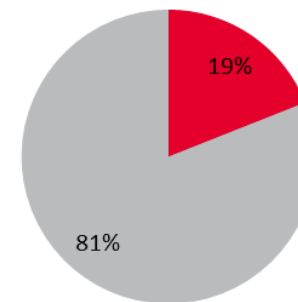


About **10 %** of the entire examiner pool accounts for close to **HALF of ALL** patents granted.

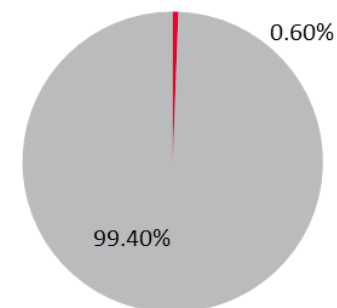


>50 patents/year

Category B



About **20 %** of the entire examiner pool accounts for **ONLY 0.6%** patents granted.



<5 patents/year

PatentAdvisor provides the best way to measure this variability.

Red = ETA of 6+, indicating a high likelihood of long prosecution length, often granting less than 15 applications per year, on average

Yellow = ETA of 2.6-5.9, indicating mediocre prosecution length, often granting between 15-100 applications per year, on average

Green = ETA of .1-2.5, indicating high likelihood of a short prosecution length, often granting over 100 applications per year, on average





EMPHASIS: Green and Red in SAME Art Unit

12 Records found for Organization: 2118

Employee

CARTER CHRISTOPHER W

DUNN DARRIN D

FENNEMA ROBERT E (SPE)

FOLEY SHON G

GAMI TEJAL

HARTMAN JR RONALD D

LAUGHLIN NATHAN L

MONTY MARZIA T

NORTON JENNIFER L

PATEL JIGNESHKUMAR C

POUDEL SANTOSH R

SKRZYCKI JONATHAN M



EMPHASIS: Both work in Art Unit 2118



Both examiners maintained about 65 pending apps in 2017/2018 but...

2017 = 48 office actions and 0 patents granted

2018 = 82 office actions and 4 patents granted

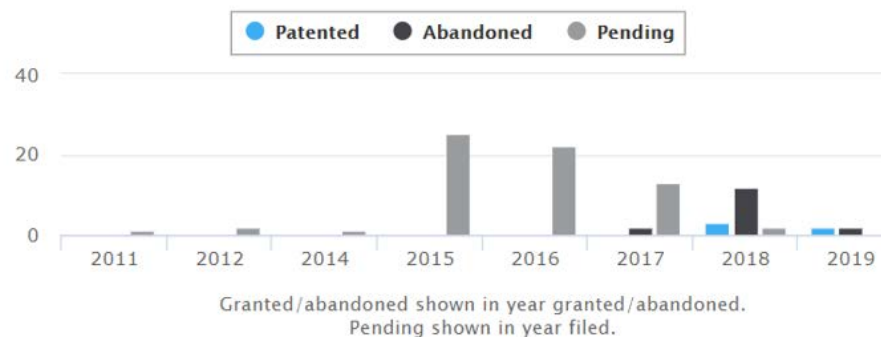


Both examiners maintained about 65 pending apps in 2017/2018 but...

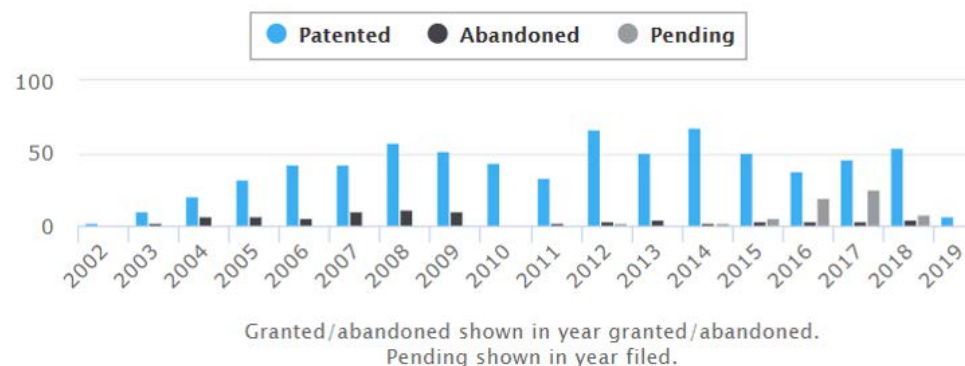
2017 = 65 office actions and 46 patents granted

2018 = 65 office actions and 53 patents granted

EMPHASIS: Both work in Art Unit 2118



Average of two office actions written in each of 65 pending apps on docket.



Average of one office action written in each of 65 pending apps on docket.

ETA Distribution across the USPTO

Overall (excluding 2900: designs)

29% Green (fast patent granters)

47% Yellow (average patent granters)

24% Red (slow patent granters)

2800: Semiconductors, Electrical and Optical Systems and Components

ETA DISTRIBUTION

This shows the number of Examiners of each colour in the group



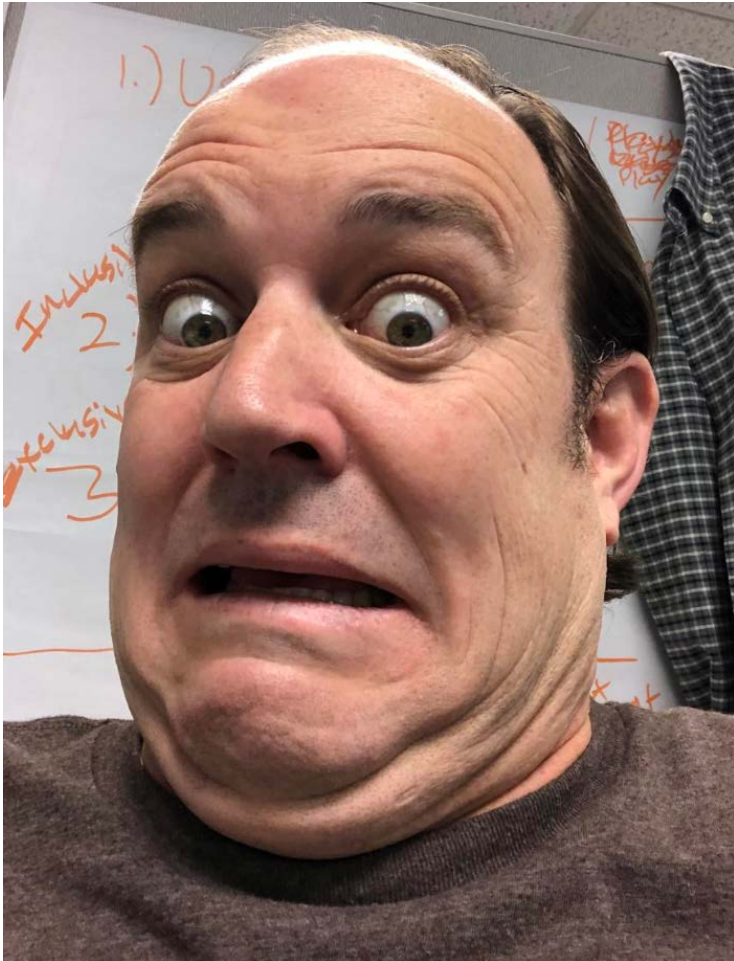
3600: Transportation, Construction, Electronic Commerce, Agriculture, . . .

ETA DISTRIBUTION

This shows the number of Examiners of each colour in the group



WOW!!!! Chris is RIGHT! What now?????



Important Points

- 1) Do not panic.**
- 2) This only requires minor change because we do the hard work for you.**
- 3) No, you can't just let your USA law firm handle this.**
- 4) Yes, you will save a lot of money. You will also deploy your USA prosecution dollars more efficiently and effectively.**

In other words...

Utilizing big data to gain significant competitive advantage is as easy as adding **one additional variable** to the calculus of the decisions that you are already making every day.

You do not have to drastically transform existing processes in order to drastically improve outcomes and opportunities.

“Should we file an application in the US for this invention?”

3680 - Electronic Commerce

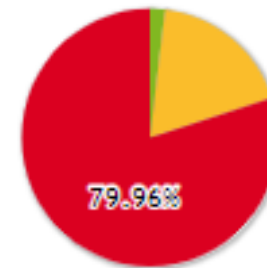
ETA DISTRIBUTION ⓘ

This shows the number of examiners of each color in the group.

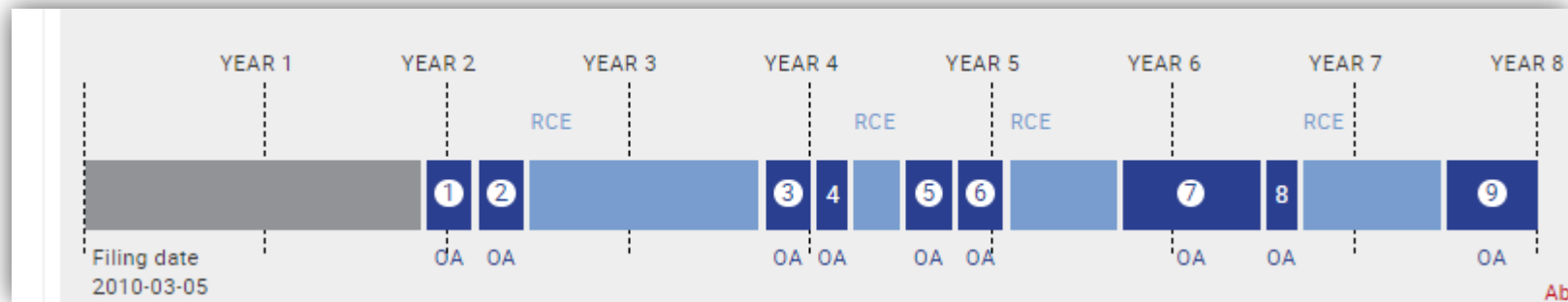


LOTTERY MAP ⓘ

This shows the probability of being assigned a particular color examiner if your application lands in this group.



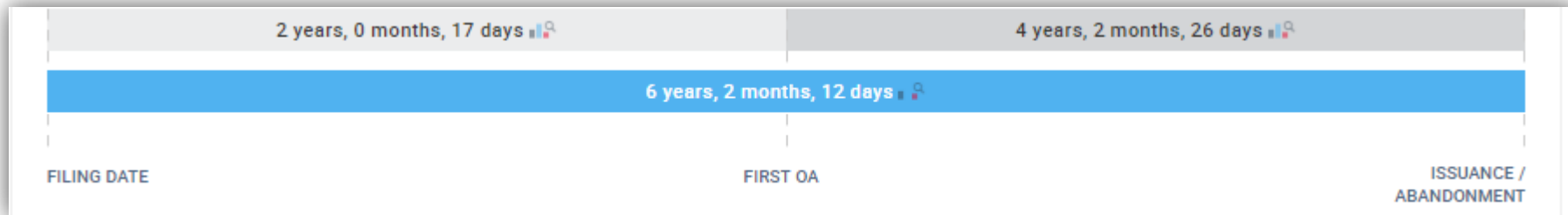
“Should we continue prosecuting this application in the US Patent & Trademark Office?”



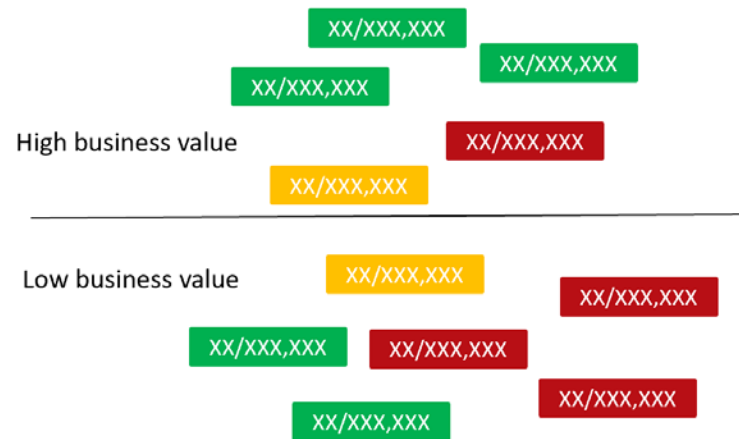
“How much should we pay (ask) for the pending US patent applications in the portfolio that we’re buying (selling)?”

	0-2.5	118
	2.6-5.9	121
	6+	52
	TOTAL	291

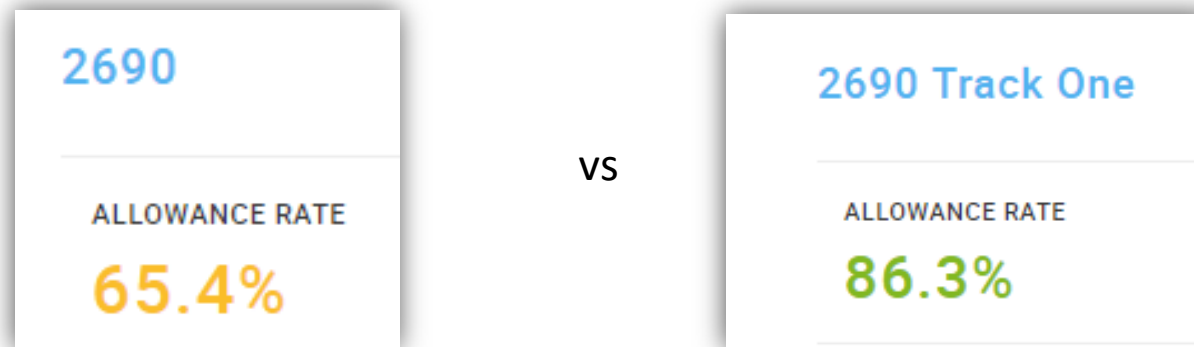
“How long will it take to attempt to obtain a patent in the United States?”



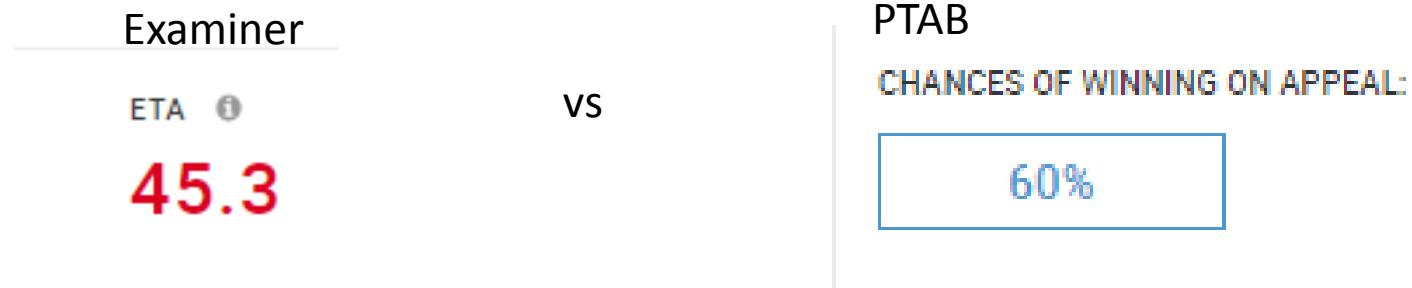
“Which of the patent applications pending in the United States should we cut for cost savings?”



“Should we utilize some type of accelerated exam as our path into the US Patent & Trademark Office?”



“Is it worth the money to appeal the decision of the United States Patent Examiner?”



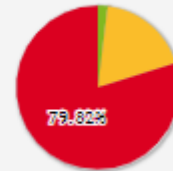
“Is it worth the money to file an application in the United States?”

Tech Center Group **3680** : Business Methods

Tech Center: **3600**

Allowance Rate: **47.7%**

Probability of examiner assignment.

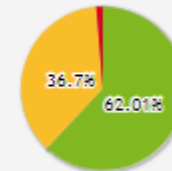


Tech Center Group **3660** : Computerized Vehicle Controls and Navigation, Radio Wave, Optical and Acoustic Wave Communication, Robotics, and Nuclear Systems

Tech Center: **3600**

Allowance Rate: **81.1%**

Probability of examiner assignment.



“How should we allocate our limited patent budget across the multiple technology fields in which we produce products?”

Art unit	↑↓	APPs	↑↓	Average # OAs ⓘ	↑↓	Allowance rate	↑↓	≥ 1 RCE ⓘ	↑↓	Appeal filed ⓘ	↑↓	1 st OA to Issue ⓘ	↑↓	
3644		1084		1.3		72.6% (11256 / 15503)		17.9%		3.7%		1 Y, 0 M		Filter
3647		350		1.6		73.2% (2647 / 3615)		25.5%		4.9%		1 Y, 2 M		Filter
3643		186		1.6		53.1% (7446 / 14026)		22.3%		7.5%		1 Y, 3 M		Filter
3726		149		1.4		70.7% (11260 / 15918)		20.1%		4%		1 Y, 1 M		Filter
3661		147		1.2		85.4% (14154 / 16579)		12.4%		2.5%		0 Y, 10 M		Filter
3641		136		1.3		77.7% (12599 / 16223)		17.7%		3.2%		1 Y, 0 M		Filter
1746		123		1.6		66.8% (6517 / 9764)		26.6%		4.7%		1 Y, 2 M		Filter
3645		113		1.4		82.6% (5313 / 6435)		23.1%		4.1%		1 Y, 0 M		Filter

“Is the attorney handling our US patent applications obtaining best possible outcomes for least possible cost?”

SMITH, SCOTT A

GROUP ART UNITS 3204, 3205, 3616, 3721, 3731, 3771

ETA ⓘ

1.1

TALLMAN, BRIAN A

GROUP ART UNIT 3628

ETA ⓘ

41.7

“How can we quickly gain business leverage over a competitor in the United States?”

2812 - SEMICONDUCTOR DEVICE MANUFACTURING: PROCESS

Filters

ALLOWANCE RATE

83.4%

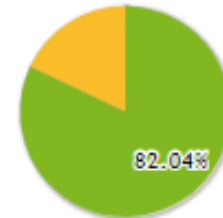
ETA DISTRIBUTION ⓘ

This shows the number of examiners of each color in the group.

14  7  1 

LOTTERY MAP ⓘ

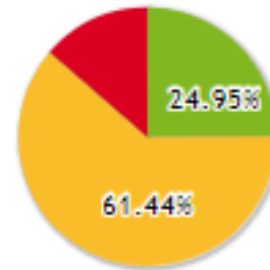
This shows the probability of being assigned a particular color examiner if your application lands in this group.



“How much will it cost to attempt to obtain a patent in the United States?”

LOTTERY MAP ⓘ

This shows the probability of being assigned a particular color examiner if your application lands in this group.



“How can we increase patent leverage in the United States in order to give rise to increased licensing revenue?”

SMITH, SCOTT A

GROUP ART UNITS 3204, 3205, 3616, 3721, 3731, 3771

ALLOWANCE RATE

89.9%

AU 3721 ALLOWANCE RATE (CURRENT AU)

69.5%

ETA ⓘ

1.1

“How do we convince a lender to accept pending United States patent applications as collateral?”

ETA ⓘ

1.1

= \$\$?

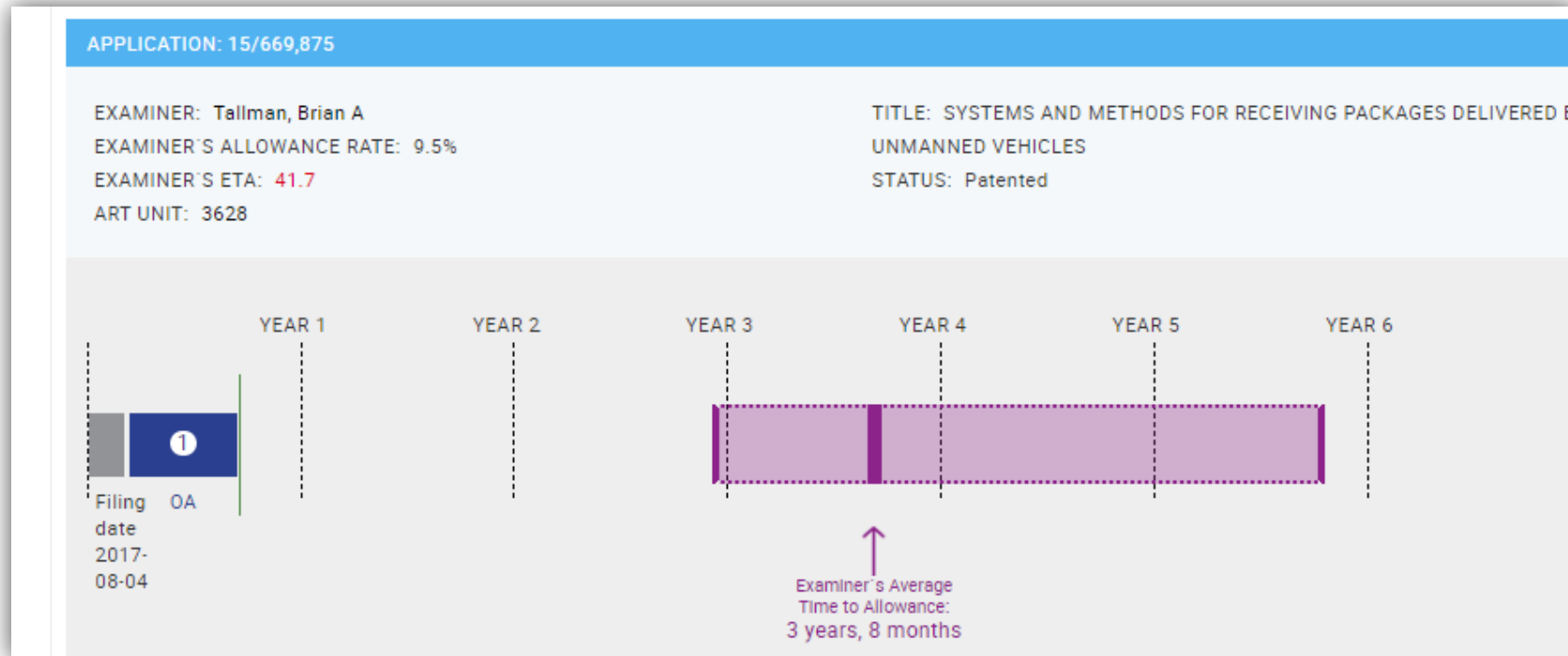
“Is there an attorney or law firm that is better or cheaper than ours when it comes to obtaining US patents?”

Name	Allow Rate	% RCE	% Appeal	Time from 1st OA to Allowance
USPTO - TC 1600	55.2%	26%	7.8%	1 Y, 7 M, 4 D
Briefcase - Troller Inc.	40.8%	29%	12.2%	2 Y, 7 M, 13 D
FISH & RICHARDSON	69.2%	11.1%	11.1%	2 Y, 10 M, 21 D
FOLEY & LARDNER	28.6%	0%	0%	2 Y, 4 M, 13 D
SUGHRUE MION	50%	0%	100%	5 Y, 11 M, 18 D

“How do we value pending applications within a US patent portfolio that we are buying?”

	0-2.5	118
	2.6-5.9	121
	6+	52
	TOTAL	291

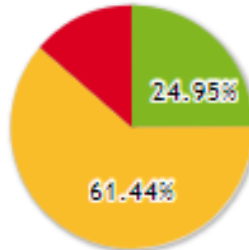
“How can we differentiate ourselves as being better or cheaper than others when it comes to obtaining US patents?”



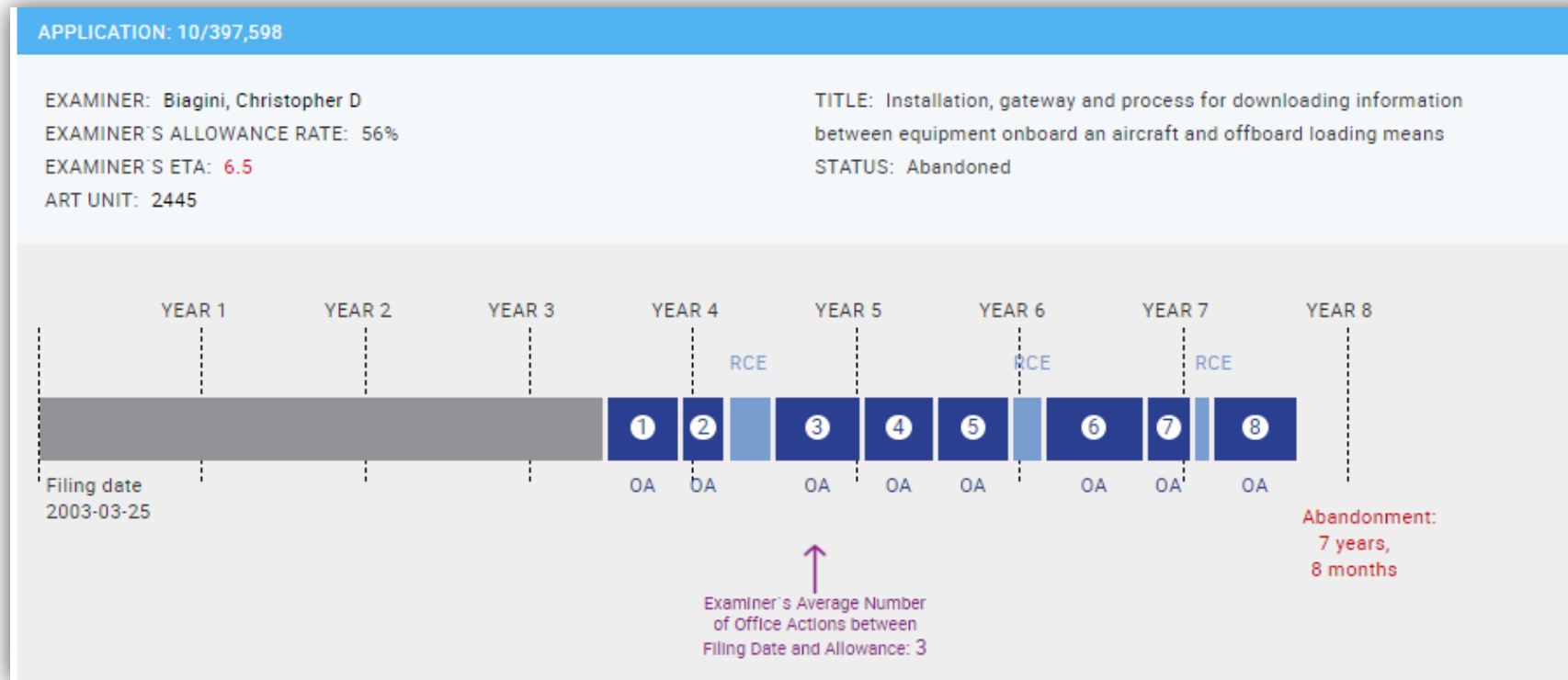
“Should we file a continuation application in order to preserve pendency?”

LOTTERY MAP ⓘ

This shows the probability of being assigned a particular color examiner if your application lands in this group.



“Should we give up on prosecution and let the application go abandoned?”



“Could we acquire an undervalued pending portfolio?”

	0-2.5	118
	2.6-5.9	121
	6+	52
	TOTAL	291

We will know how and will teach you tactics for achieving an even larger competitive advantage.

Four Steps to Improving Prosecution Outcomes



- **Target:** aim your application towards the group of examiners with the best chance of success



- **Adapt:** make strategic prosecution decisions based on which examiner you get



- **Manage:** quantitatively evaluate prosecution performance; identify and monitor for systematic prosecution issues across a portfolio



- **Switch:** file a continuation application to get a different examiner

Questions?



cholt@lexisnexusip.com

**Thanks for
Your Attention**