Patent Prosecution Analytics
No Longer Just a Nice to Have
8/31/2021
Today’s Speaker

Megan McLoughlin
Director of Product Management
LexisNexis IP
Today’s Discussion

- Accurately predicting prosecution outcomes using ETA
- Accurately communicating prosecution performance
- Engaging in PTAB “case law” research to find winning arguments
- Ensuring that prosecution data becomes a part of your workflow
Predicting Prosecution Outcomes

Examiner variability within art units

What people think:

Average Art Unit:

```
<table>
<thead>
<tr>
<th>Art Unit</th>
<th>Fast</th>
<th>Average</th>
<th>Slow</th>
</tr>
</thead>
<tbody>
<tr>
<td>1718 (chemical and materials engineering)</td>
<td>0</td>
<td>1</td>
<td>9</td>
</tr>
<tr>
<td>2811 (semiconductor device manufacturing)</td>
<td>5</td>
<td>4</td>
<td>4</td>
</tr>
<tr>
<td>2812 (semiconductor device manufacturing)</td>
<td>11</td>
<td>3</td>
<td>0</td>
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</tbody>
</table>
```
Predicting Prosecution Outcomes

Examiner variability impacts prosecution outcomes

Electronics company with 8,000+ filings at USPTO each year

Applications with “permissive” examiners

Allowance rate
94.1%

Average time to disposition
2 years, 4 months, 5 days

Average office actions to disposition
1.3

Applications with “difficult” examiners

Allowance rate
54.1%

Average time to disposition
3 years, 11 months, 26 days

Average office actions to disposition
3
Allowance rate: Patented / (Patented + Abandoned)
- Doesn’t incorporate pending applications
- Penalizes the examiner for abandonments
- Useless for new examiners

ETA (Examiner time allocation): Total office actions / total allowances
- Accounts for pending portfolio
- Doesn’t directly penalize for abandonments
- Helpful for new examiners

Predicting Prosecution Outcomes
Measuring examiner behavior
Predicting Prosecution Outcomes

Measuring examiner behavior
Measuring Prosecution Performance

Good measurements account for examiner variability

<table>
<thead>
<tr>
<th></th>
<th>Examiner A</th>
<th>Examiner B</th>
</tr>
</thead>
<tbody>
<tr>
<td>Allowance rate</td>
<td>80%</td>
<td>20%</td>
</tr>
<tr>
<td>Average OA to</td>
<td>1.5</td>
<td>3.2</td>
</tr>
<tr>
<td>allowance</td>
<td></td>
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<tr>
<td>Good result?</td>
<td>✗</td>
<td>✓</td>
</tr>
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</table>

Filing date: 2016-09-26
Issuance: 3 years, 1 month
Measuring Prosecution Performance

PatentAdvisor Efficiency Score™

Allowance rate: \( \frac{\text{Patented}}{\text{Patented} + \text{Abandoned}} \)
- Doesn’t account for examiner variability
- Penalizes for abandonments

PatentAdvisor Efficiency Score: how quickly applicants bring a case to resolution, relative to the examiner’s average
- Normalized for examiner difficulty
- No penalty for abandonments

0  Below average  50  Above average  100
Measuring Prosecution Performance

PatentAdvisor Efficiency Score™

1. Score every patented & abandoned case against “par” for the examiner
Par = 3.5 office actions + 1 RCE for a patented case
Score will be below 50 (average) because the case took much more than average.
Measuring Prosecution Performance

PatentAdvisor Efficiency Score™

2. Average the scores for every application in the dataset.

Red score = average of all scores for applications with red examiners

Yellow score = average of all scores for applications with yellow examiners

Green score = average of all scores for applications with green examiners

Overall score = weighted average of red, green, and yellow scores
Measuring Prosecution Performance

USPTO Technology Center Group 2120: AI & Simulation/modeling
Measuring Prosecution Performance

USPTO Technology Center Group 2120: AI & Simulation/modeling

Normalized for examiner difficulty using the PatentAdvisor Efficiency Score™

Allowance Rate (%) vs. PatentAdvisor Efficiency Score

USA
Europe
Asia
Finding Winning Arguments

Justify the decision to appeal

<table>
<thead>
<tr>
<th>Issues</th>
<th>Affirmed</th>
<th>Affirmed In Part</th>
<th>Reversed</th>
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</thead>
<tbody>
<tr>
<td>101</td>
<td>80%</td>
<td>1%</td>
<td>19%</td>
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<tr>
<td>102</td>
<td>41%</td>
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<td>103</td>
<td>55%</td>
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<td>48%</td>
<td>4%</td>
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<tr>
<td>Obviousness Type Double Patenting</td>
<td>79%</td>
<td>2%</td>
<td>19%</td>
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</table>

- Lack of Utility (38 decisions)
- Patent-ineligible subject matter (7988 decisions)
- Judicial Exceptions (7837 decisions)
  - Abstract Idea (7602 decisions)
    - Prima Facie case (593 decisions)
    - Step 1 (7335 decisions)
    - Step 2 (6847 decisions)
  - Law of Nature (72 decisions)
  - Naturally occurring phenomenon (109 decisions)
  - Statutory class (188 decisions)
  - Statutory Double Patenting (59 decisions)
Finding Winning Arguments

Customize your argument to the examiner and art unit

### Decisions by Issue

<table>
<thead>
<tr>
<th>Case Name</th>
<th>Application #</th>
<th>Outcome</th>
<th>Decision Date</th>
<th>Type</th>
<th>Judges</th>
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### Filter Options

- Outcome: Reversed

Download Decisions
Bring the Data into Your Workflow
Bring the Data into Your Workflow

<table>
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<tr>
<th>Application Data</th>
<th>Transaction History</th>
<th>Patent Term Adjustments</th>
<th>Continuity Data</th>
<th>Fees</th>
<th>Published Documents</th>
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**BIBLIOGRAPHIC DATA**

- **Examiner:** MILLER, BRIAN E
- **Application #:** 15/494,368
- **Filing Date:** 04-21-2017
- **Application Type:** Utility

**Correspondence Address**
- Customer Number: 45504
- Status: Patented Case
- Location: ELECTRONIC
- Location Date: -
- Earliest publication #: US 2017-0232619 A1
- Earliest publication date: 09-17-2017
- Patent #: 10,186,295
- Issue Date of Patent: 01-22-2019
- Intl. registration #: -
- Intl. registration publication date: -

**Art Unit:** 2688

- **Allowance Rate:** 82.7%
- **Average Office Actions To Allowance:** 1.3
- **ETA:** (as compared to Art Unit 2688) 1.7

- **Allowance Rate:** 85.4%
- **Average Office Actions To Allowance:** 1.3
Thank you!

Would you like more information about today’s presentation?

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