

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

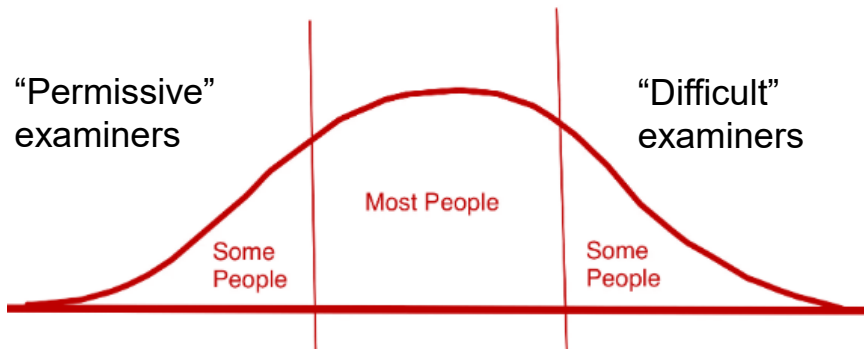
- Accurately predicting prosecution outcomes using ETA
- Accurately communicating prosecution performance
- Engaging in PTAB “case law” research to find winning arguments
- Ensuring that prosecution data becomes a part of your workflow

Predicting Prosecution Outcomes

Examiner variability within art units

What people think:

Average Art Unit:



Reality:

Art Unit	Fast	Average	Slow
1718 (chemical and materials engineering)	0	1	9
2811 (semiconductor device manufacturing)	5	4	4
2812 (semiconductor device manufacturing)	11	3	0

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



Predicting Prosecution Outcomes

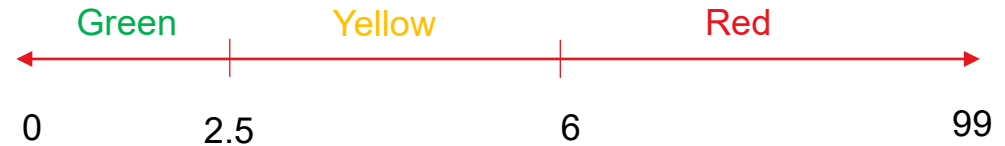
Measuring examiner behavior

Allowance rate: $\text{Patented} / (\text{Patented} + \text{Abandoned})$

- Doesn't incorporate pending applications
- Penalizes the examiner for abandonments
- Useless for new examiners

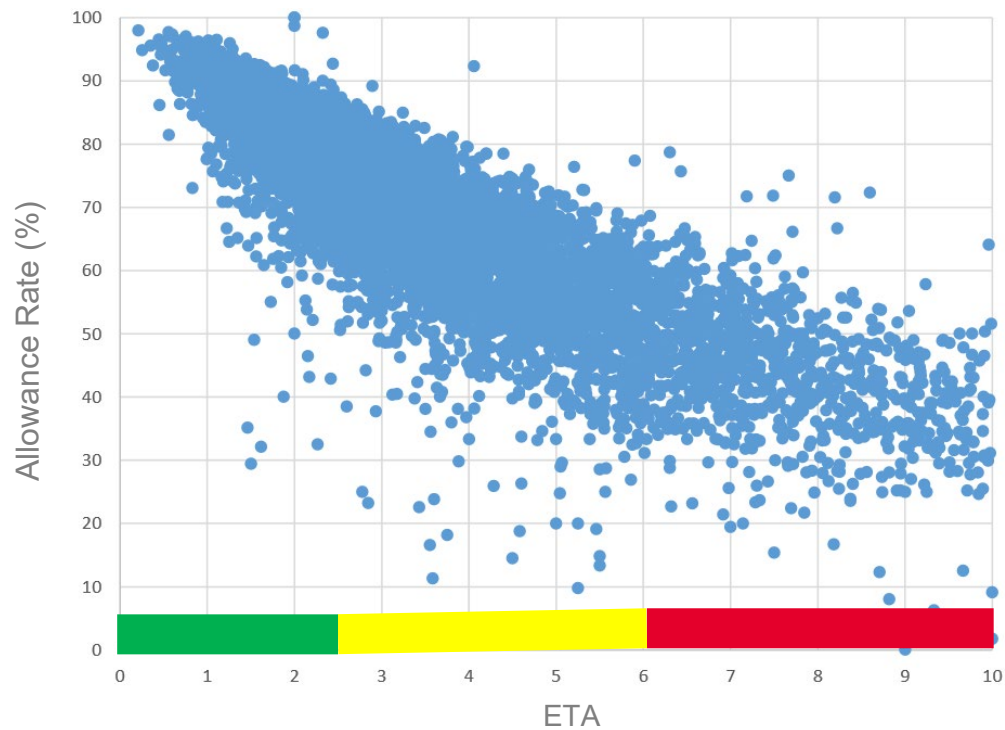
ETA (Examiner time allocation): $\text{Total office actions} / \text{total allowances}$

- Accounts for pending portfolio
- Doesn't directly penalize for abandonments
- Helpful for new examiners
- Validated by academics: https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3100326



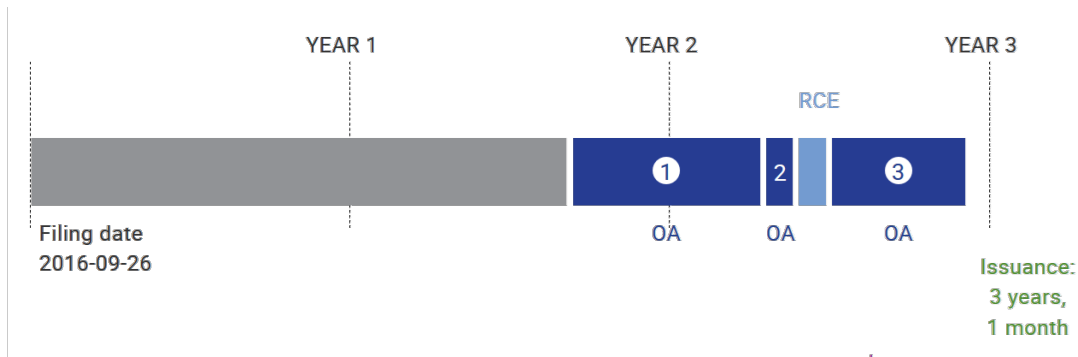
Predicting Prosecution Outcomes

Measuring examiner behavior



Measuring Prosecution Performance

Good measurements account for examiner variability



	Examiner A	Examiner B
Allowance rate	80%	20%
Average OA to allowance	1.5	3.2
Good result?	✗	✓



Measuring Prosecution Performance

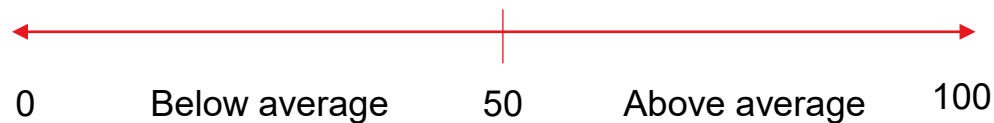
PatentAdvisor Efficiency Score™

Allowance rate: $\text{Patented} / (\text{Patented} + \text{Abandoned})$

- 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

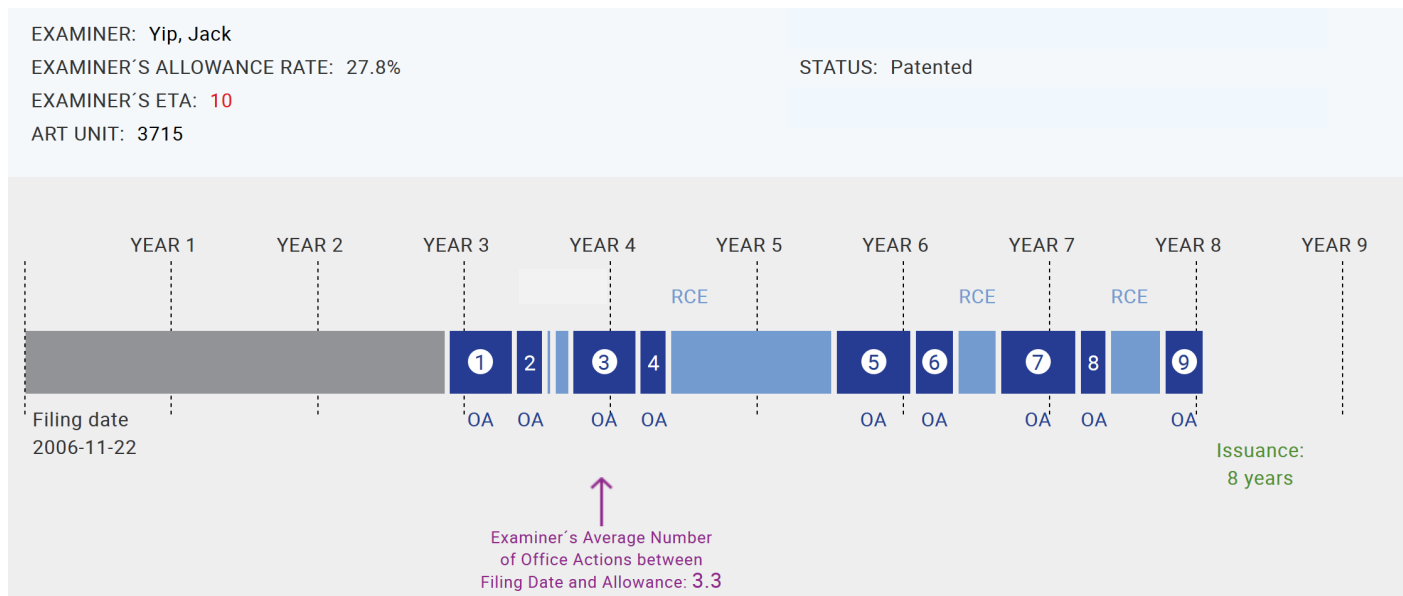
- Normalized for examiner difficulty
- No penalty for abandonments



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

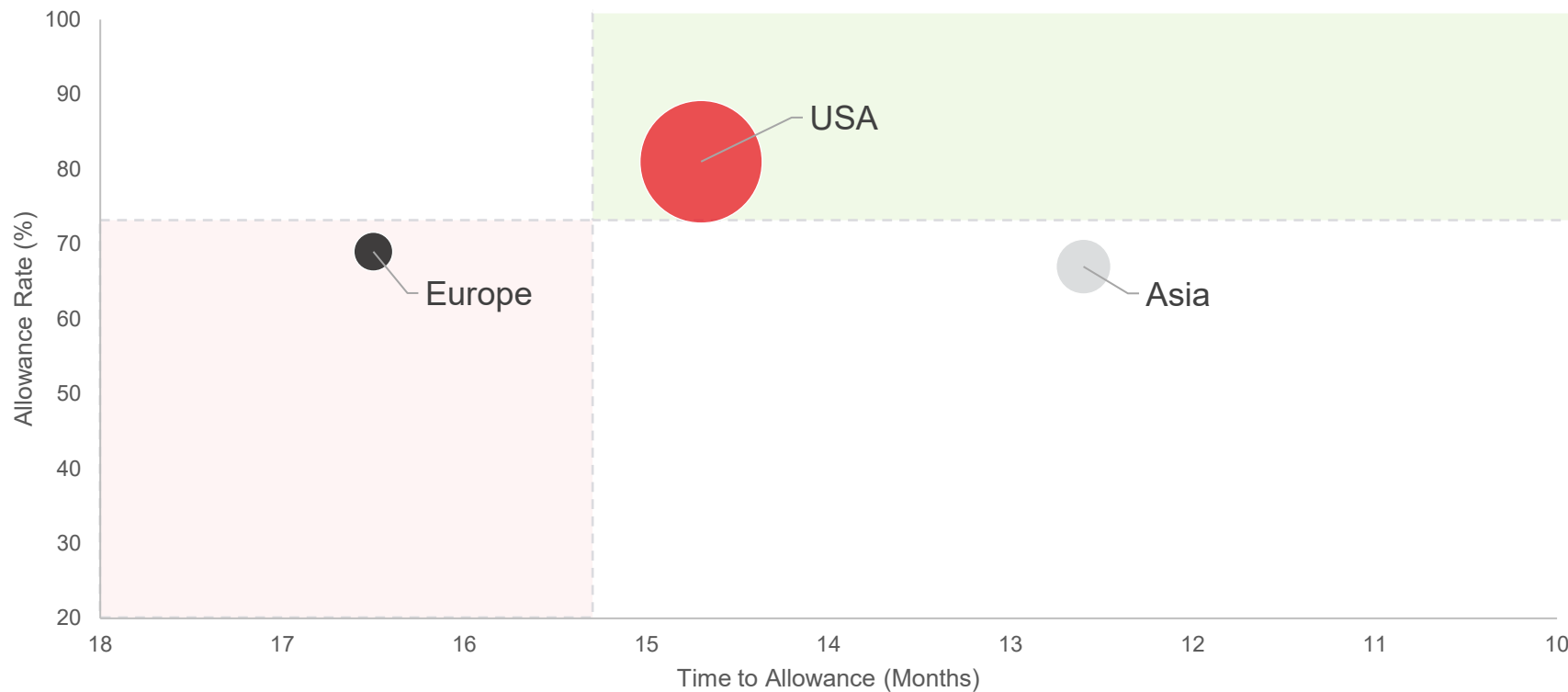
Yellow score = average of all scores for applications with yellow examiners

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

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

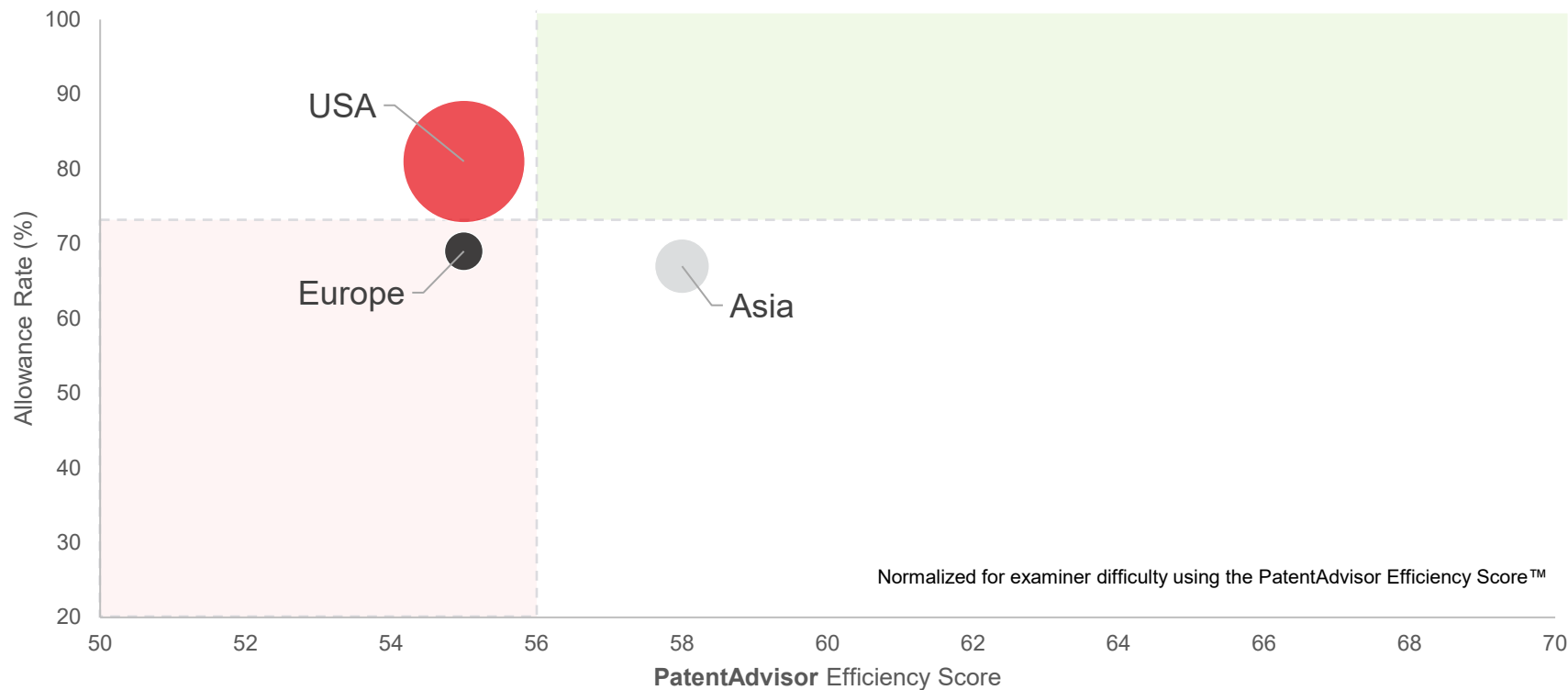
Measuring Prosecution Performance

USPTO Technology Center Group 2120: AI & Simulation/modeling



Measuring Prosecution Performance

USPTO Technology Center Group 2120: AI & Simulation/modeling



Finding Winning Arguments

Justify the decision to appeal

Issues		Affirmed	Affirmed in Part	Reversed
☐ ☐ 101 (8184 decisions)		80%	1%	19%
☐ ☐ 102 (6375 decisions)		41%	8%	51%
☐ ☐ 103 (30619 decisions)		53%	8%	38%
☐ ☐ 112 (6088 decisions)		48%	4%	48%
☐ ☐ Obviousness Type Double Patenting (1439 decisions)		79%	2%	19%

Issues	
☐ ☐ 101 (8184 decisions)	
☐ ☐ Lack of Utility (38 decisions)	
☐ ☐ Patent-ineligible subject matter (7988 decisions)	
☐ ☐ Judicial Exceptions (7837 decisions)	
☐ ☐ Abstract Idea (7682 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

Outcome: X Judge: Customer Number / Law Firm: Search Decisions:

Outcome: Reversed X

3037 decisions | 0 selected

 Download Decisions

Issues ↑↓	Case Name ↑↓	Application # ↑↓	Outcome ↑↓	Decision Date ↑↓	Type ↑↓	Judges
☐ 101 102 103	Ex parte Ocher, Alexander	14/027,820	Affirmed Reversed Affirmed	01/25/2021	Final	Joseph L. Dixon Jon M. Jurgovan David M. Kohut
☐ 101 103	Ex parte LINE CORPORATION	14/840,971	Reversed Affirmed	01/22/2021	Final	Eric B. Chen Michael J. Engle James B. Arpin
☐ 101 112(b)	Ex parte Development LP	15/217,226	Reversed Reversed	01/22/2021	Final	Jeffrey B. Robertson Terry J. Owens Christopher C. Kennedy
☐ 101 103	Ex parte International Incorporated	14/969,802	Reversed Reversed	01/21/2021	Final	Richard M. Lebovitz Ulrike W. Jenk Rachel H. Townsend
☐ 101 103	Ex parte Machines Corporation	15/204,931	Reversed Reversed	01/21/2021	Final	Gregg I. Anderson Allen R. Macdonald Bradley W. Baumesister
☐ 101 103	Ex parte Adobe Inc	14/630,460	Affirmed Reversed	01/14/2021	Final	Jennifer S. Bisk Johnny A. Kumar Joyce Craig
☐ 101	Ex parte ADOBE INC	14/812,805	Reversed	01/13/2021	Final	Deborah Katz Richard M. Lebovitz Donald E. Adams

Bring the Data into Your Workflow

Home > Extensions > LexisNexis PatentAdvisor® PAIR Extension



LexisNexis PatentAdvisor® PAIR Extension

Offered by: LexisNexis

★★★★★ 0 | Productivity | 287 users

Remove from Chrome

Overview

Privacy practices

Reviews

Related

GLOBAL DOSSIER ORDER CERTIFIED APPLICATION AS FILED ORDER CERTIFIED FILE WRAPPER VIEW ORDER LIST

14/123,456 ORNAMENTAL DISPLAY Mini-101

Select New Case Application Transaction History Image File Wrapper Continuity Data Foreign Priority Published Documents Address & Attorney / Agent Supplemental Content Assignments Display References

BIBLIOGRAPHIC DATA

Application #: 14/123,456 [Application Report](#)

Filing or 371(c) Date: 12-05-2013

Application Type: Utility

Examiner: SAHLE, MAHDERE S

Allowance Rate: 79.7% Average Office Actions To Allowance: 1.7

ETA: 2.4 (24 compared to Art Unit 2872)

View This Examiner's File Wrapper [Interview Stats](#) [Appeal Stats](#)

Art Unit: 2872

Allowance Rate: 77.9% Average Office Actions To Allowance: 1.4

Confirmation #: 5456

Attorney Docket #: MIN-101

Class/techclass: 35/0000

First Named Inventor: Steven Strimling, Kyoto, JP (JP) all Inventors

First Named Applicant:

Entity status: Undisclosed

LexisNexis PatentAdvisor® PAIR Extension

Correspondence Address Customer Number: 74712

Status: Abandoned - Failure to Respond to an Office Action

Status Date: 04-13-2015

Location: ELECTRONIC

Location Date:

Earliest publication #: US 2014-0196423 A1

Earliest publication date: 04-10-2014

Patent #: -

Issue Date of Patent: -

Int. registration # (Hague): -

Int. registration publication date: -

Bring the Data into Your Workflow

15/494,368

DISC GRIPPER FOR STORAGE DISC

ARC920150100US02

Select New Case

Application Data

Transaction History

Image File Wrapper

Patent Term Adjustments

Continuity Data

Fees

Published Documents

Address & Attorney / Agent

Assignments

Display References

BIBLIOGRAPHIC DATA

LexisNexis PatentAdvisor® PAIR Extension

Application #:

15/494,368

Filing or 371(c) Date:

04-21-2017

Application Type:

Utility

Examiner: MILLER, BRIAN

Allowance Rate

82.7%

Average Office Actions To Allowance

1.3

View This Examiner's

[File Wrappers](#) [Interview Stats](#) [Appeal Stats](#)

ETA

(as compared to Art Unit 2688)

1.7

0.7 3.8

Art Unit: 2688

Allowance Rate

85.4%

Average Office Actions To Allowance

1.3

Application Report

Correspondence Address Customer Number: 45504

Status: Patented Case

Status Date: 01-01-2019

Location: ELECTRONIC

Location Date: -

Earliest publication #: US 2017-0232619 A1

Earliest publication date: 08-17-2017

Patent #: 10,186,295

Issue Date of Patent: 01-22-2019

Intl. registration # (Hague): -

Intl. registration publication date: -

Thank you!



Would you like more information about today's presentation?

LexisNexisIP.com/PatentAdvisor

[Email: LexisNexisIP@LexisNexisIP.com](mailto:LexisNexisIP@LexisNexisIP.com)