



Impact of USPTO Examiners on Prosecution Outcomes

Presenters



Gene Quinn
IPWatchdog



Dr. Michael Sartori
Baker Botts



Measuring Examiner Behavior: Standard Metrics

67.6%

Allowance rate



Don't incorporate pending applications

2.6

Office actions to issuance



Penalize the examiner for abandonments



Useless for new examiners

TOTAL NUMBER OF APPLICATIONS

174

TOTAL ¹

71 PATENTED APPLICATIONS

34 ABANDONED APPLICATIONS

69 PENDING APPLICATIONS

New examiner

3.3

Average office actions in pending applications

Measuring Examiner Behavior: ETA

PatentAdvisor ETA™ (Examiner time allocation) = Total office actions: total allowances issued + X factors



ETA 0 - 2.5



ETA 2.6-6



ETA 6+

ETA is more accurate and a better predictor of examiner's behavior than Examiner Allowance Rate because it:



Includes all pending applications

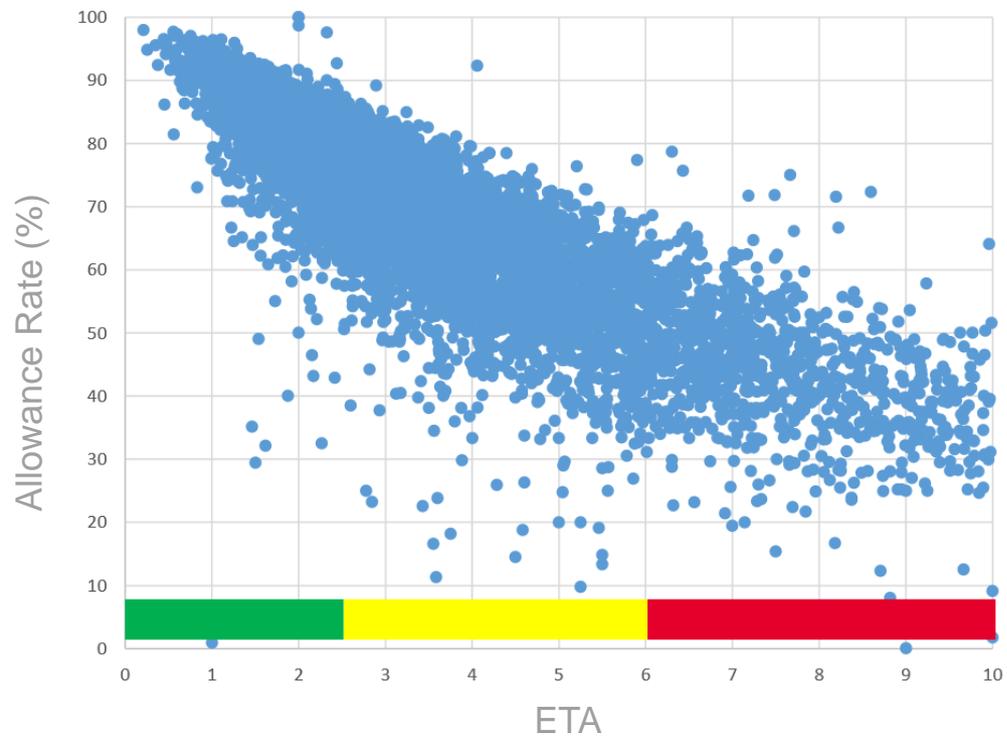


Factors in how long the examiner has been at the Patent Office



Is driven by the examiner's behaviors, not by the filer's actions

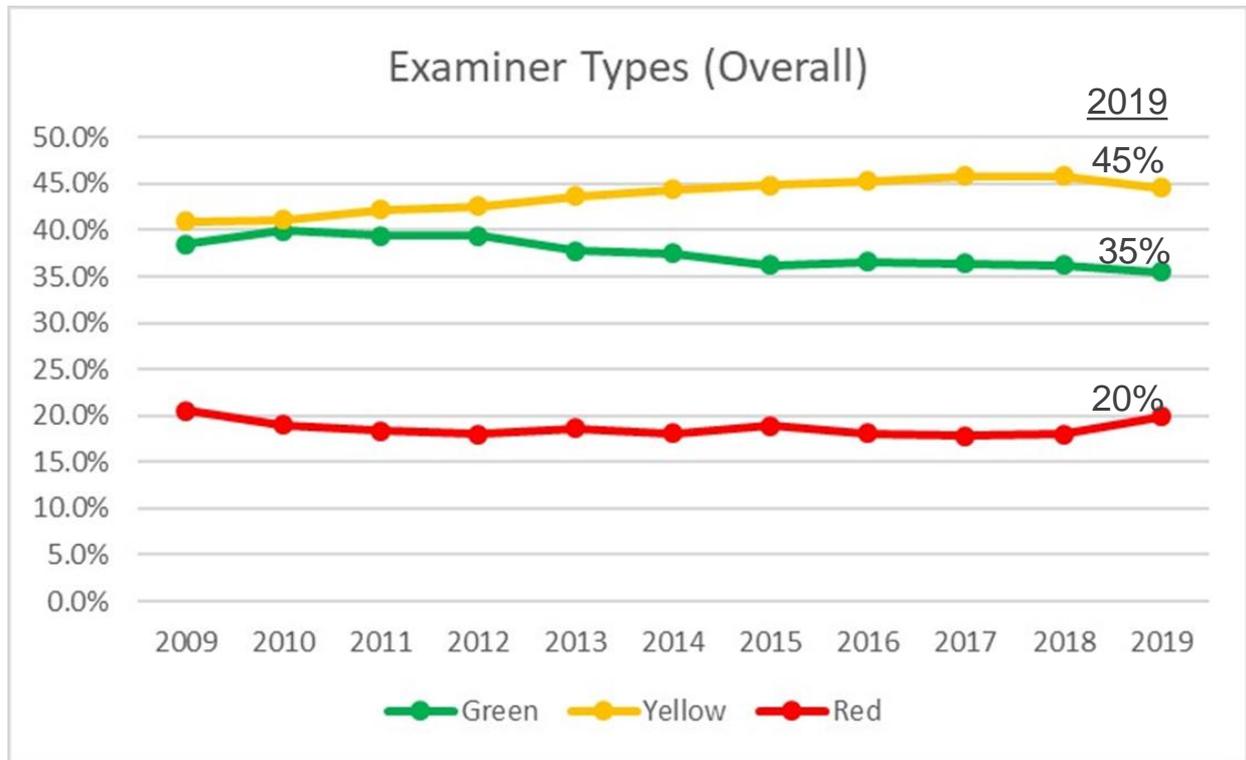
ETA v. Allowance Rate



1. USPTO Examiners



Percentage of Each Examiner Type



Averages

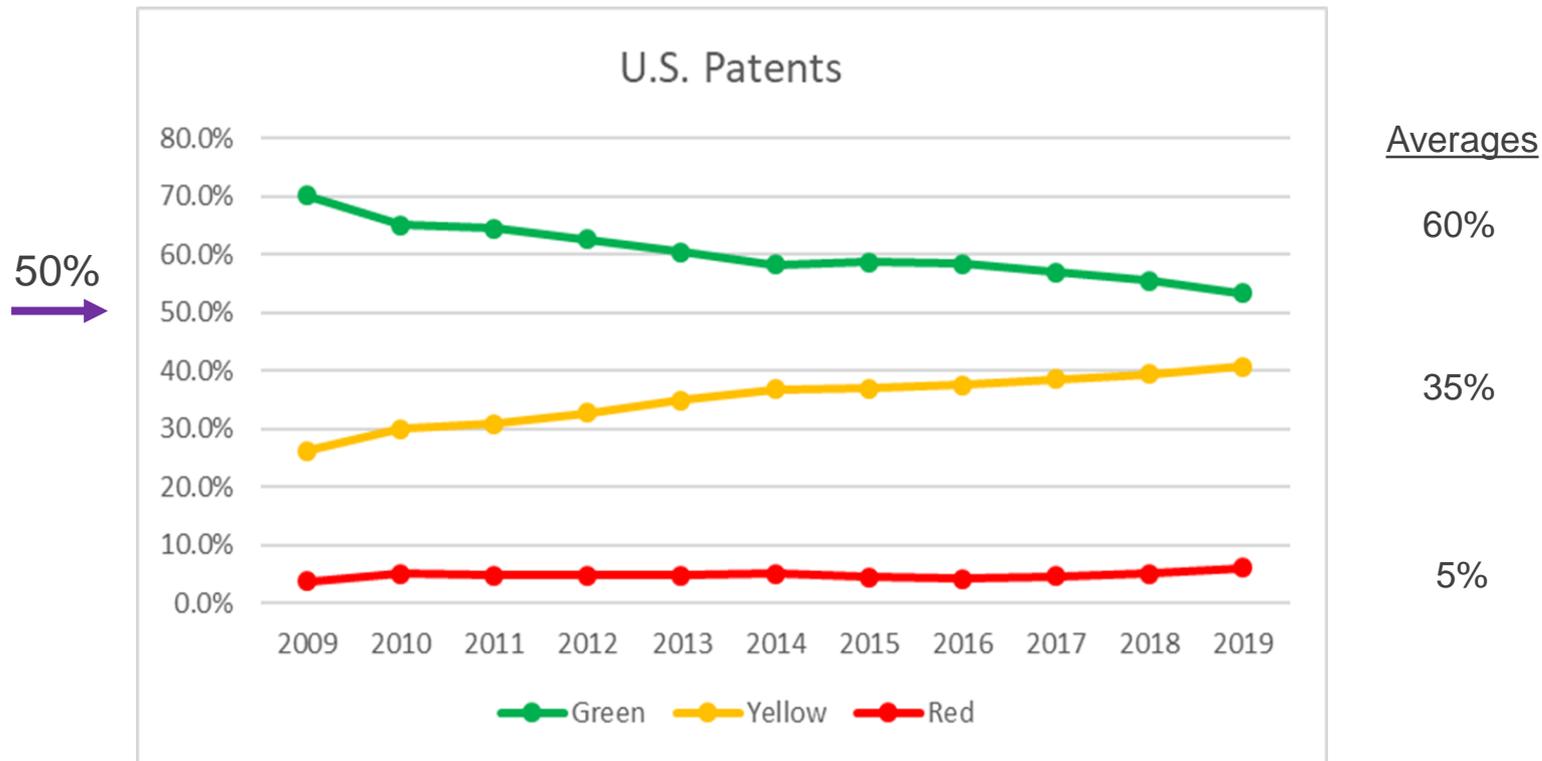
44%

37%

19%



U.S. Patents by Examiner Type



2. Doubling the Effort

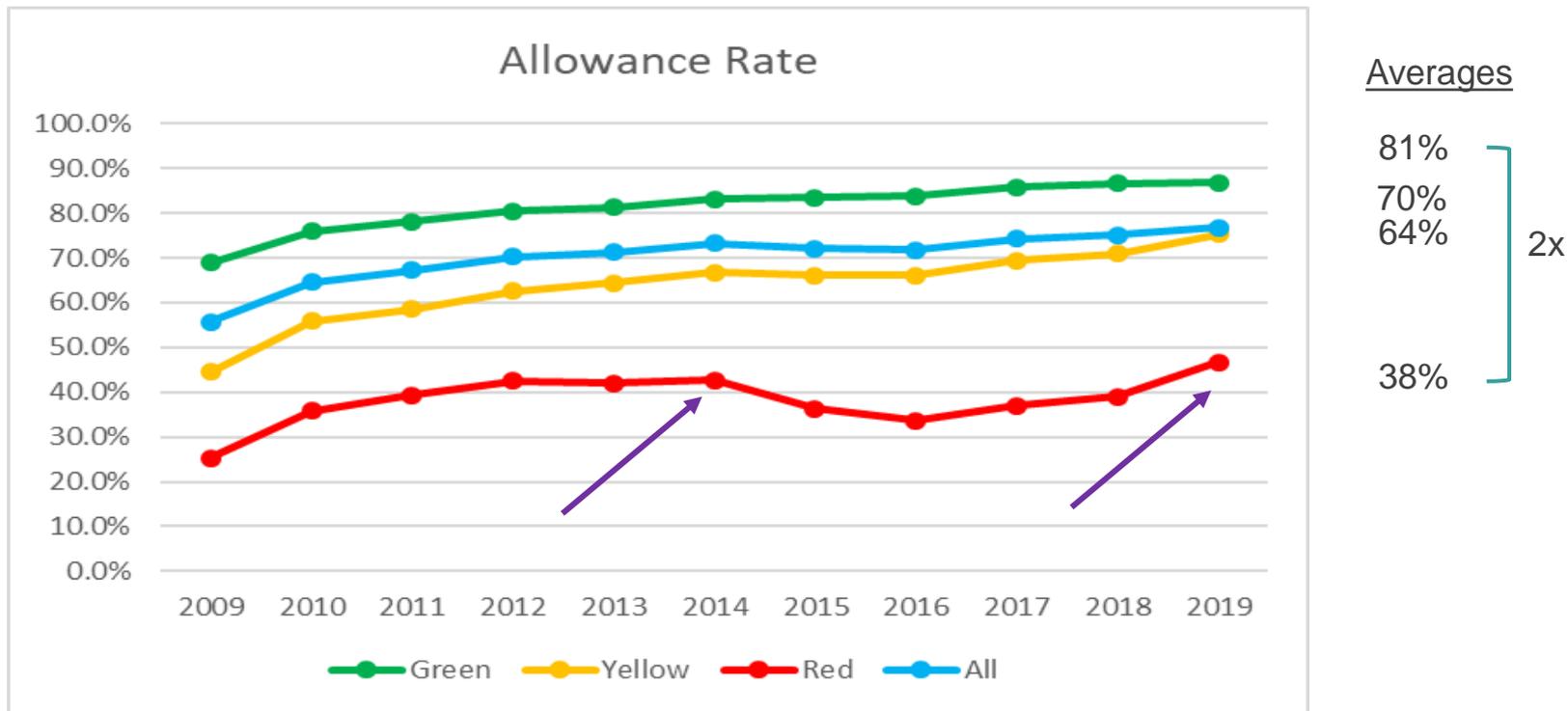


Impact of Examiner Type on U.S. Patents

- Type of Examiner impacts numerous metrics in the life cycle of a patent application:
 - Allowance Rate
 - Office Actions to Disposal
 - Time to Disposal
 - Final Office Actions
 - Restriction Office Actions
 - Interviews
- Surprisingly, the difference in many metrics between Green Examiners and Red Examiners is a **doubling effect**



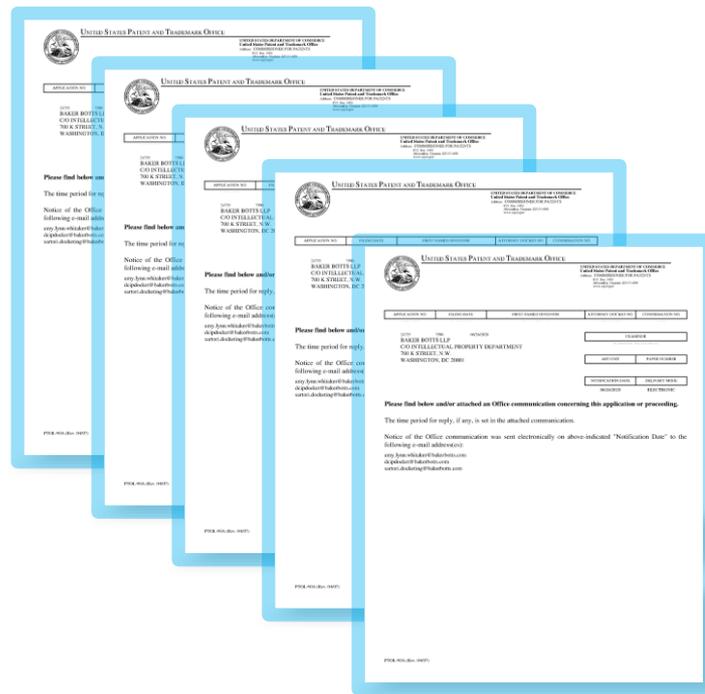
Allowance Rate by Examiner Type



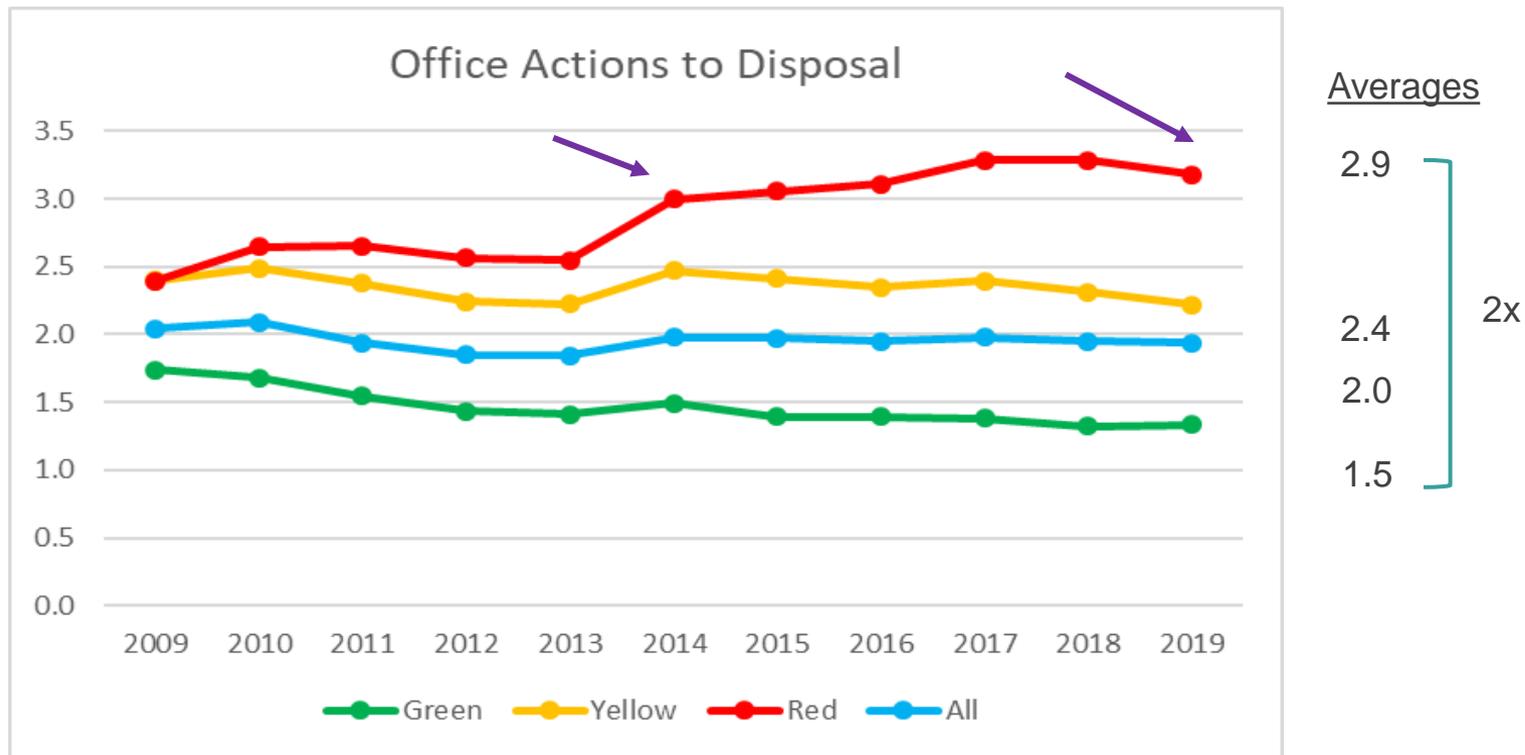
Office Actions to Disposal by Examiner Type

How many Office Actions are needed to obtain a disposed application from a particular Examiner?

Disposed Application = Patent or Abandon



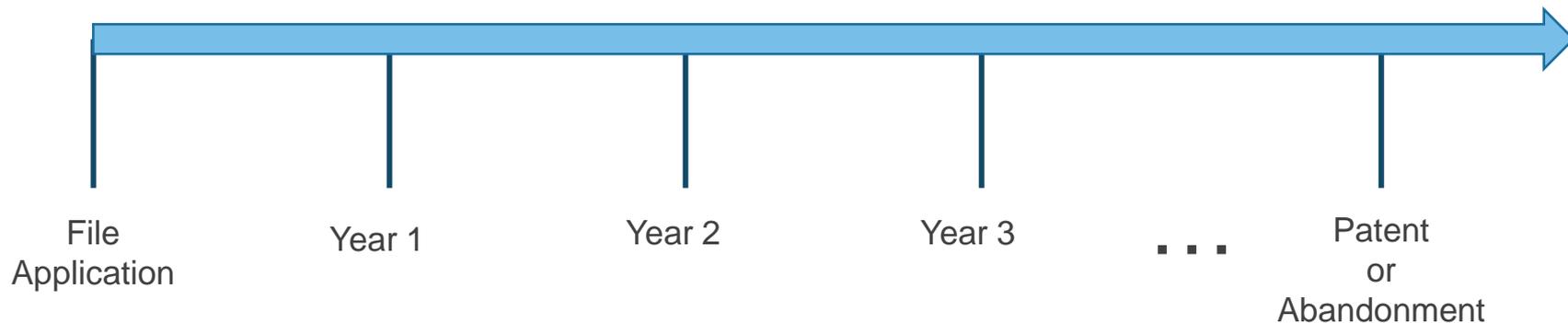
Office Actions to Disposal by Examiner Type



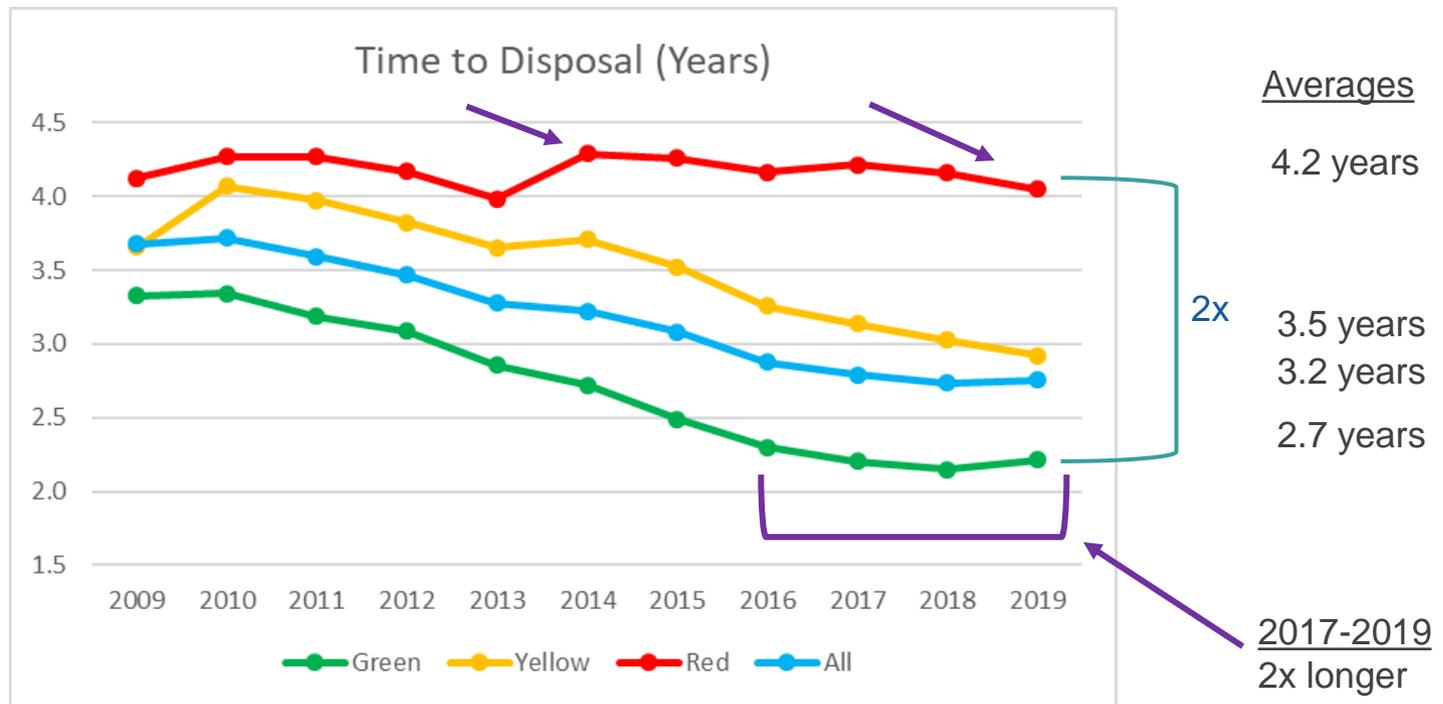
Time to Disposal by Examiner Type

How many years will it take to obtain a disposed application from a particular Examiner?

Disposed Application = Patent or Abandon



Time to Disposal by Examiner Type

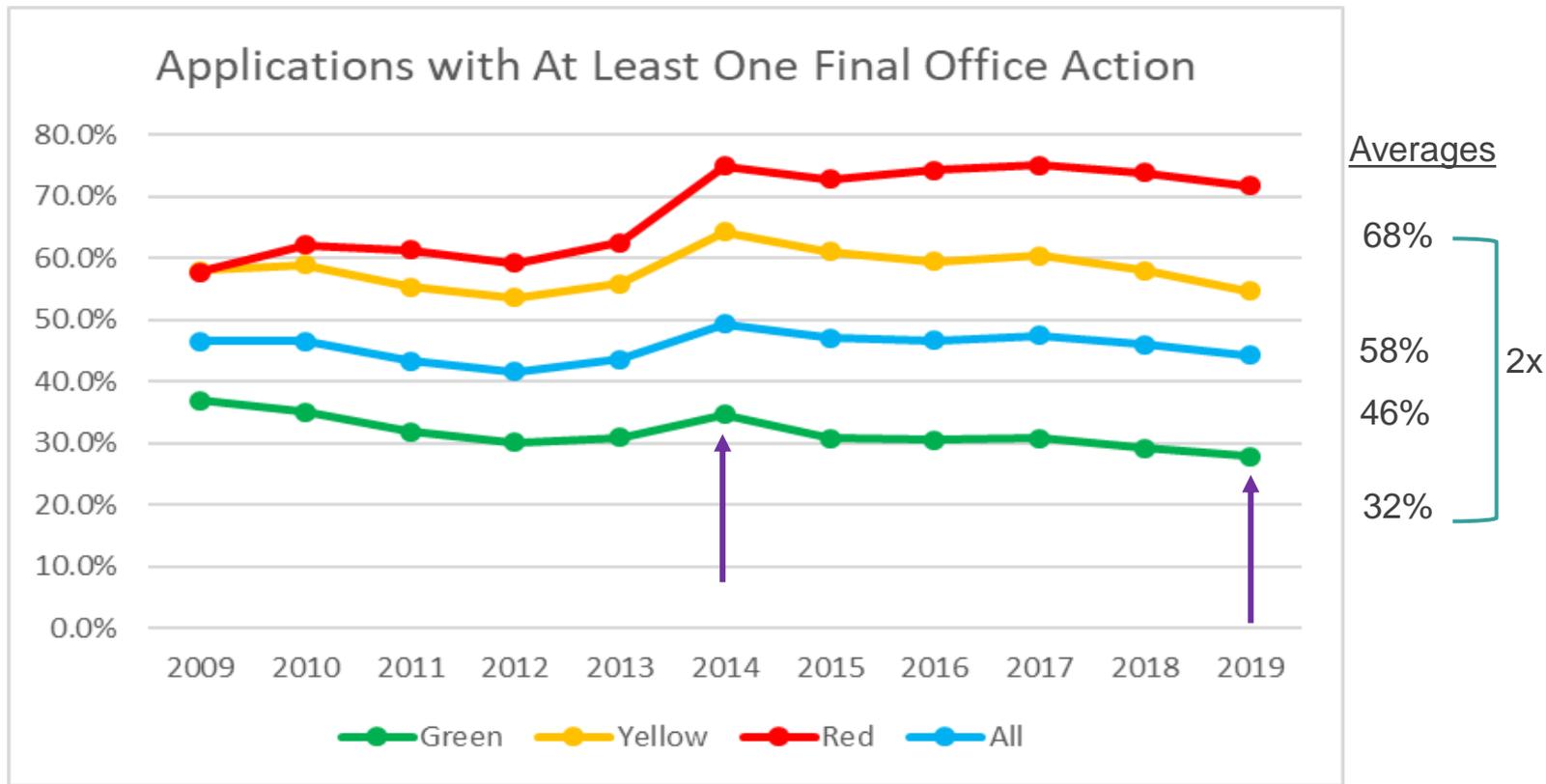


Final Office Actions

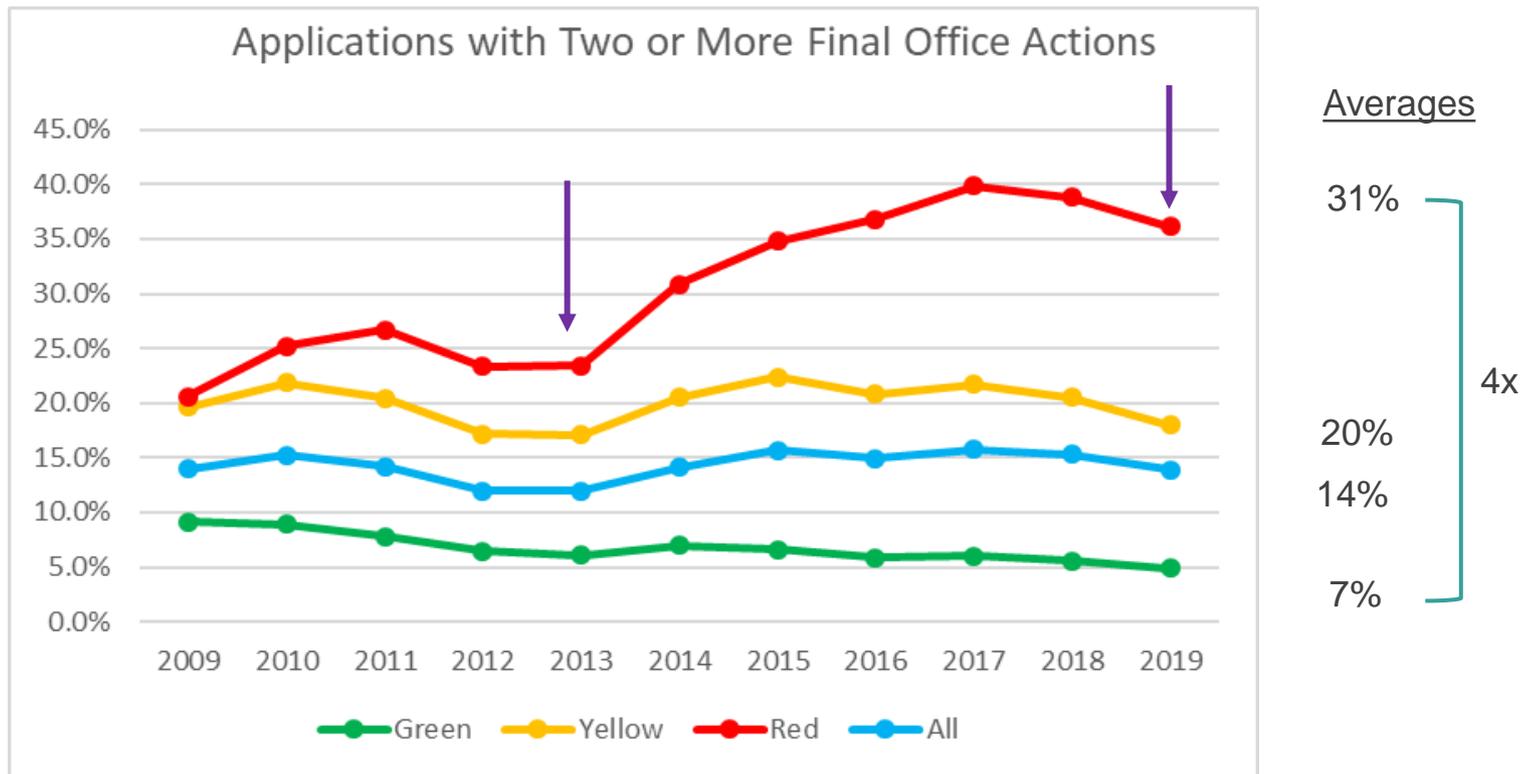
- What is the chance of obtaining at least one Final Office Action?
- What is the chance of obtaining two or more Final Office Actions?

		Application No.	Applicant(s)		
		Application No.	Applicant(s)		
Period of A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -- Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -- Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --	Office Action Summary		Application No.	Applicant(s)	
			Examiner	Art Unit 1726	AIA (FITF) Status Yes
Status 1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on 4/28/2020. 2a) <input checked="" type="checkbox"/> This action is FINAL. 3) <input type="checkbox"/> An election was made by the applicant in response to a restriction requirement set forth during the interview on _____: the restriction requirement and election have been incorporated into this action.	Status 1) <input checked="" type="checkbox"/> Re: _____ <input type="checkbox"/> A declaration(s)/affidavit(s) under 37 CFR 1.130(b) was/were filed on _____. 2a) <input checked="" type="checkbox"/> This action is FINAL. 3) <input type="checkbox"/> An election was made by the applicant in response to a restriction requirement set forth during the interview on _____: the restriction requirement and election have been incorporated into this action.	Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -- Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -- Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --			

Applications with at Least One Final Office Action by Examiner Type



Applications with Two or More Final Office Actions by Examiner Type



Impact of Examiner Type on Patent Procurement

- Comparing Green Examiners vs. Red Examiners

Metric	Green vs. Red
Allowance Rate	Green is 2x higher
Office Actions to Disposal	Red is 2x higher
Time to Disposal	Red is 2x higher
At least one Final Office Action	Red is 2x higher
Two or more Final Office Actions	Red is 4x higher
Restriction Office Actions	Red is 50% higher
Interviews	Red is 2x higher

Key Takeaways

- Patent procurement at the USPTO is affected by Examiner type
 - Types of Examiners: Green, Yellow, and Red Examiners
- The effort needed to obtain a patent is dependent on the Examiner type
- At least a doubling of effort needed between Red Examiners and Green Examiners



3. After Final Practice



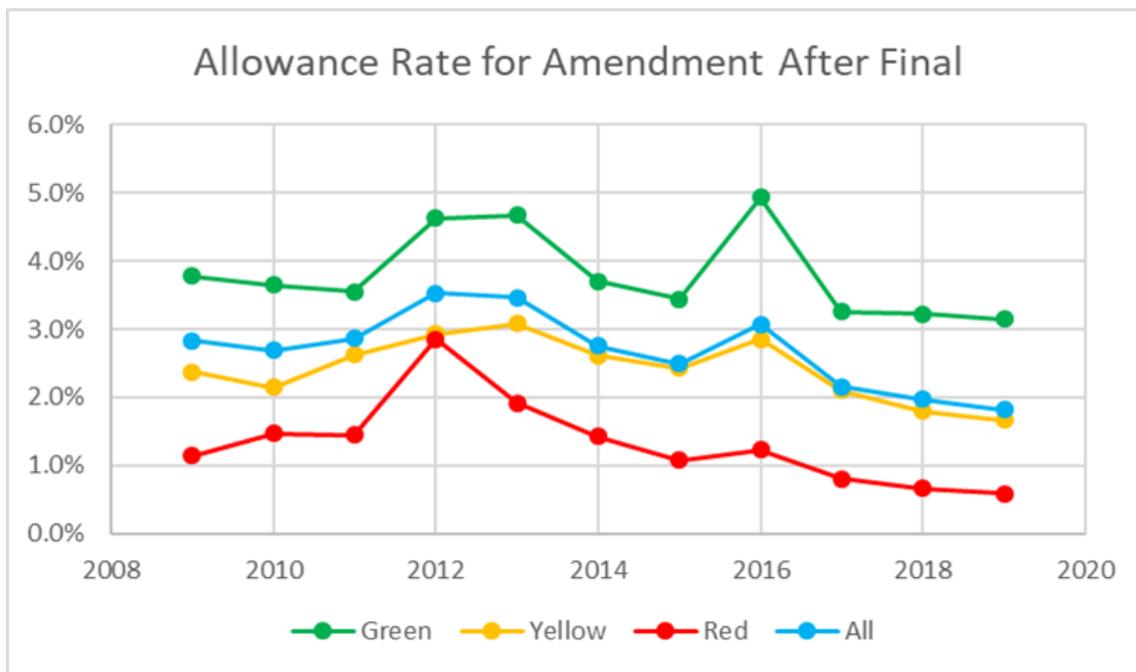
After Final Practice

- Once an Examiner sends a Final Office Action, a number of filing options are available for the next step:
 - File an After Final Response
 - File an After Final Amendment
 - File a Request for After Final Consideration Pilot (AFCP) 2.0
 - File a Request for Continued Examination (RCE)
 - File a Notice of Appeal
- What to do next?
 - Which option has the best chance of obtaining a patent?
 - Which option will be the least expensive with a good chance of obtaining a patent?
 - How will the Examiner respond to the filing?



After Final Amendment then Allowance

Examiner issues Notice of Allowance in response to After Final Amendment



Averages

3.8%

2.4%

1.3%

3x

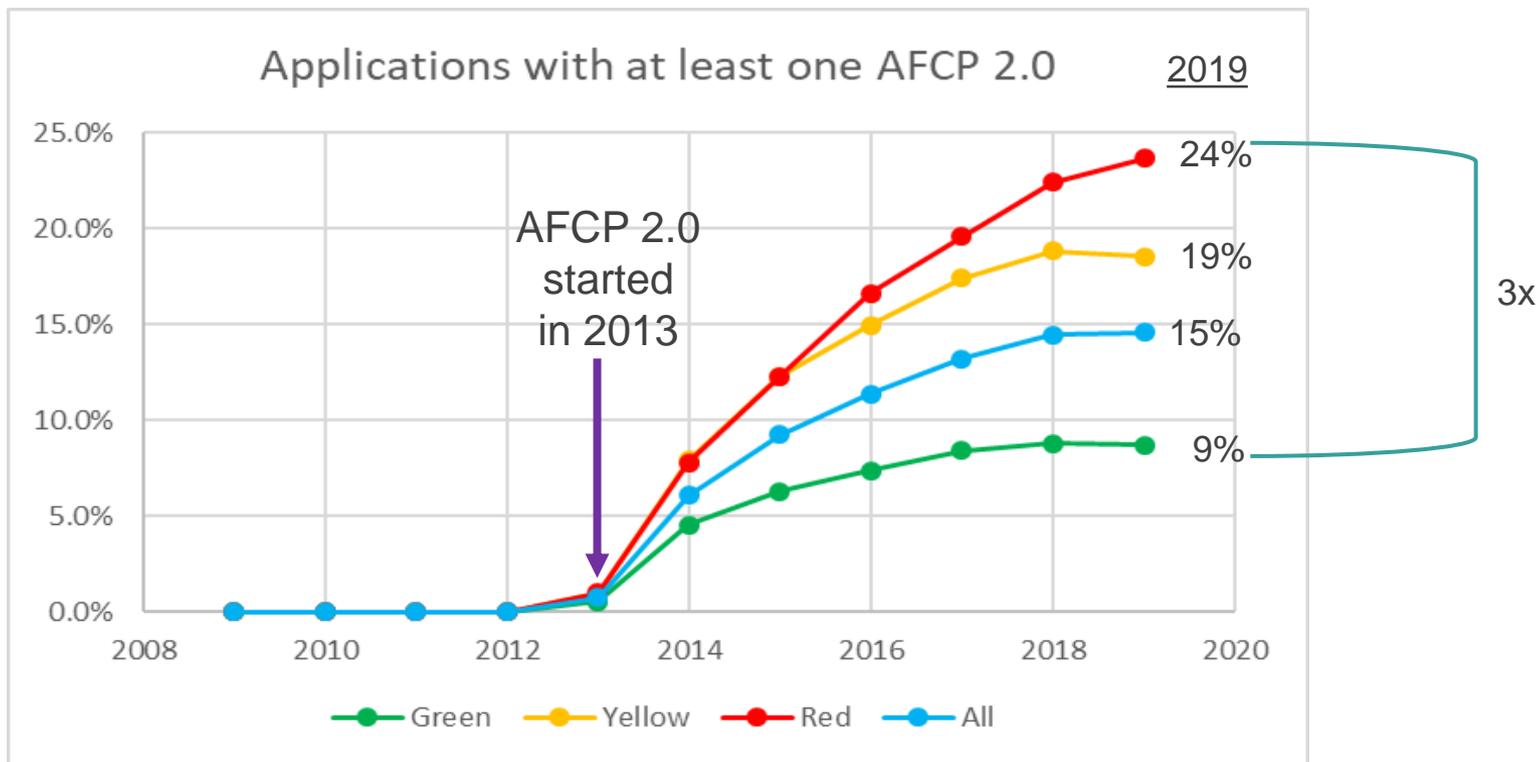
After Final Consideration Pilot (AFCP) 2.0

PTO/SB/434 (05-13)

CERTIFICATION AND REQUEST FOR CONSIDERATION UNDER THE AFTER FINAL CONSIDERATION PILOT PROGRAM 2.0		
Practitioner Docket No.:	Application No.:	Filing Date:
First Named Inventor:	Title:	
<p>APPLICANT HEREBY CERTIFIES THE FOLLOWING AND REQUESTS CONSIDERATION UNDER THE AFTER FINAL CONSIDERATION PILOT PROGRAM 2.0 (AFCP 2.0) OF THE ACCOMPANYING RESPONSE UNDER 37 CFR 1.116.</p> <ol style="list-style-type: none">1. The above-identified application is (i) an original utility, plant, or design nonprovisional application filed under 35 U.S.C. 111(a) [a continuing application (e.g., a continuation or divisional application) is filed under 35 U.S.C. 111(a) and is eligible under (i)], or (ii) an international application that has entered the national stage in compliance with 35 U.S.C. 371(c).2. The above-identified application contains an outstanding final rejection.3. Submitted herewith is a response under 37 CFR 1.116 to the outstanding final rejection. The response includes an amendment to at least one independent claim, and the amendment does not broaden the scope of the independent claim in any aspect.4. This certification and request for consideration under AFCP 2.0 is the only AFCP 2.0 certification and request filed in response to the outstanding final rejection.5. Applicant is willing and available to participate in any interview requested by the examiner concerning the present response.		

After Final Consideration Pilot (AFCP) 2.0

Applications that have at least one AFCP 2.0



Request for Continued Examination (RCE)

Doc code: RCEX

Doc description: Request for Continued Examination (RCE)

PTO/SB/30EFS (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

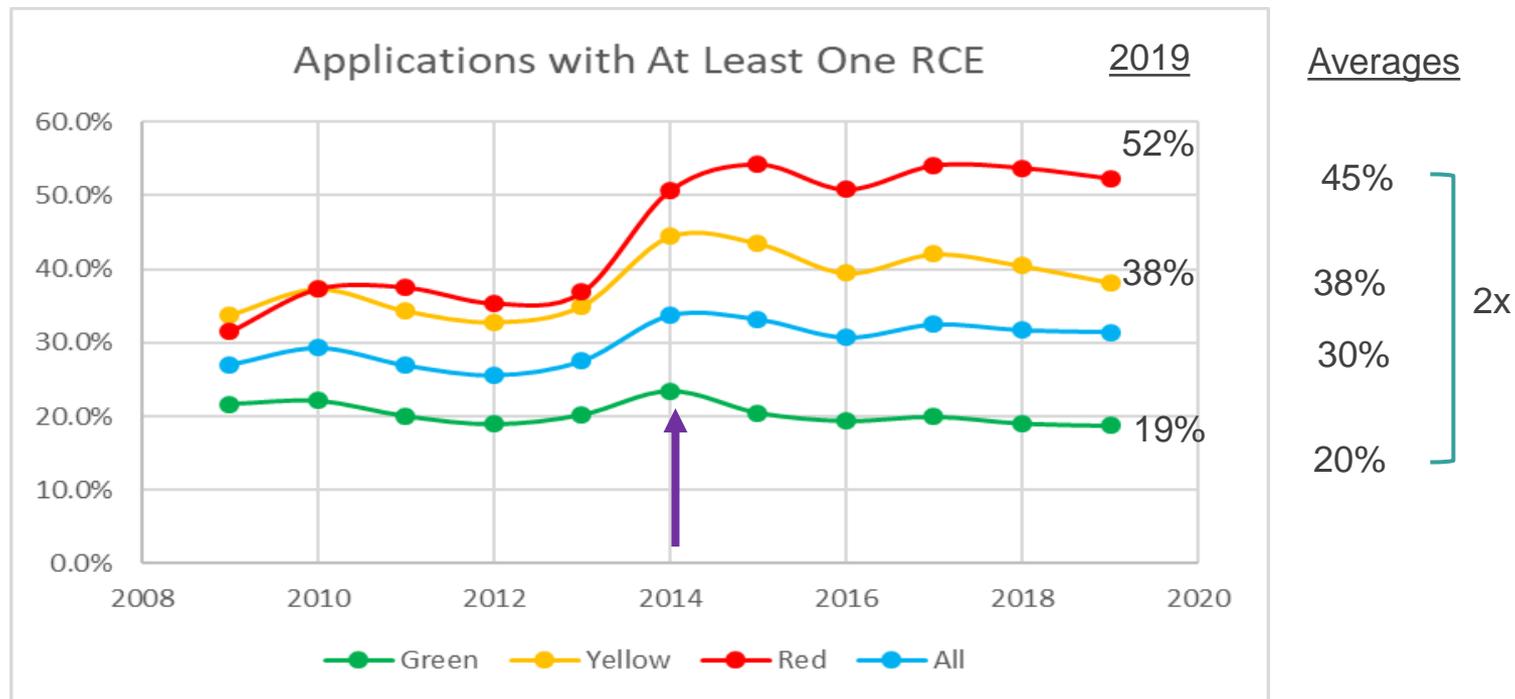
REQUEST FOR CONTINUED EXAMINATION(RCE)TRANSMITTAL (Submitted Only via EFS-Web)						
Application Number		Filing Date		Docket Number (if applicable)		Art Unit
First Named Inventor				Examiner Name		
This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application. Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. The Instruction Sheet for this form is located at WWW.USPTO.GOV						
SUBMISSION REQUIRED UNDER 37 CFR 1.114						
Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).						
<input type="checkbox"/> Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.						
FEES						
<input type="checkbox"/> The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.						
<input type="checkbox"/> The Director is hereby authorized to charge any underpayment of fees, or credit any overpayments, to Deposit Account No _____						

1st RCE:
\$1,300

2nd or more RCE:
\$1,900

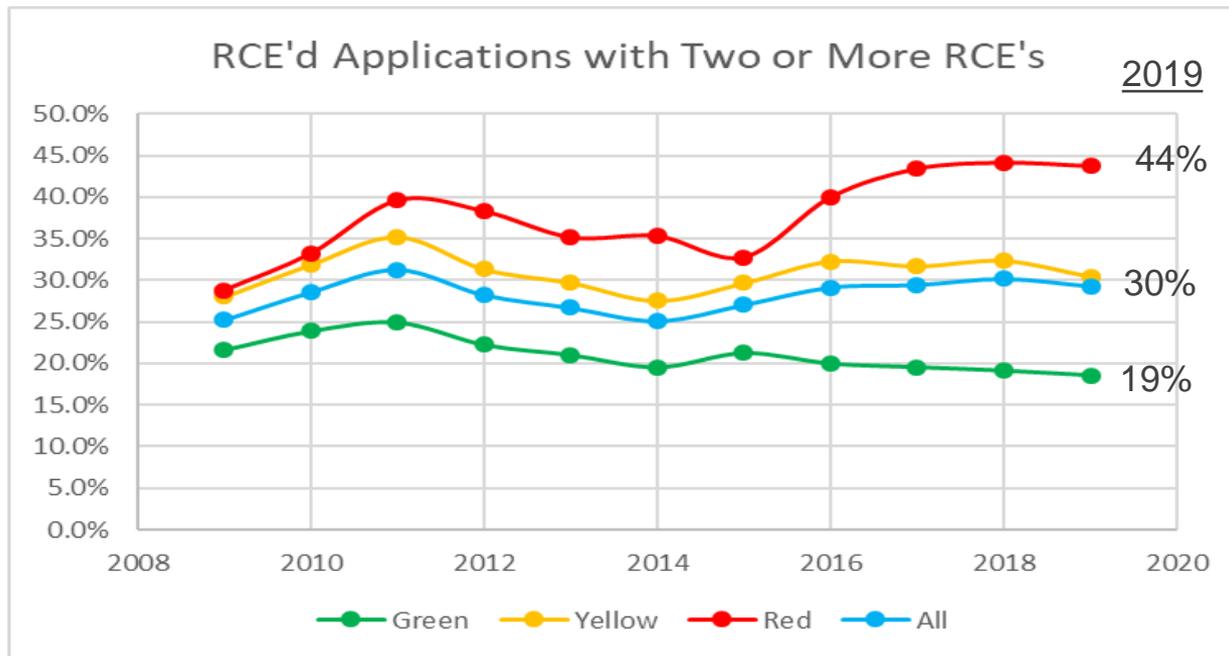
At Least One RCE

Applications that have at least one Request for Continued Examination (RCE)



RCE'd Applications with Two or More RCEs

If an Application has one RCE, what percentage have two or more RCE's



Averages

38%
31%
28%
21% } 2x

Appeal to PTAB

USPTO Patent Trial and Appeal Board (PTAB)

PTO/AIA/31 (03-14)

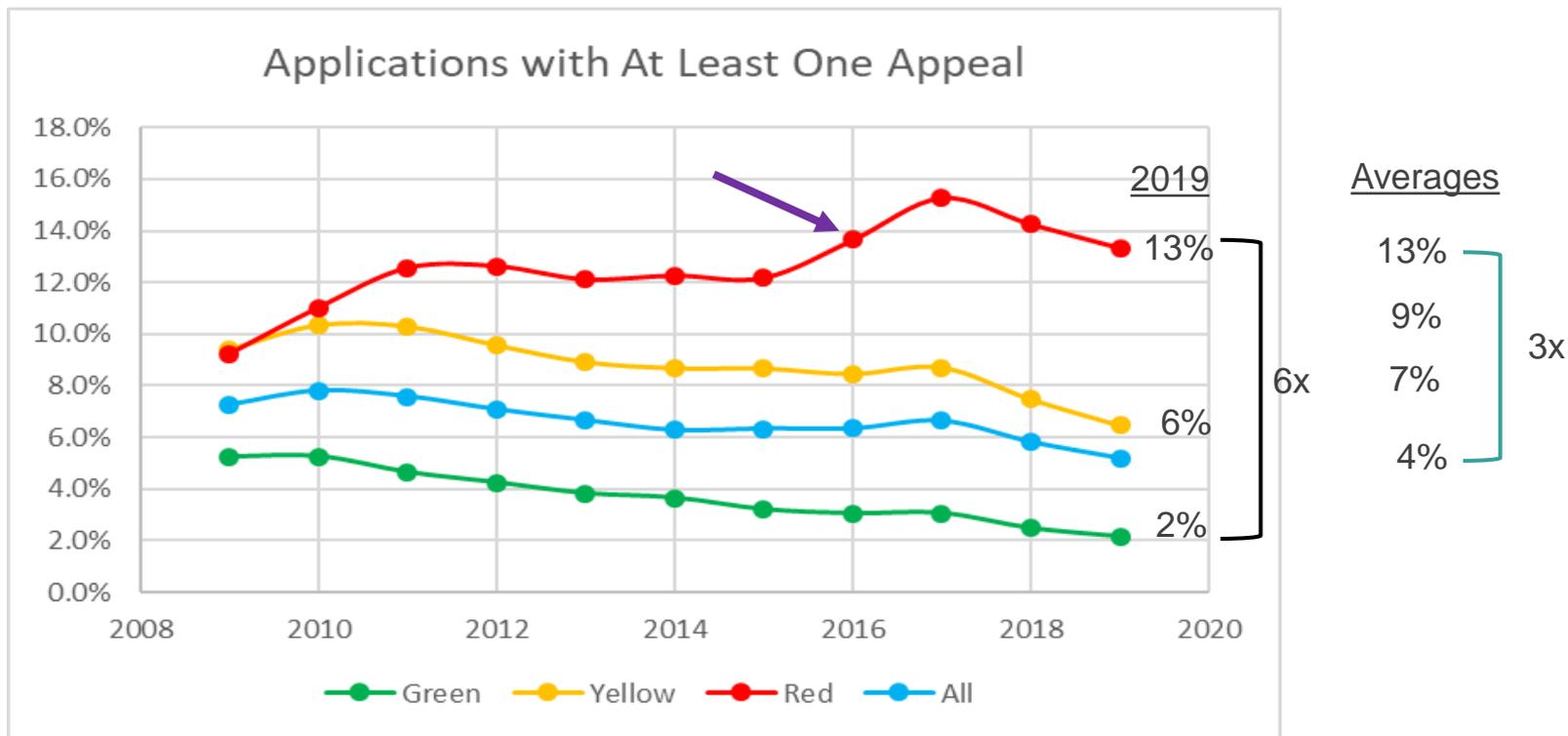
Approved for use through 11/30/2020. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

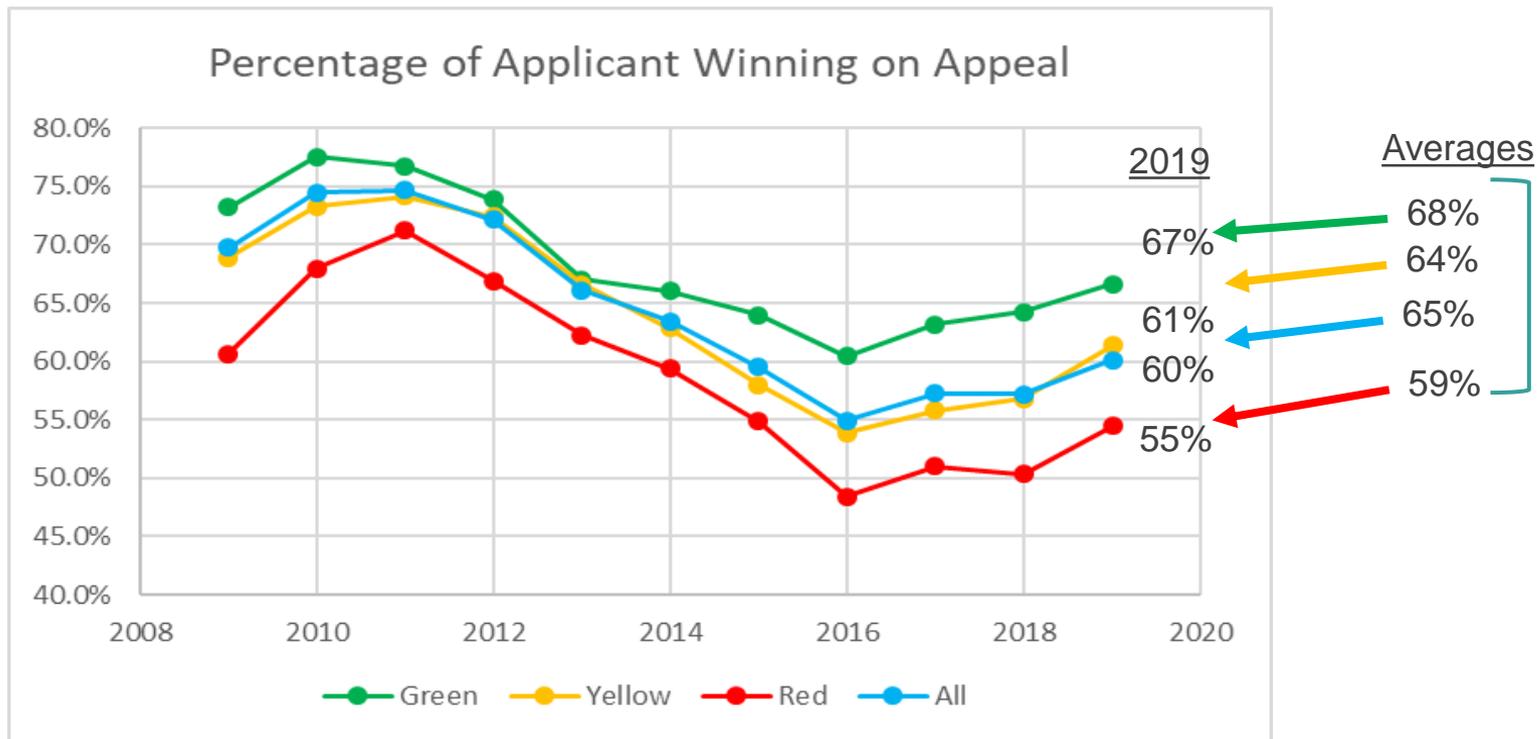
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

NOTICE OF APPEAL FROM THE EXAMINER TO THE PATENT TRIAL AND APPEAL BOARD		Docket Number (Optional)	
I hereby certify that this correspondence is being facsimile transmitted to the USPTO, EFS-Web transmitted to the USPTO, or deposited with the United States Postal Service with sufficient postage in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, on Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	In re Application of		
	Application Number	Filed	
	For		
	Art Unit	Examiner	
Applicant hereby appeals to the Patent Trial and Appeal Board from the last decision of the examiner.			
The fee for this Notice of Appeal is (37 CFR 41.20(b)(1))		\$ 800 _____	

Application with at Least One Appeal



Applicant Winning on Appeal



Impact of Examiner Type on Patent Procurement

After Final Practice

- Comparing Green Examiners vs. Red Examiners

Metric	Green vs. Red
Allowance Rate in response to After Final Amendment	Green is 3x higher
AFCP 2.0	Red is 3x higher
At least one RCE	Red is 2x higher
RCE'd Applications with two or more RCE's	Red is 2x higher
Allowance Rate in response to RCE	Green is 4x higher
Time to next Action after RCE	Red is 50% higher
Appeals	Red is 3x higher
Win Rate on Appeal	Green is 15% higher

Conclusions

- With a limited patent procurement budget, need to be efficient and cost effective as possible
- Knowing the Examiner type can help:
 - Strategize on prosecution tactics
 - Craft responses to Office Actions
 - Anticipate time needed to obtain a patent
 - Anticipate prosecution costs

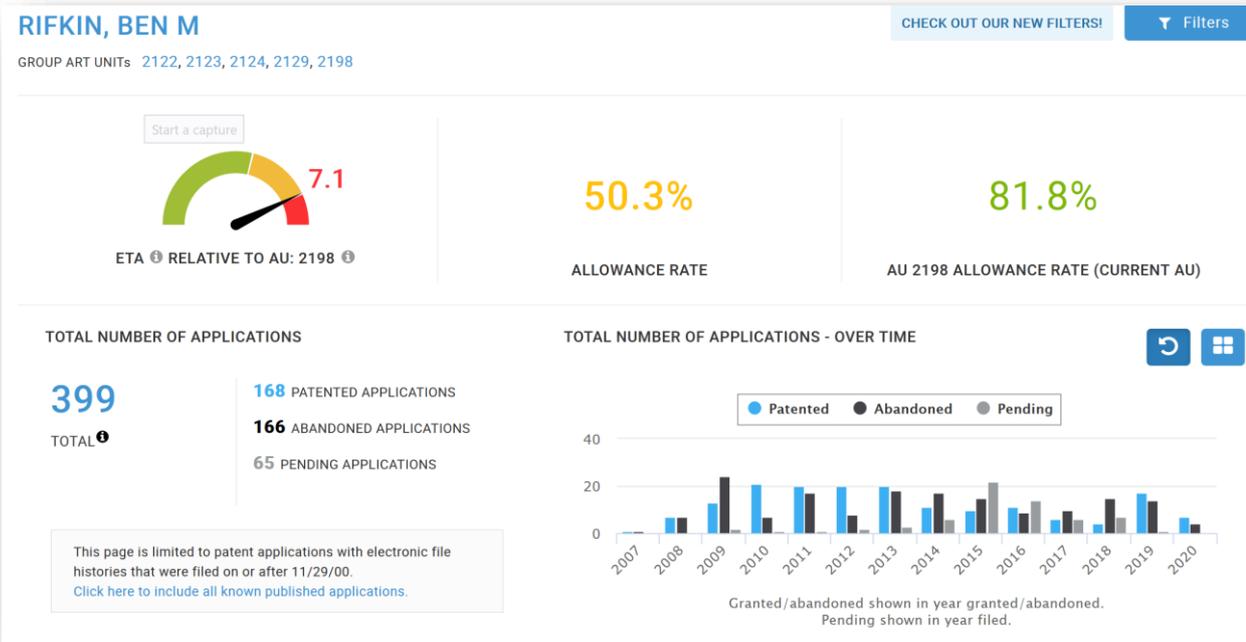
Impact of Examiner Type on Patent Procurement

For more details, see the 4-part series of articles on [IP Law 360](#)

- Part 1: [Few Allow Many, Many Allow Few](#)
- Part 2: [Doubling the Effort](#)
- Part 3: [After Final Practice](#)
- Part 4: [Impact on Patent Litigation](#)

The image displays four overlapping document thumbnails from the IP Law 360 website. Each thumbnail is titled "How USPTO Examiner Type Affects Patents: Part 3" and is attributed to Michael Santoro and Matt Walsh. The thumbnails contain text excerpts and a portrait of Michael Santoro. The text in the thumbnails discusses the impact of examiner type on patent procurement, mentioning the LexisNexis PatentAdvisor database and the USPTO's Tech Centers. The text is partially obscured by the overlapping nature of the thumbnails.

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Examiner statistics include:

- Interview
- AFCP 2.0
- Office Actions
- Appeals
- ... much more

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