McBee Moore & Vanik IP Uses LexisNexis PatentAdvisor® to Craft Persuasive Prosecution Arguments

Using PatentAdvisor™, the firm is able to reduce uncertainty during patent prosecution and be more responsive to clients' needs.

At a glance

Customer

McBee Moore & Vanik IP, LLC

Requirements

- Embrace emerging technologies to drive new efficiencies and give clients better returns on their investment in both money and time

- Shepherd clients through the patent application process and develop strategies for successful outcomes

- Craft data-driven applications and rejection responses leveraging examiner behavior insights

- Use data backed insights to build trust with clients

Solution

With PatentAdvisor, McBee Moore and Vanik IP is able to leverage key insights to reduce uncertainty, be more responsive, work faster and more efficiently to identify appropriate prosecution options and ultimately, build trust with clients.

McBee Moore & Vanik IP, LLC

In 2016, with a mission to improve client service, three patent lawyers—Susan McBee, C.G. Moore and David Vanik—came together along with 12 other professionals to form a new patent law firm, McBee Moore & Vanik, or MMVIP. Based in Maryland, the six-year-old firm works with clients that range from start-ups to large multinationals in scientific fields such as biotechnology, chemistry and pharmaceuticals. Seven practitioners hold PhDs, one holds an MD, and four are former United States Patent and Trademark Office (USPTO) examiners. Together, the team helps clients with everything from consultations during the initial phases of product development—such as identifying likely candidate inventions for patent protection—to obtaining patent rights, and defending those rights or challenging the patent rights of others.

Digital technology shifts the legal landscape

Before launching MMVIP, McBee, Moore and Vanik had worked together in a large general-practice law firm. Excited by advances in technology, they had become frustrated at the slow speed with which the legal sector was adapting to the digital revolution. "It was already taking place in other industries and we were watching it passing us by," says C.G. Moore, partner at McBee Moore & Vanik.

As U.S. and European patent offices started digitizing their data, they saw an opportunity to create a boutique firm that would use emerging technologies to drive new efficiencies and give clients better returns on their investment in both money and time. "We wanted to take technology and use it to help us do our work better," says Moore. "So we decided to do it ourselves."

With clients working mainly in chemistry and biotech, MMVIP serves a wide range of enterprises, from individual inventors and startups to universities, government agencies and Fortune 500 companies. "It's the entire spectrum," says Moore. "An individual might have had an idea and their sister-in-law told them that they should talk to a patent lawyer. Or it might be a very large established corporation where we're managing a portion of their patent portfolio."

Different organizations have different requirements and motivations, he explains. "For individuals, it's often speed—they want it now and they don't want it to be expensive. For universities and government entities, their mission is often to get the inventions out for the public good.

> "It takes time and effort to get something patented. So clients need to know what is relevant to their business now, what will be relevant in five years' time and how much they are going to spend over the lifetime of a portfolio."
>
> **C.G. Moore, Partner, McBee Moore & Vanik IP, LLC**

And for corporations, they want their assets protected, or to use them to build connections with other entities."

However, for all organizations, the digitization of legal information means managing increasingly large volumes of data. "It's easy to get overwhelmed and then you miss the forest for the trees," says Moore.

Navigating the patent prosecution process

A critical step in turning ideas into commercial products or services is patent prosecution—the process of drafting, filing, and working with the US Patent and Trademark Office (USPTO) to secure patent protection for an innovation.

Navigating this process is a core part of what MMVIP offers its clients. "Our bread and butter is patent prosecution," says Moore.

> *"PatentAdvisor enables us to have an evidence-based discussion with our clients about an examiner."*
>
> **C.G. Moore, Partner,**
> **McBee Moore & Vanik IP, LLC**

The nature of patent prosecution means decisions need to be made at different points during the process, depending on whether examiners in the patent office decide to grant or reject a patent application.

The challenge is that, with no choice over the patent examiner who takes up a case, firms such as MMVIP must build up knowledge of individual examiners, what language describing the innovation is most likely to meet their requirements and what kinds of applications they are likely to accept or reject.

"The office examines it and you get a first rejection. And more often than not, the next thing very usually is a final rejection," explains Moore. "But just because it's final doesn't mean you can't go back. You have options."

One option, he says, might be paying a fee to reset the clock and file the application again with the same examiner. There are also opportunities to have a

conversation about the application. "We might call the patent office on the phone and have an interview," says Moore. "Or we might come to an impasse and feel the only option remaining is to appeal. Then it's another level of exchange between us and a panel of administrative patent judges."

Knowing which option to choose—and when to withdraw if the costs look too high or the chances of success too low—is how MMVIP helps shepherd its clients through the application process. Using insights into the decision making choices of different examiners, the firm crafts applications that have the best chance of success and develops strategies to follow in the highly likely case that an application will fall at the first hurdle. And this is where PatentAdvisor plays a critical role.

Building trust by basing decisions on data

Moore remembers a time when decisions on which strategies to use with a particular patent examiner had to be based on personal experience. "When I started in this field, I was learning to argue back against examiners but I didn't know one from any other," he says. "As I progressed, I started encountering a few of the same examiners and I got to understand them better and know what it would take to convince them."

For MMVIP, technology has changed all this. Using PatentAdvisor, the firm can easily look up an individual examiner and see their allowance rates (the percentage of applications that receive an approval), the different categories of rejections they give and the basis for those rejections, the likelihood of success after interviewing an examiner, and the likelihood of success with an appeal.

"Suddenly, along comes PatentAdvisor, which is taking all this information and combining it into a database," says Moore. "That provides an important window into the examiner's behavior."

PatentAdvisor, he explains, enables the firm to have discussions with clients about different examiners that are based on hard data, and not simply having worked with them in the past. "It's become integrated into the way we talk to our clients and the way they talk to us, because they expect to have discussions about these kinds of things," says Moore.

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Ultimately, by using PatentAdvisor data to reduce uncertainty, be more responsive and work faster and more efficiently to identify appropriate prosecution options, technology is helping MMVIP develop close relationships with the innovators it is serving. "One of the biggest benefits is that it's facilitating deeper discussions," says Moore. "And that builds trust with clients."

> *"It's giving everyone a direction that's not just based on gut feeling or perceptions, because those could be wrong—this is hard numbers."*

C.G. Moore, Partner,
McBee Moore & Vanik IP, LLC

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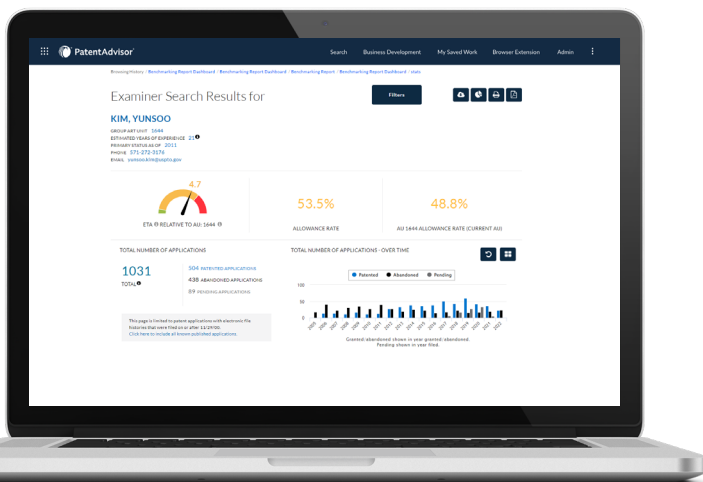
Anticipate an examiner's behavior for better prosecution outcomes

PatentAdvisor Examiner Time Allocation (PatentAdvisor ETA™) is a more reliable predictor of examiner behavior than 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

Quickly find winning arguments for every interaction with the USPTO

Reinforce your appeals by researching curated ex parte appeals data that are tagged to 217 specific legal issues that arose on appeal.

- Develop scientifically supported and defendable prosecution action.
- Identify the right arguments for your appeal or brief office action response.
- Overturn examiner's specific rejections.
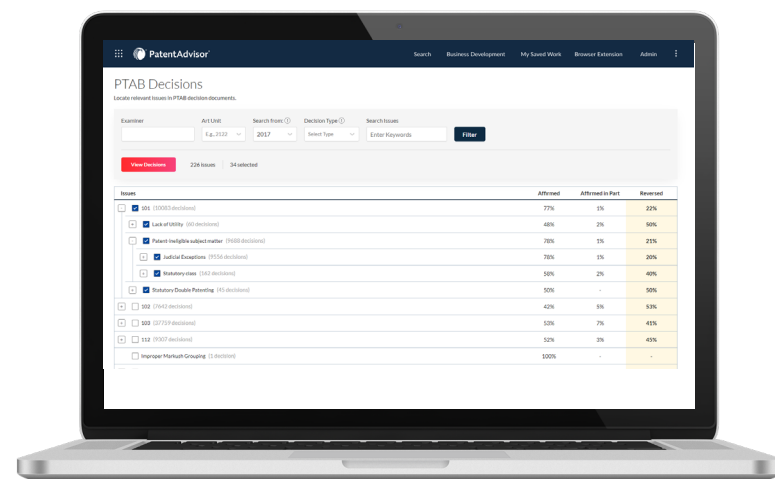
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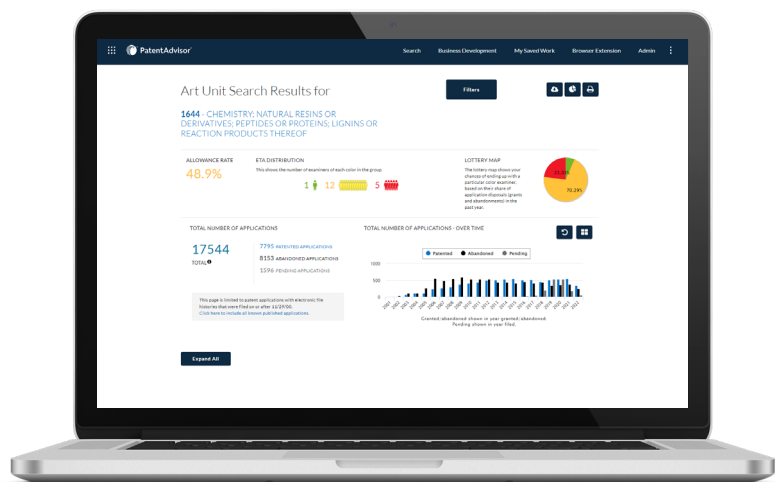
Predict the likelihood of winning the examiner lottery and identify high-risk cases

Tailor your patent application to target the most favorable tech center group, and predict the likelihood of being assigned to a specific type of examiner with the LexisNexis PatentAdvisor® Examiner Lottery Framework™.

- Identify target tech center groups with a higher chance for a favorable examiner using Tech Center Navigator within LexisNexis PatentAdvisor®.
- Infer the current makeup of patent examiners (most to least favorable) in an art unit with the ETA Distribution.
- Identify the probability of being assigned to a specific type of examiner using the Lottery Map.
- Predict the type and quantities of rejections and the likelihood of a grant based on statistical models in QuickPAIR.

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- Compare and benchmark your firm's prosecution performance against that of your competition.
- Metrics are based on objective prosecution performance as opposed to examiner efficiency.
- Take examiner difficulty out of the equation and score purely for efficiency based on the proprietary PatentAdvisor Efficiency Score.
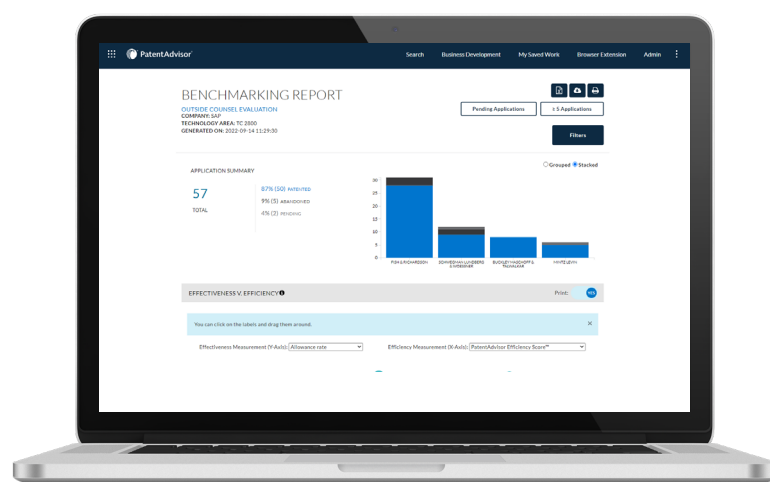
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