

# How to Reduce Your Time Spent in Appeal Processes with LexisNexis PatentAdvisor®

Lunch & Learn  
Wednesday, March 29<sup>th</sup>

Presented by:

**Katie Brown**

Customer Success Manager  
LexisNexis Intellectual Property Solutions

# Session Agenda

Today we will discuss how to:

- Easily find winning arguments in PTAB decisions and get more accurate and relevant prosecution guidance.
- Quickly find cases that are particularly relevant to you.
- Find and use settled MPEP interpretations during prosecution providing favorable case law straight from the board.
- Get additional information about examiner behavior that will be beneficial throughout all stages of the prosecution process.

# Background

## Challenges:

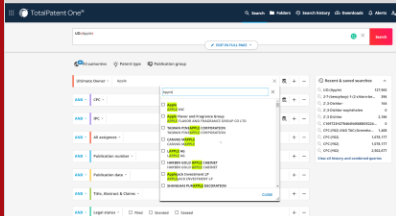
- Filing an ex parte appeal is sometimes the best option for overcoming an examiner's repeated rejections.
- The appeal process is often expensive and time-consuming.
- Navigating the process efficiently and effectively is of the utmost importance.

## Solution:

- LexisNexis PatentAdvisor helps you easily find winning arguments and get accurate and relevant prosecution guidance.

# Our unmatched suite of solutions brings clarity to innovation

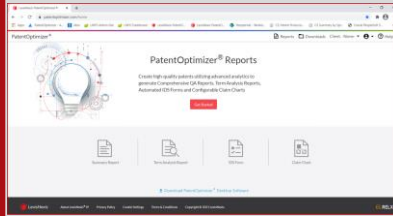
## Reliable global patent search



### LexisNexis TotalPatent One®

- Search through 110 million patent full text documents in English or original language
- Receive harmonized ownership information
- Set up alerts
- Search Orange Book and SPC

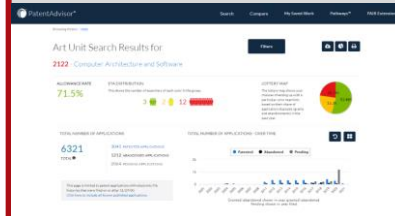
## Higher quality patent drafting



### LexisNexis PatentOptimizer®

- Draft higher quality applications
- Perform quality control checks and create "one-click" error reports
- Auto-generate the desired language specific to your office action rejections and objections

## Predictive prosecution analytics



### LexisNexis PatentAdvisor®

- Improve prosecution outcomes and manage stakeholder expectations
- Save time and increase ROI
- Efficiently manage your resources
- Generate more business

## Advanced patent intelligence and analytics



### LexisNexis® PatentSight®

- Empower strategic decision-making
- Identify high value patents
- Streamline and automate workflows
- Convince with story-telling visualizations

# The challenges facing patent prosecutors today



## Time Pressure

Every patent prosecutor faces the challenge of securing high-quality patents efficiently and accurately amidst:

- Tight deadlines
- Limited resources

## Uncertainty

Managing the patent prosecution process, crafting your prosecution strategy, and building your prosecution budget can be challenging when:

- You have no control over your examiner assignment
- You have no idea of what to expect from the examiner

## Unpredictability

The prosecution process can be unpredictable in terms of:

- Steps required to obtain a patent
- Length of time for prosecution
- Chance of success

## Insights from PatentAdvisor can help you:



### Improve prosecution outcomes

with powerful examiner analytics enabling transparency and predictability.



### Evaluate and manage outside counsel

by measuring law firm performance against USPTO Averages.



### Set accurate prosecution budgets

with insightful data at the point of need. Predict application classification and likely outcomes, and identify at-risk applications early-on.



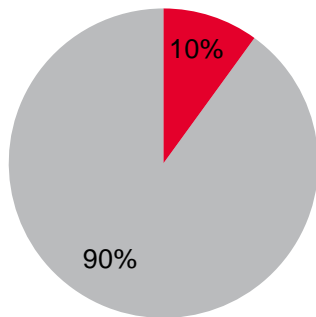
### Conduct competitive analysis

Benchmark your portfolio against others in the same space.

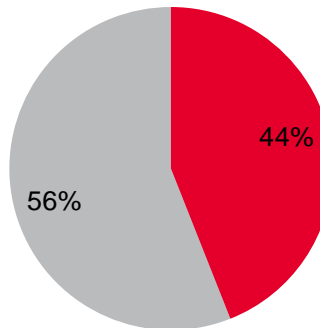
# There are two extremely different categories of USPTO patent examiners<sup>1</sup>

## Category A

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



■ >50 Pat/Yr  
■ Rest of Exmr



■ >50 Pat/Yr  
■ Rest of Exmr

<sup>1</sup>[Office Actions per Grant Ratio \(OGR\): A New Metric for Patent Examiner Activity by Professor Shine Tu](https://ssrn.com/abstract=3100326) (<https://ssrn.com/abstract=3100326>)

# There are two extremely different categories of USPTO patent examiners<sup>1</sup>

## Category B

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



<sup>1</sup>[Office Actions per Grant Ratio \(OGR\): A New Metric for Patent Examiner Activity by Professor Shine Tu](https://ssrn.com/abstract=3100326) (<https://ssrn.com/abstract=3100326>)



# Anticipate an examiner's behavior for better prosecution outcomes

Powerful examiner analytics enable transparency and predictability

**PatentAdvisor Examiner Time Allocation™ (ETA)** is the single most informative metric for **predicting examiner behavior**, which can affect length and cost of prosecution, as well as likelihood of allowance.

**ETA calculation is based on number of office actions / number of allowances** (including factors like pending cases, examiner tenure)



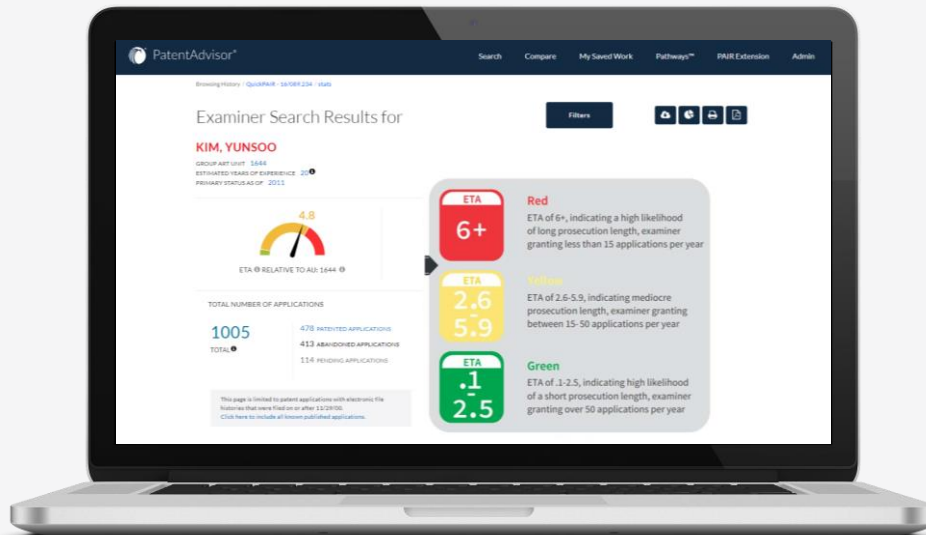
ETA ⓘ RELATIVE TO AU: 2834 ⓘ

# Anticipate an examiner's behavior for better prosecution outcomes

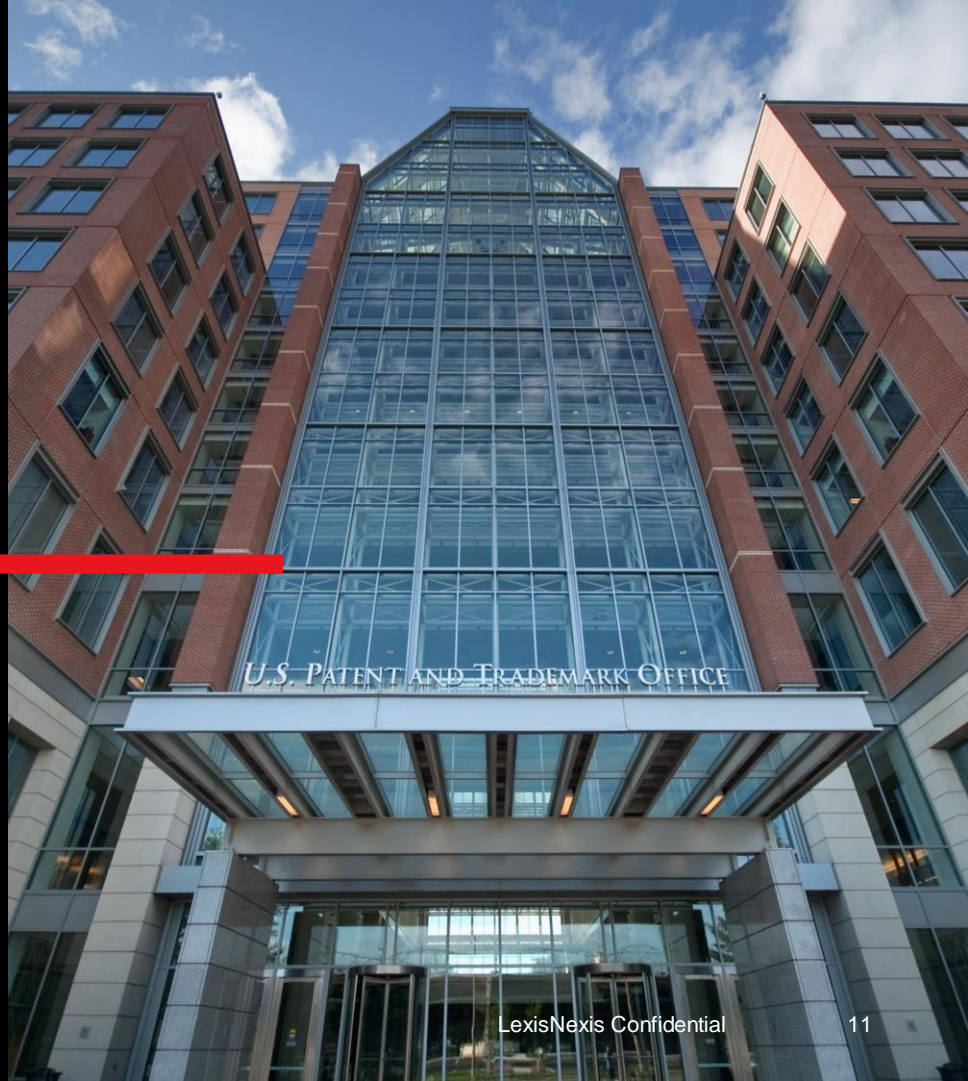
Powerful examiner analytics enable transparency and predictability

ETA is a more reliable predictor of examiner's behavior than Allowance Rate because it:

- Includes all pending applications
- Factors how long the examiner has been at the Patent Office
- Is driven by the examiner's behavior, not by the filer's actions



# Using Examiner Statistics to Guide Appeal Strategy



# Identifying Appeal Candidates Using Prosecution Pattern Monitoring

- Use Prosecution Pattern Monitoring to help manage a large pending patent portfolio
- Identify applications needing further review or a carefully crafted prosecution strategy
- Monitor applications for specific conditions
- Identify **Candidates to Appeal**: applications with a high likelihood of appeal win against a difficult examiner

## Conditions

Monitor for patterns using custom conditions

+ Add Condition

or predefined templates

+ Add Template

## Limit to applications by status

Limit to  cases only

## Pre-appeal likelihood of a win or loss

Applicant's pre-appeal likelihood of a  is  than  %

## Overall appeal likelihood of win or loss

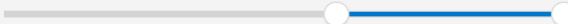
Applicant's overall likelihood of a  on appeal is  than  %

## Examiner's allowance rate

Examiner allowance rate is  than  %

## ETA

Examiner's ETA is: 6 - 10+



# Identifying Appeal Candidates Using Prosecution Pattern Monitoring

- Identify applications with **Extended Prosecution, No Interview and No Appeal**: applications that have received 3 or more Office Actions and have not yet had an interview or appeal

Conditions

Monitor for patterns using custom conditions  or predefined templates

Limit to applications by status

Limit to  cases only

Number of office actions

Number of office actions

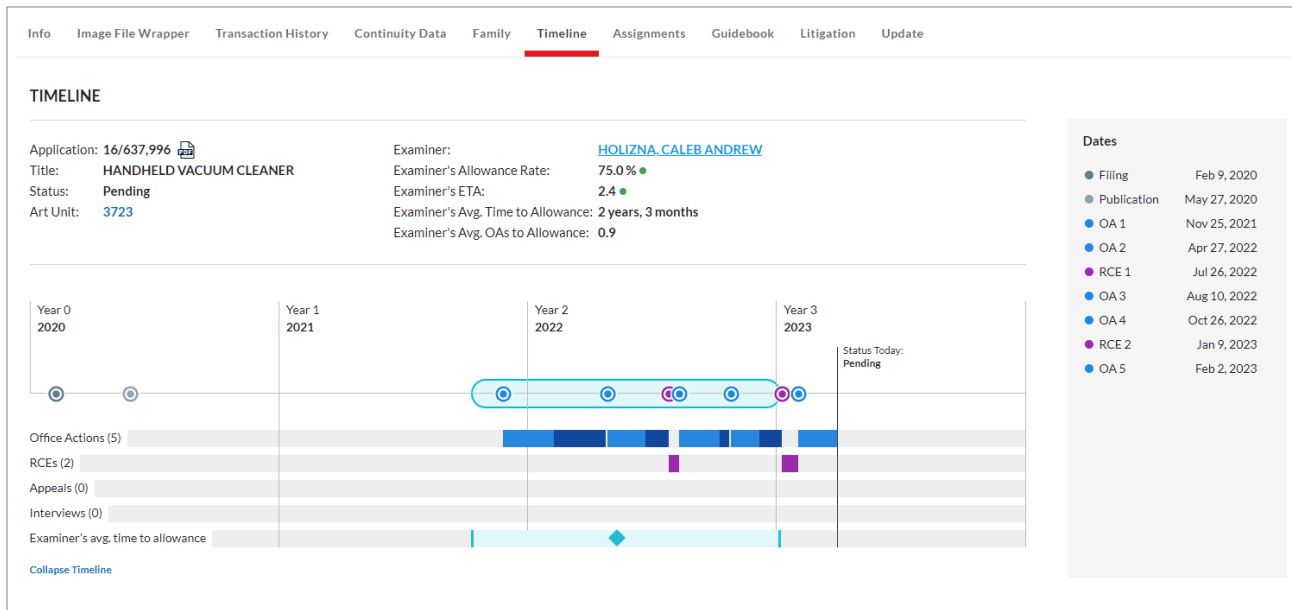
Prosecution history event

Event of a type

# QuickPAIR Timeline

- Quickly and easily gain insight into the status of the application, as well as which strategies have or have not been used, using the QuickPAIR Timeline

Application: 16/637,996



# Examiner Dashboard

- View your examiner's dashboard to better understand their behavior and guide your strategy through all stages of prosecution
- Receive information about your examiner including ETA, allowance rate, office action statistics, and much more

Examiner Search Results for

Filters



## ANDREWS, MICHAEL

GROUP ART UNIT 2834  
ESTIMATED YEARS OF EXPERIENCE 16  
PRIMARY STATUS AS OF 2014  
PHONE 571-270-7554  
EMAIL michael.andrews@uspto.gov



ETA RELATIVE TO AU: 2834

64.4%

ALLOWANCE RATE

77.1%

AU 2834 ALLOWANCE RATE (CURRENT AU)

TOTAL NUMBER OF APPLICATIONS

1,153

TOTAL

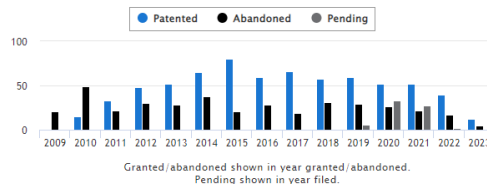
61% (698) PATENTED

33% (386) ABANDONED

6% (69) PENDING

This page is limited to patent applications with electronic file histories that were filed on or after 11/29/00.  
[Click here to include all known published applications.](#)

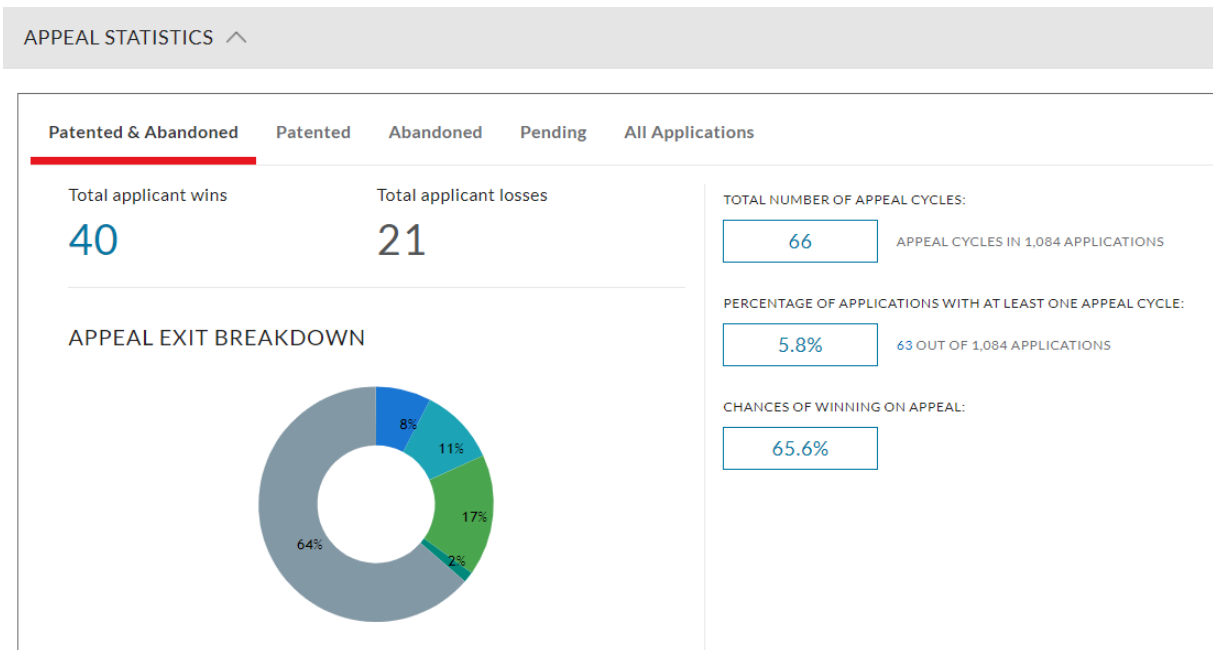
TOTAL NUMBER OF APPLICATIONS - OVER TIME



Granted/abandoned shown in year granted/abandoned.  
Pending shown in year filed.

# Examiner Appeal Statistics

- View your examiner's appeal statistics to help determine whether it makes sense to appeal
- Evaluate overall chances of winning on appeal





## Examiner Appeal Statistics

- View the final outcomes of each appeal cycle, including PTAB decisions, and see the next significant event following each appeal cycle

BPAI/PTAB Decision:

63.6%

42 of 66 cycles

The next significant event was:

Allowance	22 (Applicant Win)
Abandonment	14 (Applicant Loss)
RCE	5 (Applicant Loss)
Final Office Action	1 (Applicant Win)
Non-final Office Action	0 (Applicant Win)

## Examiner Ex Parte PTAB Cases

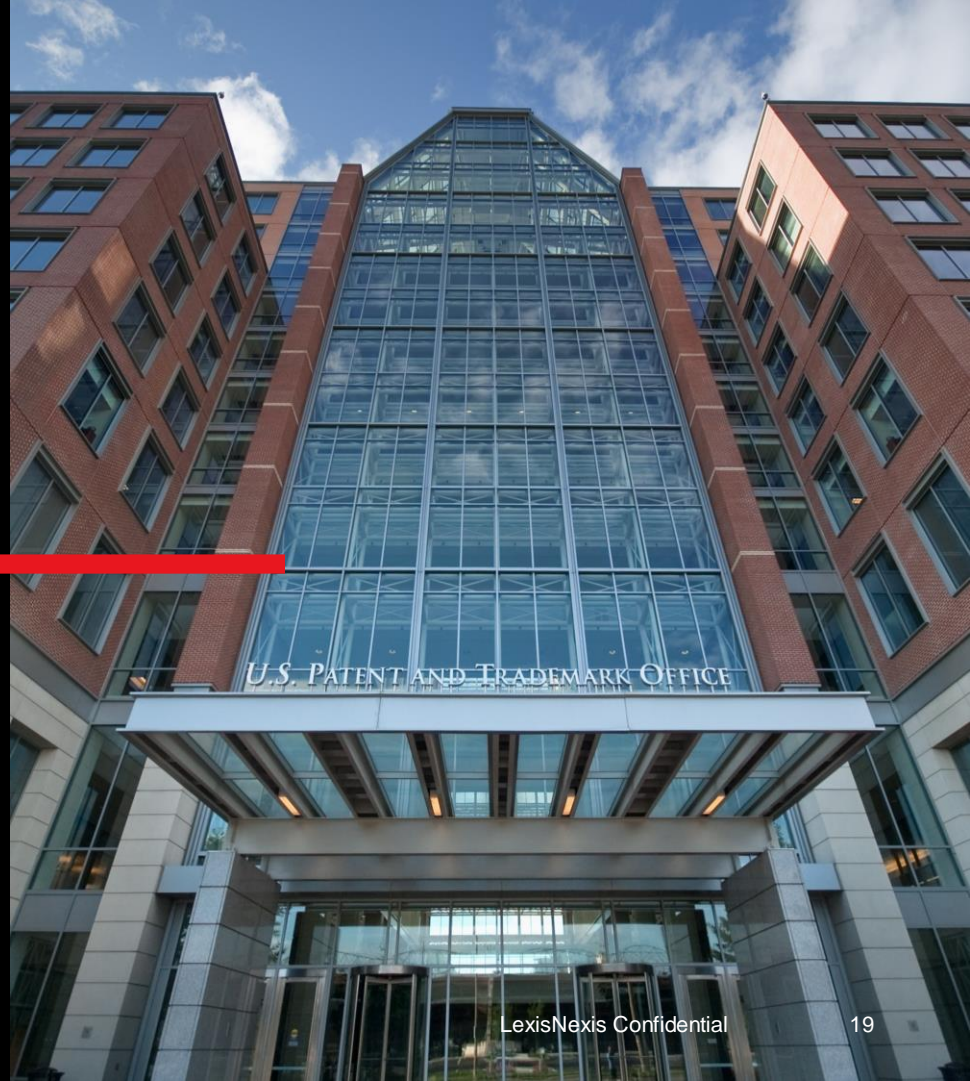
- View each examiner's ex parte PTAB case outcomes and decision documents directly in the examiner dashboard

EX PARTE PTAB CASES ^

View & Filter in PTAB Decisions

Issues	Case name	Application number	Outcomes	Decision date ↑↓
103	<a href="#">Ex parte Joseph Kenneth Coldwate and Andreas C. Koenig</a>	16/363,601	Affirmed	11/25/2022
103	<a href="#">Ex parte Jagadeesh Tangudu and Zaffir A. Chaudhry</a>	15/869,793	Affirmed	09/26/2022
103	<a href="#">Ex parte Kerry Baker Shelton</a>	15/910,223	Affirmed	02/10/2022
103 112(a) 112(b)	<a href="#">Ex parte Waldemar Becker</a>	15/577,737	Not available Affirmed In Part Examiner Reversed	08/20/2021
112(a) 112(a) 112(b)	<a href="#">Ex parte Waldemar Becker</a>	15/577,738	Examiner Reversed Not available Affirmed	07/26/2021
103	<a href="#">Ex parte Electric Corporation</a>	15/500,609	Examiner Reversed	12/10/2020
103	<a href="#">Robert D. Hall et al.</a>	14/665,750	Examiner Reversed	09/17/2020
103	<a href="#">Globe Motors, Inc.</a>	15/139,393	Examiner Reversed	09/02/2020

# PatentAdvisor PTAB Decisions



# PTAB Decisions

Welcome to LexisNexis PatentAdvisor®

## Search

Insights

QuickPAIR

Examiner

Art Unit

Assignee

Law Firm

Tech Center Navigator

Research

File Wrappers

PTAB Decisions



## Business Development & Analysis

Law Firm Report Card

Evaluate your law firm's performance

Outside Counsel Evaluation

Compare multiple law firms

Tech Space Benchmarking

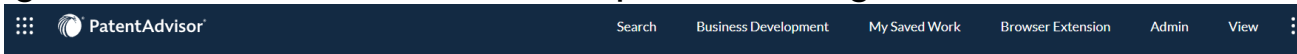
Evaluate companies or law firms in specific technologies

Licensing Reports **BETA**

Identify targets for possible licensing deals

# PTAB Decisions

- PatentAdvisor is the only prosecution analytics platform with over 111,000 ex parte appeal documents tagged to 229 legal issues
- PTAB Decisions tool allows you to easily find winning arguments and get more accurate and relevant prosecution guidance



## PTAB Decisions

Locate relevant issues in PTAB decision documents.

229 issues | 0 selected

Issues	Affirmed	Affirmed in Part	Reversed
<input type="checkbox"/> 101 (10,404 decisions)	78%	1%	21%
<input type="checkbox"/> 102 (7,938 decisions)	42%	5%	53%
<input type="checkbox"/> 103 (39,602 decisions)	52%	7%	41%
<input type="checkbox"/> 112 (9,690 decisions)	52%	3%	45%
<input type="checkbox"/> Improper Markush Grouping (1 decisions)	100%	-	-
<input type="checkbox"/> Obviousness Type Double Patenting (1,891 decisions)	71%	3%	25%

Reversal statistics provided only where we are confident we have all the data.

# PTAB Decisions

- Drill down to view outcomes of specific legal issues relevant to your case
- Search and filter results by Examiner, Art Unit, date range, decision type, and legal issue (keyword search)
- Example: search for decisions involving the legal issue “**hindsight**”

## PTAB Decisions

Locate relevant issues in PTAB decision documents.

Examiner  Art Unit  Search from:  Decision Type  Search Issues

229 Issues | 1 selected

Issues	Affirmed	Affirmed in Part	Reversed
<input type="checkbox"/> 101 (10,404 decisions)	78%	1%	21%
<input type="checkbox"/> 102 (7,938 decisions)	42%	5%	53%
<input checked="" type="checkbox"/> 103 (39,602 decisions)	52%	7%	41%
<input checked="" type="checkbox"/> 103(a) (37,986 decisions)	53%	7%	40%
<input type="checkbox"/> Arguments must comply with rules for persuasive force (1,856 decisions)	-	-	-
<input checked="" type="checkbox"/> Examiner Bears Initial Burden (Prima Facie Case) (30,147 decisions)	-	-	-
<input checked="" type="checkbox"/> Clear and Factually-Supported Articulation of Reasons for Obviousness (21,525 decisions)	-	-	-
<input type="checkbox"/> Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results (584 decisions)	-	-	-
<input checked="" type="checkbox"/> At time of Invention (no <b>hindsight</b> ) (3,788 decisions)	-	-	-

# PTAB Decisions

- View relevant PTAB decisions, including outcomes
- Additional filters: Outcome, Judge, Customer Number/Law Firm, keywords
- Click **Application #** to view the application in **QuickPAIR**
- Click **Case Name** to view the decision document

[← PTAB Decisions](#)

## Decisions by Issue

Outcome

Judge

Customer Number / Law Firm

Search Decisions

**Filter**

---

3788 decisions
0 selected
 Download Decisions

<input type="checkbox"/> Issues	Case Name	Application #	Outcome	Decision Date <span style="font-size: 0.8em;">↑↓</span>	Type	Judges
<input type="checkbox"/> 103	<a href="#">Ex parte Ahmed Abdelkarim</a>	<a href="#">16/491,795</a>	Reversed	03/14/2023	Final	Jason J. Chung Joseph L. Dixon Phillip A. Bennett
<input type="checkbox"/> 103	<a href="#">Ex parte Hendrikus Johannes Van Der Meijden</a>	<a href="#">16/140,804</a>	Affirmed	03/10/2023	Final	Michelle R. Osinski Jeremy M. Plenzler Benjamin D. M. W...
<input type="checkbox"/> 103 112(a) 112(b)	<a href="#">Ex parte Philip Rodney Kwok and Donald Darkin</a>	<a href="#">16/899,712</a>	Affirmed Affirmed Affirmed	03/02/2023	Final	Lee L. Stepina Jennifer D. Bahr
<input type="checkbox"/> 101 103	<a href="#">Ex parte Albert Subblole</a>	<a href="#">16/574,944</a>	Not Available Not Available	03/02/2023	Final	Capp William A. Capp James W. Dejmek Eleni Mantis Merc...
<input type="checkbox"/> 103	<a href="#">Ex parte David Cote</a>	<a href="#">16/296,710</a>	Affirmed	03/02/2023	Final	Jeremy J. Curcuri James B. Arpin Michael J. Strauss

# Argument Finder

## Find winning arguments to overcome rejections

Identify the salient points from ex parte appeals to guide your prosecution strategy

Improve your appeal success rate by researching curated ex parte appeals data that are tagged by the specific legal issues to:

- Quickly see highlighted issues within a PTAB case
- Decide whether it makes sense to appeal
- Craft an optimal appeal brief

You might also use these arguments in an Office Action response, before even reaching an appeal!

The screenshot displays the 'Argument Finder' tool interface. It features a title bar with the text 'Argument Finder' and an information icon. Below the title bar, there are four distinct sections, each representing a different set of legal issues. Each section includes a header with the number of issues and a status tag, followed by a list of specific arguments. The first section is titled '101 Issues' with a status of '0/6' and a tag 'AFF'. The second section is '103 Issues' with '0/8' and 'REV'. The third is '112(a) Issues' with '0/9'. The fourth is '112(b) Issues' with '0/4'. Each section has expand/collapse arrows and an eye icon for visibility control.

Issue Set	Status	Arguments
101 Issues	0/6	<ul style="list-style-type: none"><li>&gt; Abstract Idea</li><li>&gt; Judicial Exceptions &gt; Step 2</li><li>&gt; Abstract Idea &gt; Prima Facie case</li><li>&gt; Judicial Exceptions &gt; Step 1</li></ul>
103 Issues	0/8	<ul style="list-style-type: none"><li>&gt; 103(a)</li><li>&gt; Reasonable expectation of success</li><li>&gt; Reference(s) Must Teach or Suggest Limitations</li><li>&gt; Examiner Bears Initial Burden (Prima Facie Case)</li></ul>
112(a) Issues	0/9	<ul style="list-style-type: none"><li>&gt; Lack of Enablement</li><li>&gt; Wands Factors</li></ul>
112(b) Issues	0/4	<ul style="list-style-type: none"><li>&gt; Indefiniteness</li></ul>



# Example: Ex parte Sergey Loffe 15/343,458

← Decisions by Argument

Ex parte Sergey Loffe

View Conclusions

Download PDF

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UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address:  
COMMISSIONER FOR PATENTS

P.O. Box 1450

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www.uspto.gov

APPLICATION NO. FILING DATE FIRST NAMED INVENTOR ATTORNEY DOCKET NO. CONFIRMATION NO.  
15/343,458 11/04/2016 Sergey loffe 16113-7788001 6801

26192 7590 06/02/2022 EXAMINER

FISH & RICHARDSON P.C.

PO BOX 1022 SMITH, KEVIN LEE MINNEAPOLIS, MN 55440-1022

EXAMINER  
SMITH, KEVIN LEE  
ART UNIT PAPER NUMBER  
2122  
NOTIFICATION DATE DELIVERY MODE

06/02/2022 ELECTRONIC Please find below and/or attached an Office communication concerning this application or  
proceedings

Search document 0/0

Argument Finder ⓘ

**102 Issues** 0/2  
> 102(a) REV  
> 102(a) > Broadest Reasonable Interpretation (102)

**103 Issues** 0/7  
103 REV  
> Broadest Reasonable Interpretation

About This Document

Application Number: [15/343,458](#)  
Decision Date: 2022-06-02  
Filing Date: 2016-11-04  
Examiner Name: [SMITH, KEVIN LEE](#)  
Group Art Unit: 2122  
First Named Inventor: [Sergey loffe](#), Mountain View, CA (US)  
Title of Invention: REGULARIZING MACHINE LEARNING MODELS  
Panel Judges: Carolyn D. Thomas, Allen R. Macdonald, Phillip A. Bennett

# Example: Ex parte Sergey Loffe

## 15/343,458

← Decisions by Argument

Ex parte Sergey Loffe

View Conclusions

Download PDF

### REFERENCES

The references relied upon by the Examiner are:

Name Reference Date

Drissi US 2009/0240637 A1 Sept. 24, 2009

Moore US 8,620,838 B1 Dec. 31, 2013

Miyato Distributional Smoothing with Virtual Adversarial Training, JMLR: Workshop and Conference Proceedings 30:1-17 Jan. 17, 2015

### REJECTIONS

R1. **Claims 1, 2, 4-7, 9-12, 14, and 15 are rejected under 35 U.S.C.**

**§ 102(a)(1) as being anticipated by Miyato,** Final Act. 2-19.

R2. **Claims 23-25 are rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Moore and Miyato,** Final Act. 19-25.

R3. **Claims 3, 8, and 13 are rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Miyato, Moore, and Drissi.** Final Act. 25-28.

R4. **Claims 16 and 18-22 are rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Moore and Drissi,** Final Act. 28-32.

We review the appealed rejections for error based upon the issues identified by Appellant, and in light of the arguments and evidence produced thereon. Ex parte Frye, 94USPQ2d 1072, 1075 (BPAI 2010) (precedential).

## Argument Finder ⓘ

102 Issues

1/2



> 102(a) REV

> 102(a) > Broadest Reasonable Interpretation (102)

103 Issues

0/7

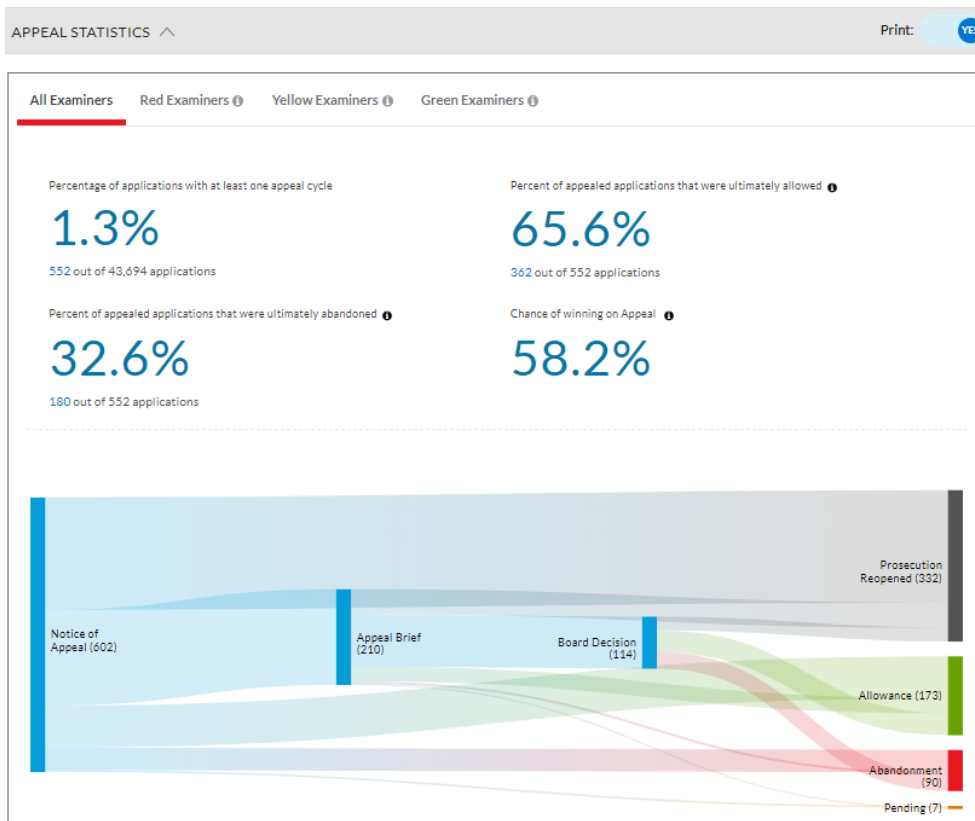


103 REV

> Broadest Reasonable Interpretation

# Assessing Appeal Performance

- Evaluate appeal statistics and performance using the **Law Firm Report Card**
- View statistics and a flowchart for any subset of applications



# Questions



For more information about our solutions,  
resources, and future webinars, please visit:  
**[www.lexisnexisip.com](http://www.lexisnexisip.com)**

**Thank you.**

**Katie Brown**

Customer Success Manager

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