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

Lunch & Learn
Wednesday, March 29th

Presented by:

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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.

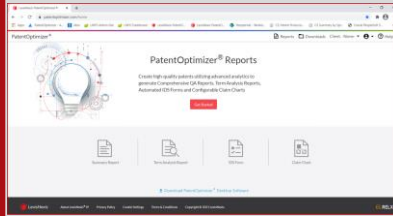# Our unmatched suite of solutions brings clarity to innovation

Reliable global patent search
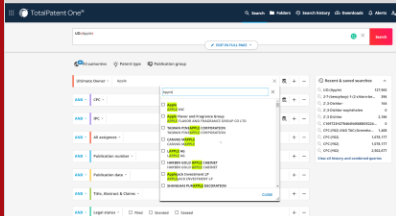
LexisNexis TotalPatent One®

Search through 110 million patent full text documents in English or original language

Receive harmonized ownership information
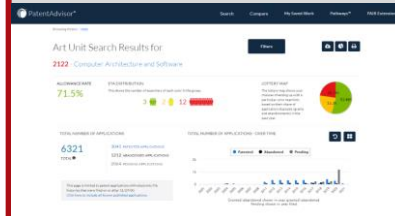
Set up alerts

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.
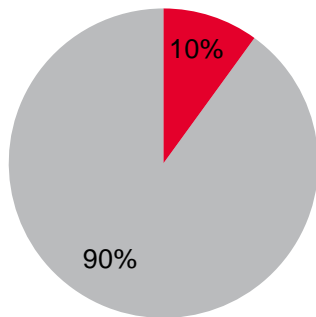
Conduct competitive analysis

Benchmark your portfolio against others in the same space.

There are two extremely different categories of USPTO patent examiners[1]

Category A

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

- >50 Pat/Yr
- Rest of Exmr
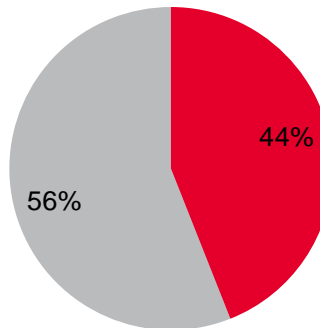
- >50 Pat/Yr
- Rest of Exmr

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

There are two extremely different categories of USPTO patent examiners[1]

Category B

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

Left pie chart:
- 19% — <5 Pat/Yr
- 81% — Rest of Exmr

Right pie chart:
- 0.60% — <5 Pat/Yr
- 99.40% — Rest of Exmr

[1]Office Actions per Grant Ratio (OGR): A New Metric for Patent Examiner Activity by Professor Shine Tu (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)

3.2

ETA ⓘ RELATIVE TO AU: 2834 ⓘ

LexisNexis

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
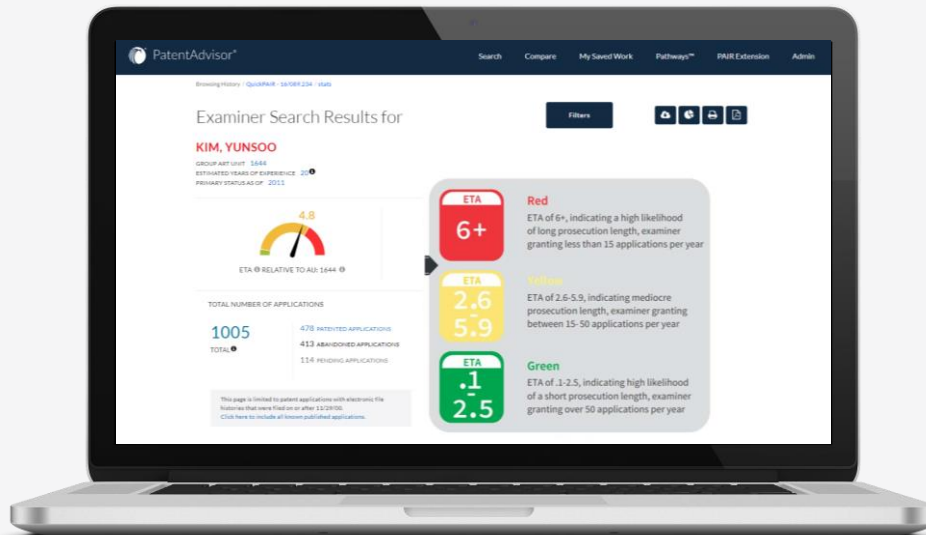
Using Examiner Statistics to Guide Appeal Strategy
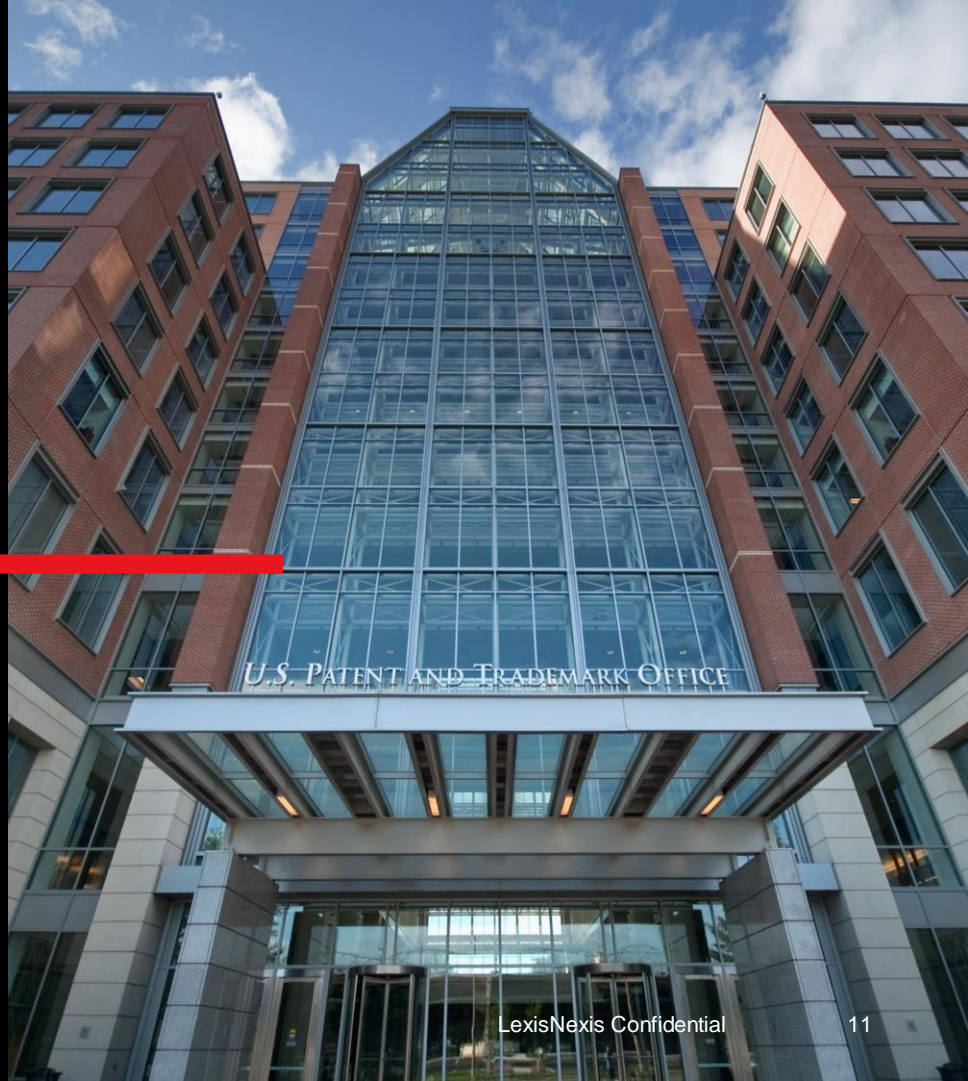
Identifying Appeal Candidates Using Prosecution Pattern Monitoring

- 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 [Pending ▾] cases only

Pre-appeal likelihood of a win or loss

Applicant's pre-appeal likelihood of a [WIN ▾] is [equal or more ▾] than [50] [%]

Overall appeal likelihood of win or loss

Applicant's overall likelihood of a [WIN ▾] on appeal is [equal or more ▾] than [50] [%]

Examiner's allowance rate

Examiner allowance rate is [less or equal ▾] than [25] [%]

ETA

Examiner's ETA is: 6 - 10+
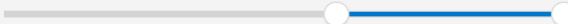
Identifying Appeal Candidates Using Prosecution Pattern Monitoring

- 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   **+ Add Condition**   or predefined templates   **+ Add Template**

Limit to applications by status

Limit to   Pending ▾   cases only

Number of office actions

Number of office actions   3+ ▾

Prosecution history event

Event of a type   EXIN   N/AP   INTRVIEW.APP   FAI.REQ.INTV   OA.FAI.PRELM   FAI.REQ   M865   OA.FAI   FAI.RQ.NNCPL   FAI.A..   FAI.REQ.WD   INTV.SUM.APP   INTV.SUM.EX   OA.FAI.OPT.O   M865E ⊕   not happened ▾   Anytime ▾

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
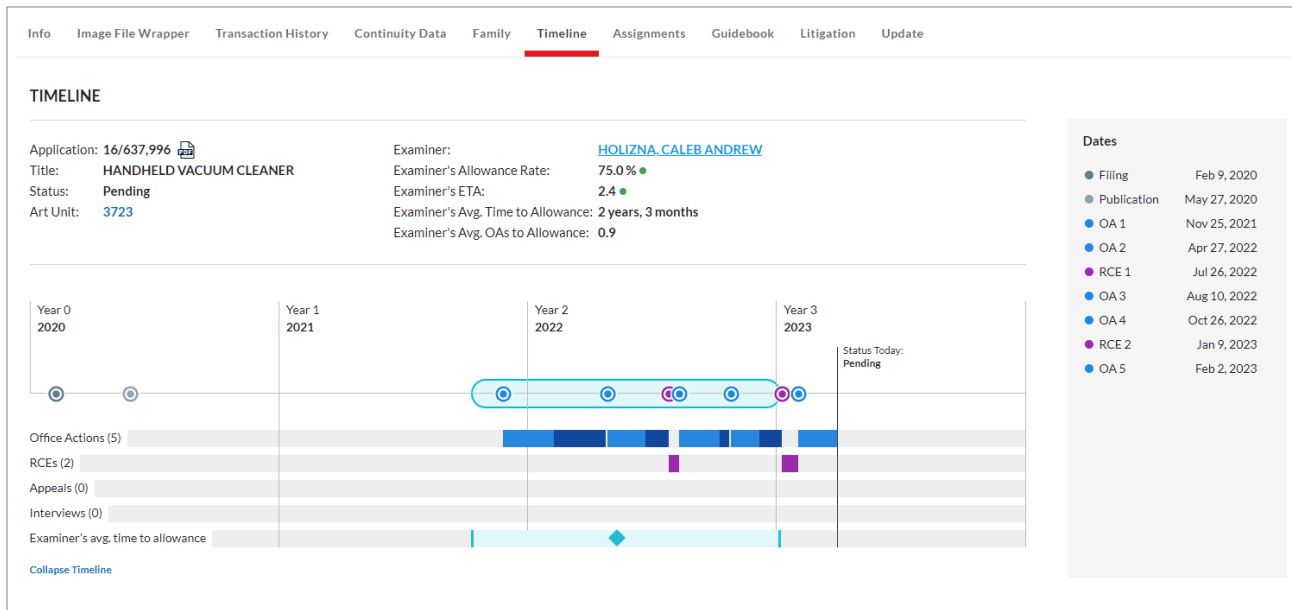
Examiner Dashboard

- 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 Appeal Statistics

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

APPEAL STATISTICS ∧

Patented & Abandoned   Patented   Abandoned   Pending   All Applications

Total applicant wins
40

Total applicant losses
21

TOTAL NUMBER OF APPEAL CYCLES:

66   APPEAL CYCLES IN 1,084 APPLICATIONS

APPEAL EXIT BREAKDOWN

PERCENTAGE OF APPLICATIONS WITH AT LEAST ONE APPEAL CYCLE:

5.8%   63 OUT OF 1,084 APPLICATIONS

8%
11%
17%
2%
64%

CHANCES OF WINNING ON APPEAL:

65.6%
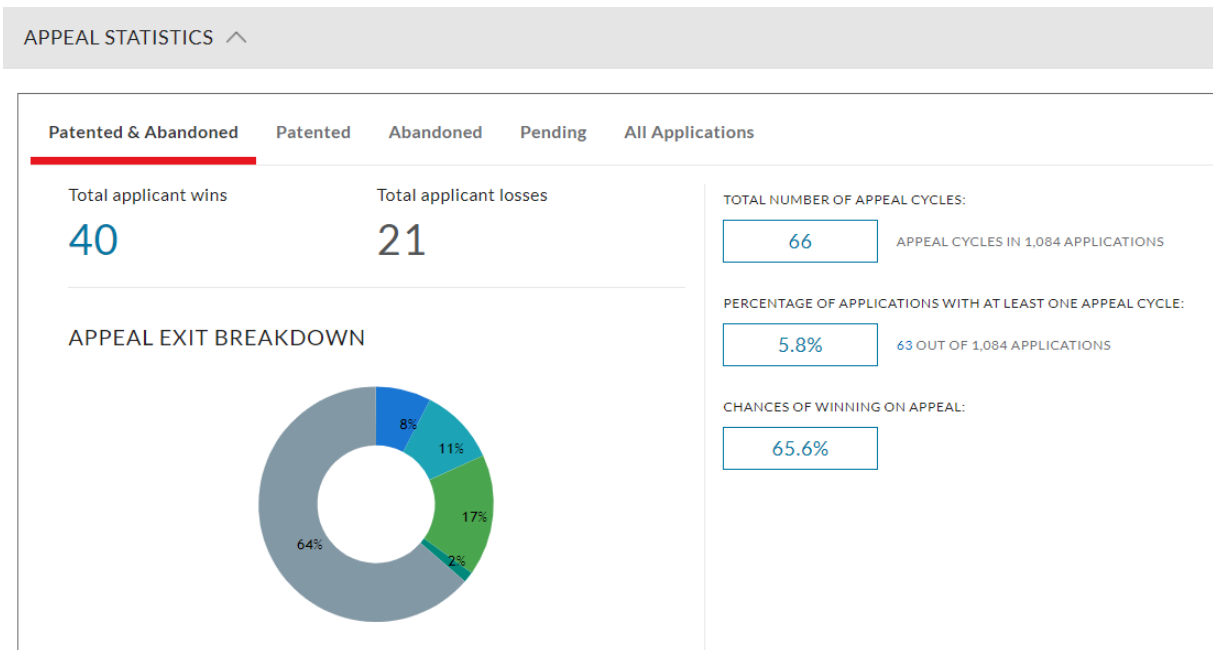
Examiner Appeal Statistics

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

PatentAdvisor PTAB Decisions
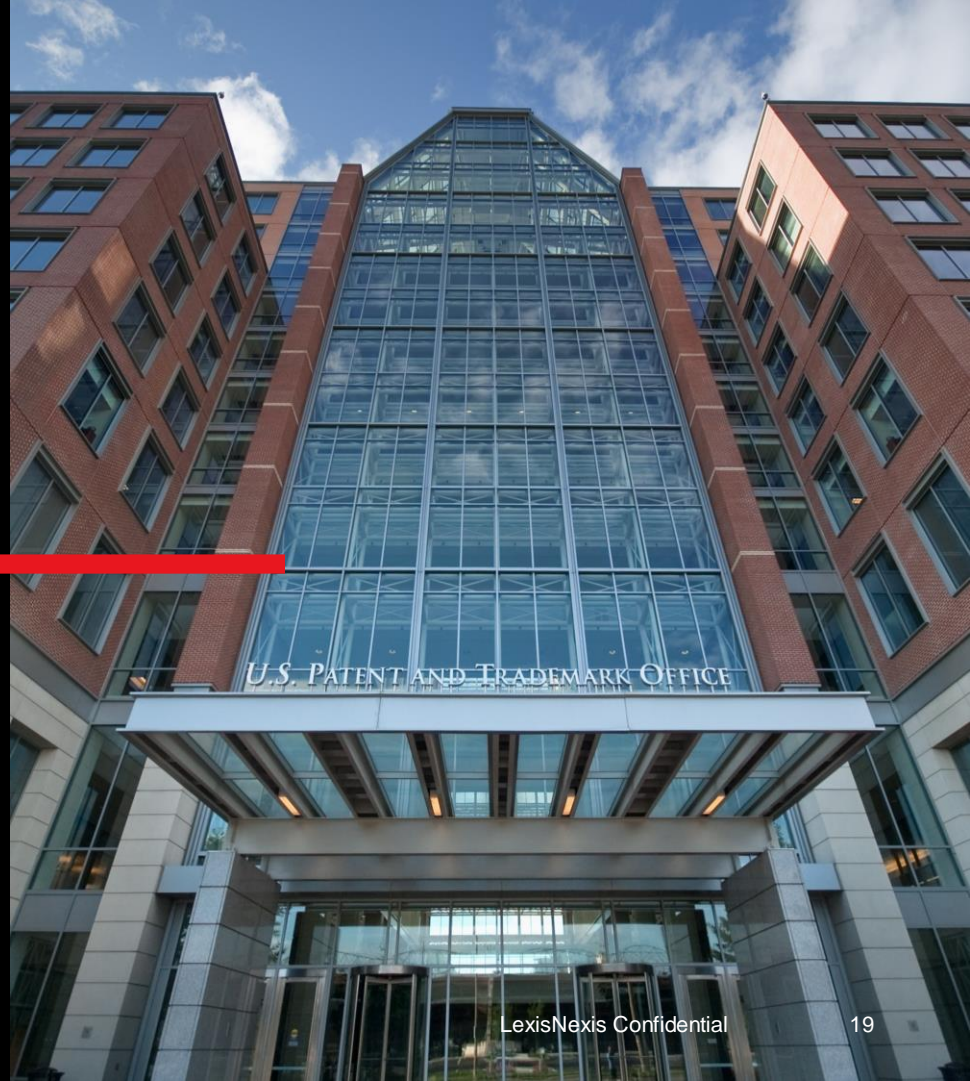
PTAB Decisions

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

- 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

- 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	
Select Outcome ∨			Enter Keywords	**Filter**

3788 decisions | 0 selected

🖨 Download Decisions

☐	Issues	Case Name	Application #	Outcome	Decision Date ↑↓	Type	Judges
☐	103	Ex parte Ahmed Abdelkarim	16/491,795	Reversed	03/14/2023	Final	Jason J. Chung Joseph L. Dixon Phillip A. Bennett
☐	103	Ex parte Hendrikus Johannes Van Der Meijden	16/140,804	Affirmed	03/10/2023	Final	Michelle R. Osinski Jeremy M. Plenzler Benjamin D. M. W...
☐	103 112(a) 112(b)	Ex parte Philip Rodney Kwok and Donald Darkin	16/899,712	Affirmed Affirmed Affirmed	03/02/2023	Final	Lee L. Stepina Jennifer D. Bahr
☐	101 103	Ex parte Albert Subbloie	16/574,944	Not Available Not Available	03/02/2023	Final	Capp William A. Capp James W. Dejmek Eleni Mantis Merc...
☐	103	Ex parte David Cote	16/296,710	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!

Example: Ex parte Sergey Loffe 15/343,458

Example: Ex parte Sergey Loffe 15/343,458

Assessing Appeal Performance

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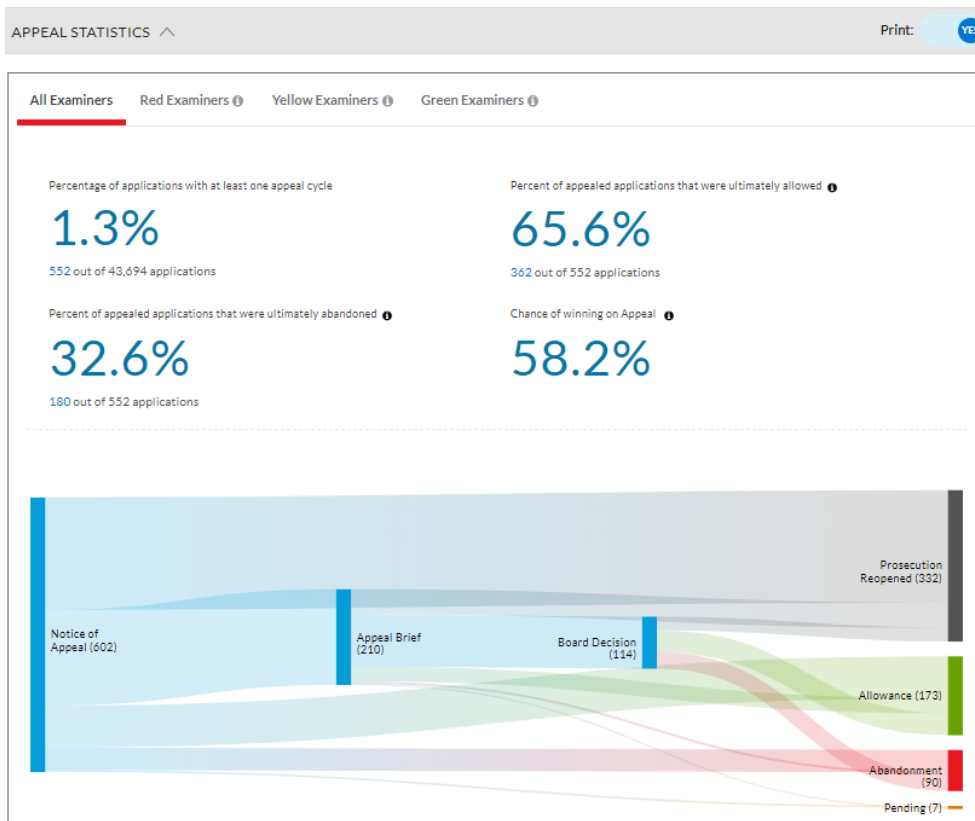
Questions

For more information about our solutions, resources, and future webinars, please visit:
www.lexisnexisip.com

Thank you.

Katie Brown
Customer Success Manager
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