



INSTITUTE
Building Extraordinary IP Assets

Episode 03:

Prosecution Analytics to Improve
Prosecution Efficiency and Identify Wasteful,
Unproductive Prosecution Spending

Patent Analytics Webinar Series

8–Episode Webinar Series



Episode 01 - Techniques and Analytics for Identifying Valuable Patents and Patents to Abandon
Thursday, April 16, 2020 at 12:00 PM CT

Episode 02 - Using Patent Landscapes to Develop IP Rich Products and Valuable Patent Positions
Thursday, April 30, 2020 at 12:00 PM CT

Episode 03 - Using Prosecution Analytics to Improve Prosecution Efficiency and Identify Wasteful, Unproductive Prosecution Spending
Thursday, May 14, 2020 at 12:00 PM CT

Episode 04 - Using Examiner Analytics to Improve Prosecution Efficiency and Develop Well-informed, Data-Driven Prosecution Decisions and Strategy
Thursday, May 28, 2020 at 12:00 PM CT

Episode 05 - Best Practices for Developing Reliable Freedom-to- Operate Landscapes and Advanced Techniques for Interactive, Reusable FTO Mapping
Thursday, June 11, 2020 at 12:00 PM CT

Episode 06 - Using White Space Maps to Identify Open Spaces in the Patent Landscape
Thursday, June 25, 2020 at 12:00 PM CT

Episode 07 - Using a Patent Analytics Dashboard for IP Strategy, Competitor Surveillance, and Portfolio Management
Thursday, July 9, 2020 at 12:00 PM CT

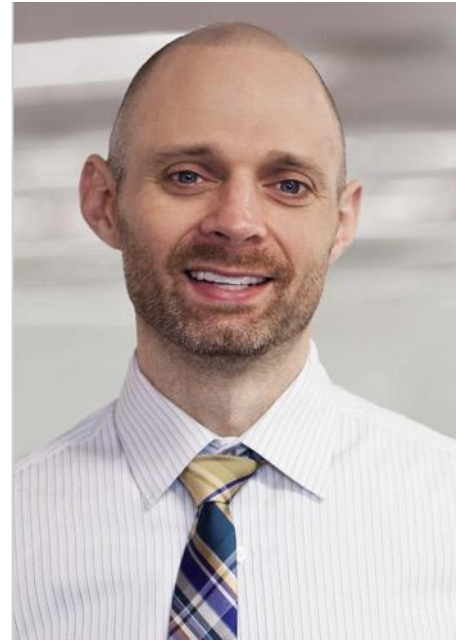
Episode 08 - Using Patent Prosecution History Reports to Increase Prosecution Efficiency and Avoid Unintended Estoppel
Thursday, July 23, 2020 at 12:00 PM CT

Today's Presenters...



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**What exactly is
Prosecution
Analytics?**

Prosecution Analytics is an analysis of patent prosecution data with a goal of gaining greater insight into the cost and effectiveness of different approaches to prosecution, and to identify patterns that might be correlated to best practices or poor practices.

What you will learn today

- Who uses prosecution analytics
- When they are used
- Strategic insight provided
- Different types of prosecution analytics
- How prosecution analytics are generated
- Overview of tools

Portfolio Prosecution Analytics Key Uses

Some key uses:

- Cost projections
- Best practices
- Bad practices
- Cost management
- Portfolio acquisition metrics
- Outcome management
- Competitor Info

Typical users:

- Corporate prosecution management
- Law firm management

What Metrics Can We Look At?

- **Financial Stats**

- Cost to draft
- Cost to prosecute

- **Application Stats**

- Page counts
- Boilerplate
- Claim counts
- Drawing counts

- **Prosecution Stats**

- Number of office actions
- Types of office actions
- Number of RCE's
- Number of references applied
- Number of words added to claims
- Number of appeals
- Length of pendency
- Number of continuations
- Abandonment

What Can the Stats Tell Us, and Not Tell Us?

Things we can learn

- Stats for best cases
- Stats for best portfolios
- Stats for best firms
- Stats for art areas
- My company's stats
- Competitors' status
- Law firm stats
- Comparisons of stats

Things we can't tell directly

- Whether quality of prosecution is good
- If stats are reasonable
- If an attorney has good or bad stats
- If a firm has good or bad stats
- What stats are driven by corporate policy or budgets

How Can Stats Help?

- Budgeting
- Prosecution Decisions
- Counsel Evaluation
- Acquisitions
- Licensing

Useful Prosecution Metrics

Firm to PTO(Quantitative)

- Pendency
- Amendment Success / Expansion
- OA Counts / Av OA per matter
- Interviews / Success Factors
- RCE Counts / Av RCE per Matter
- Extensions Taken
- Restrictions
- Appeal Win Rate
- Rejection Stats (101/102/103)

Firm to Client (Qualitative)

- Cost to Grant (Original Filing)
 - Filing+Fees+OA+RCE+Other
- CTG(Continuation)
- Claim Coverage v. Cost
- Allowance Rate v. Claim Scope
- Competitor Impact

Prosecution Analytics for M&A



Prosecution Quality

- Prosecution Trends
- Office Actions
- RCE
- Continuation Practice
- Interview use

Prosecution Effectiveness

- Pendency
- Abandonment without examination (or minimal)

Quantitative Results v. Qualitative Review

Quantitative Is Starting Point

- Each entity contributes to a Grant
 - Law Firms/Attorneys
 - Clients/Inventors
 - Patent Offices/Examiners
 - Technology Factors
- Conclusions must be validated
- Aggregated v. individual

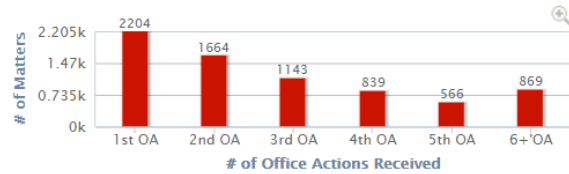
Qualitative Interprets Quantitative

- Pivot by
 - Common Assignee
 - Common Technology
 - Common Art Unit
- Interpret in light of Business
 - Inventors
 - Product line
 - Prosecution supervision

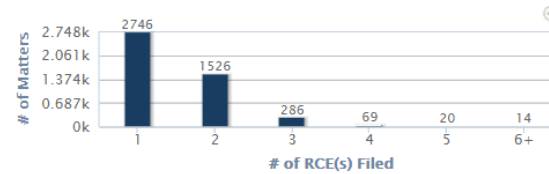
A nontrivial example follows

Examples of Stats

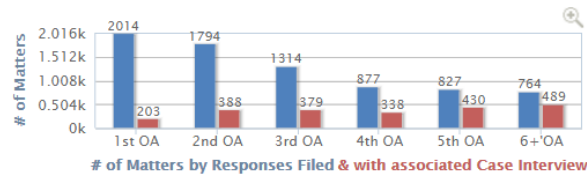
Office Action/Rejection Activity



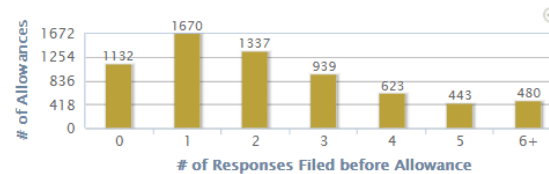
RCE Activity



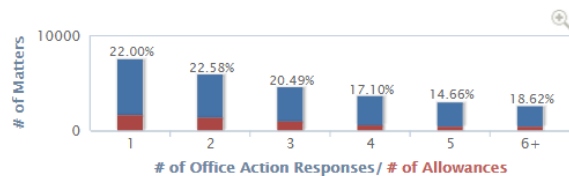
Office Action Response and Interview Activity



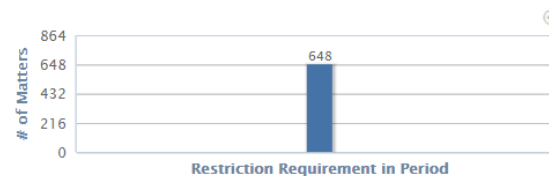
Allowances after Office Action Responses



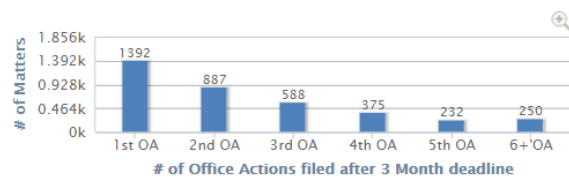
% of Time a Response Leads to Allowance



Restriction Requirement Activity



Response Extension Activity

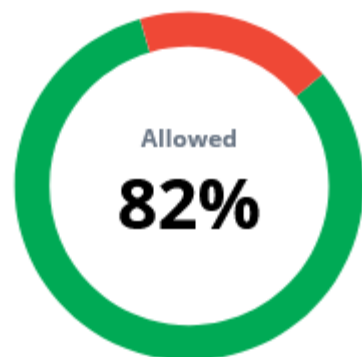


Overview of Portfolio:

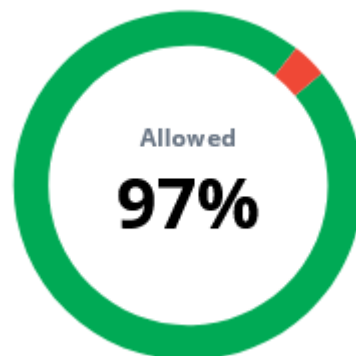
- 4-year time span
- Cases disposed of
- Identify systemic issues across all counsel
- Interviews not used frequently
- Most allowances are at 10A or 20A
- Over ¼ of my cases require an RCE

Allowance Rate Metric

Firm #1 Allowance Rate



Firm #2 Allowance Rate

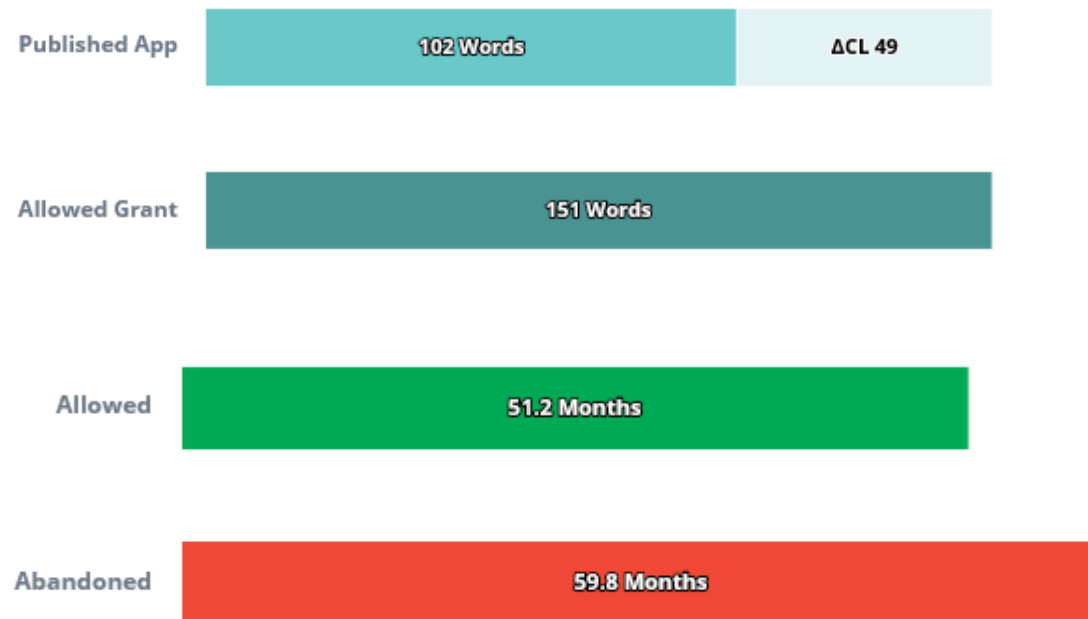


Qualitative Overview:

- Looks like a clear winner
 - Likely wrong
- Deeper Review Required
 - Business/Product
 - Inventors/Atty
 - Tech Center
 - News/Social

Claim Expansion /Pendency

Firm #1



Firm #2



Office Actions to Allowance

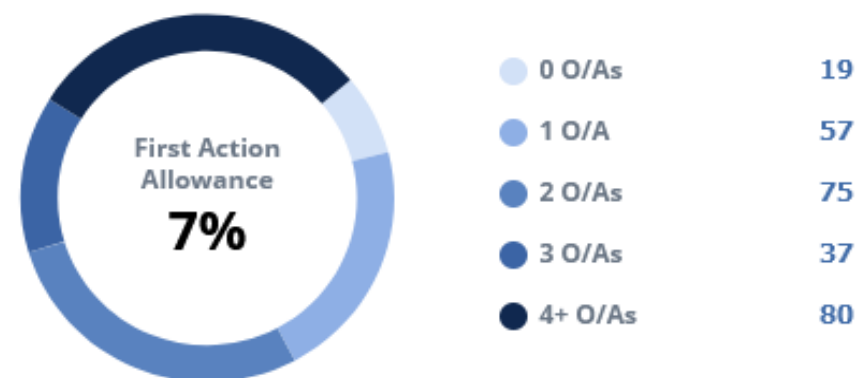
Firm #1



Average No. of Office Actions

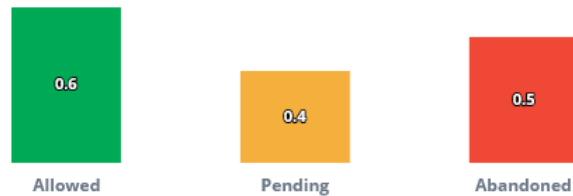
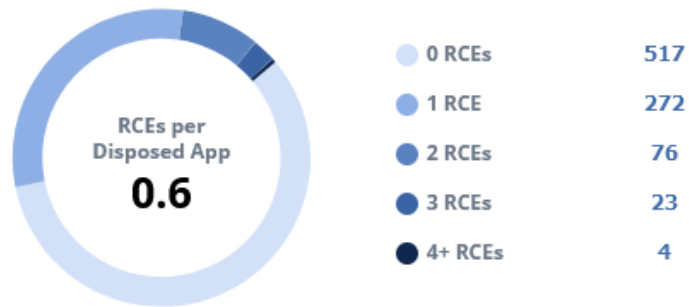


Firm #2

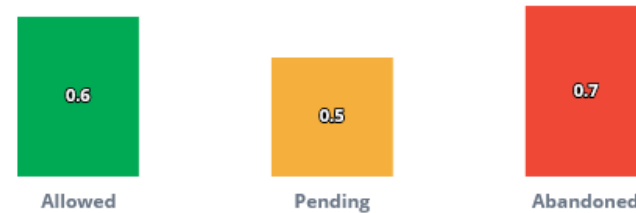
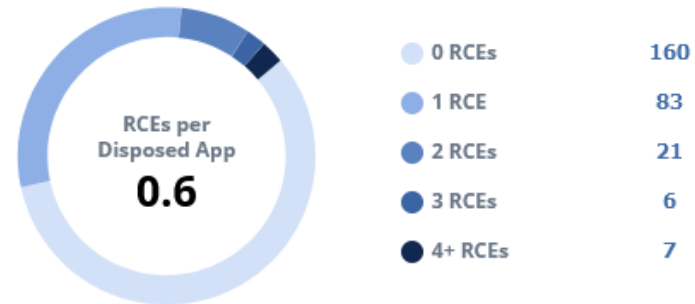


RCE Prosecution Metrics

Firm #1



Firm #2



Qualitative Overview

- Co-Actors
 - Company
 - Inventors
 - Product
 - Law Firm
 - Experience Level

Amendment Performance/Success

Firm #1



Firm #2



Overview:

- Company driven metric
 - +4 amendments
- Initial Claim Scope
 - Broad
- Firm #1 slightly better
 - Only just

Key Take-Aways

What prosecution stats are

What they can and can't do

Possible applications

The Schwegman Analytics Advantage



SLW has been helping its clients find and improve high value patents for over 20 years and has invested heavily in its Analytics processes and tools for the last decade and is now expert at helping.

- More efficient work
- Shorter timelines
- Higher quality and key strategies
- IP Operations
- Fixed Fees/AFAs
- Tracking metrics
- Non-traditional providers

**Thank You For Your Interest
Questions?**

These materials are for general informational purposes only. They are not intended to be legal advice, and should not be taken as legal advice. They do not establish an attorney-client relationship.