



Episode 04:

Using Examiner Analytics to Improve Prosecution Efficiency and Develop Well-informed, Data-Driven Prosecution Decisions and Strategy

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

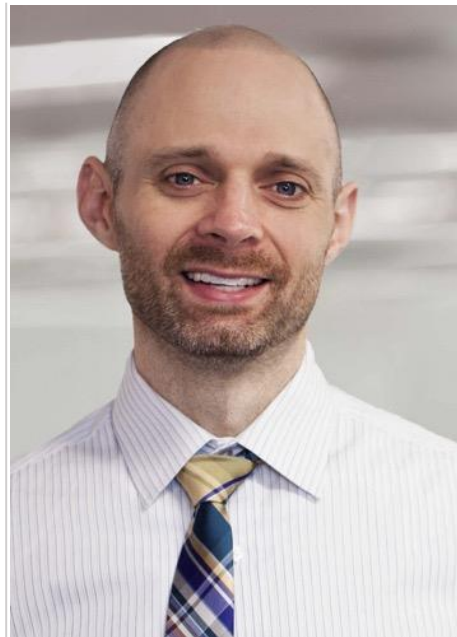
Episode 08 - Using Patent Prosecution History Reports to Increase Prosecution Efficiency and Avoid Unintended Estoppel
Thursday, July 23, 2020 at 12:00 PM CT

Today's Presenters...



Steve Lundberg

Principal & Chief Innovation Officer
Schwegman Lundberg & Woessner



Thomas Marlow

President, Renewals
Black Hills IP
Former Chief Patent Counsel of
Fairchild Semiconductor



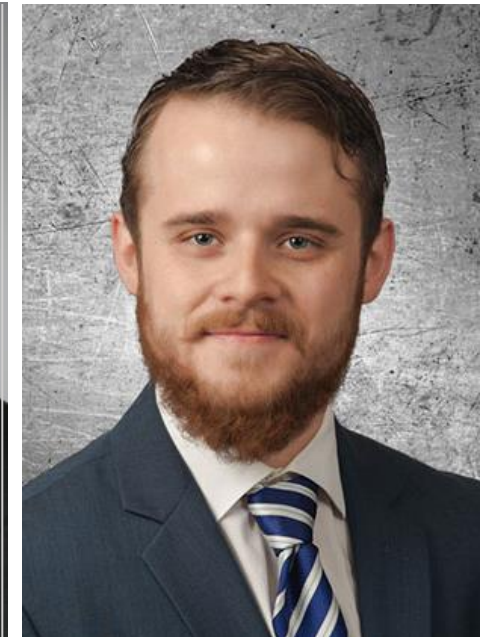
Russ Slifer

CEO, Black Hills IP
Former USPTO Deputy Director



Mark Stignani

Analytics Chair & Firm
Compliance Officer
Schwegman Lundberg & Woessner
Former Chief Patent Counsel
Thomson



Garrett Hall

Principal
Schwegman Lundberg & Woessner



**What exactly are
Examiner
Analytics?**

Examiner Analytics are review and analysis of patent prosecution data around PTO tech centers, Art Units, individual examiner statistics

What you will learn today

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

Portfolio Examiner Analytics Key Uses

Some key uses:

- Cost projections
- Outcome management
- Art Unit targeting
- Appeal v. RCE decisions
- Continuation decisions
- New application targeting

Typical users:

- Corporate Prosecution management
- Law firm management

What Examiner Metrics Can We Look At?

Financial Stats

- Cost to prosecute

Company Stats

- Company Success Rates
- Competitor Success Rates
- Law Firm Success Rates

Examiner Stats

- Number of office actions
- Types of office actions
- RCE behavior
- OA behavior
- Allowance behavior
- End-of-quarter surge

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



Things we can learn

- Success/Abandon Rates
- Examiner Education
- Examiner Experience
- Examiner Tendencies
- Best Appeal Strategy
- Budgeting
- Prosecution Decisions

Things we can't tell directly

- Quality of examination
 - Will be in line with statistics
- Outcome of examination
 - Will be in line with statistics

SLW does not recommend discussing with examiners their statistics*

*Results may vary....

Useful Examiner Metrics

PTO(Quantitative)

- Art Unit v Examiner
- OA success rates
- 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

Caveat: Examiners and Statistics

- Consider Analytics as starting point with your client (Look for the outliers)
- Examiner tools have some variability in their statistical views
- Examiner experiences have a degree of subjectivity that statistics do not measure
- Do not make the Examiner statistics self-fulfilling

Grant Rate and Difficult Ranking

3-Year Grant rate:	87% over 303 cases
Difficulty: ⓘ	Very Easy
Difficulty Percentile: ⓘ	13th 

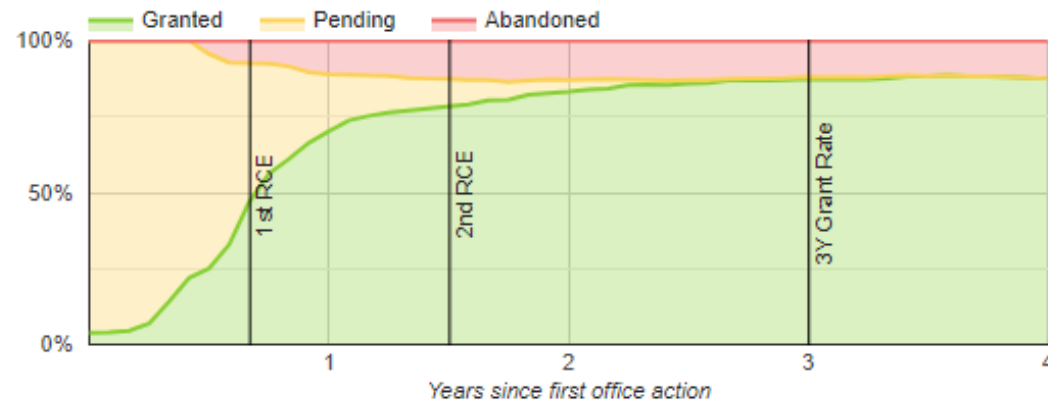
Top Level Review

- Grant Rate/Throughput
- Statistical Comparison to Others
- Art Unit

Grant Rate Timeline & Art Unit Comparison Easy Examiner

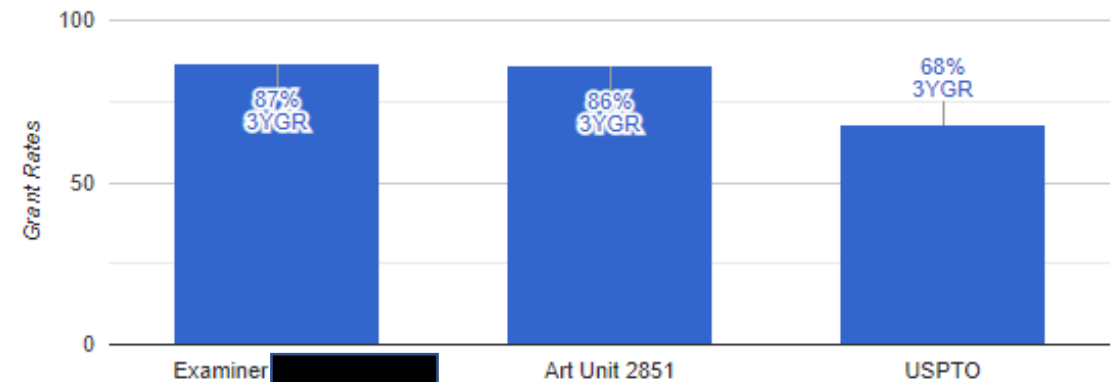
Grant Rate Timeline

Below is the grant rate timeline for Examiner [REDACTED] where the timeline is relative to the date of the first office action. The three-year grant rate is the percentage of applications granted at three years after the first office action.



Comparison with Art Unit 2851

Examiner [REDACTED] grant rate is higher than that of Art Unit 2851 and higher than that of the USPTO.

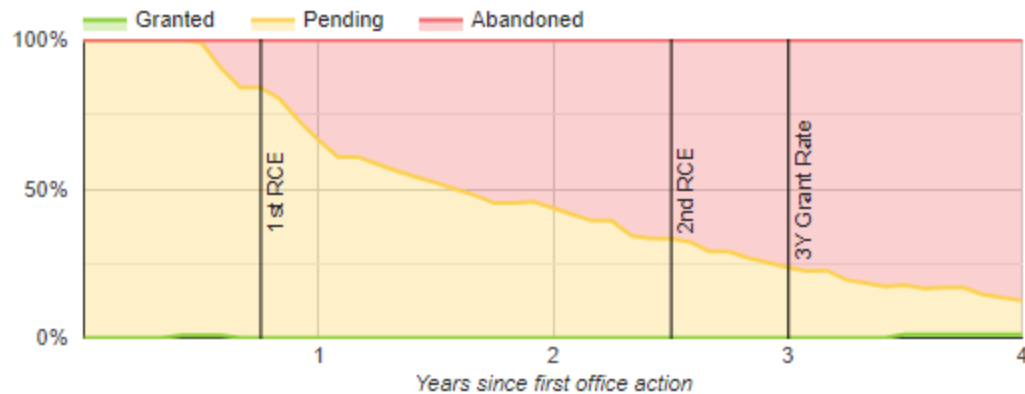


Grant Rate Timeline & Art Unit Comparison

Difficult Examiner

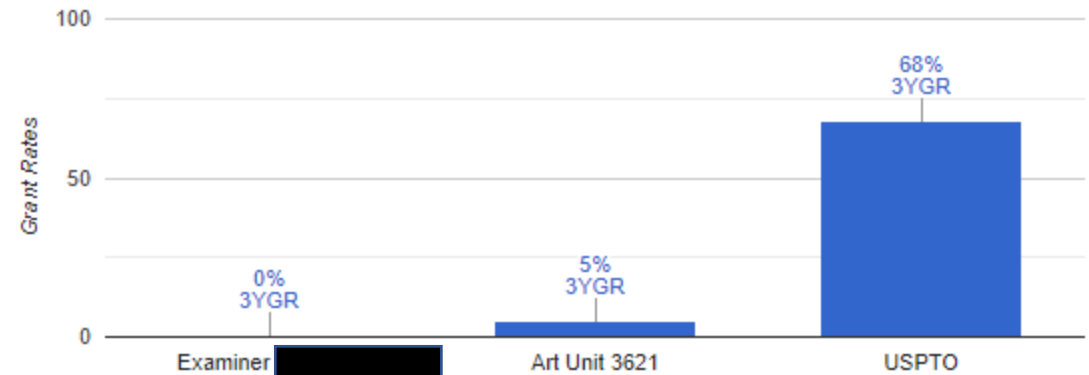
Grant Rate Timeline

Below is the grant rate timeline for Examiner [REDACTED] where the timeline is relative to the date of the first office action. The three-year grant rate is the percentage of applications granted at three years after the first office action.



Comparison with Art Unit 3621

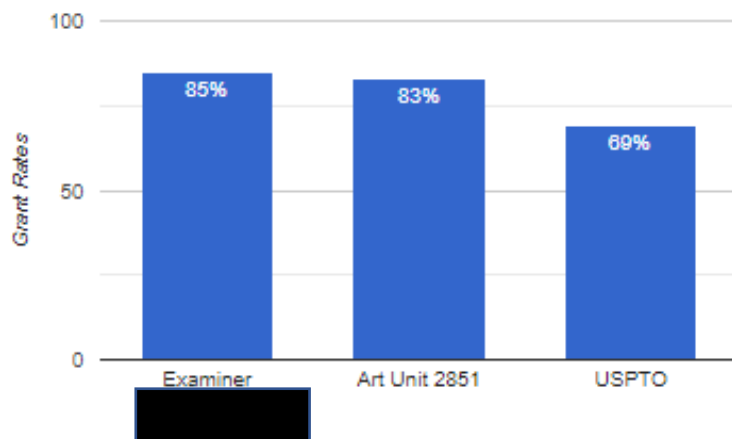
Examiner [REDACTED] grant rate is lower than that of Art Unit 3621 and lower than that of the USPTO.



Interview Benefit

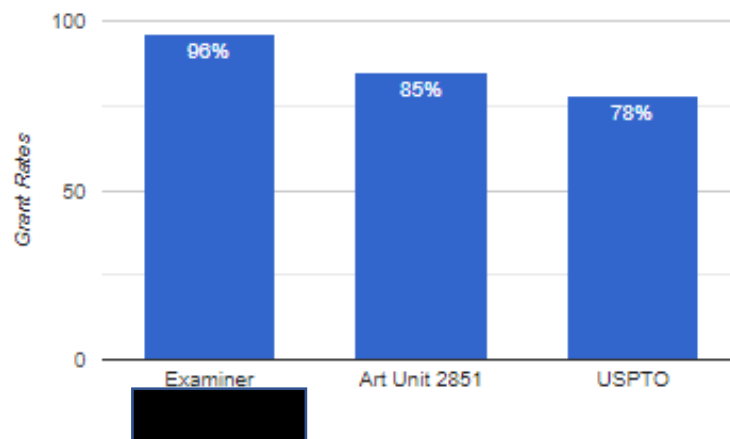
Grant Rate without Interview

Examiner [REDACTED] has granted 211 of 247 cases without any applicant-requested interviews for a grant rate of 85%.



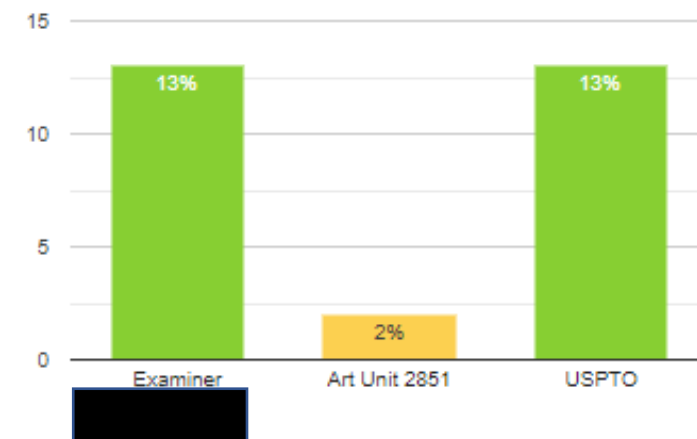
Grant Rate with Interview

Examiner [REDACTED] has granted 54 of 56 cases with at least one applicant-requested interview for a grant rate of 96%.



Interview Benefit

With Examiner [REDACTED] conducting an interview increases your chance of getting a patent granted by 13%.

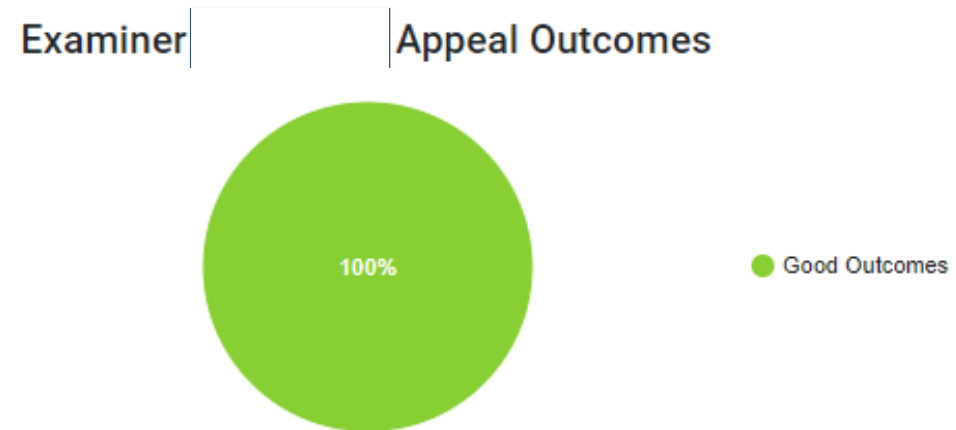


Appeal Outcomes – Should I Appeal? Easy Examiner

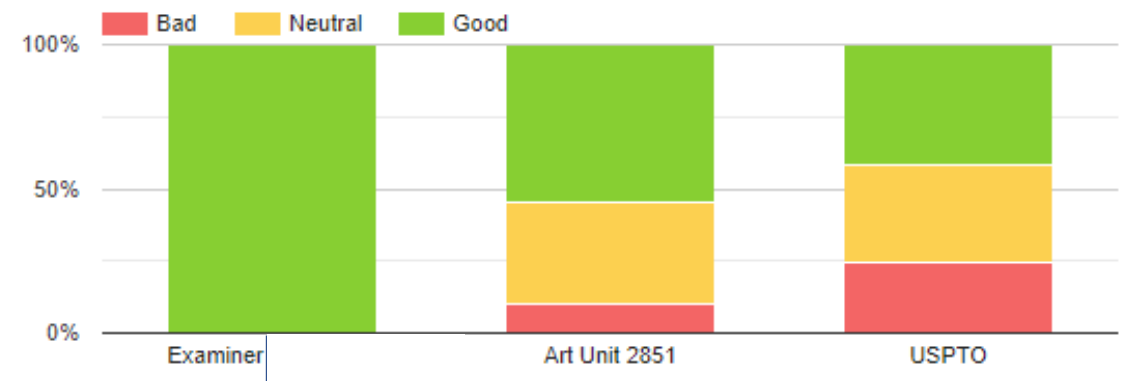
Of the 5 appeals for Examiner [redacted] 2 have outcomes for comparison. We excluded 3 appeals that ended with an RCE or abandonment and 0 appeals that are still pending.

Of the 2 appeals with outcomes:

- **100% had good outcomes** (2 appeals) where the examiner was reversed or affirmed in part or the examiner otherwise allowed claims
- **0% had neutral outcomes** (0 appeals) where prosecution was reopened
- **0% had bad outcomes** (0 appeals) where the examiner was affirmed



Comparison with Art Unit 2851



Appeal Outcomes – Should I Appeal? Difficult Examiner

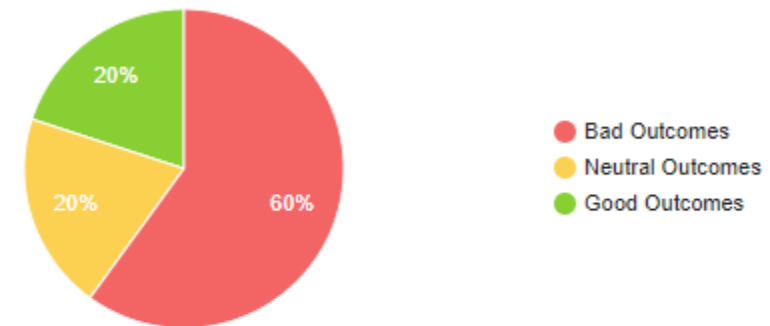
Of the 13 appeals for Examiner [redacted], 5 have outcomes for comparison. We excluded 2 appeals that ended with an RCE or abandonment and 6 appeals that are still pending.

Of the 5 appeals with outcomes:

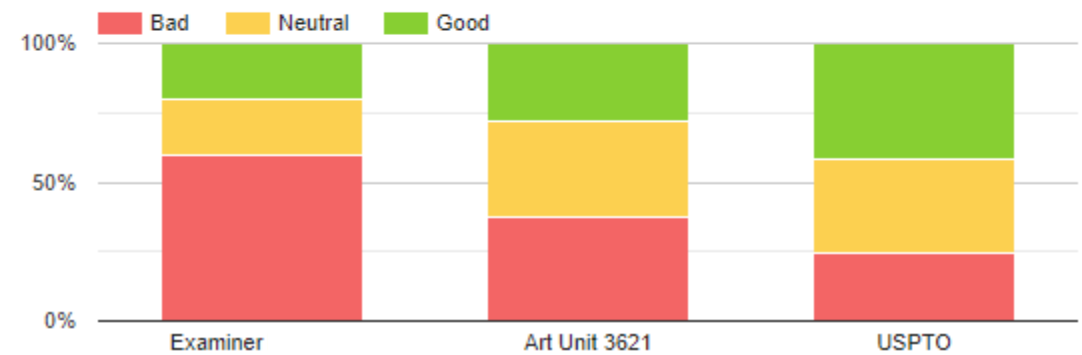
- **20% had good outcomes** (1 appeals) where the examiner was reversed or affirmed in part or the examiner otherwise allowed claims
- **20% had neutral outcomes** (1 appeals) where prosecution was reopened
- **60% had bad outcomes** (3 appeals) where the examiner was affirmed

Examiner

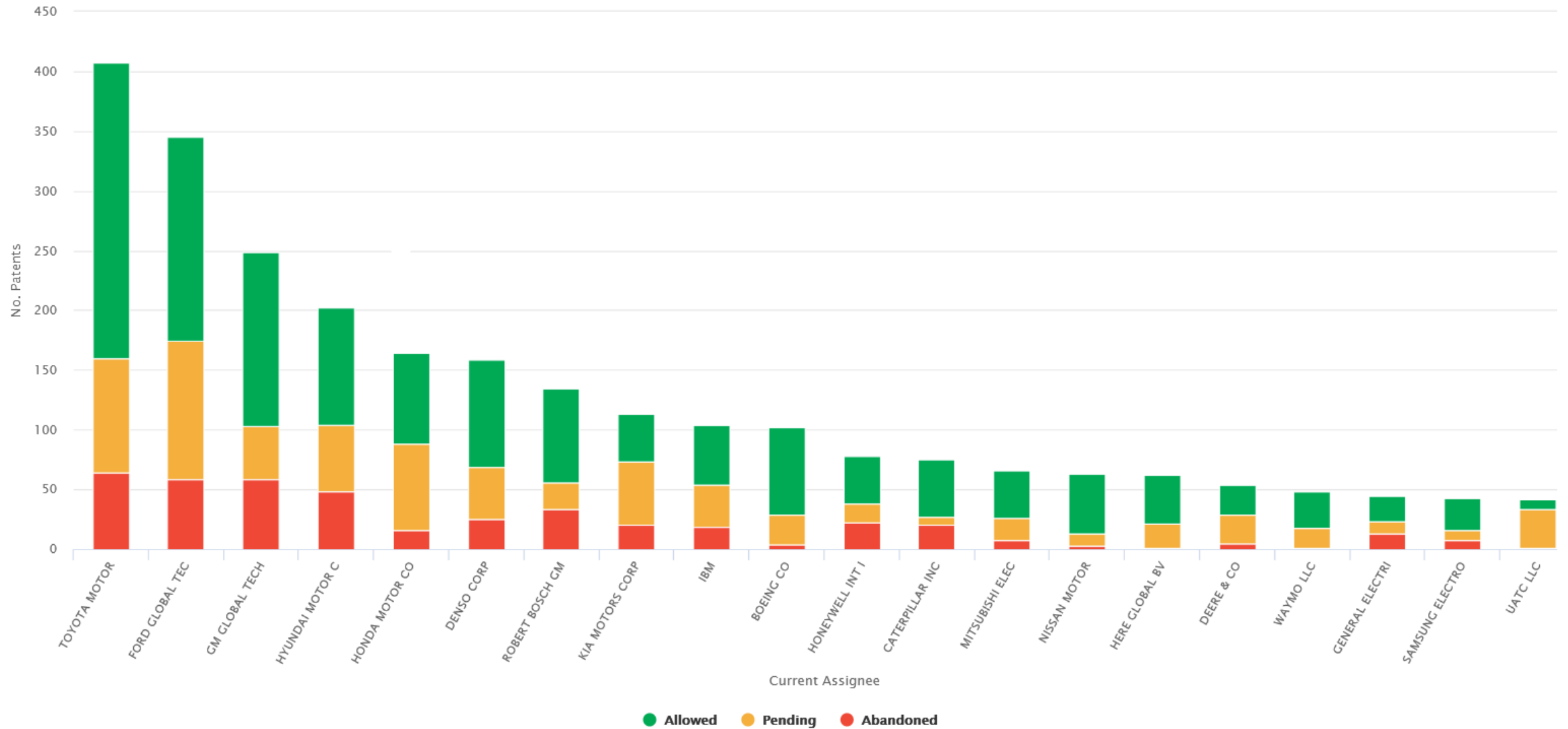
Appeal Outcomes



Comparison with Art Unit 3621



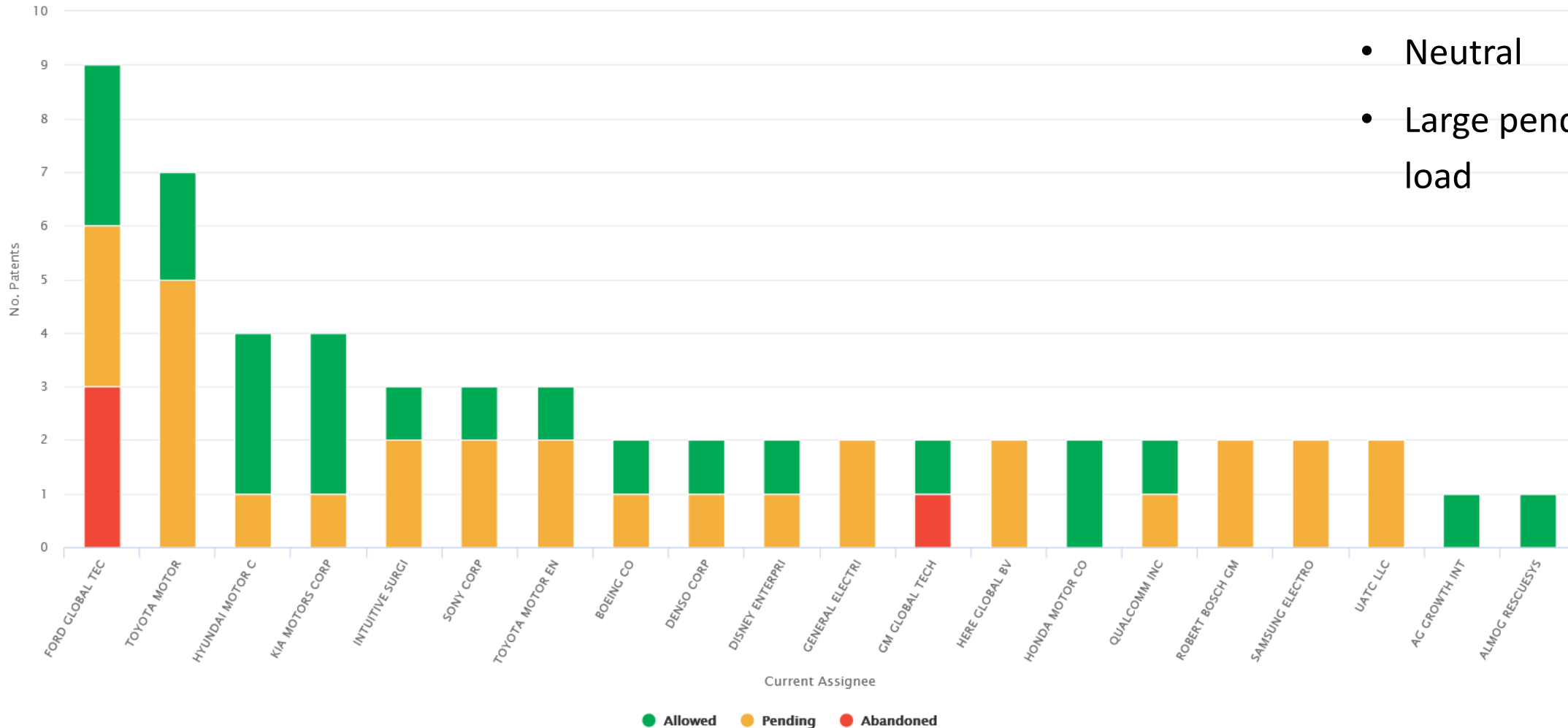
Art Unit 3665 (76%) in Light of Assignees



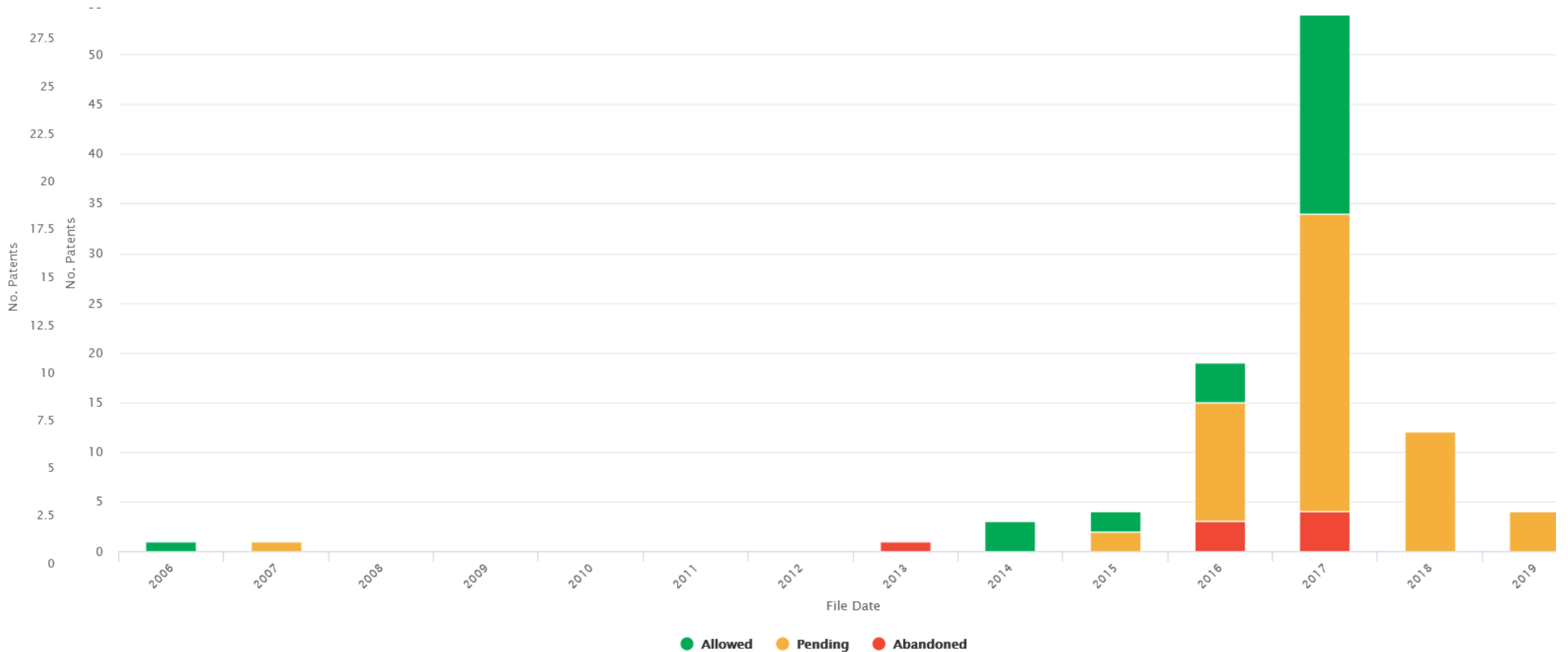
Examiner (68%) in Light of Assignees

Examiner:

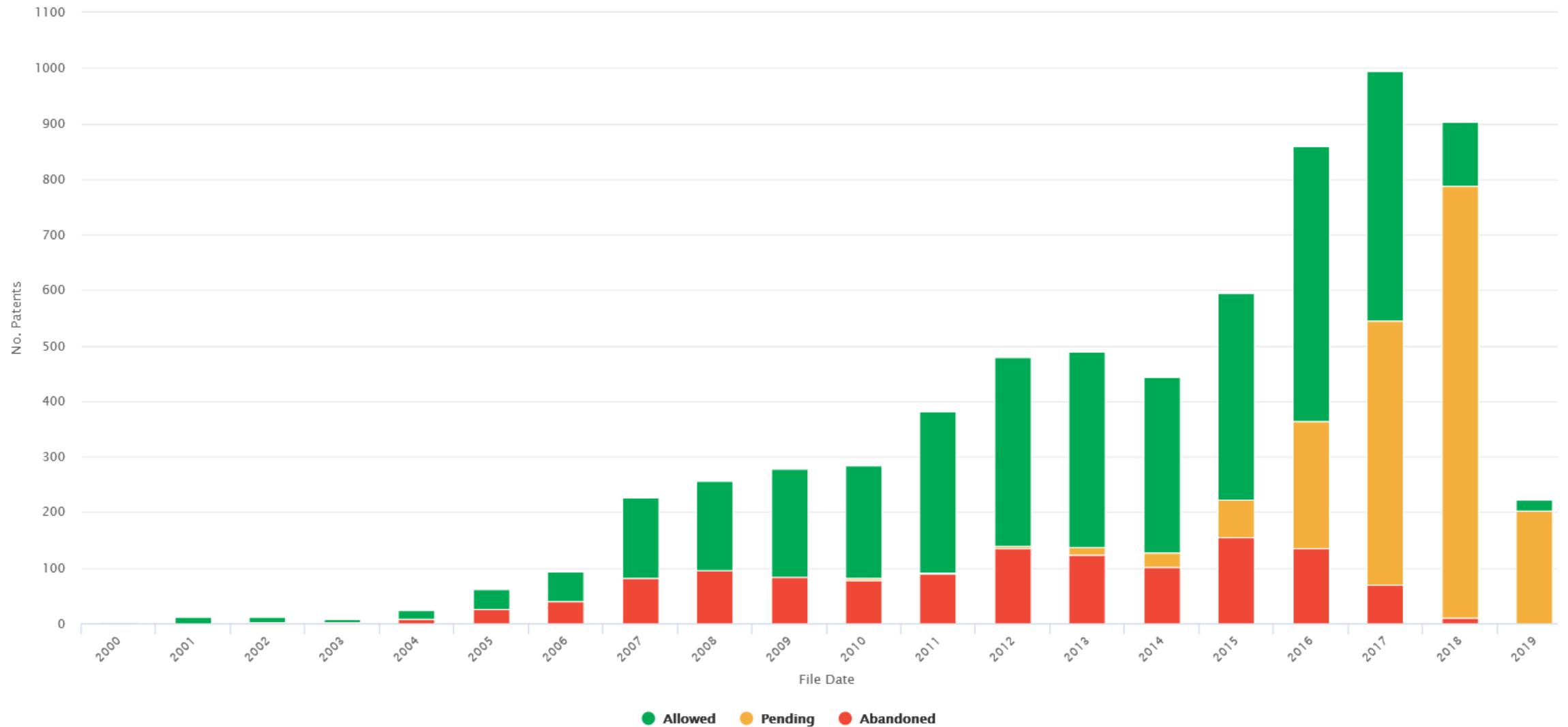
- Neutral
- Large pending load



Annual Examiner Performance

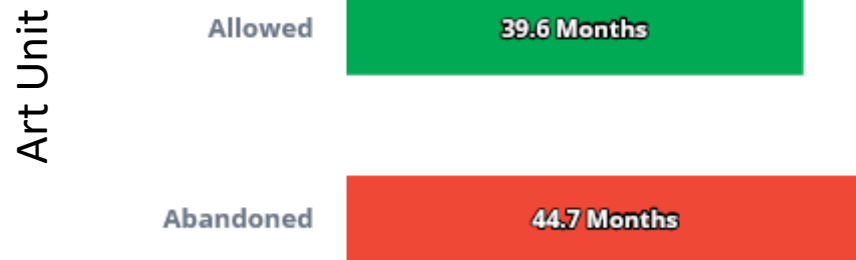
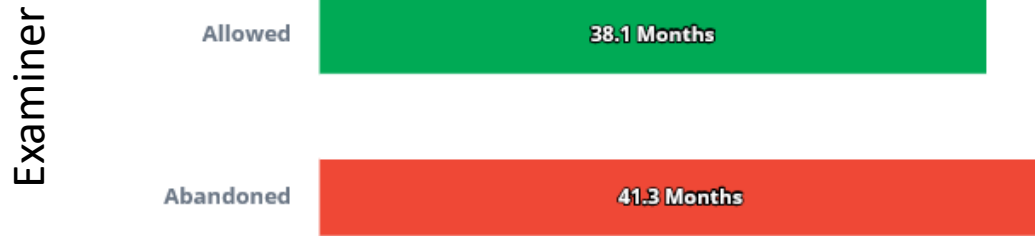


Annual Art Unit Performance (78%)

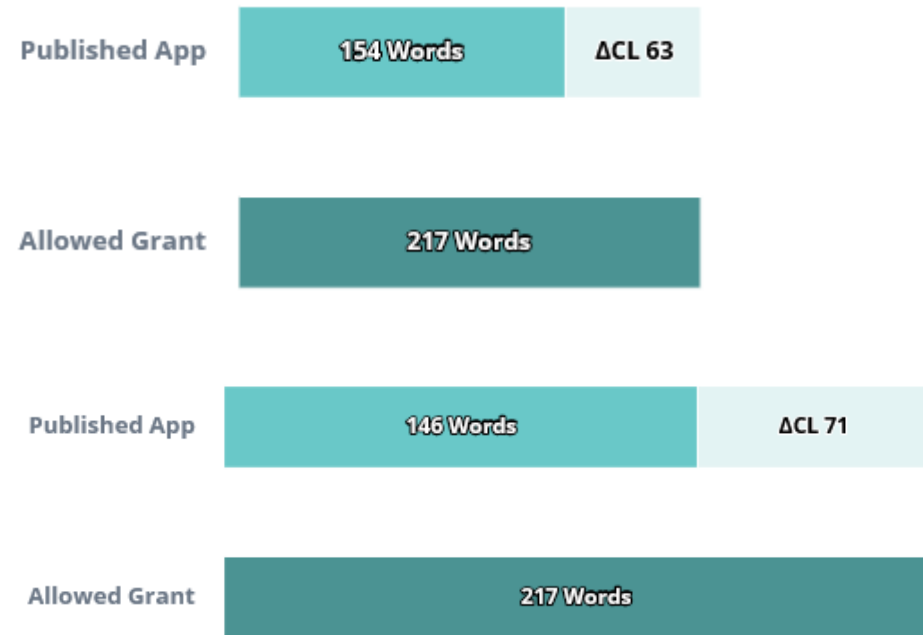


Examiner (68%) v. Art Unit 3665 (73)%

Pendency

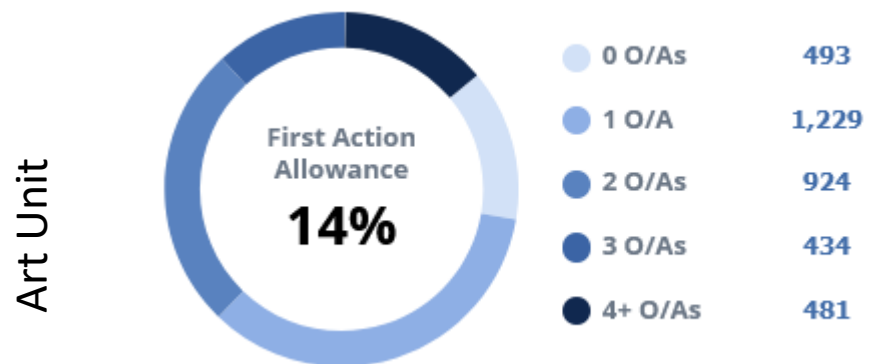
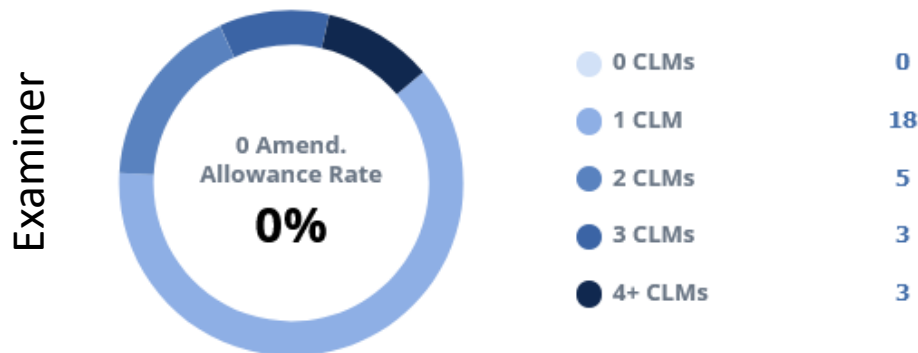


Amendments

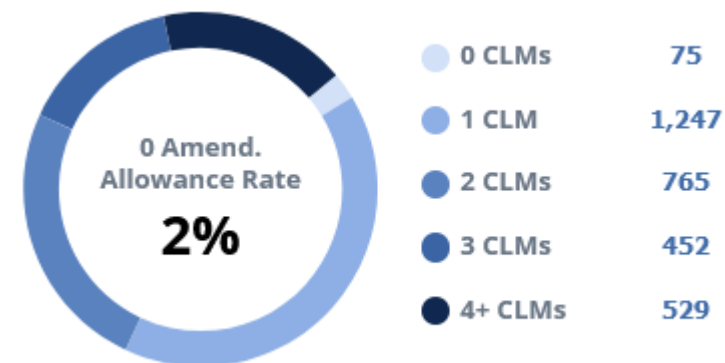
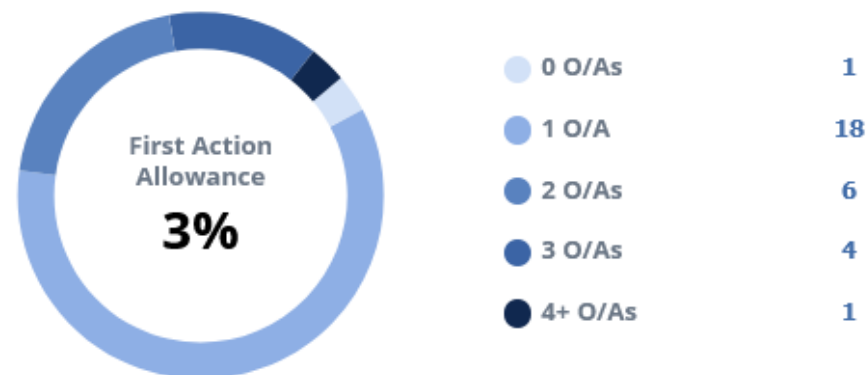


Examiner v. Art Unit 3665

Office Actions to Allowance

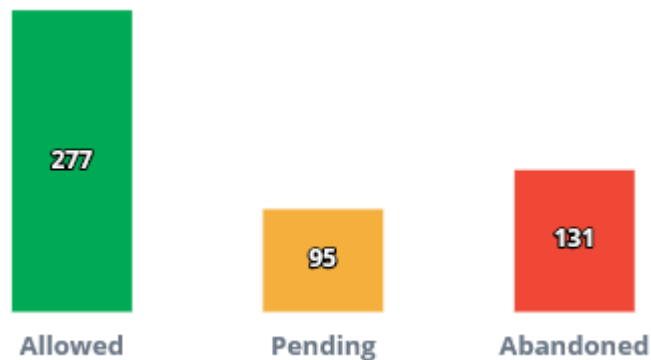


Amendments to Allowance



Examiner v Art Unit 3665 Appeals v. RCE

Appeals (50% Win by Applicant)



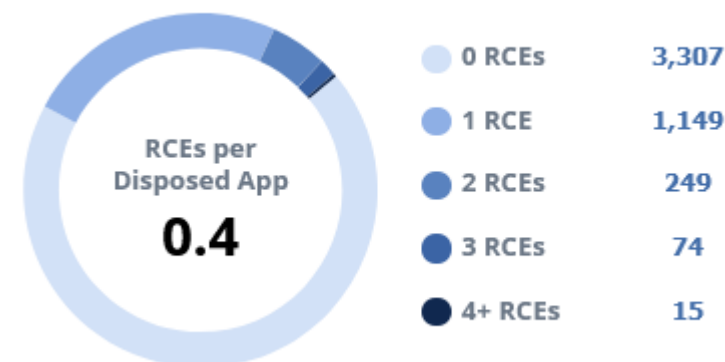
Art Unit: 67.9% Win by Applicant

RCEs to Disposition

Examiner



Art Unit



Examiner V. Art Unit 3665 Interviews

Interviews - Examiner Initiated

Interviews - Applicant Initiated



Key Take-Aways

- What Examiner 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.