

## Episode 08:

Using Patent Prosecution History Reports to Increase Prosecution Efficiency and Avoid Unintended Estoppel

# 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**

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

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

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**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 BOA Mapping  
**Thursday, June 11, 2020 at 12:00 PM CT**

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

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

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**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  
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Principal  
FTO and Patent Analytics Expert  
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Legal Process Manager, Schwegman,  
Lundberg & Woessner  
Legal Workflow and Systems  
Architecture Expert



**Mark Stignani**

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



# What is a prosecution history report?

A prosecution history report gathers together – for a family of related cases -- the following information:

- History of claim amendments and all claim versions for all cases in family
- History of non-art and art rejections for all cases in family with examiner's remarks re same, indexed by claim and art cited
- History of arguments made by applicant for all cases in the family with applicant's arguments, indexed by claim and PTO rejections

# Questions Answered



# Use Cases

## Use Cases:

- Used by patent prosecutor in prosecution
- Family claiming overview
- To avoid inconsistent arguments
- To reuse successful arguments
- Prosecution History Estoppel review
  - Offensive/Defensive

## Questions Answered:

- What amendments made previously in this and other family members
- What prior art has been cited in past
- What arguments have been made before

# How Reports are Assembled

## Data collection and organization:

- All pertinent prosecution history data is loaded in a structured DB - ClaimScape®:
  - claims as filed
  - claim amendments
  - references cited
  - office actions
  - responses
- Data is obtained by ingesting and parsing all prosecution history documents from PTO and Applicant
- Claimscape® contains all the information needed to automatically produce a claim history report

## ClaimScape® :

- ClaimScape® is a complex database that offers many features including:
  - Search and slice the data in a multitude of ways, e.g.,
    - Report on all citations of a given reference and all remarks or arguments made about that reference, across all client matters
    - Report on all citations made by a given examiner and all remarks or arguments made about that reference, across all client matters
    - Summary report on interactions with a particular examiner for a particular client or a particular art unit
    - Extraction of data for client reports for prosecution management

# ClaimScape®

# Workflow


- Patent applications and amendments filed are all processed into ClaimScape® automatically and with some user assistance in some cases
- Likewise, all actions from PTO are processed into ClaimScape®
- Data is obtained by ingesting and parsing all prosecution history documents from PTO and Applicant
- Claimscape® contains all the information needed to automatically produce a claim history report
- After an office action or allowance is received and processed into ClaimScape®, a claim history report is automatically generated and provided to attorney prosecuting application



# Quick Review on PHE

- PHE occurs when an applicant makes narrowing amendments/arguments during the application prosecution then they may be precluded from using the doctrine of equivalents to broaden the scope of their claims during litigation (Predominantly US concept)
- Additionally, Examiners Amendment/Interview Summary can contribute to a PHE determination. See *Amgen, Inc. v. Amneal Pharmaceuticals, LLC*, 945 F.3d 1368 (Fed. Cir. 2020).
- Arguments made at any time during prosecution, whether or not they are ultimately required for allowance, may create an estoppel
- PHE is also occurs in RCEs, especially when Examiner's basis for rejection is unclear

# Basic File History Summary

	
MATTER DETAILS:	
PERSONAL AUDIO ASSISTANT DEVICE AND METHOD	
Patent/Publication No.	2008/0031,475
Patent/Publication Date	7-Feb-08
Country	United States of America
Filing Date	9-Jul-07
Application No.	11/774,965
Status	Pending
Priority Date	8-Jul-06
Inventors	Steven Wayne Goldstein
Published Assignee	PERSONICS HOLDINGS INC.;PERSONICS HOLDINGS
Current Assignee	PERSONICS HOLDINGS, LLC
Assignment Chain	<p><u>Assignment 1</u></p> <p><b>Reel/Frame :</b> 019916/0814</p> <p><b>Date Recorded :</b> 03-Oct-2007</p> <p><b>Conveyance :</b> ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).</p> <p><b>Assignor :</b> GOLDSTEIN, STEVEN WAYNE</p> <p><b>Assignee :</b> PERSONICS HOLDINGS INC.</p> <p><b>Execution Date :</b> 17-Sep-2007</p> <p><u>Assignment 2</u></p> <p><b>Reel/Frame :</b> 020033/0719</p> <p><b>Date Recorded :</b> 30-Oct-2007</p> <p><b>Conveyance :</b> ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).</p> <p><b>Assignor :</b> GOLDSTEIN, STEVEN WAYNE</p> <p><b>Assignee :</b> PERSONICS HOLDINGS INC.</p> <p><b>Execution Date :</b> 17-Sep-2007</p> <p><u>Assignment 3</u></p> <p><b>Reel/Frame :</b> 025713/0409</p> <p><b>Date Recorded :</b> 28-Jan-2011</p> <p><b>Conveyance :</b> ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).</p> <p><b>Assignor :</b> GOLDSTEIN, STEVEN</p> <p><b>Assignee :</b> PERSONICS HOLDINGS INC.</p> <p><b>Execution Date :</b> 17-Sep-2007</p> <p><u>Assignment 4</u></p> <p><b>Reel/Frame :</b> 032189/0304</p> <p><b>Date Recorded :</b> 08-Feb-2014</p>

## Bibliographic Tab

- Basic Inventor
- Basic Class/Priority
- Assignment Chain
- Examiner/Art Unit
- Abstract

# Procedural Claim History




**CLAIM CHART: 2008/0031,475 (11/774,965)**

Claim #	Application - 07/09/2007	Non-Final Office Action - 07/11/2011	Non-Final Office Action Response - 10/11/2011	Final Office Action - 02/07/2012
1	Original	Original   Rejected (103)	Currently Amended <Amended 1 time(s)>	Currently Amended   Rejected (103)
2	Original	Original   Rejected (103)	Currently Amended <Amended 1 time(s)>	Currently Amended   Rejected (103)
3	Original	Original   Rejected (103)	Currently Amended <Amended 1 time(s)>	Currently Amended   Rejected (103)
4	Original	Original   Rejected (103)	Currently Amended <Amended 1 time(s)>	Currently Amended   Rejected (103)
5	Original	Original   Objected to (103)	Original	Original   Rejected (103)
6	Original	Original   Objected to (103)	Currently Amended <Amended 1 time(s)>	Currently Amended   Rejected (103)
7	Original	Original   Objected to (103)	Currently Amended <Amended 1 time(s)>	Currently Amended   Rejected (103)
8	Not Filed	N/A	New	New   Rejected (103)
9	Not Filed	N/A	Not Filed	N/A
10	Not Filed	N/A	Not Filed	N/A
11	Not Filed	N/A	Not Filed	N/A
12	Not Filed	N/A	Not Filed	N/A

## PCH Tab

- Claim Status
  - Original
  - Amended
  - New
- Chronological
  - By PTO Event
- Rejections Basis
  - 101
  - 102
  - 103
  - 112

# Claim Language History



Show Redlined Text

**CLAIM HISTORY: 2008/0031,475 (11/774,965)**

Claim #	Application Filed 07/09/2007	Non-Final Office Action 07/11/2011	Non-Final Office Action Response 10/11/2011	Final Office Action 02/07/2012
1	1. An earpiece comprising: an ambient microphone; an ear canal microphone; an ear canal receiver; a sealing section; a logic circuit; a communication module; a memory storage unit; and a user interaction element, where the user interaction element is configured to send a play command to the logic circuit when activated by a user where the logic circuit reads registration parameters stored on the memory storage unit and sends audio content to the ear canal receiver according to the registration parameters.	1. An earpiece comprising: an ambient microphone; an ear canal microphone; an ear canal receiver; a sealing section; a logic circuit; a communication module; a memory storage unit; and a user interaction element, where the user interaction element is configured to send a play command to the logic circuit when activated by a user where the logic circuit reads registration parameters stored on the memory storage unit and sends audio content to the ear canal receiver according to the registration parameters.	1. (Currently Amended) An earpiece comprising: an ambient microphone <del>configured to pick up ambient audio content</del> ; an ear canal microphone <del>configured to pick up audio in an ear canal</del> ; an ear canal receiver; a sealing section <del>configured to seal the ear canal</del> ; <del>a logic circuit</del> ; a communication module; a memory storage unit; <del>and</del> a logic circuit coupled to the ambient microphone, the ear canal microphone, the ear canal receiver, the communication module, and the memory storage unit; and a user interaction element <del>coupled to the logic circuit</del> , where the user interaction element is configured to send a play command to the logic circuit <del>when</del> <del>activated</del> <del>responsive to an indication</del> by a user, where the logic circuit reads registration parameters stored on the memory storage unit and sends audio content to the ear canal receiver according to the registration parameters, <del>where the registration parameters relate to the audio content that may be played and limitations on a use of the audio content by the earpiece.</del>	1. (Currently Amended) An earpiece comprising: an ambient microphone <del>configured to pick up ambient audio content</del> ; an ear canal microphone <del>configured to pick up audio in an ear canal</del> ; an ear canal receiver; a sealing section <del>configured to seal the ear canal</del> ; <del>a logic circuit</del> ; a communication module; a memory storage unit; <del>and</del> a logic circuit coupled to the ambient microphone, the ear canal microphone, the ear canal receiver, the communication module, and the memory storage unit; and a user interaction element <del>coupled to the logic circuit</del> , where the user interaction element is configured to send a play command to the logic circuit <del>when</del> <del>activated</del> <del>responsive to an indication</del> by a user, where the logic circuit reads registration parameters stored on the memory storage unit and sends audio content to the ear canal receiver according to the registration parameters, <del>where the registration parameters relate to the audio content that may be played and limitations on a use of the audio content by the earpiece.</del>

## CLE Tab

- Claim Status
  - Original
  - Amended
  - Deleted
- Chronological

# Applicant/Examiner Remarks



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**PROSECUTION REMARKS: 2008/0031,475 (11/774,965)**

Remark #	Non-Final Office Action 07/11/2011	Non-Final Office Action Response 10/11/2011	Final Office Action 02/07/2012
1	<p>Examiner Statements: The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.</p> <p>Dno et al. disclosed a wireless transmitting and receiving system (U.S. Patent 4,334,315).</p> <p>Shennib et al. disclosed a canal hearing device with transparent mode (U.S. Patent 6,914,394 B1).</p> <p>Kim disclosed an MP-3 player (U.S. Patent 6,823,365 B1).</p>	<p>Attorney Remark: Claim 1 was objected to because claim 4 recites a "second user interaction element" whereas claim 1 recites "a user interaction element." Applicant has amended claim 4 to replace "second user interaction element" with "further user interaction element." Accordingly, Applicant respectfully requests that the objection to claim 1 be withdrawn.</p>	<p>Examiner Statements: Applicant's arguments filed with the amendment on 10/11/2011 have been fully considered but are moot in view of the new ground(s) of rejection presented above.</p>

## AER Tab

- Rejections
- Objections
- Arguments
- Argument Results

# Argued Reference Tab



**ARGUED REFERENCES: 2008/0031,475 (11/774,965)**

# of Citations in portfolio	Matters with Cited References in Common	References cited with Action	Non-Final Office Action 07/11/2011	Non-Final Office Action Response 10/11/2011	Final Office Action 02/07/2012	Final Office Action Response 04/06/2012
1		<a href="#">3865998</a>	103 : Claims 1-7	Claims 1-4		
1		<a href="#">4539439</a>	103 : Claims 1-7	Claims 1-4		
1		<a href="#">7558529</a>	103 : Claims 1-7	Claims 1-4		
1		<a href="#">4334315</a>	Examiner Statements : Claims 1-7			

## AR Tab

- Family Citations
- When Cited
  - Rejection type
  - Which Claims
- Chronological

# Reference Detail Tab

## REFERENCE DETAILS: 2008/0031,475 (11/774,965)

Patent/Pub#	Grant/Pub Date	Filing Date	Inventor(s)	Title	Status
<a href="#">3865998</a>	11-Feb-1975	15-Jun-1973	Weiss, Erwin M.	Ear seal	Received From PTO
<a href="#">4334315</a>	08-Jun-1982	05-May-1980	Ono Hiroshi	Wireless transmitting and receiving systems including ear microphones	Received From PTO
<a href="#">4539439</a>	03-Sep-1985	18-Apr-1983	Strothmann Rolf	Plugs, receptacles and hearing aids	Received From PTO
<a href="#">6587822</a>	01-Jul-2003	06-Oct-1998	Brown, Michael Kenneth		Received From PTO
<a href="#">6636953</a>	21-Oct-2003	29-May-2001	Yuasa Aki	Receiving apparatus that receives and accumulates broadcast contents and makes contents available according to user requests	Received From PTO

## RD Tab

- Reference Biblio
- Cited By IDS/PTO
- Link out to Ref.

# Usage – Law Firm

- Single File History Review
  - Claim review
    - Scope
    - Design Around
    - Discoverability
  - Limitations/Expansion
  - Prosecution Analysis
    - Targeted Changes
    - De minimus Amendment
  - PHE commentaries
- Multiple File History Review
  - Co-Citation Review
  - Claim planning across family
    - Gap Discovery
  - Competitor PHE
  - Coverage Overlap
  - Extraction of Claiming Strategies
  - Work product review
  - Licensing review



# Usage – In-House

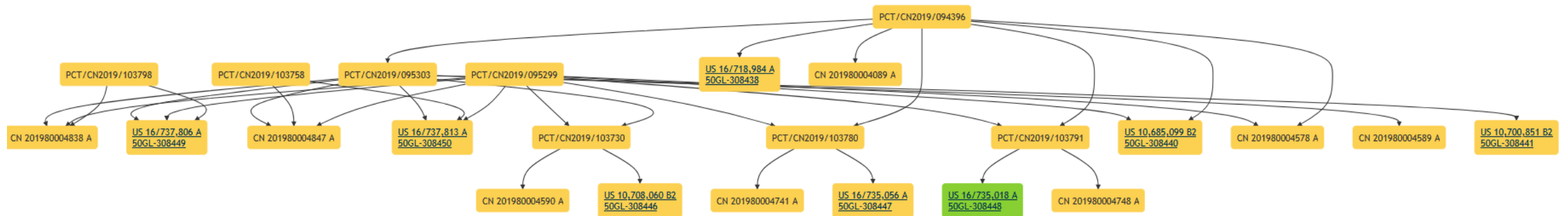
- Single File History Review
  - Speed Memory Refresh
  - Proposed Claim Coverage
  - PHE review
- Competitor File History Review
  - Quick Estoppel Review
    - Narrowing Commentary
- Multiple File History Review
  - Co-Citation Review
  - Claim planning across family
    - Gap Discovery
  - Competitor PHE
  - Coverage Overlap
  - Law Firm evaluation
    - Review of High OA/RCE filings

# Other Usage – With Claim Mapping

- Enhanced Assertion Planning
  - Pre-Answer PHE Arguments
- Targeting EOU of a Competitor
  - Scope
  - Design Around
  - Detectability
- Licensing Discussions
- Valuation

# FHS areas of high usage

- Complex Chemical
- Biotech
- Genomic
- Complex Families
- Appeals/RCE/CIP/CA
- Law Firm or Lawyer Evaluation



# Key Take-Aways

- **File History Summaries allow In-House to speed monitor**
  - FHS provide the details to confirm high level analytics
  - FHS also reveal the inner skills of a firm/atty
- **PHE mitigation requires mapping in prosecution**
  - FHS provide the details to confirm mapping
  - FHS multiply in value across continuations prosecution

# 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.