

USPTO File Wrapper-Derived Patent Intelligence Tools – An Overview

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Agenda

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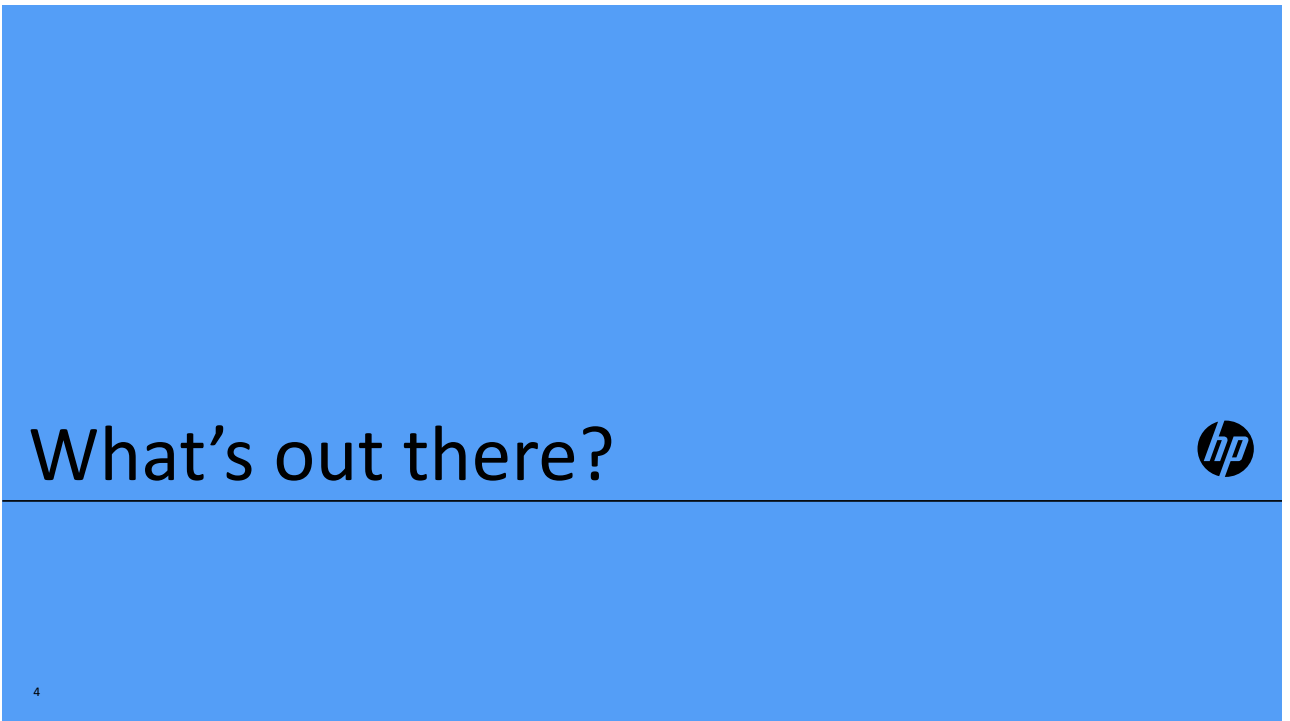


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Why? Why should I consider using data to complement my practice?

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What's out there?



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Patent Advisor

Paid software solution
(owned by Lexis Nexis)



Patent Advisor offers:

- Examiner Statistics and trends
- Corporate and law firm statistics
- Art Unit assignment prediction/refinement
- PTAB decisions (including issue-based review)

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Patent Bots

Paid software solution
with limited free
functionality



Patent Bots offers:

- Automated proofreading
- Examiner Statistics and trends
- Art Unit assignment prediction/refinement
- Client-law firm mapping

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Big Patent Data

Paid software solution
with limited free
functionality

Big Patent Data includes:

- Art Unit and examiner statistics

Big Patent Data has a very useful and entertaining blog

bigpatentdata

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Patentprufer

Free software solution;
allows users to
contribute comments
regarding examiners

Patentprufer includes:

- Art Unit and examiner statistics

Patentprufer

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Patent 300

Paid dashboard with some limited access for free

Patent 300 includes:

- Corporation portfolio and law firm statistics



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How can these tools help my clients?



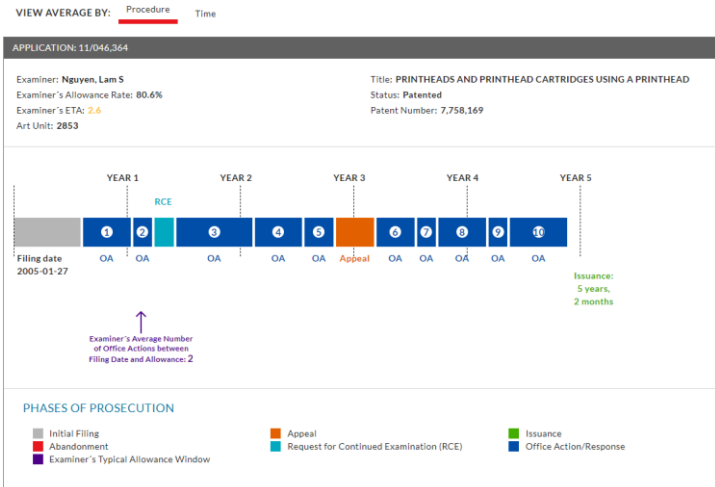
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In-house counsel/law firm partner use case

Using Patent Advisor's graphical QuickPAIR view to quickly understand the prosecution history of a case

Situation: You receive a file and a draft to review prior to filing.



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35 USC § 112 use case

A wasted RCE and additional round of responses

- Weak § 112 enablement rejection
- 2 OA responses, an RCE, then a NFOA response after the RCE before abandonment



Issue	Case name	Application number	Outcome	Decision date
102 (112)	Ex parte Brian/Robert Collins	09/063,303	Examiner Reversed Examiner Reversed	05/04/2010
103	Ex parte Charles Raymond Brown II	12/448,973	Affirmed	05/04/2015
102	Ex parte Mark S. Hancock	12/344,893	Affirmed	02/24/2013
102	Ex parte Michael Orlan Kaye and Edward James Orlan	13/025,856	Affirmed	10/26/2012
103	Ex parte Steven B. Egan and Steve O. Bannerman	13/021,450	Examiner Reversed	08/19/2011
103 (112)	Ex parte Barry P. Masarik	13/413,401	Affirmed Affirmed	05/11/2011
102	Ex parte Chang-Lin Yao and Dennis Chao	09/006,204	Not available	04/05/2010
103	Ex parte John O. Ptasinski and Van-Ho Nhoan Ho	09/040,513	Not available Not available	
103	Ex parte Mikasa Takahashi and Tomohisa Otsu	09/095,045	Examiner Reversed Affirmed	06/09/2009
103	Ex parte Jeffrey D. Hall	09/454,262	Not available	04/02/2009

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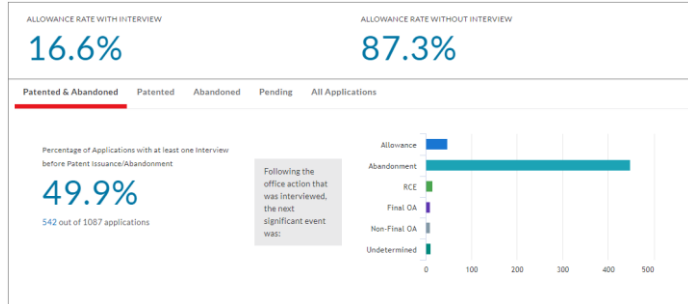
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Interview use case

How could you go wrong with an interview?

Some of us may have spoken with examiners who do not like to conduct interviews. This particular examiner is but one example of someone for whom the default recommendation of an interview may be a *bad idea*.



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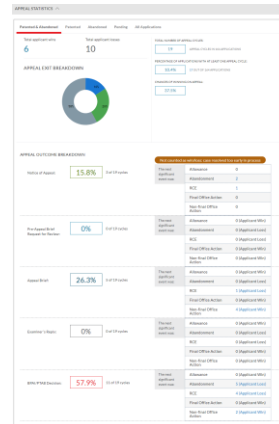
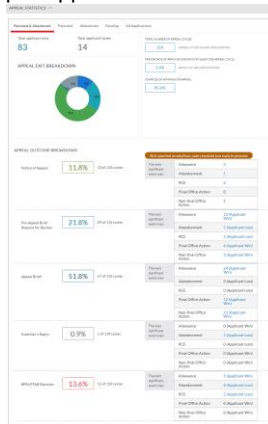


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Appeal? Pre-appeal conference?

Should I appeal? Does it make sense to do a pre-appeal conference?

Appeals are slow and expensive. If you want something allowed quickly for your client, the best route is usually to work with the examiner. But these tools can help identify cases in which it may make sense to appeal—and further, when the pre-appeal conference route may make sense.



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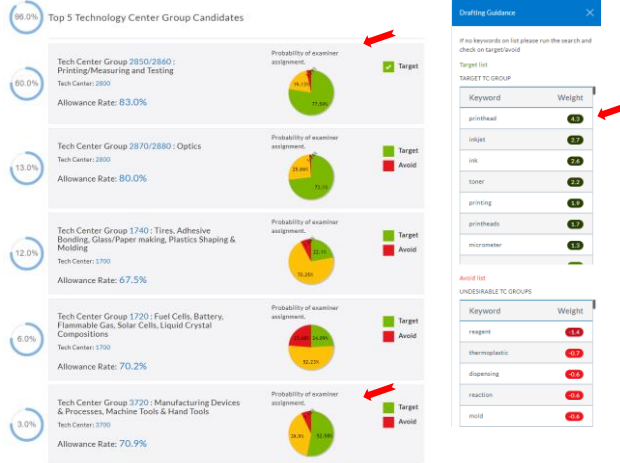


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Art Unit Prediction/Refinement

Which group of examiners do you want examining your application?

If your client's goal is to get something allowed quickly, then it may make sense to target certain Tech Centers/Tech Center Groups/Art Units.



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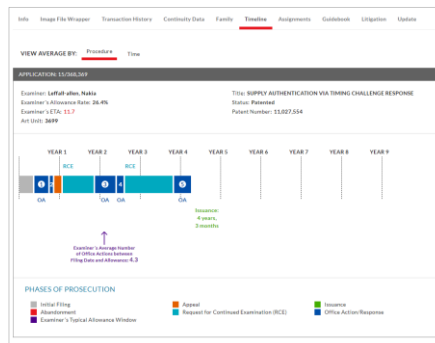
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Expectation setting

These tools can be helpful to set client expectations

When you pick up a file and see that you have a challenging examiner, it may be a good idea to let the client know that examination may take longer than might be expected (and may be more expensive).

There may be times when a client might be willing to make significant amendments to get the case allowed relatively quickly (e.g., to have IP as part of a pitch to investors)—particularly when the examiner is more challenging.



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How can these tools help me stand out?



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Patent Bots Quality Rankings

Patent Bots releases annual quality rankings of law firms and corporations

What is Patent Bots looking at in its quality rankings?

The Patent Bot AI tool scans through all of the patents issued in a given year, and looks for (1) numbering, (2) antecedent basis, and (3) word support errors in each patent. Averages for 1-3 are determined for each firm, and the firms are then ranked.



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Patent 300 Dashboard

Patent 300 provides analytics on different aspects of corporate patent portfolios and competitive law firm analysis

Data points include, average numbers of OAs, average numbers of RCEs, pendency, interview statistics, etc.



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Patent Advisor Competitive Intelligence

Patent Advisor compares law firms by normalizing examiners by difficulty



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Thank you

Please send any questions to benjamin.hoopes@hp.com

