Practical Use of Examiner Data – A Perspective

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October, 2019
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Agenda – *Practical Use of Examiner Data – A Perspective*

- Introduction to our perspective

- Decision Making

- Examples

- Our experience

- Questions

Introduction

- Largest women-owned IP boutique (based on #US patents, ~770 in 2018)

- Focus on portfolio development

- Top National Quality Rankings (section 101, drafting quality, etc.)

- Strategic Appeals Practice (>> than the usual 30% reversal rate)

- Specialized restriction/petition practice

- Thought Leadership
  - www.mriplaw.com blog (over 4 years)

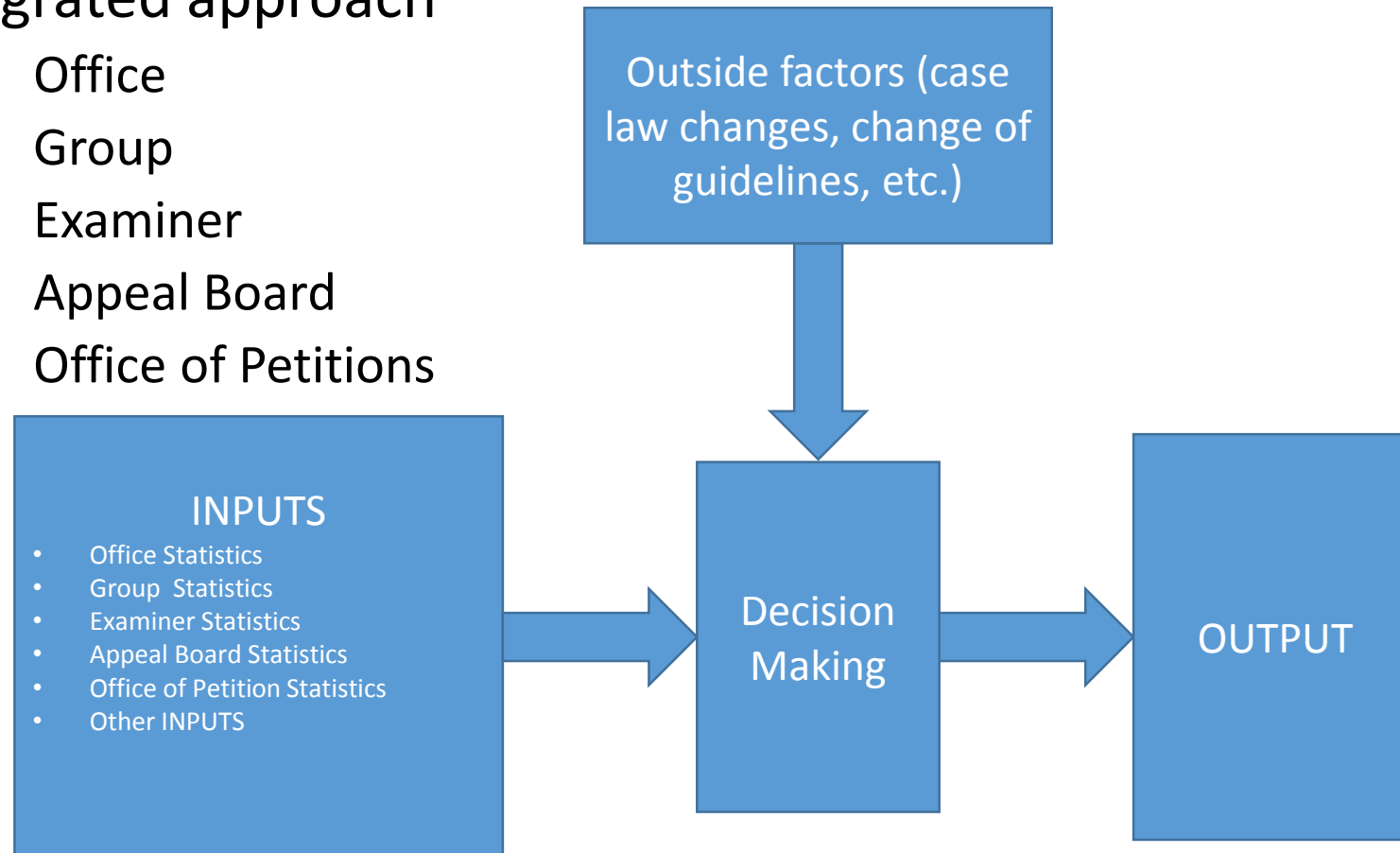- Integrated Practice Using USPTO Statistics

Evolution of Our Use of USPTO Data

- Practice of using statistics has evolved (Homegrown System)
  - Memory
  - Firm charting of specific examiner's and group responses in Excel
  - Additional columns entered over time
    - FOIA requests
    - USPTO dashboard trend data
- Development of more widely based USPTO statistics - Evolution to Third Party Aggregators
  - Data available quickly
  - Data available without firm history for specific examiner or group
  - Data is up-to-date
  - Standardized approaches and collection of data
  - Cost reductions make the data more widely available

USPTO Statistics

- Different types of statistics combine to provide a more integrated approach
  - Office
  - Group
  - Examiner
  - Appeal Board
  - Office of Petitions

Outside factors (case law changes, change of guidelines, etc.)

INPUTS
- Office Statistics
- Group Statistics
- Examiner Statistics
- Appeal Board Statistics
- Office of Petition Statistics
- Other INPUTS

Decision Making

OUTPUT

Example Data

EXAMINER

Interview Success Rate ⓘ

37%
(104 interviews)

Final Rejection Allowance Rate With AFCP ⓘ

70%
(10 final rejections)

Final Rejection Allowance Rate Without AFCP ⓘ

18%
(203 final rejections)

ART UNIT

Interview Success Rate ⓘ

33%
(1813 interviews)

Final Rejection Allowance Rate With AFCP ⓘ

46%
(493 final rejections)

Final Rejection Allowance Rate Without AFCP ⓘ

21%
(3772 final rejections)

But, the data is just part of the picture... good prosecution requires seeing the whole situation.
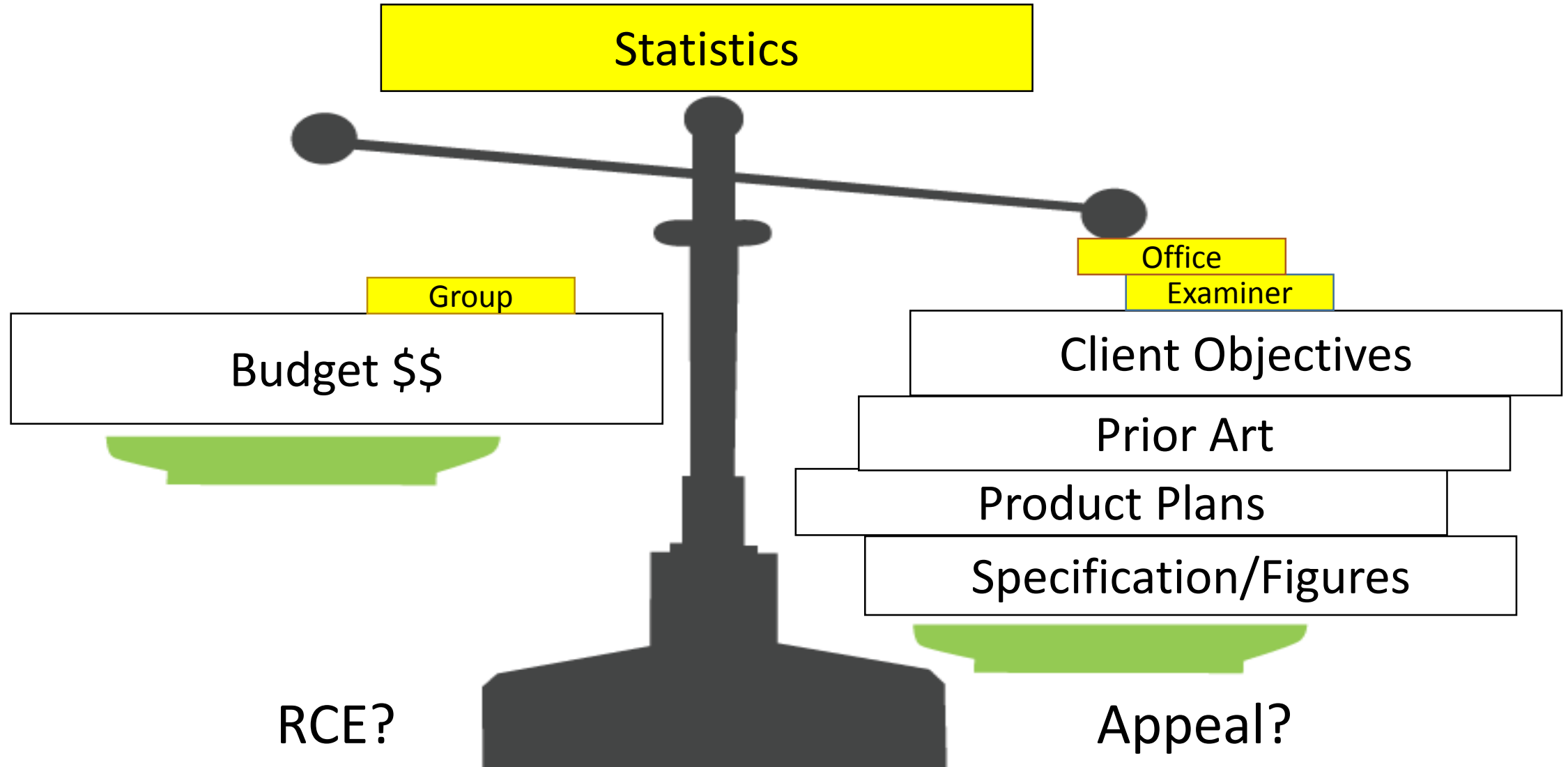
# Factors in Preparing a Response to Office Action

- Client objectives
- Budget
- Extent of disclosure in specification/figures
- Scope and Content of the Prior art
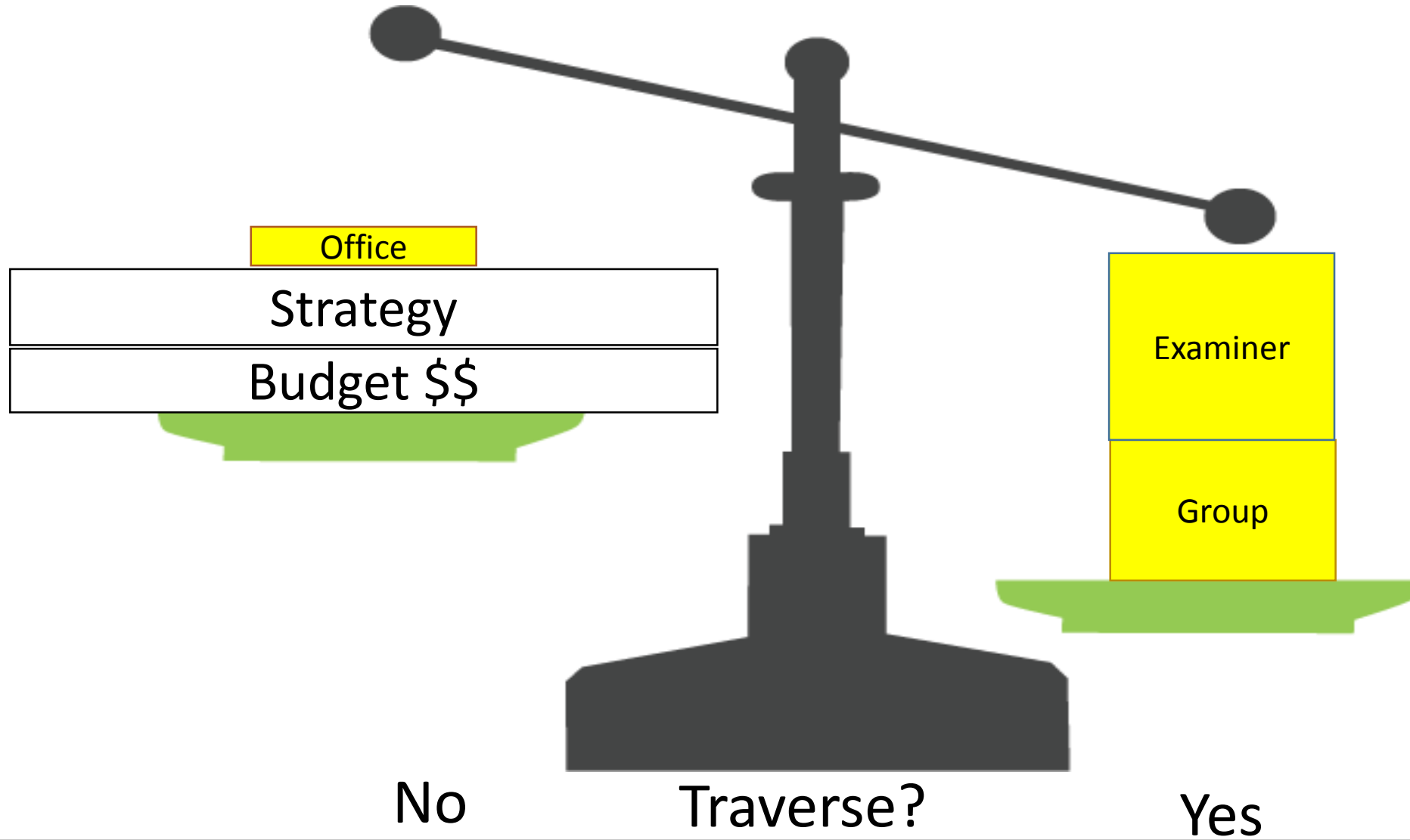- Product plans
- And yes, Patent Office Data…

Can Examiner Data Auto-generate your OA Response Decisions

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Office
Examiner
Group

Product Plans

Client Objectives
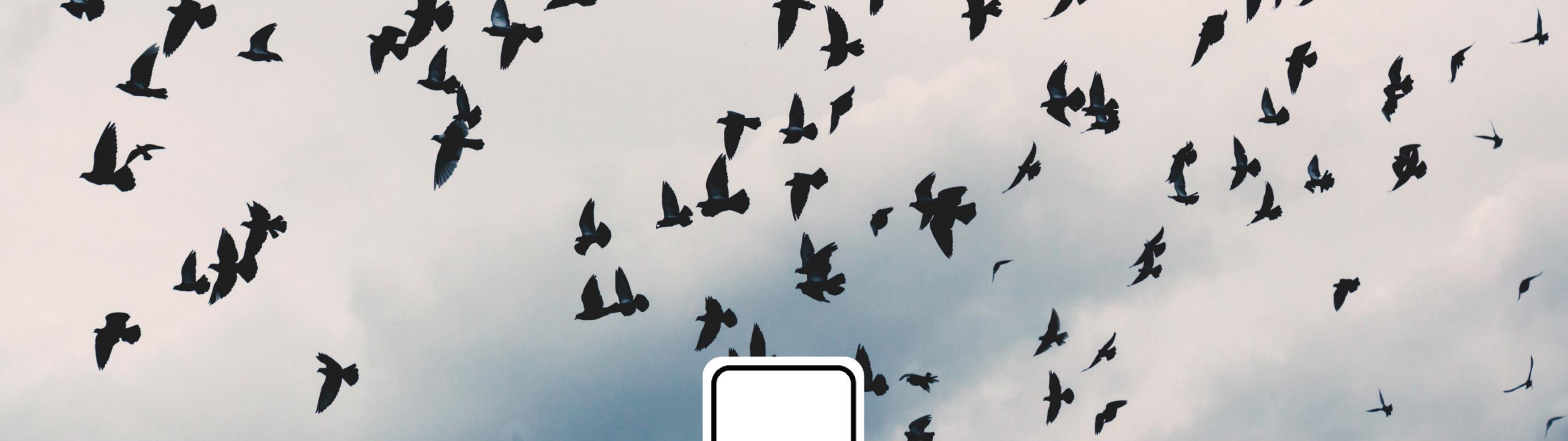
Yes   Interview?   No
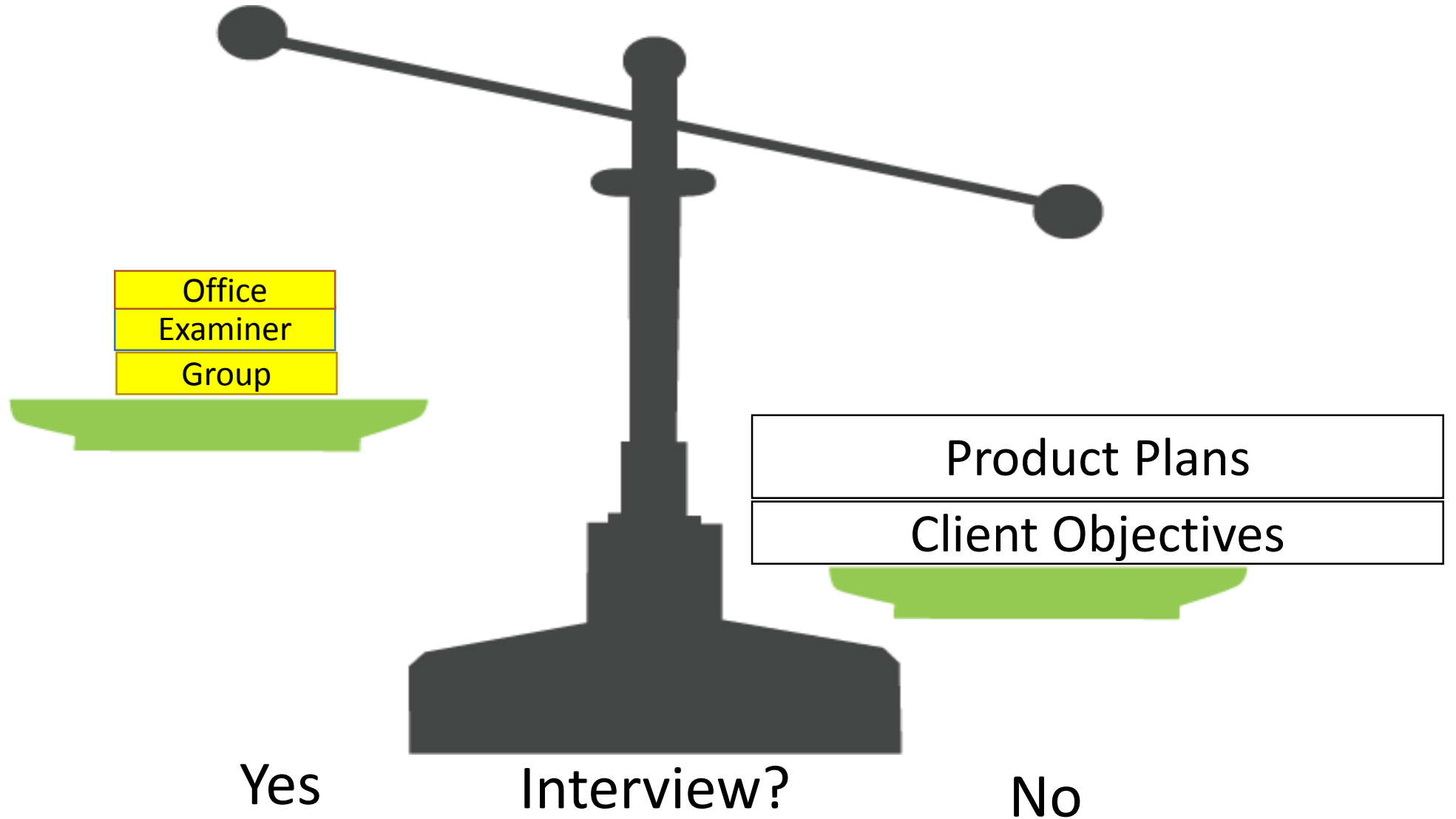
Can Examiner Data Auto-generate your OA Response Decisions

Don't let the Data Tail Wag the Dog

- Sometimes USPTO data seems compelling but it actually causes incorrect decisions for your specific case

- But, for many cases, the data is an important factor and should be considered at every stage of prosecution

- We have found that the data can be used at three levels to improve prosecution efficiency, but only when it is used as one factor among others, including experience and an overall strategy.
  - Case level
  - Family level
  - Portfolio level

- Not a magic talisman
  - Won't solve problems with poor drafting
  - Won't solve problems of close prior art
  - Won't give you the winning arguments specific to the facts of your case

Thank you