



# Examiner Reports



Every good patent attorney believes that he or she can prosecute an application on the merits and that doing this will ensure a reasonable chance of success. Since patent law is the same across the USPTO, developing a winning personal prosecution strategy should work the same with any examiner, right?

Not necessarily.

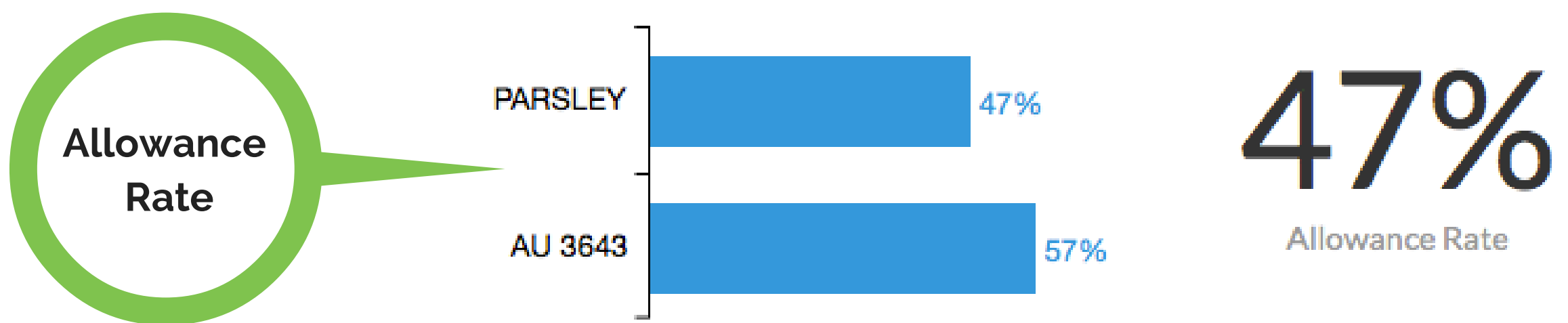
While patent law is the same for everyone at the USPTO, the interpretation of that law varies wildly from examiner to examiner. Every examiner has unique opinions and biases about the law and this will greatly affect the outcome of prosecutions before them. Information as to how examiners behave is not widely available, and most attorneys thus rely on word of mouth or their past experiences with specific examiners to inform their prosecution strategies. But word of mouth is not always accurate, and past experiences are not always reliable. Patent prosecutors need to measure their examiners' performance using reliable metrics that observe trends on a longer, more comprehensive scale. This is what Juristat Examiner Reports do.

Juristat Examiner Reports are interactive tools that allow patent attorneys and agents to use big data analytics to plan their prosecution strategies. Using public and private PAIR data, Juristat has created an Examiner Report for every examiner at the USPTO. This paper will reveal a bit about what Examiner Reports do and how a typical patent prosecutor might use them.

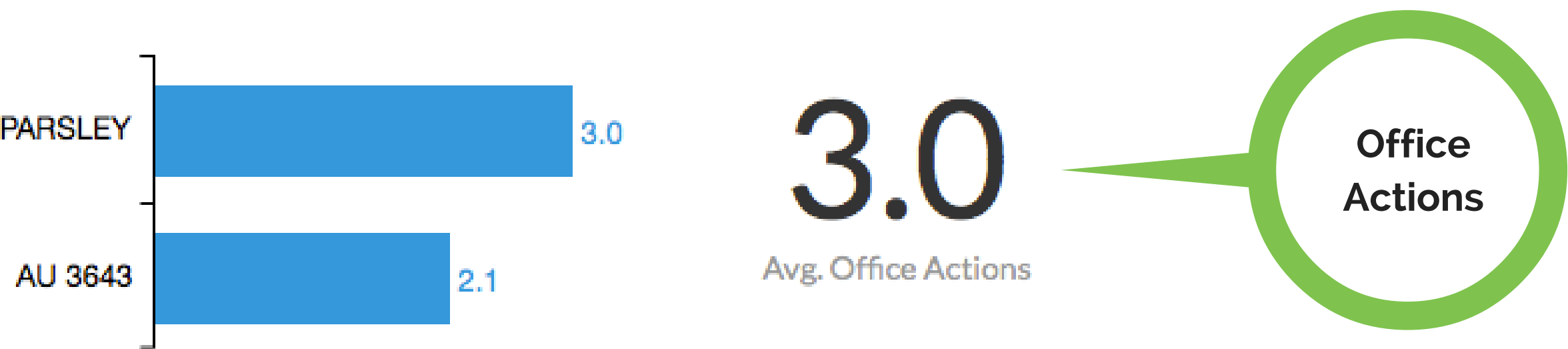
## Core Metrics

Every Examiner Report revolves around a set of core metrics that provide the vital statistics for every examiner at the USPTO. These metrics provide the foundation for every Examiner Report and tell practitioners at the very beginning what they can expect from the prosecution at hand. The four principle core metrics every Examiner Report measures are allowance rate, average number of office actions, office action response win rates, and claims change data.

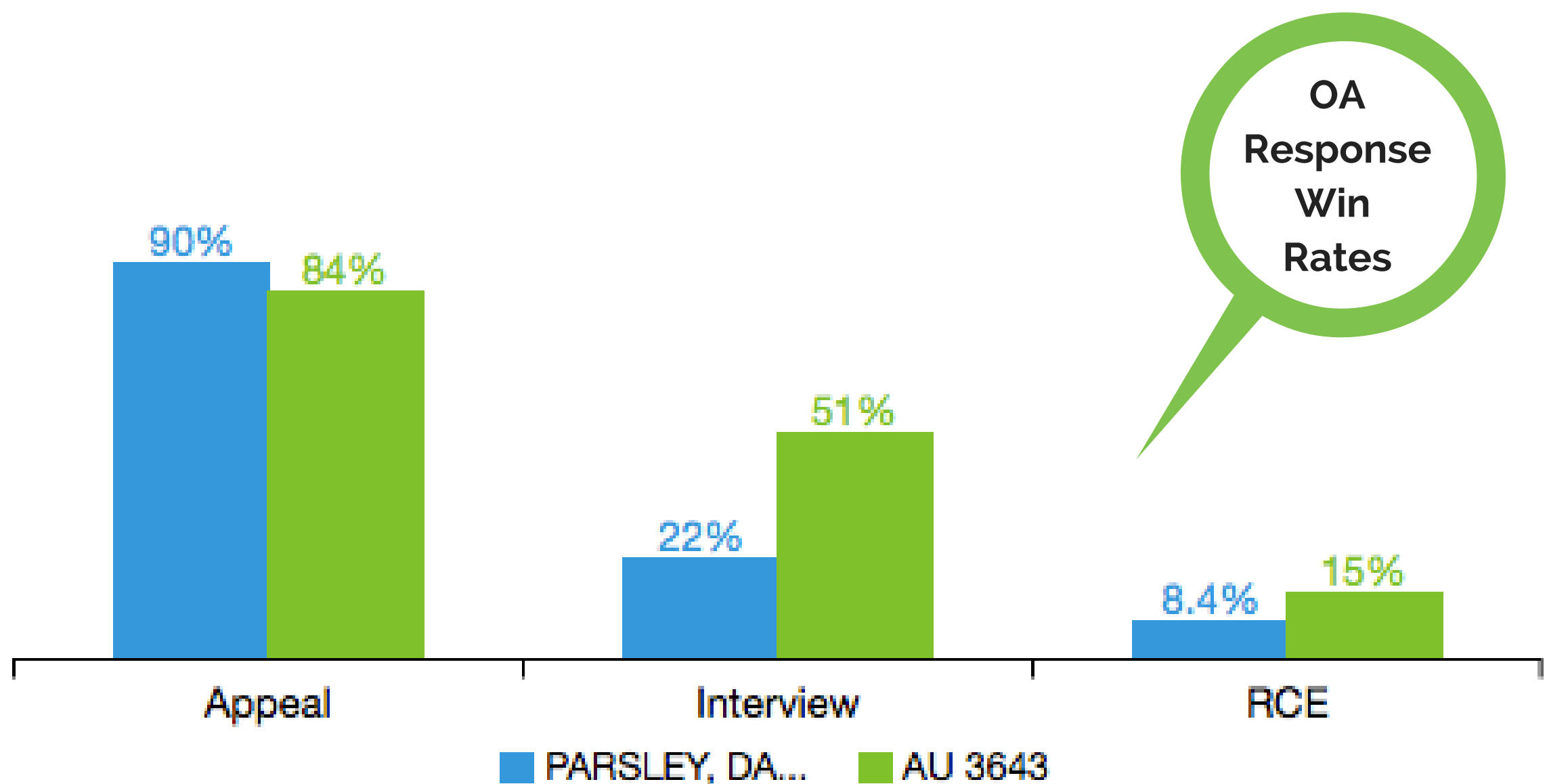
Below, we'll take a look at the core metrics and explain how they work. This data is taken from an actual examiner report on David J. Parsley in Art Unit 3643.



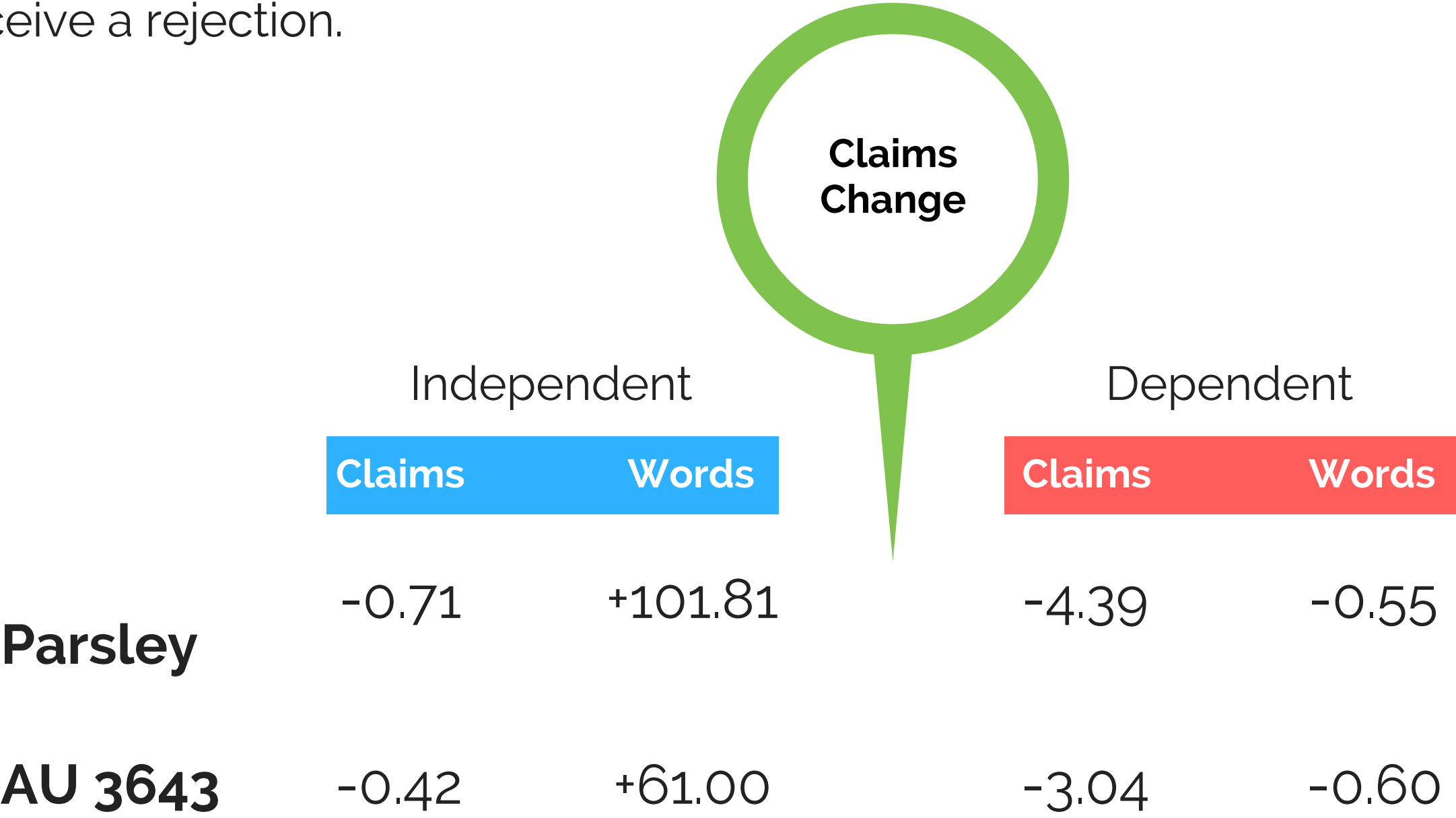
An examiner's allowance rate is the overall benchmark of how difficult patent prosecution will be in front of that examiner. It tells you what percentage of applicants obtain a notice of allowance from that examiner. It is calculated by dividing the number of allowed applications by the number of disposed applications (allowed + abandoned). Here, we see that Examiner Parsley's allowance rate is 10 percentage points lower than his art unit's average allowance rate, indicating that he issues fewer allowances than this art unit average.



The average number of office actions for a particular examiner tells prosecutors how many office actions to expect before receiving an allowance. Juristat defines an office action as a rejection (final or non-final), a restriction requirement, or an ex parte Quayle action. Along with allowance rate, this is also a good indicator of the overall difficulty of prosecution in front of a particular examiner. It also allows practitioners to make a rough approximation of the length and cost of the prosecution.



Every response to an office action from an examiner can be considered either a “win” or a “loss.” An office action response is generally considered a “win” if it is followed by an allowance with no other intervening response. For some examiners, an RCE might be the best way to overcome a rejection, while for others, an appeal might be the way to go. The Office Action Response Win Rates tool tells prosecutors which strategy will work best for a particular examiner based on how they have responded to them in the past. This is the first place practitioners should check when they receive a rejection.



Clients want an NOA, but they also want to make sure that they retain as much claim scope as possible. Generally, the more claims in an application, the narrower the claims are and the easier it is to get an allowance, while the fewer claims in an application, the broader the claims are and the harder it is to get an allowance. Bearing this in mind, Examiner Reports measure the average claims change between publication and allowance and the number of words per claim change for all applications in front of a particular examine. Thus, practitioners can get a pretty good idea of how much claim scope they can expect to retain and a general idea of how broad or narrow those claims are likely to end up after prosecution

In addition to the above core metrics, every Examiner Report also includes a set of metrics that are designed to give practitioners the full picture of their examiner’s behaviors. For example, Examiner Reports allow users to track their examiner’s allowance rate by disposition year to find out how their allowance rate has changed over time.

The Dispositions by Rejection Count features offers a breakdown of dispositions (allowances and abandonments) after a given number of rejections that allows users to see their examiner's allowance rate per rejection and how it changes over the course of prosecution. One of the most popular of these metrics is the continuation tracker that allows users to see the probability of obtaining either a new examiner or a new art unit by filing a continuation or a continuation-in-part. And on top of that, all of the metrics in every Examiner Report are filterable by year, art unit, class, assignee, firm, and more.

## Historical Analysis

The best decisions in patent prosecution are made by studying an examiner's past behavior to predict how they will behave in the future. This information is particularly useful for responding to office actions and planning an appeal of a final rejection. Lawyers are specially trained in making legal arguments and most do so quite well, but, as we mentioned above, every examiner is different and has his or her own preferences when it comes to the law. The truly skilled patent prosecutor will know these preferences before drafting any response to an examiner. Luckily, Examiner Reports provide everything prosecutors need to know to draft winning arguments by examining how previous applicants have fared.

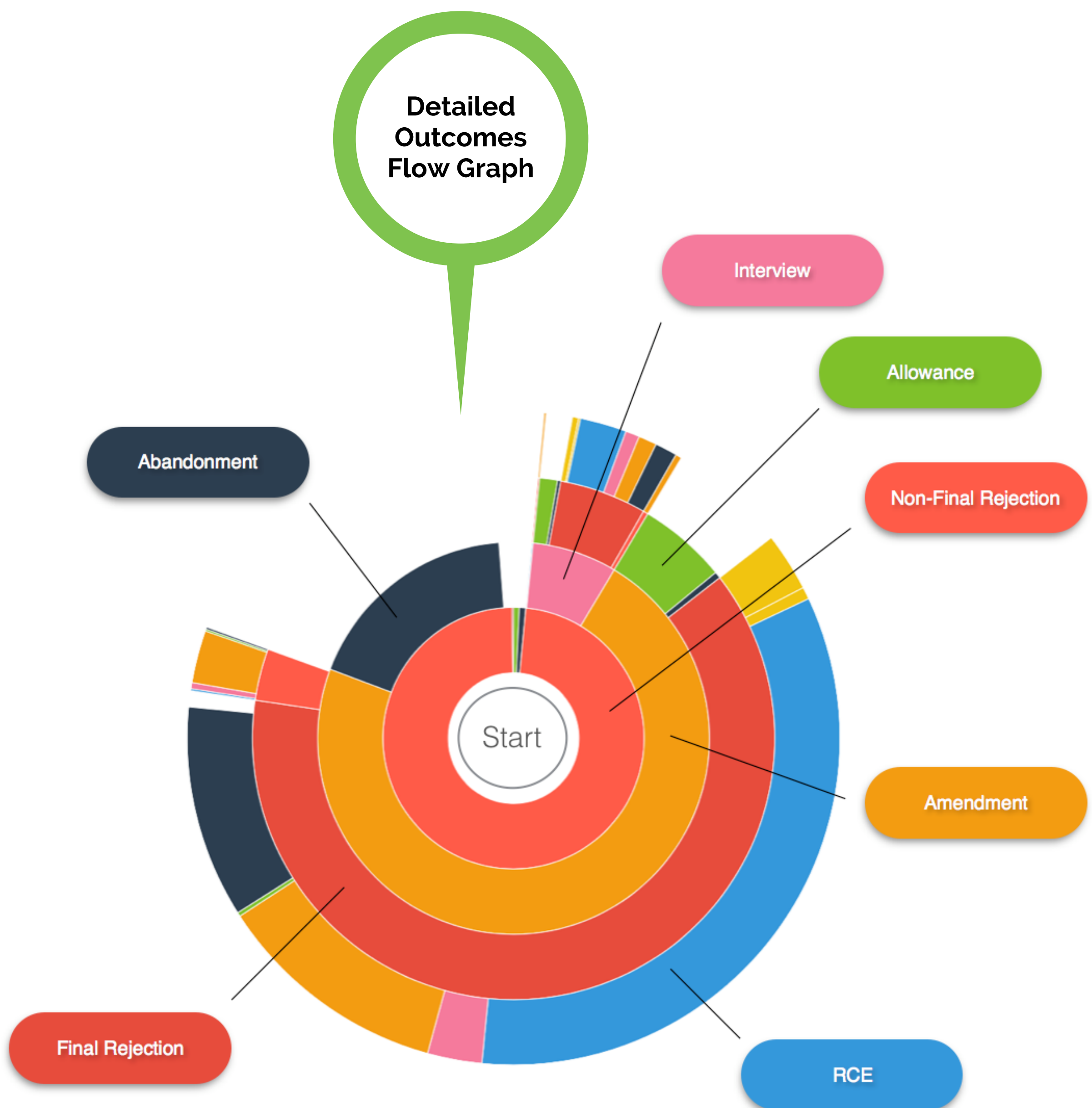
For responding to rejections, each Examiner Report includes a history of every rejection the examiner has ever issued. This feature shows the application the rejection was issued to, whether the rejection was final or non-final, the applicant's response to the rejection, and the final outcome of the rejection. These histories are easily searchable by using an intuitive comma-separated text search. For example, typing in "103, RCE" will bring up only applications where there was a rejection based on § 103 to which the applicant's response was an RCE. Each previous applicant's response is also linked directly to the actual document in Public PAIR, allowing users to see which previous arguments were successful and which ones weren't, right from within the app.

For writing appeal briefs, Examiner Reports include a similar tool that shows the application the appeal was filed from, the appeal brief, the examiner's response, the applicant's reply brief, the PTAB decision (if applicable), and the final outcome of the appeal. Just like the rejection history tool, all original documents are available right within the app simply by clicking on the link to Public PAIR.



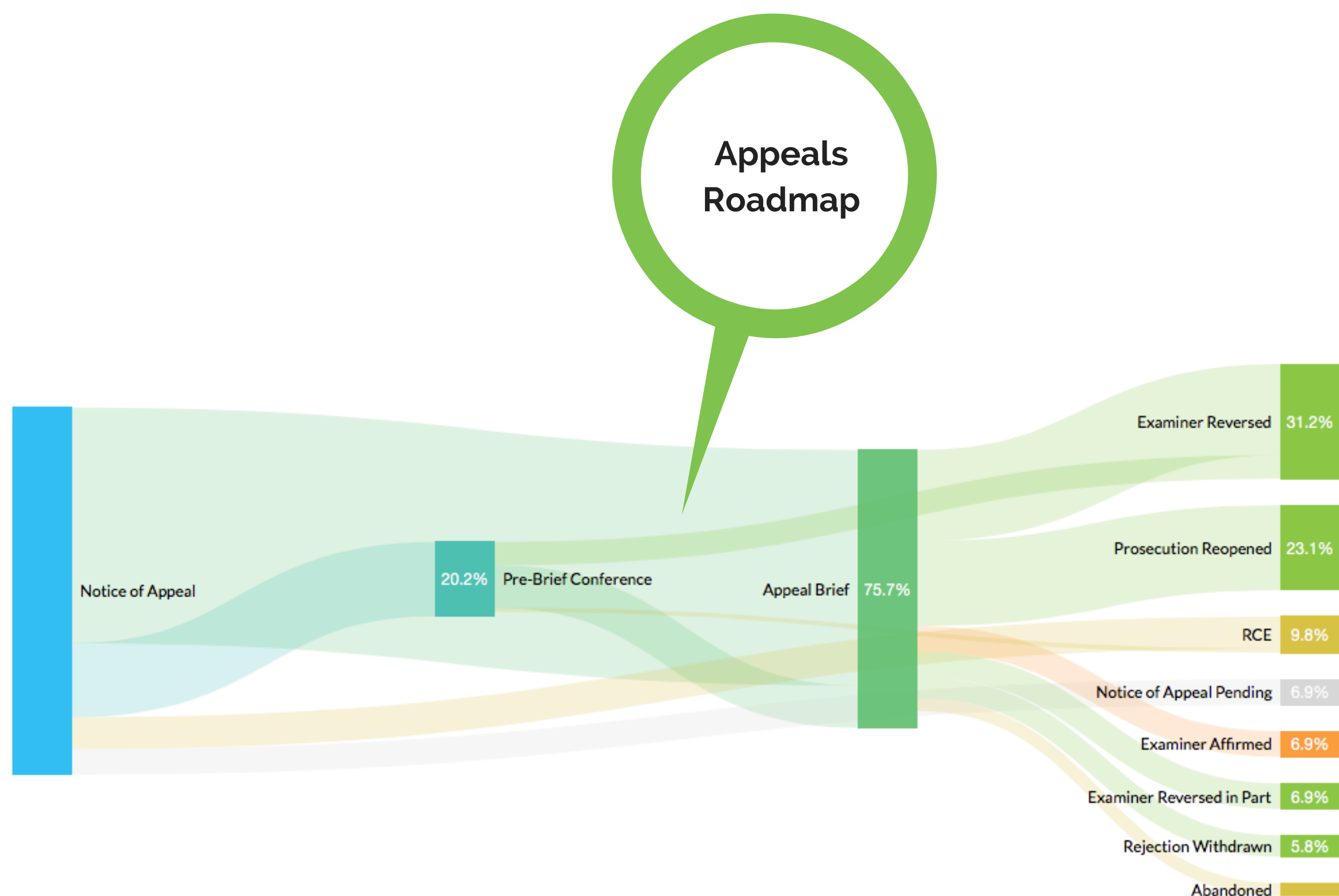
# Strategic Planning

Knowing which arguments to make in response to a final rejection is useful, but practitioners also need to know what to expect after that so that they can start planning their next move. That's why every Examiner Report includes a flow graph showing the outcomes from every decision previous applicants have made, as well as a flow graph showing the outcomes of every appeal of an examiner's final rejections.



The detailed outcomes flow graph displays the rates at which significant actions and outcomes occur at each stage of patent prosecution before every examiner. Each segment corresponds to a particular action and what happened next. For example, the innermost segment shows that the first action on the vast majority of applications before this examiner receive a non-final rejection.

Moving outward, we can trace the outcomes of every response to that first non-final rejection through an amendment, a final rejection, an RCE, and on and on until every application is either allowed or abandoned.



The appeals roadmap graph shows users the lifecycle of appeals from their examiner from the notice of appeal stage all the way to a final outcome. It is meant to be read from left to right. For example, here, 26.6% of appeals are resolved at the pre-brief conference and 78.1% go on to the appeal brief stage. Of those that made it past the appeal brief stage, the examiner was reversed in 34.4% of cases and affirmed in only 7.8% of cases. This flow graph gives users a roadmap of how their appeal is likely to play out even before they file their first brief.

If all of this seems overwhelming, don't worry. We know jumping into the world of big data with both feet can be a daunting prospect, especially in an industry like law where its use is still in its infancy. That's why we designed Juristat Examiner Reports to be the simplest, most user-friendly legal data analytics tool on the market. Everything users need to know about their examiners is right in front of them on a single clean, easy-to-read page--no hidden tabs, no back buttons, no endless drop-down menus.

We're so committed to our user experience that we've even added the ability to chat live with members of the Juristat Team as a standard feature for all users, right from within each Examiner Report (of course).

With Juristat Examiner Reports, patent prosecutors now have more information available to them than ever before. Using the power of big data, practitioners can now predict how many office actions they will receive, what the best response to those office actions is, how much claim scope they are likely to retain, and more. For additional information about Juristat Examiner Reports, please contact one of our sales representatives for a private demo or sign up for a free trial today.

