



# TRANSPARENT, PREDICTABLE, AND PROSPEROUS



PATENT PROSECUTION IN THE AGE OF BIG DATA







## INTRODUCTION

Patent prosecutors are being pushed to be more efficient and more effective with rapidly shrinking budgets. One key way prosecutors are finding to improve margins while continuing to deliver quality work product to their clients is by utilizing patent analytics in their practice. Many are turning to Juristat for this very reason, and they are already seeing the results.

We studied our customers' prosecution outcomes and found that, when they utilized Juristat's analytics, they achieved 16% higher allowance rates, 24% higher appeal win rates, and they lost fewer claims between publication and allowance. In total, we studied all patent applications filed by our customers since they began using Juristat's analytics. We then separated the applications into two groups. The first consisted of applications for which customers purchased and utilized a Juristat Examiner Report or other analytic. The second group consisted of applications prosecuted at the same time by the same firms, but where the customer did not use a Juristat analytic.

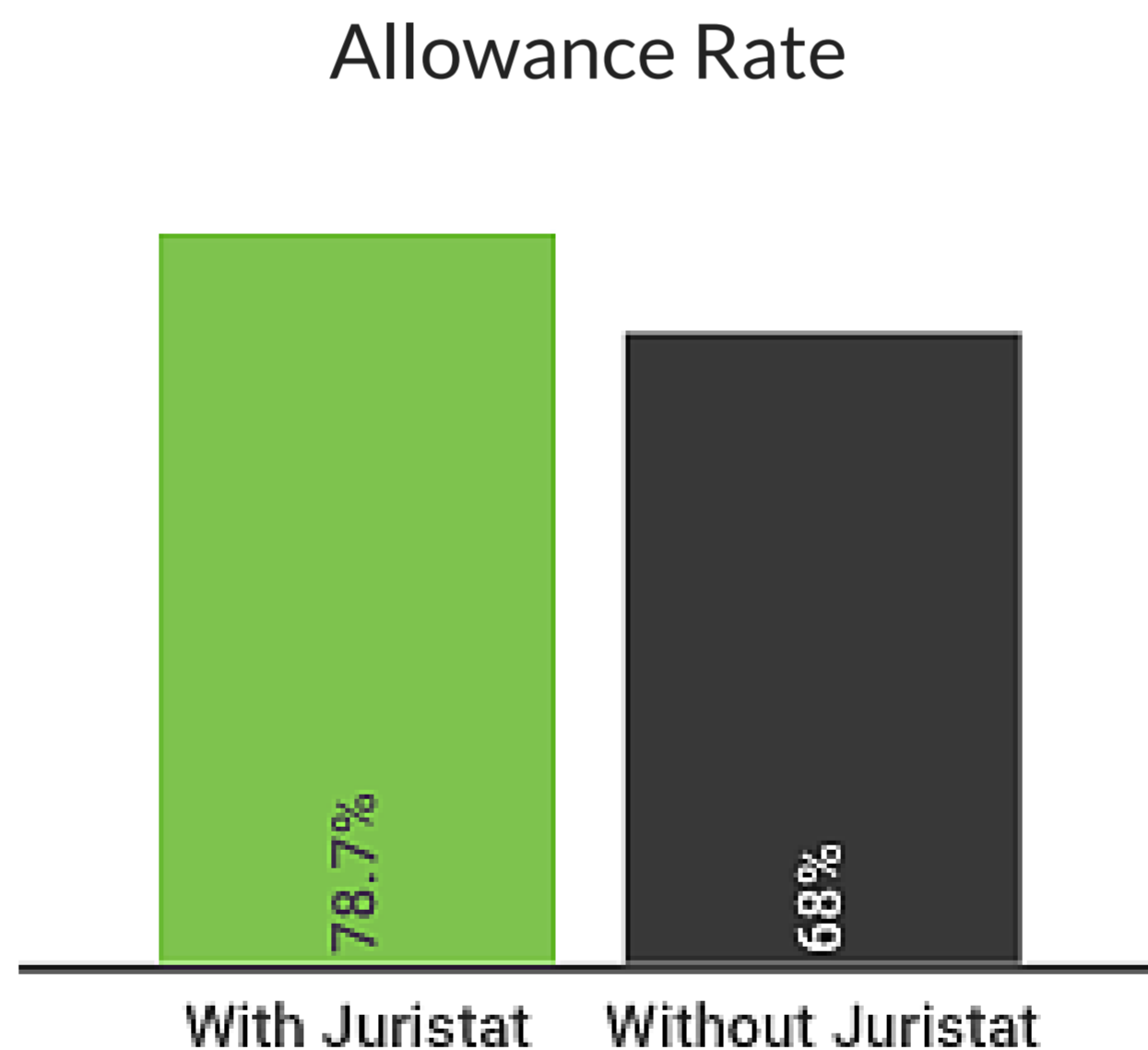
Ultimately, Juristat's analytics improved almost every aspect of our customers' practices. Below we provide a detailed analysis of each of our findings and the methodologies behind our calculations.



## EFFECT ON ALLOWANCE RATE

Successfully obtaining a patent is an applicant's top priority. It's how clients are most likely to measure a patent practitioner's skill and a law firm's reputation. As such, practitioners are understandably eager to maximize their allowance rates. Juristat's analytics help practitioners achieve this goal by providing a detailed history of their examiners' past behaviors, such as the examiners' allowance rates, the probable number of office actions to expect, the rejection bases to expect, and the most advantageous path to overcoming a rejection.

To determine whether Juristat's analytics had any effect on practitioner allowance rates, we divided the number of allowed applications by the total number of disposed applications. We defined allowed applications as an application that at any time received a notice of allowance, even if it was later abandoned. Disposed applications are defined as applications that have either been allowed or abandoned.



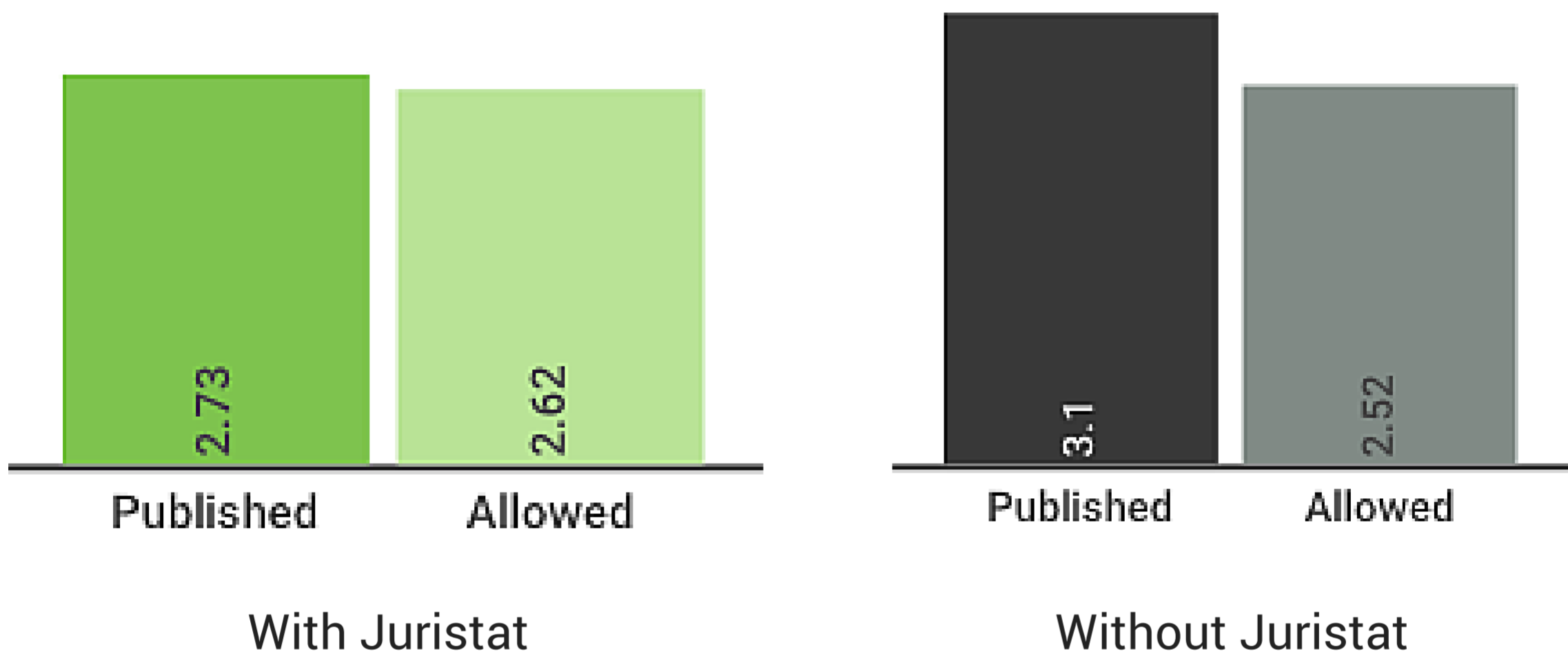
We then compared the allowance rates for the two groups in our data set. Our analysis showed that applications where the practitioner used a Juristat Examiner Report or analytic were allowed 78.7% of the time, while those that did not use Juristat were allowed 68% of the time. In other words, the Juristat applications were allowed almost 16% more frequently than the non-Juristat applications. The significance of the difference between the two groups is apparent – a higher allowance rate can translate to greater client satisfaction and increase the likelihood of repeat representation.



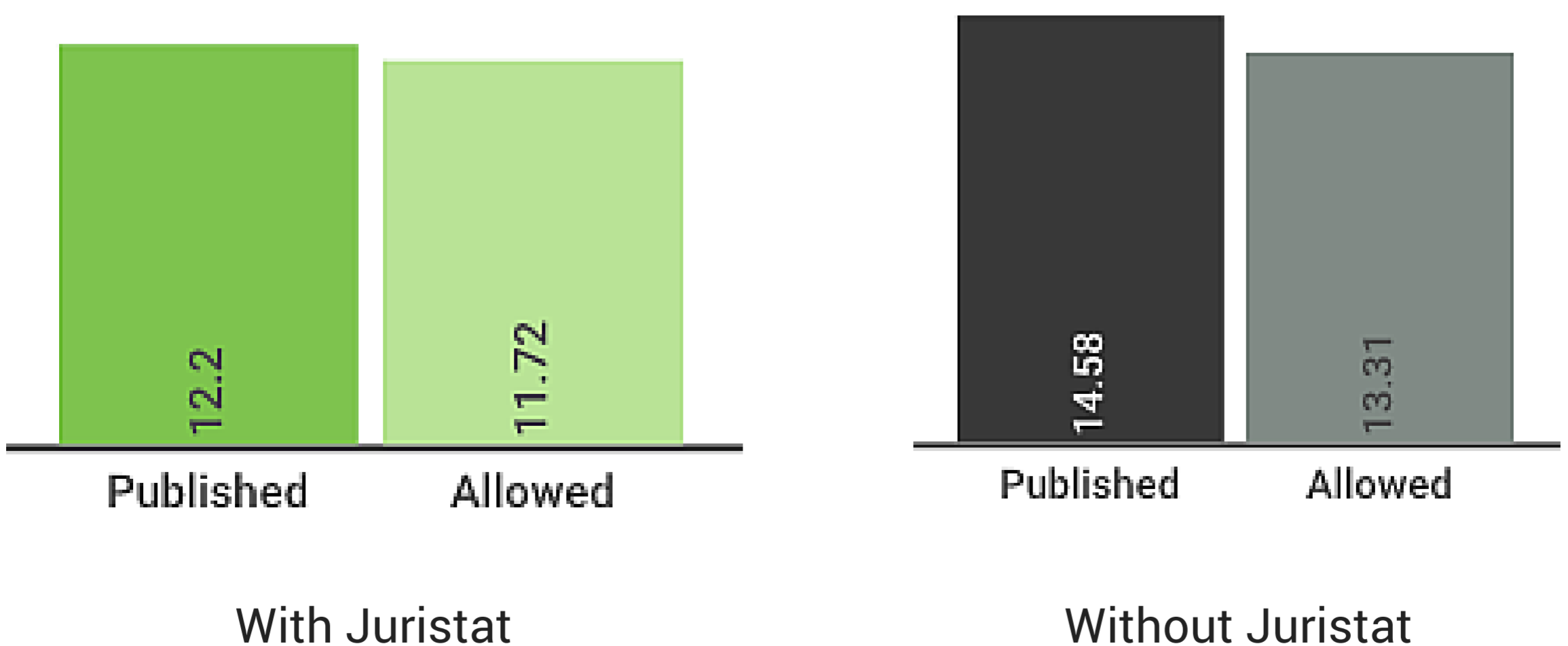
## EFFECT ON CLAIMS

The number of claims in a patent is generally a good indicator of the strength and scope of that patent. Consequently, patent practitioners strive to preserve as many claims as possible throughout the examination process. To determine whether Juristat had a noticeable effect on the number of claims that survived examination, we compared the number of independent and dependent claims present at each application's publishing date to the number remaining at allowance and then averaged the results.

### Independent Claims



### Dependent Claims





Of those applications where the practitioner used a Juristat, nearly 96% of independent claims survived examination. For those where the practitioner did not use Juristat, only about 81% of independent claims survived – nearly 16% less than the Juristat applications. Juristat applications also retained more dependent claims. Applications retained approximately 96% percent of dependent claims when the practitioner used Juristat and approximately 91% of dependent claims when the practitioner did not. While the average total number of claims was higher for the non-Juristat applications in our data set, the claim survival rate was higher for the Juristat applications. This indicates that practitioners who use Juristat's analytics are better able to preserve their claims, regardless of the number of claims sought.

## EFFECT ON APPEAL WIN RATES

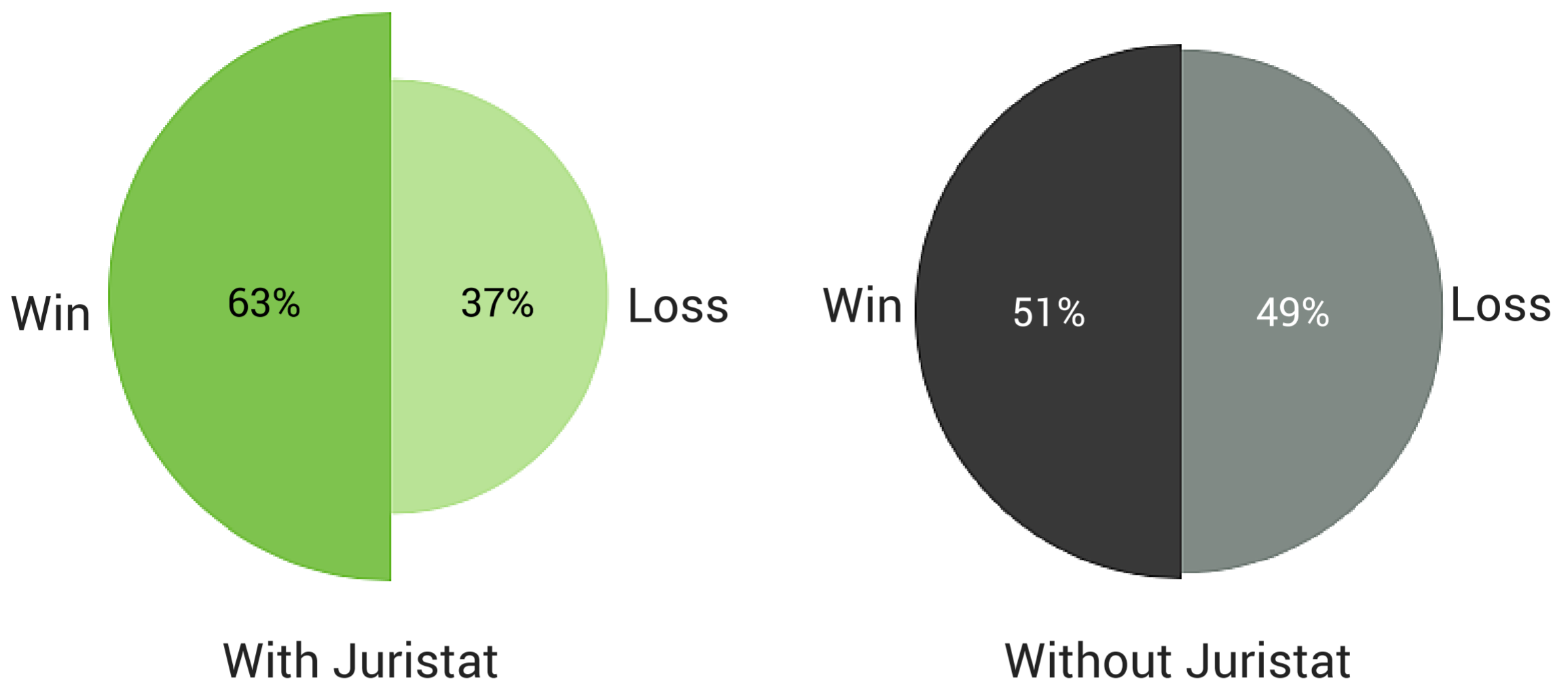
When deciding how best to handle a rejection, practitioners want to be certain that they are choosing the most effective response. Practitioners tend to choose appeals when they are confident in the quality of their claims and want to let their examiner know that they are serious about preserving them. Because appeals often consume more time and resources than other strategies, practitioners also want to ensure that filing an appeal will be the most advantageous option for their clients.

To determine whether Juristat improved win rates on appeal, we examined the outcomes of appeals for every application in our data sets in which an appeal brief had been filed in its prosecution history. We considered an appeal a win where: 1) the examiner was reversed in-whole by a final PTAB decision, 2) the examiner was reversed in-part by a final PTAB decision, 3) the examiner reopened prosecution by filing a rejection on different grounds, or 4) the examiner withdrew the rejection and granted an allowance. We considered appeal losses to be appeals in which: 1) the examiner was affirmed by a final PTAB decision, 2) the examiner was affirmed on new grounds by a final PTAB decision, or 3) the appeal was dismissed. We then divided the appeal wins by the total number of appeal dispositions (wins and losses) to calculate the appeal win rate.





## Appeal Win Rates



We discovered that applications where the practitioner used Juristat saw an almost 24% higher win rate on appeal than applications where the practitioner did not use Juristat. Our analysis indicates that this increase may be due to the fact that practitioners who used Juristat's analytics were able to more accurately determine when an appeal was statistically the most advantageous strategy to overcome their rejections. This resulted in a higher appeal win rate, with claims being allowed through appeal that may have otherwise been abandoned after unsuccessful RCEs or interviews.

## EFFECT ON NUMBER OF OFFICE ACTIONS

Beyond their chances of obtaining a patent, practitioners and their clients also want to know the number of office actions they can expect for a given application because each office action adds complexity and cost to the prosecution. Accordingly, we examined whether the use of Juristat's analytics had any effect on the average number of office actions that practitioners underwent to obtain a patent. We measured this by counting the number of office actions in the prosecution histories of the applications in our data set and then averaging the results. We defined office actions as non-final rejections, final rejections, restriction requirements, and ex-parte Quayle actions.



The average number of office actions for the Juristat applications was 3.68, while the average number for the non-Juristat applications was 3.71. Thus, applications where the practitioner used Juristat saw a slight, but not statistically significant, reduction in the number of office actions. Though patent analytics may not substantially affect the number of office actions, they can enable practitioners to more effectively manage their clients' expectations as to the potential complexity and cost involved in prosecuting their applications.

## EFFECT ON TIME TO ALLOWANCE

Clients also want to know how long it will take to obtain their patent. Depending on the art unit, prosecution can last on average anywhere from 10.7 months to 78.9 months, with an overall average of 24.3 months. Practitioners who have access to patent analytics are able to tailor their strategies to take advantage of their examiners' biases and avoid investing time into statistically ineffective strategies.

To determine whether Juristat had any effect on the speed at which practitioners obtained allowances, we measured how much time (in months) elapsed between the date the applications were filed and the date they received a notice of allowance. For applications in our data set where the practitioner used Juristat, the average time to allowance was 37.3 months, while those where the practitioner did not use Juristat had an average time of 44.9 months. Thus, the Juristat applications were allowed about 7.6 months faster than the non-Juristat applications.

Even in the slow-moving world of patent prosecution, 7.6 months is not an insignificant amount of time. Shortened prosecution timelines may even allow practitioners to increase the volume of their prosecution practice.



## CONCLUSION

Our study revealed that practitioners who use Juristat's patent analytics in their practice obtain patents at a higher rate, in a shorter amount of time, and preserve more of their claims than those who do not. This indicates that Juristat gives practitioners actionable insight into the behavior of their examiners and reduces the incidences of taking shots in the dark. Practitioners who used Juristat's patent analytics enjoyed a more streamlined prosecution practice, enabling them to represent innovators and assignees with greater precision and confidence. Our goal is to make the patent system transparent, predictable, and prosperous so that innovators can focus on doing what they do best –innovating. For the patent professionals who represent them, this is easier to achieve when they use patent analytics to help predict the behavior of their examiners.