



How an In-House Attorney Makes Informed Decisions Using LexisNexis PatentAdvisor®

With patent prosecution analytics at his fingertips, Ben Hoopes can make the best use of his time and his company's resources.

At a glance

Customer

Fortune 100 Global Technology Company

Requirements

- Balance legal risks and business objectives
- Build a patent portfolio to enforce patents against competitors
- Bring predictability to the patent prosecution process
- Align overall patent prosecution budget with business objectives
- Plan prosecution process more strategically
- Benchmark the performance of law firms to manage outside counsel resources

Solution

With PatentAdvisor™, this global technology company more efficiently reaches final disposition for their patents, and is able to be more strategic when hiring outside counsel.



"We are looking at the technological landscape and building a patent portfolio with a view to being able to enforce patents—offensively or defensively—against competitors."

Ben Hoopes, Senior Patent Counsel

Fortune 100 Global Technology Company

Operating in more than 170 countries and serving its customers for more than 80 years, the technology company that is Ben Hoopes' employer treats intellectual property protection as a key strategic function. Hoopes is part of a large team helping manage the tens of thousands of patents and patent applications that the company uses to defend its position in the market for a wide array of products. These range from medical products and devices to point-of-sale devices, personal systems—such as desktop computers, workstations and laptops—and printers and 3D printing and digital manufacturing equipment.

An aspiring engineer finds his calling with patent law

Like many young men of his generation, what led Ben Hoopes to a bachelor's degree in electrical engineering was the dream of going into space as an astronaut. But things didn't work out that way. "I sprouted to six foot three and my eyes were bad, so I was automatically out for the space program," he recalls. "But I thought that if I couldn't fly a spaceship, at least I could design and build them. So, my initial path was towards aerospace engineering."

At university, this did not feel like quite the right fit for Hoopes, so he decided to move into electrical and computer engineering. However, growing up, as he watched friends and family in engineering lose their jobs at companies in his home of Boise, Idaho, he had reservations about the stability of a career in engineering.

As an undergraduate, he was contemplating going to business school until an engineering professor told him about the possibility of a career as a patent lawyer. "I'd never heard of patent law," he says. "But the more I looked into it, the more interesting it sounded." When some students from the university's law school gave a presentation on patent law to the engineering students, his mind was made up.

After gaining his legal qualifications and working in private practice at a boutique IP firm, Hoopes was drawn to the corporate world. "When you're a private attorney, you tend to advise your clients to avoid risk in all forms," he explains. "For me, what was of interest was that in-house attorneys are tasked with balancing legal risks and business objectives. That was a big change."

Navigating unpredictability

While Hoopes clearly loves his job, there are frustrations. First, he and his colleagues are not able to control the patent prosecution process or which examiner gets assigned to which cases. “We submit our patent applications and they sit in a queue for often a number of years before getting assigned to an officer,” he says. “And there is a significant amount of variability in the way patents are examined. That’s a little frustrating.”

A few years ago, as patent attorneys started thinking about how to navigate this uncertainty, open source databases of patent officers began to emerge. “We’re engineers so we like finding solutions to problems,” says Hoopes. “But those publicly available examiner trend databases would burn bright and not for very long. When solutions such as Examiner Ninja fell by the wayside and stopped working, we’d end up being forced either to rely on our familiarity with patent examiners to plot examination trajectory or to use a more rigid one-size-fits-all approach to prosecution.”

Second, beyond the frustration of uncertainty, in-house patent attorneys also have to consider their overall budget for patent prosecution and balance that with business objectives.

PatentAdvisor has helped Hoopes and his colleagues with both challenges. First, the tool injects far more predictability into the overall management of the patent portfolio for the company. Second, being able to understand early on that, for example, a case has been assigned to a challenging examiner enables informed decisions to be made on how to prosecute that case—decisions that also help control costs.

“We need to wrap our heads quickly around what the trajectory is going to be for the examination of a particular asset and how that will fit into our objectives and budget.”

Ben Hoopes, Senior Patent Counsel

For example, PatentAdvisor offers insights into the number of requests for continued examination, or RCEs, that particular examiners tend to require before allowing a case—something that is important for a company like the one Hoopes works for, which aims to minimize the number of RCEs permitted in a typical examination cycle.

Not only is there a direct cost to be managed (in terms of fees charged by the USPTO after the first RCE), but in a system where securing a patent is a long process, there is also a need to keep the time needed for the case to be allowed to a minimum.

“If an examiner requires on average three RCEs before allowing a case and our own internal objective is to file at most a single RCE in an application, then we need to find a way to quickly get to a resolution, which may be an early appeal,” he explains.

Patent attorneys also want to understand the relative likelihood that an examiner will reject an application on the basis of prior art (evidence that an invention is already known) or patentability (based on subject matter eligibility, validity, and industrial applicability of an invention).

Can PatentAdvisor help with this? “Quite a lot,” says Hoopes. “For every examiner, PatentAdvisor tells us the frequency at which they have these different grounds for rejection at the different phases,” he says. “That’s very useful.”

Joining users on the journey

While his company has only been using PatentAdvisor for a year, Hoopes is no stranger to the tool. As a newly minted attorney, he attended an early presentation of PatentAdvisor. “At the time it was difficult for patent attorneys to see the potential utility of something like PatentAdvisor. It was still very new.”

Now, he says, he is constantly impressed to see the features being added to the tool and the improvement in functionality. “It’s definitely evolved,” he says.

He cites one feature recently added that enables attorneys to see the issue-specific PTAB appeal records for different examiners, giving additional insight with which to plan patent prosecution more strategically.

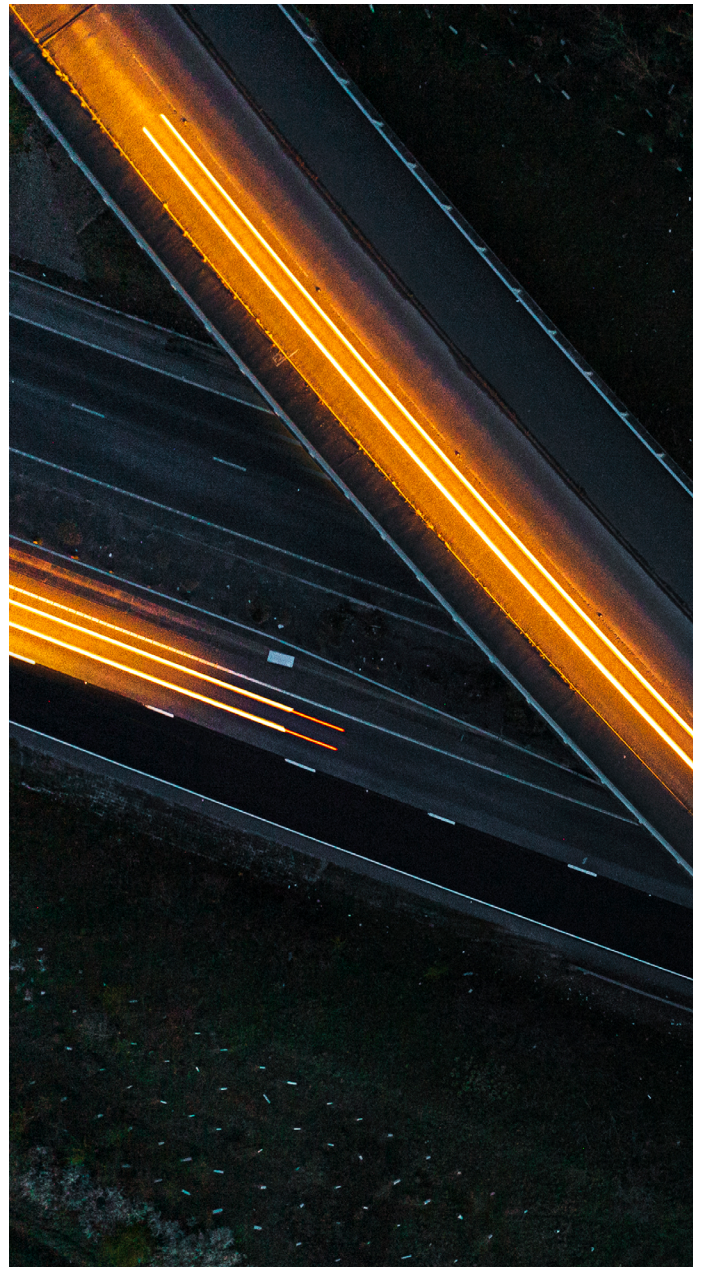
In addition, he says, the tool now allows users to benchmark companies, law firms and attorneys against each other based on the data that can be gleaned from PatentAdvisor Benchmarking Reports.

This makes it possible to assess how different law firms are performing when measured against a similar set of examiners. "If one law firm is more efficient at getting to allowance within the same bucket of patent examiners than another firm, that's a very interesting data point," he says. "And we can see if some law firms are better suited for different technology areas than others."

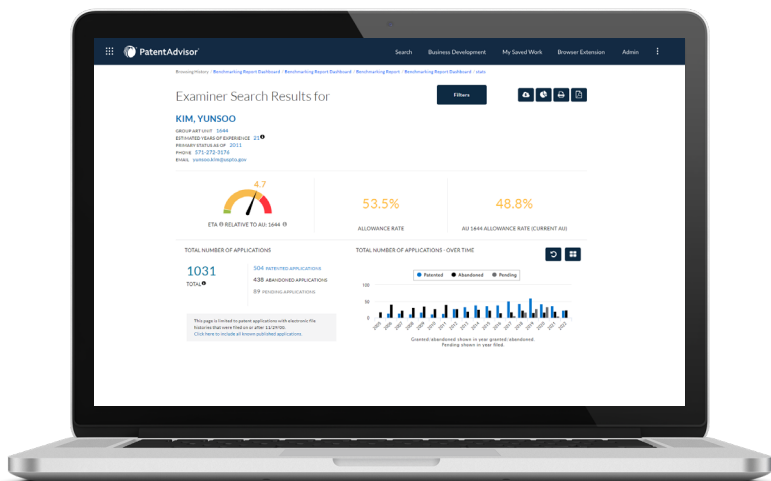
Hoopes sees data as becoming the norm in his industry. "We see more and more corporations and law firms turning to data to help make their practice more efficient," he says. "So, moving forward, I believe use of a tool like PatentAdvisor will only increase."

"PatentAdvisor allows us to be more efficient in quickly getting to a final disposition for our cases. And it allows us to be more strategic in allocation of our own time and outside counsel resources."

Ben Hoopes, Senior Patent Counsel



Bring Predictability and Productivity to Your Patent Prosecution Process



Anticipate an examiner's behavior for better prosecution outcomes

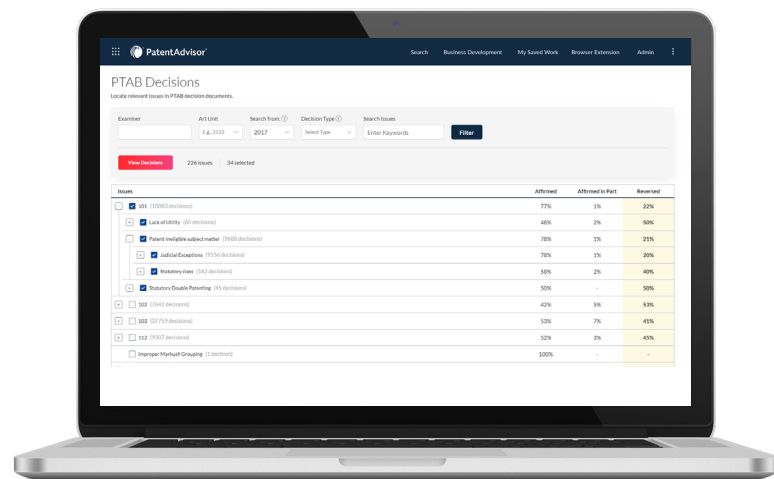
PatentAdvisor Examiner Time Allocation (PatentAdvisor ETA™) is a more reliable predictor of examiner's behavior than allowance rate because it:

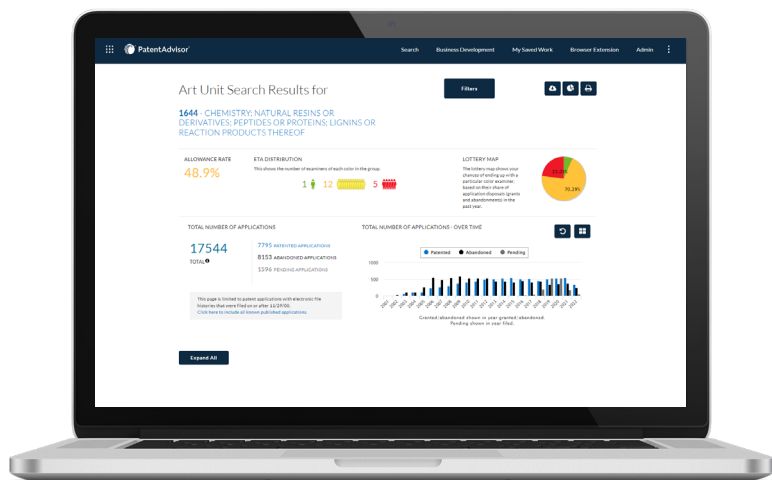
- Includes all pending applications
- Factors in how long the examiner has been at the patent office
- Is driven by the examiner's behaviors, not by the filer's actions

Save your valuable time—Get reliable data right where you work

Get relevant and useful examiner analytics directly in your USPTO Patent Center and Private PAIR search results by using the PatentAdvisor Extension, including:

- PatentAdvisor ETA™
- Allowance rate
- Average office actions to allowance
- Art unit allowance rate
- Art unit's average office actions to allowance





Predict the likelihood of winning the examiner lottery and identify high-risk cases

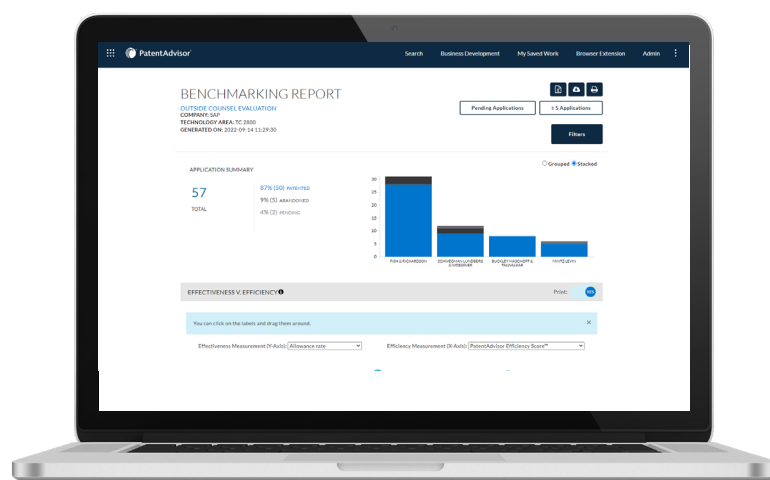
Tailor your patent application to target the most favorable tech center group, and predict the likelihood of being assigned to a specific type of examiner with the LexisNexis PatentAdvisor® Examiner Lottery Framework™.

- Identify target tech center groups with a higher chance for a favorable examiner using Tech Center Navigator within LexisNexis PatentAdvisor®.
- Infer the current makeup of patent examiners (most to least favorable) in an art unit with the ETA Distribution.
- Identify the probability of being assigned to a specific type of examiner using the Lottery Map feature.
- Predict the type and quantities of rejections and the likelihood of a grant based on statistical models in QuickPAIR.

Benchmark and manage outside counsel performance

Quickly create insightful data-backed reports on prosecution performance with the PatentAdvisor Benchmarking Reports feature. Create reports that:

- Compare and benchmark your prosecution performance against that of your competition or an outside counsel.
- Are based on objective prosecution performance metrics as opposed to examiner efficiency.
- Justify external legal spending to stakeholders.
- Take examiner difficulty out of the equation and score purely for prosecution efficiency based on the proprietary PatentAdvisor Efficiency Score.



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