

Patent Prosecution: Driving Alignment Between In-house Counsel and Law Firm



Today's Speakers



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*Fortune 100 Global Technology
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Technology and IP Attorney
Founders Legal



Amit Alagh

Senior Product Marketing
Manager
*LexisNexis Intellectual
Property Solutions*

Today's Discussion

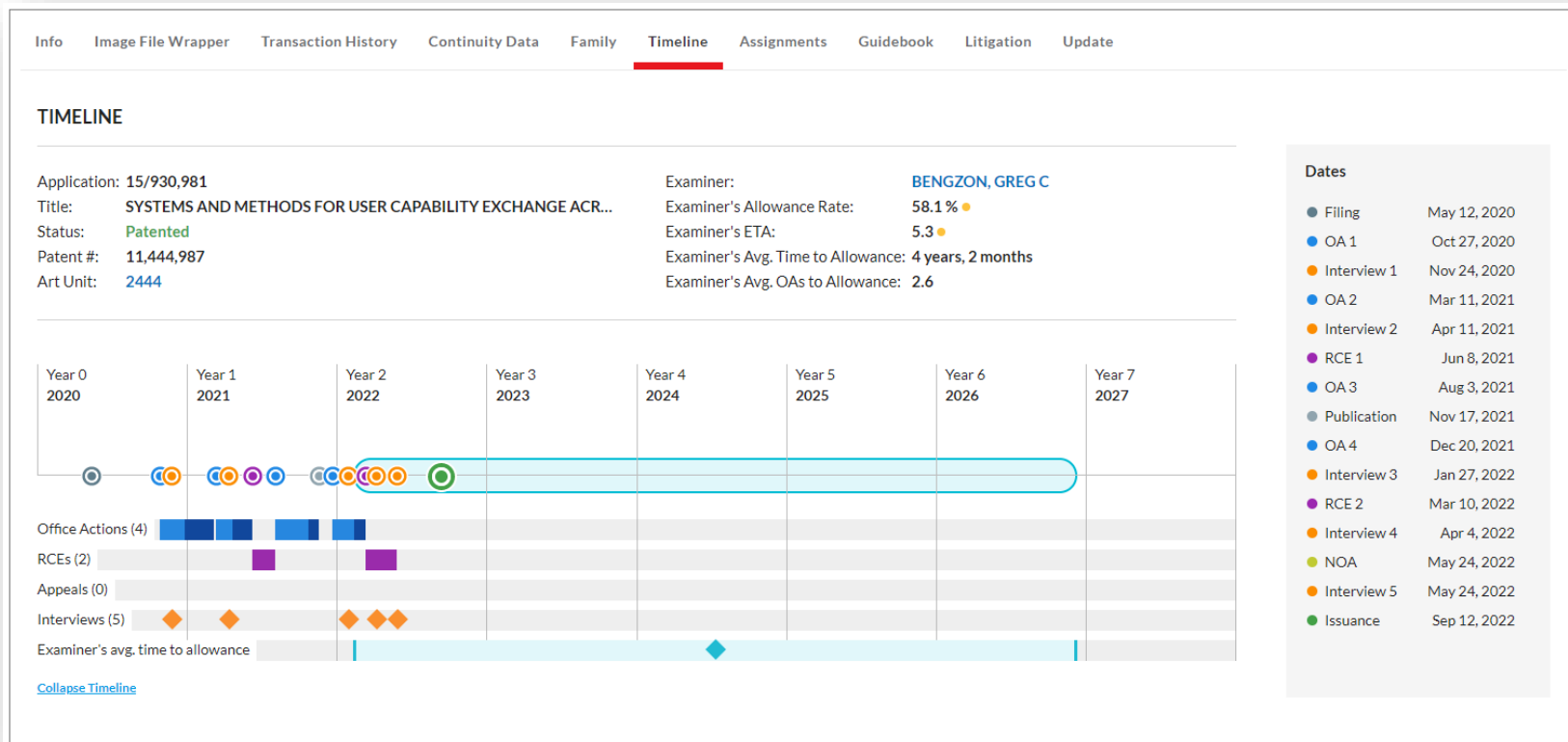
- Keys to establishing a good relationship between in-house and outside counsel.
- What makes a good pitch?
- How PatentAdvisor™ can facilitate the attorney/client relationship.

Establishing a Good Relationship: Table Stakes

- Communication
- Timeliness
- Subject matter capability
- Being proactive
- Proofreading

Being Proactive

Graphic representation of the procedural posture of a case



Being Proactive

Developing the next strategic move

HENRY, RODNEY M

GROUP ART UNITS: 3622, 3644, 3681, 3682

ESTIMATED YEARS OF EXPERIENCE 15

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ETA [Ⓢ] RELATIVE TO AU: 3644 [Ⓢ]

6.8%

ALLOWANCE RATE

74%

AU 3644 ALLOWANCE RATE (CURRENT AU)

CHANCES OF WINNING ON APPEAL:

59.6%

Total applicant wins

28

Total applicant losses

19

Establishing a Good Relationship: Table Stakes

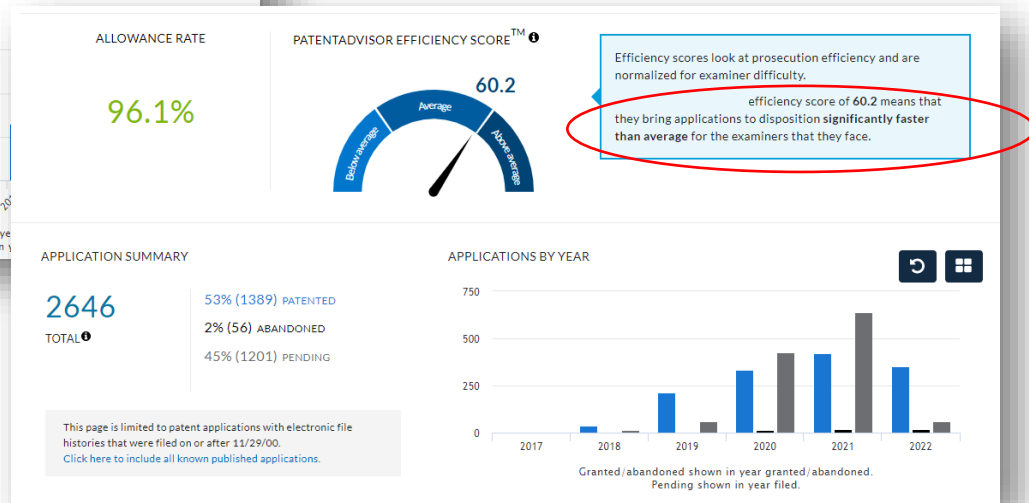
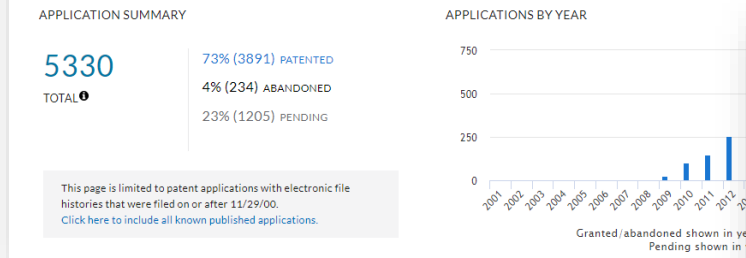
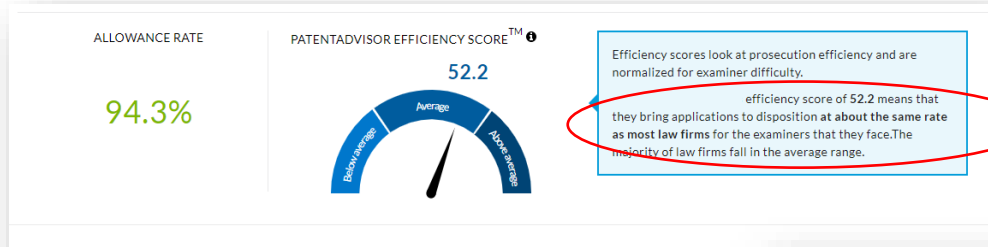
- Communication
- Timeliness
- Subject matter capability
- Being proactive
- Proofreading

Establishing a Good Relationship: Extra Credit

- Efficiency: getting to “yes” quickly
- Becoming a strategic partner, not a transactional attorney

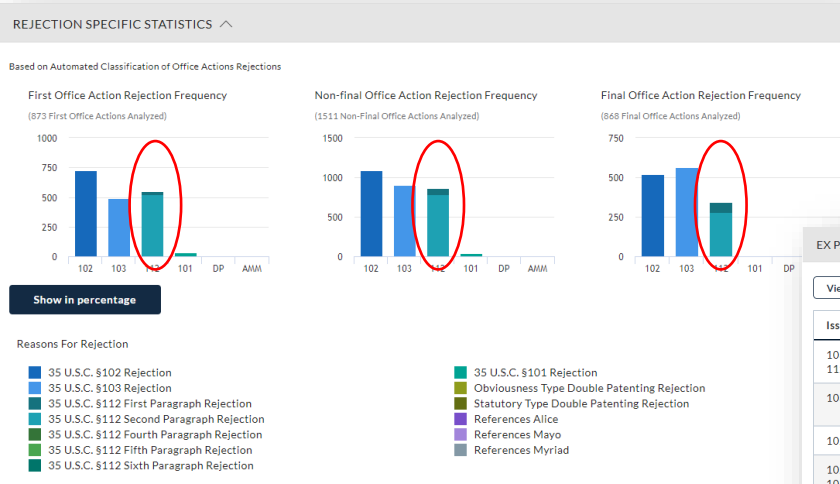
Getting to a “yes” Quickly

Data can help improve efficiency



Getting to a “yes” Quickly

Data can help identify examiner quirks



EX PARTE PTAB CASES ^

View & Filter in PTAB Decisions

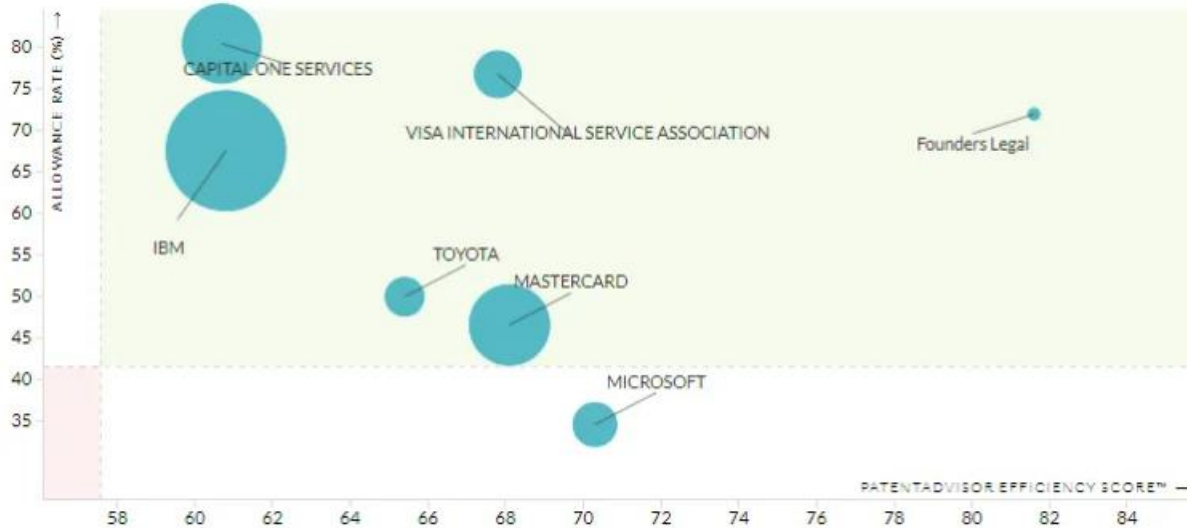
Issues	Case name	Application number	Outcomes	Decision date ↑↓
103 112(b)	Ex parte Brian Robert Elkinson	10/980,583	Examiner Reversed Examiner Reversed	12/01/2016
103	Ex parte Charles Raymond Brewer III	12/468,973	Affirmed	03/04/2015
102	Ex parte Mark S. Hancock	12/144,893	Affirmed	02/24/2015
102 103	Ex parte Mehmet Oktay Kaya and Edward James Limbert	11/825,856	Affirmed Affirmed	10/26/2012
103	Ex parte Steven B. Elgee and Steve O. Rasmussen	11/021,650	Examiner Reversed	09/19/2011
103 112(b)	Ex parte Barry P. Mandel	11/411,651	Affirmed Affirmed	11/07/2011
102	Ex parte Cherng Linn Teo and Dennis Chua	10/808,224	Not available	04/01/2010
103 112(b)	Ex parte John P. Panunto and Van Ho Robin Ho	10/660,533	Not available Not available	08/03/2010
103 112(b)	Ex parte Mituru Takahashi and Tomotaka Osada	10/895,065	Examiner Reversed Affirmed	12/01/2009
103	Ex parte Jeffrey D. Hall	10/454,262	Not available	04/02/2009

1 2 Rows per page: 10

The counsel didn't address this rejection; it was affirmed.

Getting to a “yes” Quickly

Using data to prove efficiency



- TC Groups 3620, 3680, and 3690
- Filed in the last 5 years

Establishing a Good Relationship: Extra Credit

- Becoming a strategic partner, not a transactional attorney

13/837,486 | 111647-3: Magnetic Headband

Public view

Application #	Attorney Docket #	Patent #	Status
13/837,486	111647-3	8,919,354 Issued - 12/30/2014	Patented Case - 12/10/2014

Examiner
[RACHEL RUNNING STEITZ](#)

[Application Report](#)

Allowance Rate 51.8%	Average Office Actions To Allowance 2	Examiner Time Allocation (ETA) ⓘ <i>(as compared to Art Unit 3772)</i> 3.8 2.3 22
View This Examiner's File Wrappers Interview Stats Appeal Stats		

Art Unit
[3776](#)

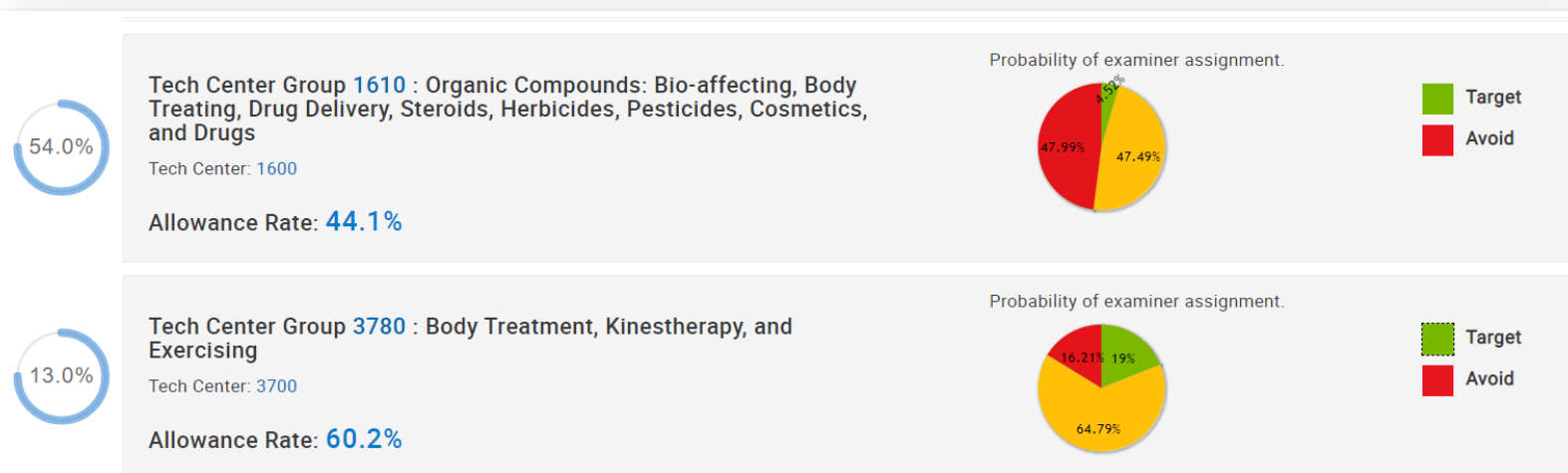
Allowance Rate 48.7%	Average Office Actions To Allowance 2.1
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What makes a good pitch?

- Demonstrate understanding of technology, portfolio, and business
- Demonstrate recognition of in-house struggles
- Demonstrate a desire to be a strategic partner

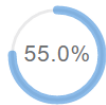
Offering Unique Services

1. A system comprising:
an **orthopedic hardware component** attachable to a portion of a body; and
a **sustained release device** associated with the orthopedic hardware component, the sustained release device configured to **release a compound having a therapeutic effect** over an extended period of time.



Offering Unique Services

1. A system method of treating a patient, comprising:
Implanting an orthopedic hardware component attachable to a portion of a body; and
Dispensing medication to the patient via a sustained release device associated with the orthopedic hardware component, ~~the sustained release device configured to release a compound having a therapeutic effect over an~~ extended period of time.

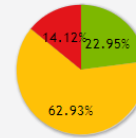


Tech Center Group **3770** : Medical & Surgical Instruments, Treatment Devices, Surgery and Surgical Supplies

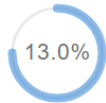
Tech Center: 3700

Allowance Rate: **66.8%**

Probability of examiner assignment.



Target
Avoid

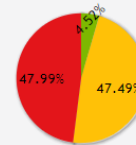


Tech Center Group **1610** : Organic Compounds: Bio-affecting, Body Treating, Drug Delivery, Steroids, Herbicides, Pesticides, Cosmetics, and Drugs

Tech Center: 1600

Allowance Rate: **44.1%**

Probability of examiner assignment.



Target
Avoid

THANK YOU



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