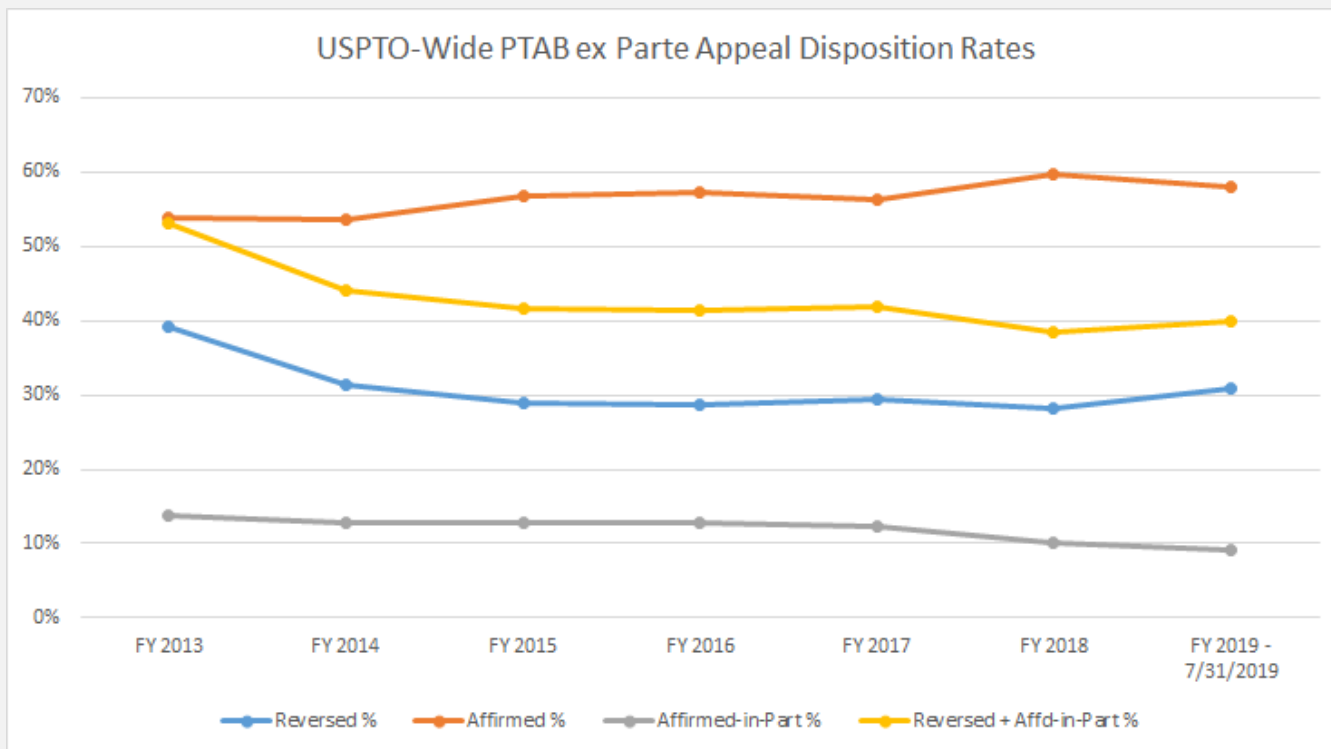


MYTH #1

- Ex parte appeals decisions issued each day cannot show any trends in examination quality for the USPTO.
- False: While ex parte appeals decisions are not random samples, they are representative samples of examination quality. With hundreds of decisions issuing each month from the PTAB, issue level ex parte appeals data is a powerful indicator of examination quality.

FY2013-7/31/19 PTAB EX PARTE APPEAL DISPOSITION RATES



QUESTION

- Is a USPTO-wide affirmance rate at the PTAB of just 3%-8% over 50% acceptable for the examining corps?

MYTH #2

- Patent applicants determine which cases get ex parte appeal Board decisions
- False: The 3 examiners in each appeal conference determine, after reading the full appeal brief, whether an Examiner's Answer will be written. Since the Examiner's Answer cannot contain different arguments from the final rejection, the appeal conferees are the ones who make the final decision on whether they believe the final rejection will hold up at the Board.

QUESTION

- Given the USPTO-wide reversal rate for novelty is currently 64% for at least one at the Board, if the only issue in your case at final rejection is novelty, should you appeal?
- Yes, especially if your examiner's allowance rate right after an interview is less than 55%.

MYTH #3

- All cases in which of notice of appeal is filed result in PTAB ex parte appeals decisions.
- False: For TC 1600, the examiner(s) withdrew 60% of appealed cases from consideration before a decision by the Board was rendered. For the other TCs, the percentages are:
 - TC 1700: 51.4% withdrawn; TC 2100: 48.6% withdrawn; TC 2400: 52.8% withdrawn; TC 2600: 49.9% withdrawn, TC 2800: 61.1% withdrawn; TC 3700: 50.3% withdrawn.

QUESTION

- Given the leading legal reason used by the Board to reverse for novelty over the last 2.5 years is the all-elements rule, if that is the issue in your case, should you appeal?
- Yes, especially if your examiner's allowance rate right after an interview is less than 55%.

MYTH #4

- Because of the time delay between notice of appeal and board decision, ex parte appeals decisions are irrelevant to the patent prosecutor.
- False: for the patent prosecutor, the ex parte appeals decisions issuing today are how the Board is ruling today on the issues of novelty, obviousness, indefiniteness, written description, statutory subject matter, and obviousness type double patenting.

QUESTION

- Given the leading legal reason used by the Board to reverse for obviousness is the failure of the reference combination to teach all the claim elements, if that is the issue in your case, should you appeal?
- Yes, especially if your examiner's allowance rate right after an interview is less than 55%.

MYTH #5

- Because of the time lag between the filing of a notice of appeal and a PTAB decision, ex parte appeals data is irrelevant to the USPTO.
- False: Ex parte appeals are representative (and pre-randomized) data outputs from examination process that provide the likely best end of line monitor for monitoring the quality of Examiner final rejections USPTO-wide.

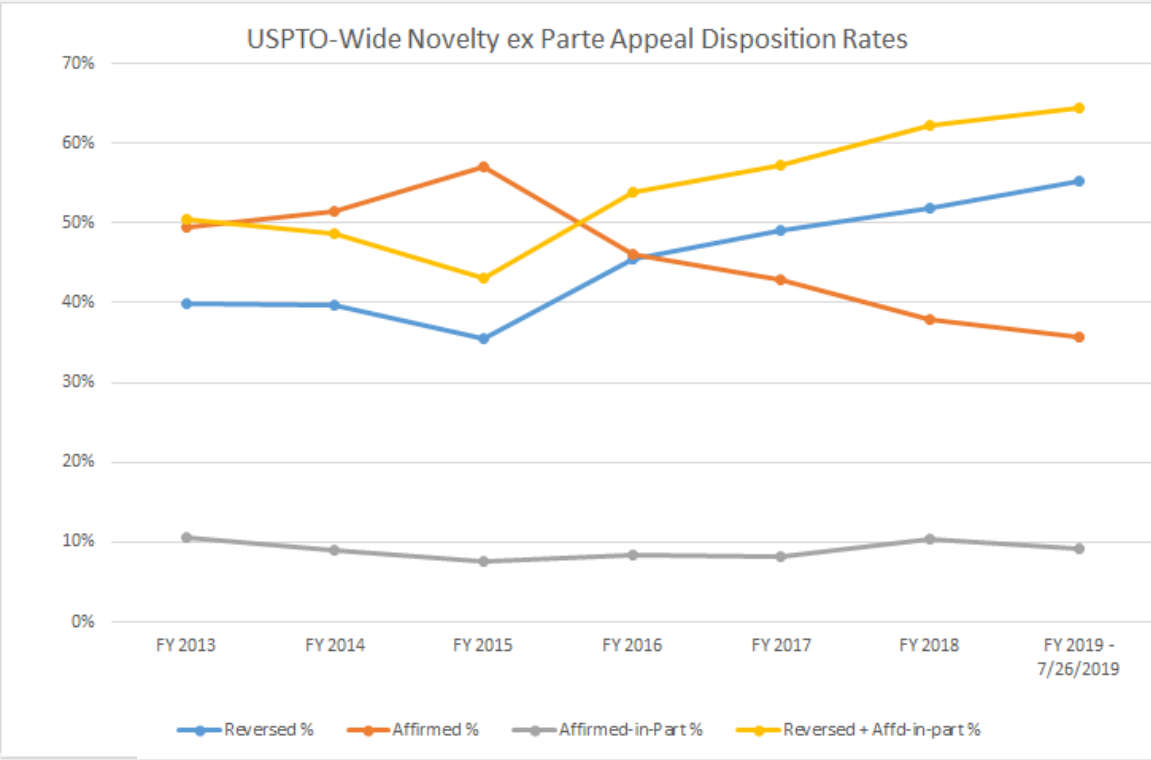
QUESTION

- Given the USPTO-wide reversal rate for section 112 written description is over 62% for at least one claim, if this is the issue in your case, should you appeal?
- Yes, especially if your examiner's allowance rate right after an interview is less than 55%.

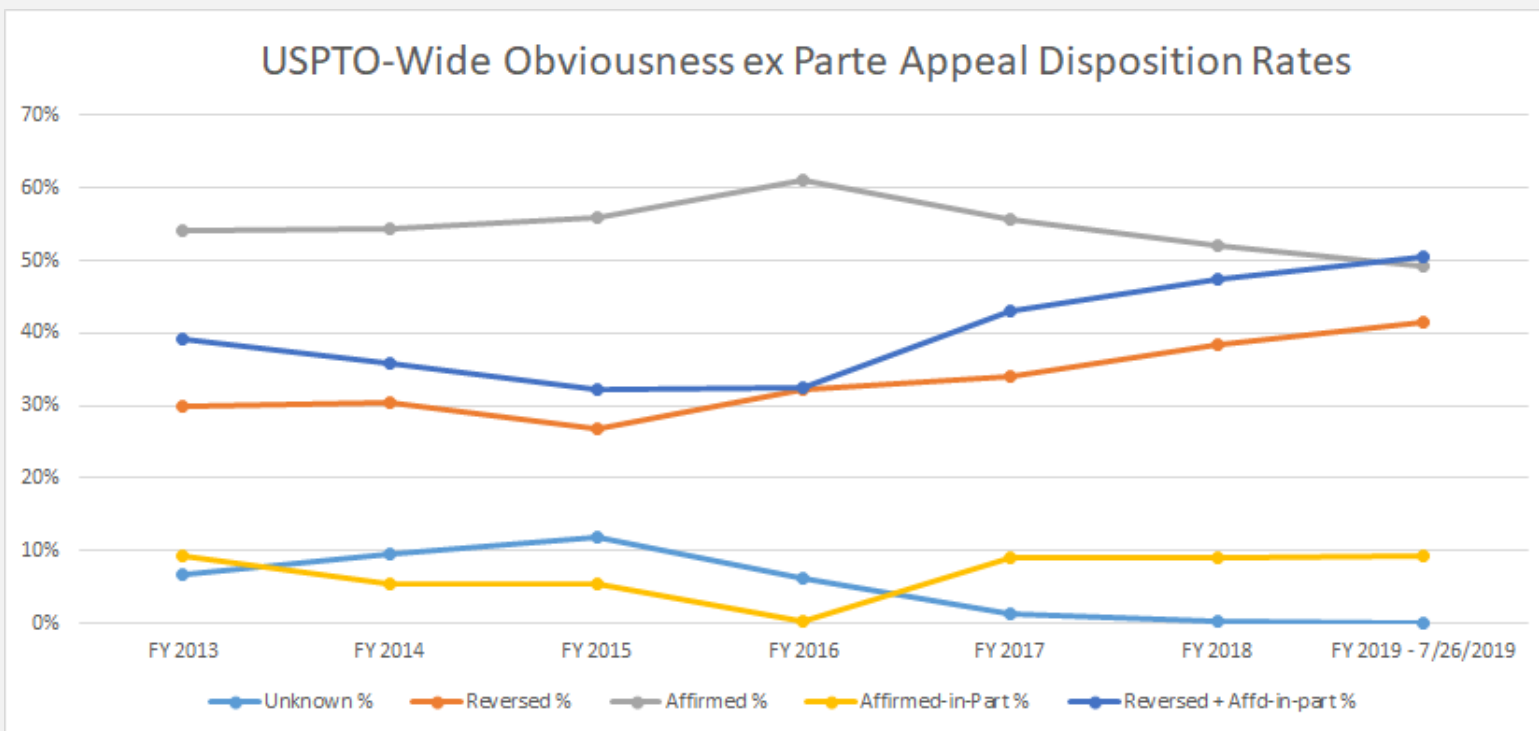
MYTH #6

- The PTABs statistics over the past 7 fiscal years show the case-level affirmance rate by the Board has been basically flat so the issue-level affirmance rates for novelty, obviousness, etc. are also flat.
- False: for all but statutory subject matter and obviousness type double patenting, the issue-level reversal rate for every other issue **has actually risen** over the past 3 to 4 fiscal years.

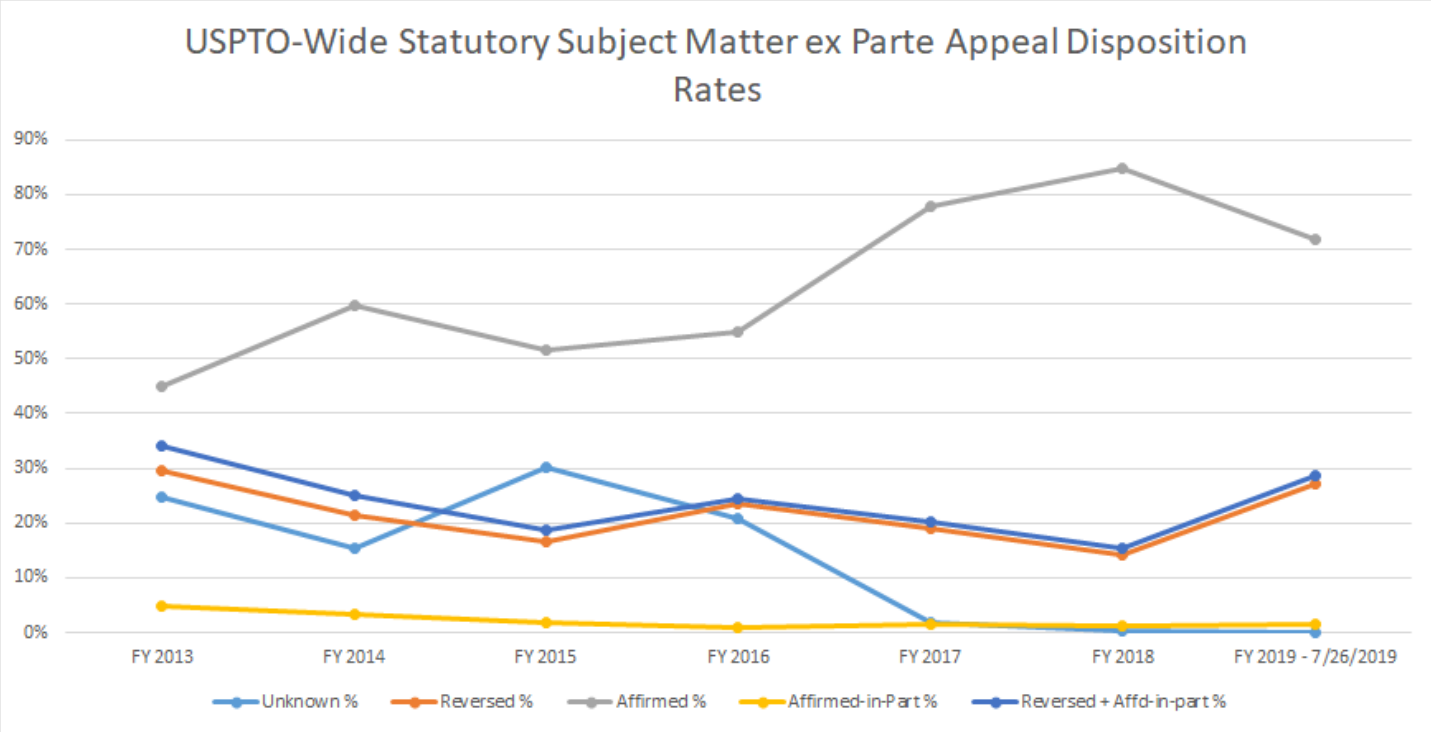
FY2013-7/26/2019 ISSUE-LEVEL NOVELTY DATA



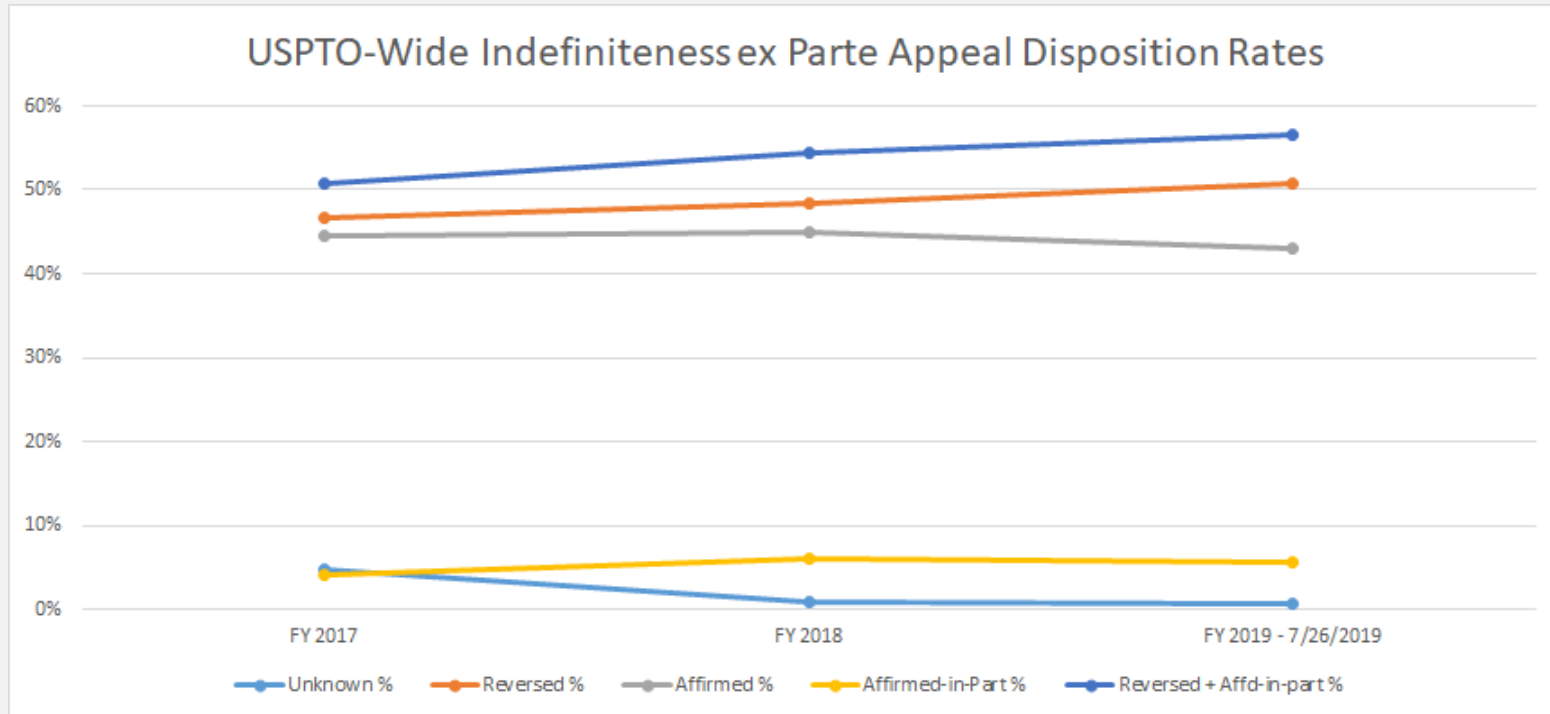
FY2013-7/26/2019 ISSUE-LEVEL OBVIOUSNESS DATA



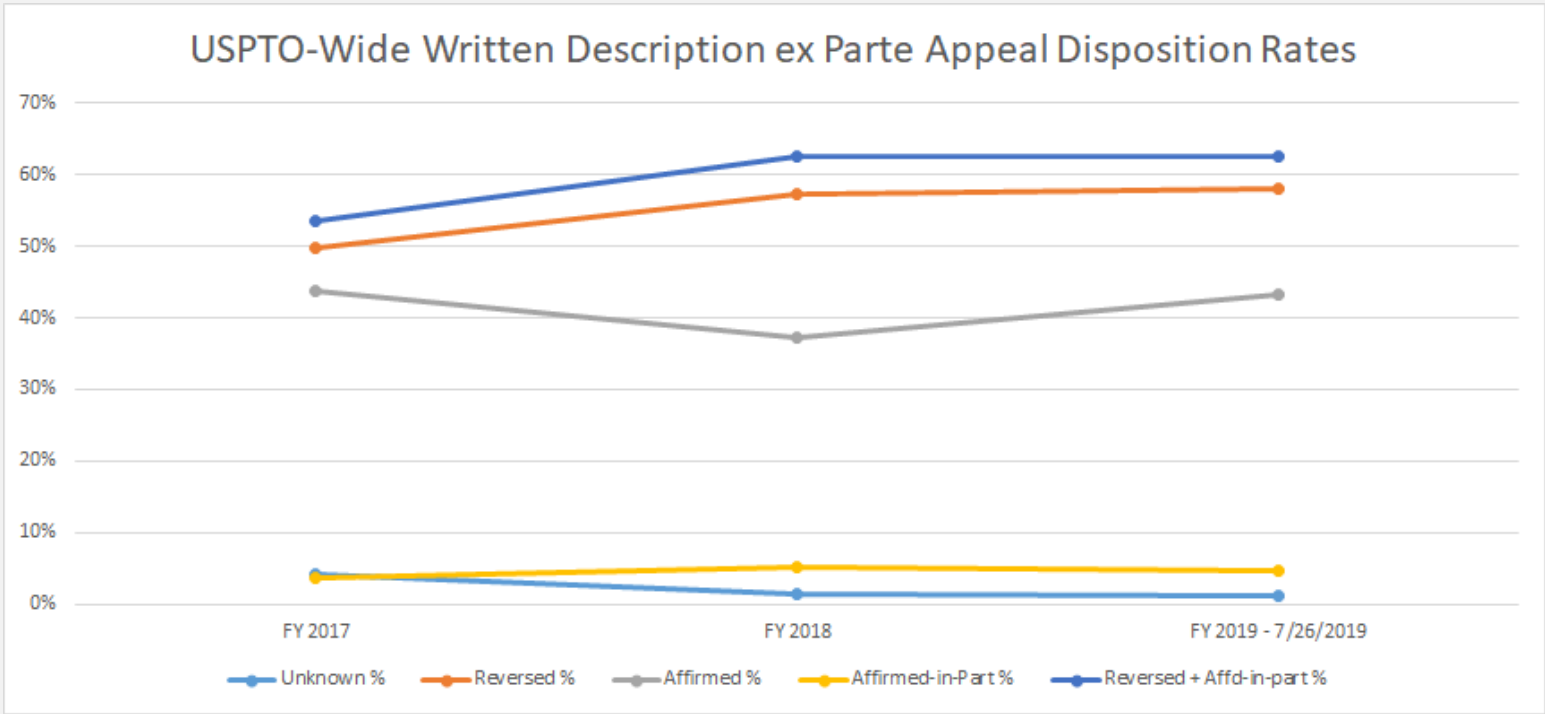
FY2013-7/26/2019 ISSUE-LEVEL STATUTORY SUBJECT MATTER DATA



FY2017-7/26/2019 ISSUE-LEVEL INDEFINITENESS DATA



FY2017-7/26/2019 ISSUE-LEVEL WRITTEN DESCRIPTION DATA



QUESTION

- Given the USPTO-wide reversal rate for section 112 written description is over 62% for at least one claim, if this is the issue in your case, should you appeal?
- Yes, especially if your examiner's allowance rate right after an interview is less than 55%.

MYTH #7

- Since every patent case is different from every other, what happens at the Board in each board decision is completely irrelevant to my client's case.
- False: Because your case is not the same as any other case handled by your examiner, your Examiner is **actually most likely to treat your case similarly** to how they treat any other. Thus, a particular examiner's ordinary response to an appeal is predictable for your case by studying what the Examiner did on average in all previous appeals.

QUESTION

- How can I get daily updates on what is happening for ex parte appeal decisions?
- Sign up for our free daily decision recap emails at [Anticipat.com!](https://anticipat.com)

MYTH #8

- Filing an appeal is going to antagonize the Examiner and prejudice her or him against me in future cases.
- False: Examiners get no negative repercussions if they are reversed on appeal and are given disposal credit for writing an Examiner's Answer. If your Examiner has less than a 55% allowance rate after an interview, you are better off having the Board decide your cases than your Examiner.

QUESTION

- Can I try all of Anticipat.com for free?
- Yes! Sign up for a two week free trial for all the site has to offer by creating an account at Anticipat.com.

MYTH #9

- There is no way to quantitatively determine the success rate for any particular legal argument for any particular legal issue (novelty, etc.) at the Board.
- False: Anticipat tags the legal arguments used for each legal issue in each case. Anticipat Analytics shows an ordered list of the most frequently successful legal arguments made showing the frequency of success.

QUESTION

- Is there any way to find a list of ex parte appeal decisions in TC 1600 which included a section 101 rejection?
- Yes! Anticipat Research allows you to filter by Technology Center and by issue and produce a list of decisions for your review.

MYTH #10

- Using ex parte appeals data cannot reduce prosecution costs because current cases have different facts from any pending case today.
- False: A side by side comparison of cases prosecuted for a Fortune 500 client where patent data was used versus where patent data was not used over an 18 month period showed nearly **20% reduction in total prosecution cost!**

COST-SAVINGS STUDY DETAILS

- Factors controlled: Same in-house counsel, same outside counsel, same technological areas
- Sampling methodology:
 - Eliminated cases: first action allowances, allowances after restriction response, allowances after first office action, and cases partially involving patent data use (“transitional”)
 - “Contested” cases involving at least 2 Office Actions were selected for side by side comparison
 - Compared cases were issued or at least allowed at the time of comparison.

COST-SAVINGS STUDY DETAILS

- Over 19% reduction in total prosecution cost observed
 - Includes both government fees and attorney fees
 - Attorney fees included flat rate items and hourly items

COST-SAVINGS STUDY DETAILS

- When patent data was used:
 - **50% reduction** in RCE filings
 - **2X increase** in use of interviews
 - **2X increase** in use of amendments after final to take allowable subject matter
 - **Higher** overall allowance rate

MYTH #11

- Ex parte appeals statistical rates of reversal can have no predictive effect on the outcome of my case because my case has different facts.
- False: If your case has the same legal issue and same legal reasoning being applied by the same Examiner, statistically, your Examiner will make the same procedural decisions as made in previous cases. Examiner interview outcome data demonstrates that Examiners have distinct preferences that come out in their preferred next procedural step.

QUESTION

- Where does quality patent prosecution work and representation count more, before the Examiner or before the PTAB?
- Before the PTAB. The high reversal rates of the Examiners before the PTAB by issue show the PTAB judges are more likely to pay attention to the law and the facts of any given case.

MYTH #12

- Interviewing all my cases will always help each case progress better.
- False: Examiner interview outcome data shows that interviewing the right examiners will improve outcomes but interviewing the wrong examiners is statistically a poor use of time and can make things worse in some cases.

QUESTION

- How much should I appeal?
- Early and often if the art cited allows. The results of the cost savings study showed that appeals were only taken in cases where patent data was used.

MYTH #13

- There is no way to predict how reasonable an Examiner will be in advance of prosecution.
- False: Interview outcomes have been found to be the major predictor of Examiner reasonableness throughout the prosecution process. You can see this data for your Examiner using Anticipat Office Action Answers [before a single office action has been received](#).

QUESTION

- Can I use Anticipat to see my Examiner's Interview Statistics?
- Yes! Anticipat's new Office Action Answers module shows this data along its recommendation as to whether to interview your Examiner or not.

MYTH #14

- Obviousness rejections have no real hope of reversal at the Board.
- False: In FY19 the USPTO-wide obviousness issue-level reversal rate for at least one claim was 50.5% up from 32% just three years ago.

QUESTION

- How can I see the Art Unit's issue-level reversal rates for obviousness, novelty, and other issues with Anticipat?
- Anticipat Analytics shows you the issue-level reversal rates for the Examiner, Art Unit, Technology Center, and the USPTO over the past 2.5 years.

MYTH #15

- Filing an appeal is going to drag my client's case out forever before a decision is made.
- False: Average ex parte appeal pendency before the PTAB is currently 13.7 months following docketing of the appeal. Waiting for the Board to decide costs your client no money out of pocket either.

QUESTION

- When is it financially better for a client to pursue an appeal rather than an RCE?
- Appeals should seriously be considered on a financial basis when Office Action Answers does not recommend you interview your Examiner.

MYTH #16

- Arguing hindsight reasoning against a *prima facie* case of obviousness is a winning argument at the Board.
- False: Hindsight reasoning was cited as the dispositive legal ground for reversal in 497 out of the 5661 cases involving obviousness in the past 2 years—only 8.8% successful.

QUESTION

- What is the leading ground for reversal for obviousness at the board?
- The combination of references much teach or suggest the claim limitations at 3X the next closest ground (clear and factually supported articulation of reasons for obviousness)

MYTH #17

- Statutory subject matter rejections have no practical hope of reversal at the PTAB.
- False: FY 19 affirmance rate (72%) post USPTO guidance was 12% percent lower than FY 18 (89%) for similar case volumes (2137 FY18 decisions vs 1852 FY19 decisions).

QUESTION

- Do the issue-level reversal rates vary by Technology Center at the Board?
- Yes. For novelty from 1/1/2013 through 7/26/2019, TC 3700 (mechanical) had the highest reversal rate at 66% for at least one claim and TC 2100 (computer architecture) had the lowest reversal rate at 45% for at least one claim.

MYTH #18

- There is no way to financially justify the cost of getting access to patent prosecution data.
- False: Using patent data to avoid conducting one interview per month more than covers the monthly subscription cost for a small law firm from most data providers—it covers it for nearly a year for Anticipat!

MYTH #19

- Appeals cannot be used to negotiate with examiners--they are win or lose proceedings.
- False: Results from the side by side data study showed that where no appeals were taken, costs were nearly 20% higher, half as many interviews were conducted, and allowance rates were lower.

MYTH #20

- Filing a notice of appeal means you are committed to have to see a case through to the PTAB.
- False: Currently, by Technology Center, 48.6% to 60% percent of the time the Examiners back down prior to an Examiner's Answer.

MYTH #21

- My personal experience is superior to patent data statistical evidence.
- False: Anticipat's statistics are objective scientific evidence of experiments conducted by practitioners with your specific Examiner. Taking the scientific approach by using Office Action Answers can only improve your odds of getting a successful outcome for your specific case.

MYTH #22

- Since my Examiner is brand new she has no data so I cannot predict anything and must just experiment.
- False: New examiners have a senior Examiner who signs off on their work. Use the senior Examiner's data to predict the outcome. If your Examiner cannot interview independently, the senior Examiner is most likely to control the outcome.

MYTH #23

- Patent prosecution cannot be regarded as a science since it is governed by human choices.
- False: By this definition [economics is not a science either](#) because it fundamentally is just the study of human choices—so we shouldn't worry about the Nobel Prize in Economics handed out each year either.

MYTH #24

- I don't need to use scientific data in my day to day patent prosecution because I am better at prosecution than anyone else.
- False: The examiner, not you, makes the decision on what happens next. How much better than average are you? Are you 95th percentile? 99th percentile? No one can escape data!

MYTH #25

- If everyone uses patent data, then the data won't be helpful anymore because there are no secret insights anymore—everyone has the answer key to the test.
- False: If you believe this, you likely believe that all Examiners and your colleagues are as progressive as you. The number of law firms still using paper files today in 2019 gives you a rough idea how long it will be before data overuse will become an issue.

MYTH #26

- I don't need to use statistical data in my patent practice because patent prosecution is a completely arbitrary and capricious endeavor.
- False: It may feel this way sometimes but an Examiner and the PTAB are most likely to treat any given case the same as they treated any other case in the past. Using the law of averages in your decisions will inevitably increase your rate of success. It's science!

MYTH #27

- The way the PTAB counts reversals, affirmances, and affirmances-in-part provides useful information to a practitioner.
- False: The PTAB's "case-level outcomes" approach eliminates the ability to observe what Anticipat's issue-level outcomes reveal.