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Making it Easier to Get a Patent



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Written by **Mark Nowotarski**
Markets, Patents & Alliances, LLC

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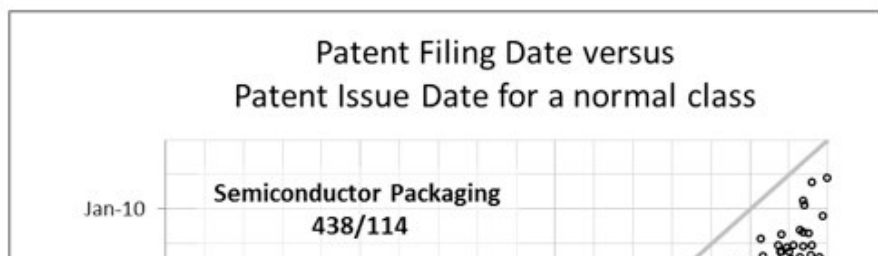
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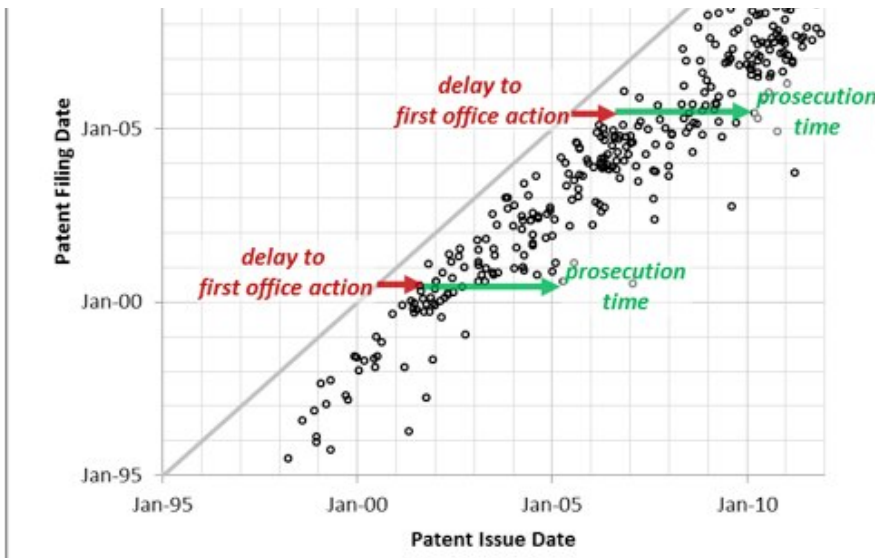


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It's tough to get a patent these days. All too often applicants and patent examiners lock horns and get stuck in an endless loop of rejection/response/rejection/response, etc. The applicant cannot convince the examiner to allow the patent and the examiner cannot convince the applicant to abandon the patent. It would be a lot easier to get a patent if there was a way to avoid this.

I have found in my own practice that each technology class at the USPTO is different. Some are easy. Some are hard. I have also found that this can change. Some of the easy ones suddenly get hard and some of the hard ones suddenly get, well maybe not "easy", but at least better. You can see if a technology class is getting easier or harder by plotting the patent filing dates in that class versus patent issue dates. Here is an example for a "normal class", semiconductor packaging, class/subclass 438/114.





Data is shown for all patents that were filed in class/subclass 438/114 since 1995 (i.e. Jan-95). I download the data from one of the paid services, www.delphion.com. I use the search string “438114nc and ad>19950101”, click on the “Data Extract” tab, and download a spreadsheet with the filing dates and issue dates of the patents. You can do the same thing with other paid services like LexisNexis. I don’t know of any free services that allow you to download spreadsheets of patent data. If anyone knows of one, please mention it in the comments below.

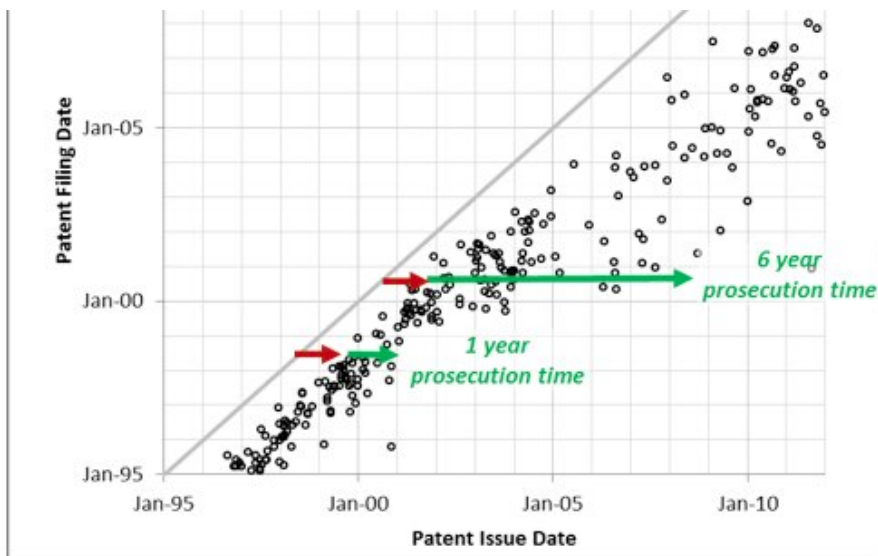
The data points look like a diagonal cloud. The width of the cloud indicates how fast patents are getting allowed once examination starts. The width is indicated by the green arrows labeled “prosecution time”. The width is about 3 years. That’s fairly reasonable.

There is a gap between the cloud and the diagonal grey line that indicates how long it took for applications filed in a given year to get their first office actions. This is indicated by the red arrows labeled “delay to first office action”. Delays to first office action are about one year. This looks fairly reasonable also.

From a patent drafting perspective, the above graph indicates that normal diligence in prior art searching and drafting is appropriate. There is no need for any special considerations.

The next graph shows data for the surgery instrumentation class/subclass 606/060. This class is having some serious difficulties. Special consideration is absolutely indicated if an inventor wants to get a patent in this technology in a reasonable amount of time and cost.





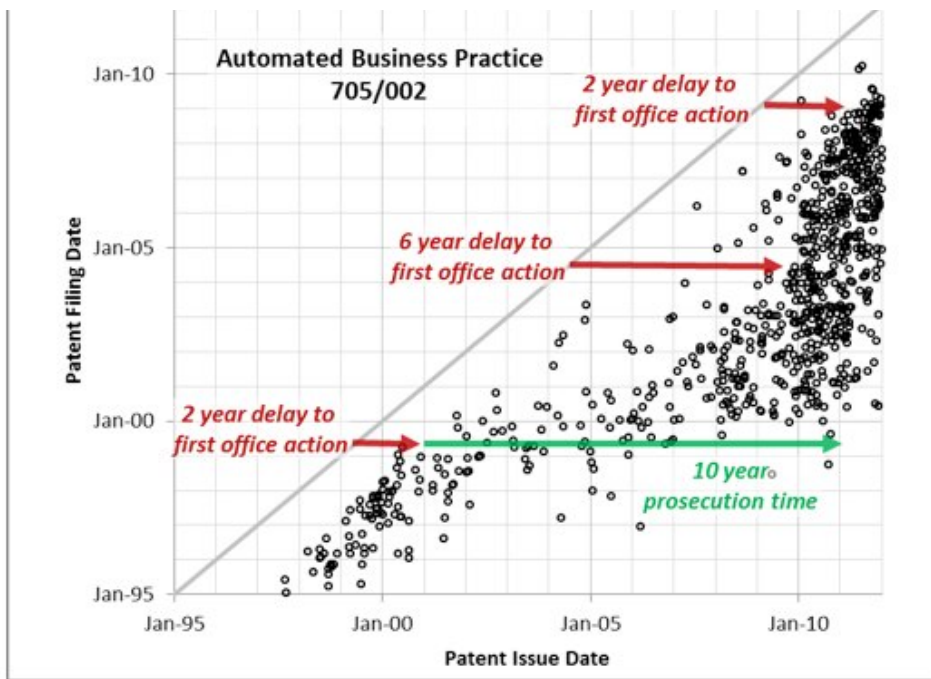
Up until 1999, the prosecution times for applications in this technology class were very low, only about 1 year (lower green arrow). Then abruptly in 2001, the prosecution times jumped to over 6 years and have remained high ever since (upper green arrow). For some reason, examiners and applicants have had a very difficult time reaching agreement on what is or isn't patentable. Applications have been undergoing repeated cycles of rejection and response with little headway towards either abandonment or allowance.

When I see significant increases prosecution times like this, I know that extra care will be needed in drafting the patent application. I have a candid conversation with the inventor on what we need to do to get his/her case allowed in a reasonable amount of time. This may mean reviewing the file wrappers of recently issued patents to see why they were allowed, doing **a more thorough prior art search** so we can clearly identify the unique and nonobvious aspects of the invention, in-person interviews with the examiner with a demonstration of the invention to physically show why the invention is not obvious, and immediate preparations for an appeal if we can't reach agreement by the first final office action. We also consider one of the USPTO's accelerated examination programs, like Track 1, PCT patent prosecution highway, or 12 Month Accelerated Examination. USPTO management strongly supports these programs and examiners are encouraged to reach agreement quickly with applicants that participate in them.

All of these options require extra effort which means more cost up front. The data allows us, however, to compare the up front cost with a fairly good estimate of the downstream savings in reduced prosecution costs and delays.

The final graph shows data for a much maligned technology class that has actually shown a dramatic improvement over the past few years, business methods. The particular class/subclass illustrated is 705/002, health care management.

Patent Filing Date versus
Patent Issue Date in an improving class



Contrary to popular belief, things are getting much better in business methods. Applications filed in 1999 had prosecution times of over 10 years (lower green arrow). These and subsequent applications jammed up the system leading to excessive delays to first office actions. Applications filed in 2004, for example, had delays to first office action of 6 years (middle red arrow). Sometime around 2010, however, things started to improve. A lot more patents started issuing and the delays to first office action dropped to around 2 years (upper red arrow). That's not to say that it's easy to get a patent in business methods, but at least examiners and applicants are making much better progress in reaching agreement on allowable claims in a reasonable amount of time.

In terms of preparing a patent application in business methods, greater care is still indicated even though things are getting better. You need to know why things are getting better and plan accordingly. A review of the file wrappers of recently issued patents to see how applicants and examiners are reaching agreement is worthwhile.

It can be very difficult to get a patent depending upon which technological class an invention is in. Making a plot of patent filing date versus patent issue date is an effective way to identify which technological classes are having difficulties and which ones are improving. This can be important information in helping applicants draft applications that have the best chance of early allowance, no matter what technology class their invention is in.

About the Author

Mark Nowotarski is the President of Markets, Patents & Alliances L.L.C. and is a registered U.S. patent agent specializing in business method patents. He currently serves clients in the financial services, medical devices,

consumer products and manufacturing industries.

Mark is also co-editor of the Insurance IP Bulletin. The Insurance IP Bulletin is dedicated to providing useful information to innovators in the insurance industry regarding the protection of their inventions with patents and ways to effectively promote their innovations.

Mark is a former Associate Director of R&D for Praxair. There he was responsible for the development and successful worldwide introduction of new products into the health care, electronics, and manufacturing industries. He was a leader in the reengineering of Praxair's patent system, and was responsible for technology planning for their home health care division.

Mark is an inventor on 17 US patents. He was appointed Corporate Research Fellow for the commercial impact of his inventions (+\$300 million in sales).

Mark has a Master's degree in Mechanical Engineering from Stanford and a Bachelor's degree with honors in Aerospace, Mechanical Sciences and Engineering Physics from Princeton. His academic awards include the Sigma Xi award for most outstanding Mechanical Engineering research at Princeton and the Union Carbide Award for Academic Excellence and Leadership in Mechanical Engineering, also at Princeton.

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Early in my career, I encountered a series of approximately 20 patent applications that were assigned to a small number of different art units. During the time it took to bring the cases to resolution, I kept detailed notes of my experiences prosecuting each case. It eventually occurred to me...

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17 comments

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1. Mark Fearer **March 13th, 2012 8:14 am**

Superb, Mark. Factual and statistical. Thank you for sharing your analysis contrasting some of the classes.

2. **Mark Nowotarski March 13th, 2012 9:04 am**

Thank you.

3. Thin Mints **March 13th, 2012 9:23 am**

Great article. I wonder whether there is an easy way to break out different art units where a class is handled by more than one art unit.

4. Blind Dogma **March 13th, 2012 11:11 am**

Well done.

5. J N Gross **March 13th, 2012 5:27 pm**

Nice write up!

6. Anon **March 13th, 2012 6:47 pm**

I would add one word of caution. You are too optimistic.

These graphs have a built in condition of measuring *success*. And even those that show a rough road are done through a filter of Achieved Patent status.

A picture that would set the expectations of the client more in tune with reality would be the same graphs adding in the abandonments and those that are still lingering in the pipeline.

I would love to see such a graph with red circles added for abandonments and empty circles for still in process (of course these would crowd the right edge, so some type of density factor would be desired.

And since I am making suggestions (which I do not have to do), I would also suggest that all RCE's be placed to include the lapsed pre-RCE time and use a blue circle for those.

7. **Mark Nowotarski March 13th, 2012 7:55 pm**

"I wonder whether there is an easy way to break out different art units where a class is handled by more than one art unit."

Not quite sure, but I'm open to suggestions.

8. **Mark Nowotarski March 14th, 2012 8:48 am**

"A picture that would set the expectations of the client more in tune with reality would be the same graphs adding in the abandonments and those that are still lingering in the pipeline."

Absolutely. The challenge is getting the data at a reasonable cost. A quick reality check is to compare published patent applications filed in a given year with issued patents filed in the same year.

9. David Postolski **March 14th, 2012 8:50 am**

Hi Mark,

As always, your postings do not disappoint! Bravo on this article- really brings to life whats been going on since 1999 in Business method classes. I would be curious to hear what the PTO and SPE's in these each centers think of this enlightening data. thanks

10. **Tom Bakos March 14th, 2012 11:54 am**

Mark:

The statistics are great and you relate long prosecution times to the need for better preparation on the part of the applicant with respect to, for example, better prior art searching. I suppose the focus of what we should learn from these statistics is what applicants can do to improve time lines since we can't really control the patent office side.

A while back you did some looking at closely related classifications and their prosecution times relative to each other. That would seem to be a way to discover problems within the patent office with respect to staffing or experience in particular classes. I assume that it is still true that an applicant might describe his or her invention in such a way as to be more likely to be assigned to a quick prosecution class than a very similar slow prosecution class. That too might be a way for an applicant to "better prepare" in order to get speedier examination.

I assume that the differences in delay to first office action are entirely attributable to patent office overload within particular classes. That stat too might be an indication of what classes ought to be avoided if possible.

11. PS DIP **March 14th, 2012 12:38 pm**

Mark,

Check and see if Primary Examiner or Assistant Examiner is a searchable field within your database. It is within most of them. Then you can do an entire Art Unit with ease based on the names from the USPTO employee locator for the Art Unit you expect your application to land in. This would also clean the data for examiners no longer employed who left (and often leave a lot of 'ugly' cases for their co-workers). You could even pick out the SPEs behind bottle necks very easily this way since they are often the Primary on the face of the patent.

12. **Mark Nowotarski March 14th, 2012 3:51 pm**

Tom,

Good points. The article Tom mentioned about targeting specific technology classes is here **<http://www.ipwatchdog.com/2011/04/06/increasing-allowance-rates-by-selectively-targeting-patent-class/id=16283/>**

13. **Mark Nowotarski March 14th, 2012 4:29 pm**

PS DIP,

Good point. Yes you can search by primary and assistant examiner.

14. **Patent Law Practice Center - PLI – Top 5 Patent Law Blog Posts of the Week March 16th, 2012 1:01 am**

[...] IP Watchdog: Making it Easier to Get a Patent – Guest author, Mark Nowotarski, shares the experience he has had in getting patent [...]

15. IreneGP **March 16th, 2012 10:15 am**

Mark,

Excellent analysis!

PS DIP,

Good thought, but I think the amount of turnover among the examiners might introduce too much noise into the analysis you suggest.

16. Mark Nowotarski March 16th, 2012 1:54 pm

IreneGP,

Thank you. The turnover among primary examiners is actually fairly low. "Backlog plot" like the ones above look pretty good for individual primary examiners.

One source of noise, however, is continuing applications. These are often taken up quickly and allowed quickly. I filtered out continuing applications from the above graphs to give a cleaner signal. They only show original applications.

17. Wil Jacques March 16th, 2012 3:25 pm

Mark,

Great work. I consider this essential information to have at hand in helping clients with patenting strategy and in properly setting their expectations.

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