



Saving Time, Money, & Your Reputation Using PAIR Status Change Alerts

Jim Hallenbeck and Tom Marlow

What Are PAIR-Based Notifications?

- Based on PAIR status changes that can be found in Private PAIR scrapes
 - *Patent Application Information Retrieval System*
- Can be based solely on changes in PAIR status
- Can be based on other factors in addition to PAIR status change
 - Monitor your own matters
 - Monitor matters of others
 - Options for public-based updates on third party patent applications
- Both of the above are generated by BHIP's Notification Service

What Are PAIR Status Alerts?

- Every patent matter in PAIR includes a PAIR Status
- The status captures process changes in the processing of patent applications in the PTO
- The large majority of PAIR status conditions signify internal process changes that may or may not be indicated in the matter Transactions
- These status changes give advance notice of actions taken by the PTO that have not yet been notified to the Applicant by mailed docket correspondence
- The most sophisticated patent practitioners monitor these status changes to improve the efficiency of prosecution

What are PAIR Status Alerts?

- Where they are found
 - portal.blackhillsip.com
- When they are checked
 - Daily
- How they are delivered
 - Dashboard
 - Email
 - Text message

Example – Matter Management

Advance notice of an Ex parte Quayle action enables:

- filing of an IDS,
- filing new claims and claim amendments, and
- filing other items

all without the filing of and paying for an RCE or continuation/divisional application plus any associated extension of time fees.

Example – Matter Management

Advance notice of rejection or allowance mailing enables:

- filing an IDS before late fees or an RCE is required to have the references considered
- allocating time and resources to promptly respond to actions in critical and time sensitive matters
- providing prompt, advance insight and advice to clients/management

Example – Matter Management

Advance notice of an Advisory Action enables:

- filing of a further response, such as an RCE or amendment to place the application in condition for allowance, without extension when the notification of the advisory action is on or after the three-month date for response.
 - i.e., when a response to a final action is made no later than the two-month date for response, the period for reply without extension is the later of the three-month date for response and the mailing of the advisory action

Example – Critical Matter Management

- More sensitive cases can be monitored for positive or negative events in order to be able to promptly notify the client and/or formulate a strategy for next steps
- Early warning may also provide a chance to rectify any issues that may exist
- Many times clients can find out about a recent development before the prosecuting attorney if your manual docketing process is delayed and the client is actively checking PAIR

Example – Matter Management and Oversight

Receive notice when failure to file a response before a shortened statutory period for reply expires resulting in a loss of accumulated patent term adjustment.

Example – Oversight Within a Law Firm

- Notification of extensions taken for a particular owner/client
 - Violating client policy
 - Firm performance metrics
 - Firm incurring the extension cost
- Notification of extensions taken by a particular attorney
 - Attorney/Team performance monitoring

Example – Oversight Within a Corporation

- Notification of extensions being taken by a particular firm/attorney
- Notification of extensions being taken within a particular portfolio
 - Proactively Manage outside counsel performance that impacts internal KPI and other monitored metrics and policies
 - Set up to monitor all counsel and learn in real time about violations of policies, outside counsel guidelines, and incidents that impact in-house counsel performance metrics

Limitless Opportunities for PAIR Status Change Alerts

- Avoidance of delays due to USPTO process getting ahead of actions required by prosecution docket
- Advance notice of rejections on critical applications
- Advance notice of allowances on critical applications

Many more alerts can be set up based on any and all PAIR status updates. There are many additional use cases and many more to be conceived.

Setting Up Pipeline® Services

- Docketing customers of BHIP already have access to BHIP's PAIR notification service
- If you are not yet a customer, you can reach out to us after this webinar and we will be happy to discuss set up, which can be done very quickly and is very affordable
- In the following slides we will show how the portal can be used to set up notifications

Setting Up *Pipeline*® Services

How PAIR Status Change Alerts are
set up in Black Hills IP *Pipeline*® Portal



Customer Portal ▼

Notification Center

Docketing Statistics

Docketing Received

Analytics

Matters

Docket Saver

Renewals Calculator

Power Prosecutor

Admin ▼

Client Users

Admin Users



Welcome

Jim Hallenbeck
JHallenbeck@blackhillsip.com





Customer Portal

Notification Center

Docketing Statistics

Docketing Received

Analytics

Matters

Docket Saver

Renewals Calculator

Power Prosecutor

Admin

Client Users

Admin Users



Notification Center

Jim Hallenbeck
JHallenbeck@blackhillsip.com



Manage Alerts

New notifications will be listed here.



No Notifications



Customer Portal

Notification Center

Docketing Statistics

Docketing Received

Analytics

Matters

Docket Saver

Renewals Calculator

Power Prosecutor

Admin

Client Users

Admin Users



Notification Center / Manage Alerts

Add New Alert

Jim Hallenbeck
jhallenbeck@blackhillsip.com



Alerts

	Name	Email	Phone	Status	Actions
Show Filters	BHIP US4 Con AA Count, not mailed	jhallenbeck@slwip.c om	563-580-5129	Advisory Action Co...	 

< 1 >



New Alert



* Alert name: BHIP US4 Con AA Count, not mailed

Application Number: 17364554 x

Attorney File Number:

Applicant:

Customer Number:

Email: jhallenbeck@blackhillsip.com

Phone (SMS): 563-580-5129

* Status: Advisory Action Counted, Not Yet Mailed

Add Alert

Setting Up Pipeline® Services

Status examples:

- Abandoned (including reason)
- Advisory Action
- After Appeal Decision
- Allowed, Notice of Allowance Not Yet Mailed
- PTAB Decision
- Final Rejection Counted, Not Yet Mailed
- Advisory Action Counted, Not Yet Mailed
- Docketed New Case, Ready For Examination
- Ex parte Quayle Action Counted, Not Yet Mailed

BLACKHILLSIP

Notification Center / Manage Alerts

Jim Hallenbeck
jhallenbeck@blackhillsip.com

New Alert

* Alert name: BHIP US4 Con AA Count, not mailed

Application Number: 17364554

Attorney File Number:

Applicant:

Customer Number:

Email: jhallenbeck@blackhillsip.com

Phone (SMS): 563-580-5129

* Status: Advisory Action Counted, Not Yet Mailed

Add Alert

Black Hills IP Security

- *How we handle security & data*
 - *MFA*
 - *Encrypted data storage*
 - *Export Control*

Response Shells

- Office Action response shells are custom documents automatically generated that include the presently pending claims and a remarks section with relevant headings matched to the present office action.
- Shells are prepared by an automated process configured according to your own preferences.
- How are they obtained?
 - E-Mail
 - Power Prosecutor®

Power Prosecutor®

The screenshot displays the Black Hills IP web application interface. On the left is a sidebar menu with the following items: Customer Portal, Notification Center (highlighted in blue), Docketing Statistics, Docketing Received, Analytics, Matters, Docket Saver, Renewals Calculator, Power Prosecutor (circled in red), Admin, Client Users, and Admin Users. The main content area is titled 'Notification Center / Manage Alerts'. It features a top bar with an 'Add New Alert' button and a user profile for Jim Hallenbeck. Below this is an 'Alerts' section containing a table with one alert entry. The table has columns for Name, Email, Phone, Status, and Actions. The alert entry shows 'BHIP US4 Con AA Count, not mailed' with email 'jhallenbeck@slwip.com' and phone '563-580-5129'. The status is 'Advisory Action Counted, No...'. A 'Show Filters' button is located to the left of the table. At the bottom right of the table, there are pagination controls showing '< 1 >'.

BLACKHILLSIP

Customer Portal

Notification Center

Docketing Statistics

Docketing Received

Analytics

Matters

Docket Saver

Renewals Calculator

Power Prosecutor

Admin

Client Users

Admin Users

Notification Center / Manage Alerts

Add New Alert

Jim Hallenbeck
JHallenbeck@blackhillsip.com

Alerts

Name	Email	Phone	Status	Actions
Show Filters BHIP US4 Con AA Count, not mailed	jhallenbeck@slwip.com	563-580-5129	Advisory Action Counted, No...	 

< 1 >

Power Prosecutor®

The screenshot displays the Power Prosecutor web application. At the top, the header includes the application name "Power Prosecutor" on the left and the user profile "Jim Hallenbeck" with email "JHallenbeck@blackhillsip.com" on the right. Below the header, a navigation bar shows the "PowerProsecutor™" logo and a share icon. The main content area is titled "Recent Document Shells" and features a blue button labeled "+ NEW SHELL" in the top right corner. A table below lists the document shells with columns for Name, Application Number, and Last Modified. A single entry is visible: "17364554 Rejection Response 2022-10-17" with application number "17364554" and last modified date "Oct 17, 2022, 4:42 PM". A red oval highlights the "+ NEW SHELL" button, and another red oval highlights the first row of the table. The bottom right of the table shows "Records per page: 10" and "1-1 of 1".

Name	Application Number	Last Modified
17364554 Rejection Response 2022-10-17	17364554	Oct 17, 2022, 4:42 PM

Power Prosecutor®

Power Prosecutor

Jim Hallenbeck
jhallenbeck@blackhillsip.com

BACK

17364554 Rejection Response 2022-10-17

Font Times New Roman

Change Tracking

Header Information

Inventor(s)
Lundberg Et al.

Application No
17364554

Filed
2021-06-30

Confirmation No
8944

Examiner
SANA, MOHAMMAD AZAM

Group Art Unit
2166

Docket No
2385.004US4

Title
PATENT MAPPING

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Lundberg Et al.
Mohammad Azam

Application No.: 17364554

Filed: 2021-06-30
2385.004US4

Confirmation No.: 8944

Title: PATENT MAPPING

AMENDMENT & RESPONSE UNDER 37 C.F.R. § <<cfText>>

<<mailStopText>>
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant has received the Non-Final Office Action dated July 21, 2022. Please enter the following.

PTO ACTION

CLAIMS

BOILERPLATE LIBRARY

FILE HISTORY

PDF

TEXT

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 09/28/2021 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

Claims 12-16, 18-19 are depending on claims 20 and claim 17 is depending on claim 25. The examiner is unclear to determine the proper dependency of these claims. The appropriate correction is required.

Claim Rejections - 35 USC §112

The following is a quotation of the first paragraph of 35 U.S.C. 112(a):

(a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such

Black Hills IP Confidential
Copyright © 2022 Black Hills IP

BLACKHILLSIP

Power Prosecutor®

The screenshot displays the Power Prosecutor software interface. At the top, the title bar reads "Power Prosecutor" and the user information "Jim Hallenbeck" is shown. The main window is divided into two panes. The left pane shows a patent claim, "1. (Currently Amended) [A] An information management system comprising: at least one computer system a plurality of computer systems including: at least one central processing unit adapted to execute computer instructions; a memory; a database management system operative on the computer system to manage data; and wherein the at least one central processing unit and memory operatively coupled; machine-readable data managed at least in part by the database management system and stored at least in part in the memory, the machine-readable data including: machine-readable patent pool data stored in the memory, the pool data including machine-readable data identifying a plurality of patent documents and at least some of the patent claims included in each patent document, wherein the patent document is published by a government entity; machine-readable user-defined limitation data representing the text of one or more user-defined limitations mapped to one or more of the patent claims, at least one of the user-defined limitations specifying a limit on the scope of one or more of the patent claims; machine-readable patent claim mapping data defining an association of user-defined limitation data to the data identifying the patent claims in order to represent a mapping of at least one of the user-defined limitations to at least one of the patent claims; and machine-readable computer instructions stored at least in part in the memory, the computer instructions executable in the central processing unit to cause the computer system to: generate patent claim mapping data that associates at least one user-defined limitation to at least one patent claim, wherein the patent claim mapping data is generated in response to a selection by a user of the system of at least one of the user-". The right pane shows a comparison of the claim with a prior art document, "1. (Currently Amended) [A] An information management system comprising: at least one computer system including: at least one central processing unit adapted to execute computer instructions; a memory; a database management system operative on the computer system to manage data; and wherein the at least one central processing unit and memory operatively coupled; machine-readable data managed at least in part by the database management system and stored at least in part in the memory, the machine-readable data including: machine-readable patent pool data stored in the memory, the pool data including machine-readable data identifying a plurality of patent documents and at least some of the patent claims included in each patent document, wherein the patent document is published by a government entity; machine-readable user-defined limitation data representing the text of one or more user-defined limitations mapped to one or more of the patent claims, at least one of the user-defined limitations specifying a limit on the scope of one or more of the patent claims; machine-readable patent claim mapping data defining an association of user-defined limitation data to the data identifying the patent claims in order to represent a mapping of at least one of the user-defined limitations to at least one of the patent claims; and machine-readable computer instructions stored at least in part in the memory, the computer instructions executable in the central processing unit to cause the computer system to: generate patent claim mapping data that associates at least one user-defined limitation to at least one patent claim, wherein the patent claim mapping data is generated in response to a selection by a user of the system of at least one of the user-".

Power Prosecutor®

The screenshot displays the Power Prosecutor software interface. The main window shows a document titled "17364554 Rejection Response 2022-10-17". The document content includes a "REMARKS" section with the following text:

This responds to the Non-Final Office Action Received dated 07/21/2022.

Claims 1,11-19 are presently amended. Claims are presently canceled, and claims were canceled previously. New claims are presently added. As a result, claims 1-19 are now pending in this application.

Rejection of Claims under Section 112

Claim 1, and presumably claims 2-10, were rejected under 35 U.S.C. § 112(a) as allegedly failing to comply with the written description requirement by containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor possessed the invention at the time of filing.

Rejection of claims under Section 103

Claims 1-6 and 8-10 were rejected under 35 U.S.C. § 103 over **Hodes** (U.S. Patent Application Publication 2005/0144177; hereinafter "Hodes") in view of **Stobbs et al.** (U.S. Patent Application Publication 2004/0181427; hereinafter "Stobbs") further in view of **Rivette et al** (US 5991751; hereinafter "Rivette").

Claim 7 was rejected under 35 U.S.C. § 103 over **Hodes**, **Stobbs**, and **Rivette** in further view of **Mahesh** ("Ontology Development for Machine Translation: Ideology and Methodology"; hereinafter "Mahesh").

Claims Objections

Claims 12-19 were rejected due to errors in their dependency. Appropriate amendments are herein correcting these errors. Entry of the amendments and withdrawal of the claim objections are respectfully requested.

Rejection Type:- Allowable

The right sidebar contains a "Boilerplates" section with a search bar and a "+ NEW" button. Below this, there are three boilerplate options, each with a "Standard" icon and a menu icon:

- Interview Summary** (Standard icon)
- Specification Objections** (Standard icon)
- The Rejection of Claims Under 101** (Standard icon)

The top of the interface shows the user's name "Jim Hallenbeck" and email "jhallenbeck@blackhillsip.com". The bottom of the interface shows the text "Black Hills IP Confidential Copyright © 2022 Black Hills IP" and the "BLACKHILLSIP" logo.

Power Prosecutor®

Power Prosecutor

Jim Hallenbeck
j.hallenbeck@blackhillsip.com

BACK 17364554 Rejection Response 2022-10-17

Font Times New Roman Change Tracking

Header Information

Inventor(s):
Lundberg Et al.

Application No:
17364554

Filed:
2021-06-30

Confirmation No.:
8944

Examiner:
SANA, MOHAMMAD AZAM

Group Art Unit:
2166

Docket No:
2385.004US4

Title:
PATENT MAPPING

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s):
Lundberg Et al.
Mohammad Azam

Examiner:
Sana

Application No.:
17364554

Group Art Unit:
2166

Filed:
2021-06-30
2385.004US4

Attorney Docket No.:

Confirmation No.:
8944

Title:
PATENT MAPPING

AMENDMENT & RESPONSE UNDER 37 C.F.R. § <<cfText>>

<<mailStopText>>
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant has received the Non-Final Office Action dated July 21, 2022. Please enter the following.

PTO ACTION CLAIMS BOILERPLATE LIBRARY FILE HISTORY

Jul 21, 2022
Outgoing

Email Notification
Jul 21, 2022

Jul 21, 2022
Outgoing

Non-Final Rejection
Jul 21, 2022

List of references cited by examiner
Jul 21, 2022

List of References cited by applicant and considered by examiner
Jul 21, 2022

Jul 21, 2022
Internal

Search information including classification, databases and other search related notes
Jul 21, 2022

Bibliographic Data Sheet
Jul 21, 2022

Examiner's search strategy and results
Jul 21, 2022

Black Hills IP Confidential
Copyright © 2022 Black Hills IP

BLACKHILLSIP

Power Prosecutor®

- Power Prosecutor® is presently in beta.
 - If you are interested in the beta, please email betasign-up@blackhillsip.com or jhallenbeck@blackhillsip.com to express your interest and to request a personalized demo
 - Currently onboarding our first 20 beta participants and will be adding more over time.
 - Beta participants will receive a discount on pricing after the beta concludes.
 - Need not be a docketing customer to utilize our Response Shell service or Power Prosecutor®

PAIR Status Alerts and Power Prosecutor®

- Questions
- Jim Hallenbeck
 - jhallenbeck@blackhillsip.com
- Tom Marlow
 - tmarlow@blackhillsip.com

Thank you

A series of thin, dark grey lines that flow from the top left, curve across the top of the slide, and then curve downwards on the right side, creating a sense of movement and depth.