

# 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 twomonth 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 inhouse 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.



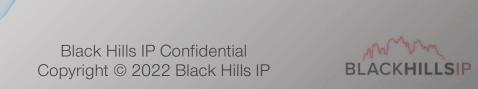
### Setting Up Pipeline® Services

- 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 P*ip*eline® Portal





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Welcome

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Customer Portal Notification Center **Docketing Statistics** Docketing Received Analytics Matters Docket Saver Renewals Calculator Power Prosecutor Admin Client Users

Admin Users

BLACKHILLSIP



Customer Portal

**Notification Center** 

**Docketing Statistics** 

**Docketing Received** 

Analytics

Matters

Docket Saver

Renewals Calculator

Power Prosecutor

Admin

Client Users

Admin Users



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#### **Notification Center**

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Manage Alerts

New notifications will be listed here.



BLACKHILLSIP

No Notifications





Customer Portal

Notification Center

**Docketing Statistics** 

**Docketing Received** 

Analytics

Matters

Docket Saver

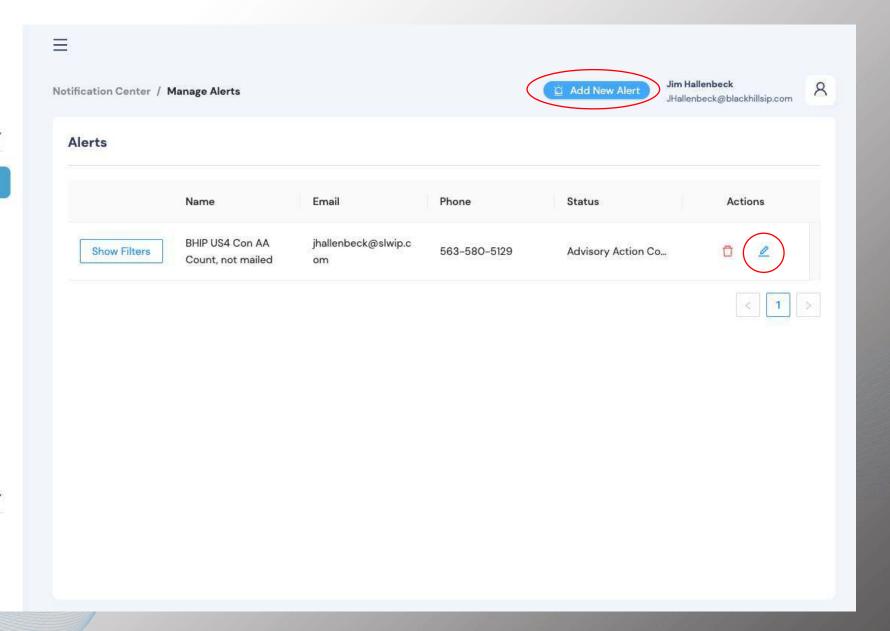
Renewals Calculator

Power Prosecutor

Admin

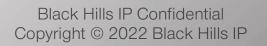
Client Users

Admin Users





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BLACKHILLSIP	Notification Center / Manage	e Alerts Ö. Add New Alert	Jim Hallenbeck  JHallenbeck@blackhillsip.com	8
Customer Portal ▼	New Alert	X		
Notification Center	* Alert name :	BHIP US4 Con AA Count, not mailed		
Docketing Statistics	Application Number:	17364554 ×	Actions	
Docketing Received	Attorney File Number:			
Analytics	Applicant:			
Matters	Customer Number:			
Docket Saver	Email:	jhallenbeck@blackhillsip.com		
Renewals Calculator	Phone (SMS):	563-580-5129		
Power Prosecutor	* Status :	Advisory Action Counted, Not Yet Mailed		
Admin		Add Alert		
Client Users				
Admin Users				

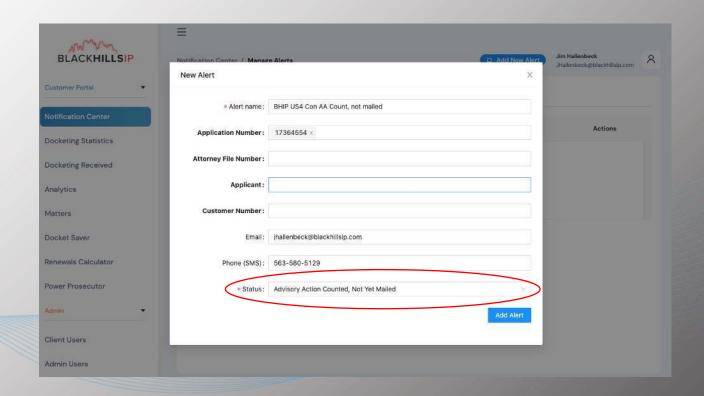




### Setting Up Pipeline® Services

### 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







### Black Hills IP Security

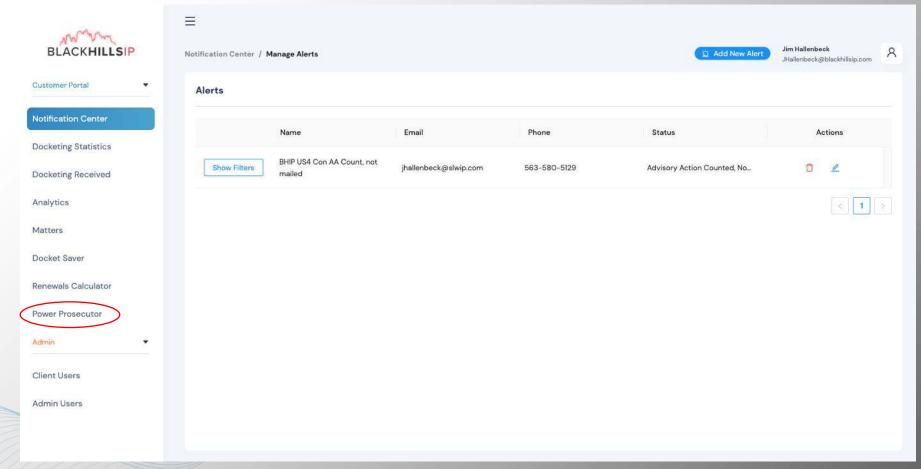
- How we handle security & data
  - MFA
  - Encrypted data storage
  - Export Control



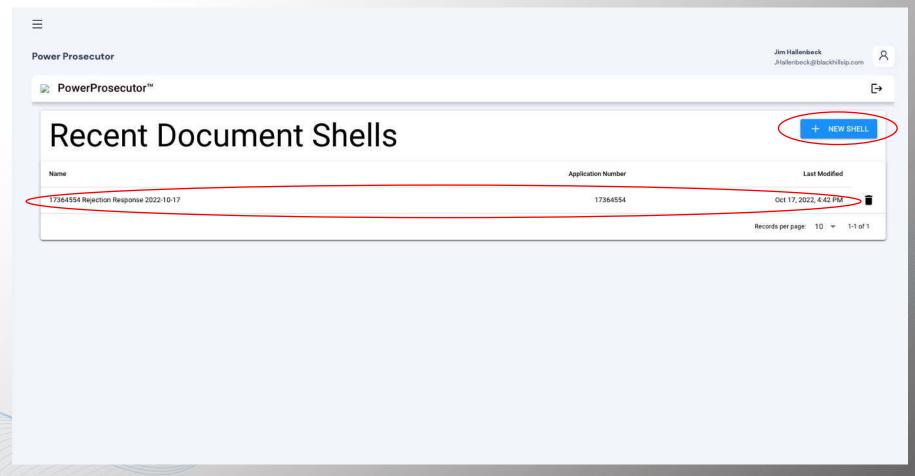
### Response Shells

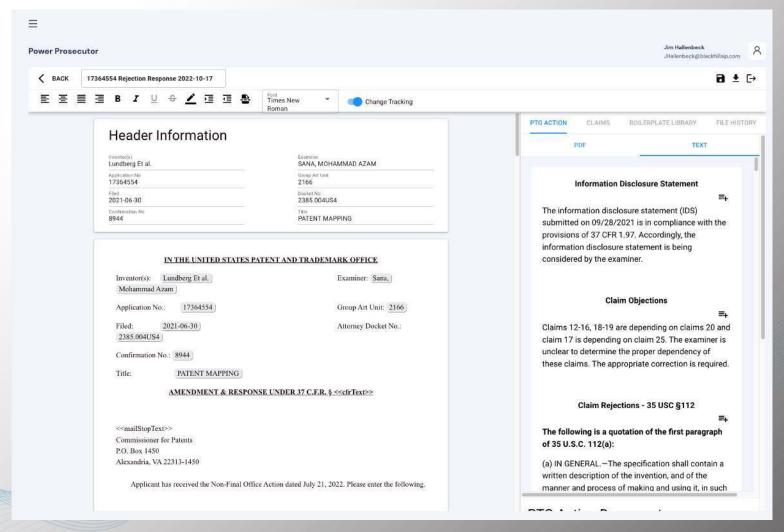
- Office Action response shells are custom documents automatically generated that include the presently pending claims and a remarks section with relevant headings matched to the present office action.
- Shells are prepared by an automated process configured according to your own preferences.
- How are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



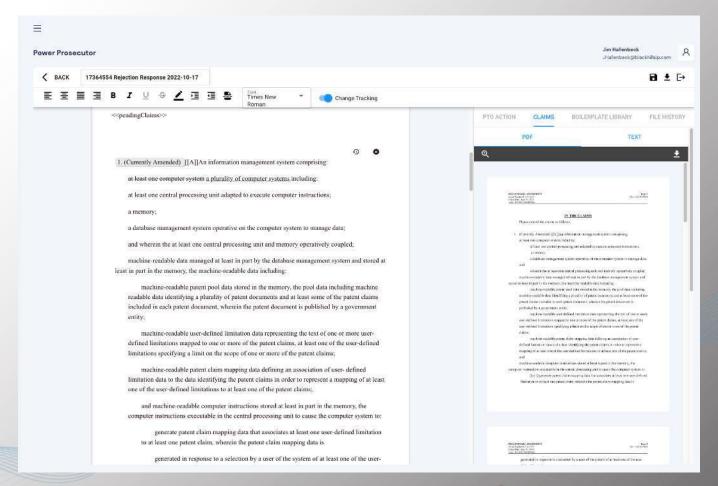


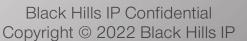




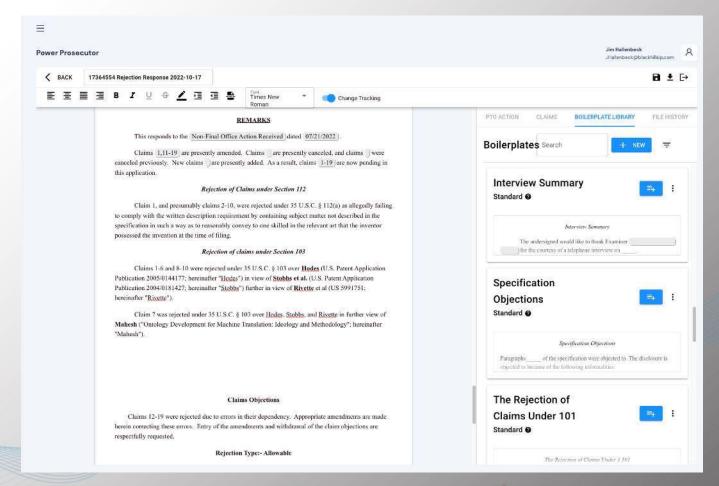






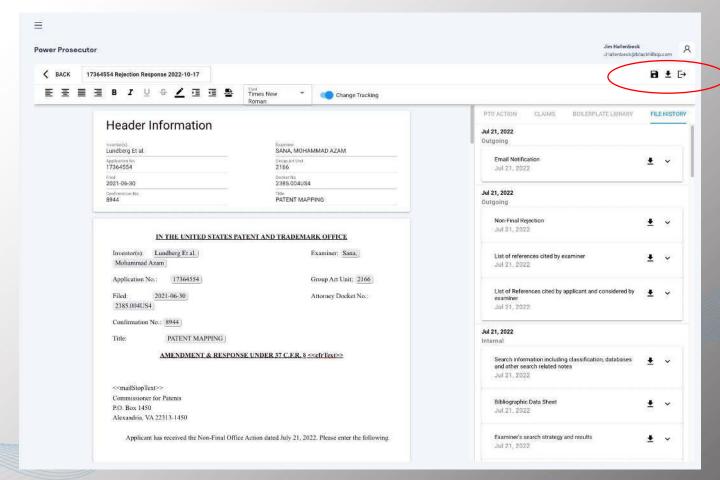














- Power Prosecutor® is presently in beta.
  - If you are interested in the beta, please email <u>betasign-up@blackhillsip.com</u> or <u>jhallenbeck@blackhillsip.com</u> to express your interest and to request a personalized demo
    - Currently onboarding our first 20 beta participants and will be adding 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

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# Thank you

