



COMPETITIVE BENCHMARKING WHITE PAPER

Choosing the Right Generative AI Tool
for Office Action Responses

intelli

September 2024



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Executive Summary

This white paper highlights how Bob, a patent attorney, evaluated AI-based office action tools and chose IP Author for its superior precision, speed, and control. Unlike other tools, IP Author excels in identifying missing elements from cited references, offering minimal and targeted amendments that maintain claim scope, and generating well-structured legal arguments. Bob appreciated its ability to handle complex legal issues efficiently while providing full customization and faster, accurate amendments. Ultimately, IP Author empowered Bob to manage more cases effectively, making it the ideal choice for patent attorneys seeking to streamline their office action responses.

Introduction

Background

Patent attorneys like Bob are under constant pressure to manage growing workloads while delivering high-quality office action responses. The complexity of modern patent prosecution requires attorneys to efficiently respond to examiner rejections without compromising the scope or strength of their claims. With the advent of AI-based tools, patent professionals are exploring solutions to automate and streamline these processes. However, not all AI tools offer the same level of precision, flexibility, and control, which makes selecting the right tool critical for attorneys and their firms.



Problem Statement

As patent attorneys face increasing demands, traditional methods of responding to office actions are proving inefficient and time-consuming. Many AI-based tools fall short by either suggesting excessive amendments that weaken claim scope or by providing poorly structured arguments that require significant manual revision. Patent attorneys need a solution that balances speed, accuracy, and minimal intervention while maintaining the integrity of their claims. This white paper explores how Bob, a patent attorney, addressed this challenge by choosing IP Author as the most effective AI tool for his office action responses.



Methodology

To evaluate the effectiveness of various AI-based office action response tools, Bob conducted a hands-on comparison of multiple solutions, including IP Author, Solves Tool and Dip Tool. His focussed on obtaining office action responses for a couple of cases (15/755,561 and 16/348,508). His evaluation criteria – key factors essential to patent prosecution: precision in identifying missing claim elements, the ability to suggest minimal and targeted amendments, the structure and logic of generated arguments, speed, accuracy, and customization options. Each tool was tested on real-world patent office actions (15/755,561 and 16/348,508), examining the tools' ability to preserve claim scope while addressing examiner rejections efficiently. Bob's evaluation also considered the user interface and the flexibility to control the amendments and arguments generated by the tools. Through this practical testing and analysis, Bob determined that IP Author outperformed the other solutions in delivering reliable, efficient, and customizable responses to office actions.



Qualitative Key Findings

Parameter	IP Author	Solves Tool	Dip Tool
Precise Identification of Missing Elements	Provides detailed identification of missing claim elements, reducing manual review time.	Misses important details, requiring manual review of file history.	Sometimes provides incomplete or incorrect identification, increasing risk of missed details.
Focus on Minimal and Targeted Amendments	Suggests minimal and precise amendments to maintain claim strength and avoid unnecessary limitations.	Often suggests unnecessary amendments, complicating the claim structure.	Occasionally introduces errors or redundancies in amendments, requiring correction.
Maintains Claim Scope with Simplicity	Recommends few, concise changes that preserve the integrity of the original claim scope.	May overcomplicate amendments, risking limitations on claim scope.	Generates overly complex amendments that risk limiting the protection scope.
Better Argumentation Structure	Provides clear, logical arguments with strong and weak points identified, enabling informed strategy.	Offers generic, shallow arguments that lack depth and require manual refinement.	Provides disorganized arguments that require significant effort to structure into a coherent response.
Customization and User Control	Offers extensive customization, allowing users to tailor arguments and amendments to client preferences.	Limited customization, making it difficult to adapt to specific client needs.	Lacks flexibility, frustrating users who require more control over responses.
Faster and More Accurate Amendments	Delivers fast, accurate amendments fully supported by the specification, helping meet deadlines effectively.	Frequently suggests amendments not supported by claims, leading to rejections.	Slower processing time and higher error rates, requiring additional correction time.
Strategic Suggestions for Complex Legal Arguments	Excels in providing nuanced legal suggestions, helping navigate complex office actions confidently.	Lacks depth in handling complex legal issues, leaving users to manage tricky cases alone.	Provides limited support for complex legal arguments, requiring additional manual input from the attorney.

01

Precise Identification of Missing Elements

As Bob reviews the examiner's rejections, he needs an AI tool that clearly identifies what's missing in his claims compared to the cited references. IP Author excels at pinpointing these missing elements, allowing Bob to quickly assess and address critical gaps. The system automatically highlights areas where the examiner's objections hold ground, giving Bob clear insights into how to tackle the issues head-on.

In comparison, Solves Tool leaves out important details in its assessment, forcing Bob to spend extra time manually reviewing the file history. This not only slows down his workflow but also increases the risk of missing something important.

02

Focus on Minimal and Targeted Amendments

Bob knows that over-amending patent claims can lead to unnecessary limitations that weaken the protection offered by the patent. He needs a tool that suggests only the minimal amendments required to address the examiner's concerns. IP Author is built to make these focused, targeted amendments that preserve claim scope while efficiently addressing objections.

Bob notices that Solves Tool often suggests unnecessary changes that complicate the claim structure, leaving him to manually simplify the claims. Dip Tool, on the other hand, sometimes introduces errors or redundancies that Bob must correct before moving forward.



03

Maintains Claim Scope with Simplicity

A key aspect of Bob's evaluation is how well the tools help maintain claim scope without over-complicating the amendments. IP Author stands out here by recommending the fewest necessary changes, keeping claims concise and to the point. This allows Bob to maintain the integrity of the original invention while resolving any examiner concerns.

Meanwhile, Dip Tool generates overly complex amendments that risk limiting the scope of protection. Bob finds himself wasting time cleaning up these amendments, which defeats the purpose of using an AI tool.

04

Better Argumentation Structure

When it comes to crafting arguments for the examiner, Bob needs a tool that provides structured, logical arguments he can trust. IP Author delivers by pointing out strong and weak points in the argumentation, enabling Bob to make informed decisions about which strategies to pursue.

In contrast, Solves Tool defaults to generic arguments that lack depth, leaving Bob to manually refine the arguments to make them compelling. Dip Tool offers disorganized arguments that Bob finds hard to assemble into a coherent response.

05

Customization and User Control

Bob appreciates having control over how arguments and amendments are presented. With IP Author, he can see all potential arguments—strong or weak—giving him the flexibility to decide what to present to his clients. This level of control is especially useful when clients have different strategic preferences.

Neither Solves Tool nor Dip Tool provides this level of customization. Bob finds himself frustrated with their more rigid systems, which limit his ability to tailor responses to specific client needs.

06

Faster and More Accurate Amendments

As deadlines approach, Bob values speed without sacrificing accuracy. IP Author consistently delivers fast, accurate amendments that are fully supported by the specification. In contrast, Solves Tool frequently suggests amendments that aren't supported by the claims, leading to rejections under 35 USC 112(a).

Dip Tool is even slower and more prone to errors, leaving Bob to fix mistakes rather than focus on strategy.

07

Strategic Suggestions for Complex Legal Arguments

Handling high-stakes patent applications often requires making complex legal arguments. Bob finds that IP Author is particularly adept at identifying nuanced legal considerations, such as product-by-process limitations, helping him navigate tricky office actions with confidence.

Neither Solves Tool nor Dip Tool provides this level of depth. Bob often feels like he's handling these complex issues on his own when using the other tools.



IP Author Vs Applicant Submitted Office Action Responses

IPAuthor's suggestions were largely effective in addressing both technical and legal challenges in patent prosecution, particularly in applications where detailed technical amendments were required. We found an average relevance score of 80% when compared to the applicant-submitted arguments and amendments.

Application number	Arguments comparison		Match score	Amendments comparison		Match score
	IP Author suggested	Applicant submitted		IP Author suggested	Applicant submitted	
US16/931,779	The invention provides for an attachable-and-detachable database session.- Allows clients to intentionally detach from and reattach to the session.- Includes proactive management of the session's lifecycle and maintenance in a detached state.	A database platform that provides a variety of database sessions, including connection-specific and attachable-and-detachable sessions.	60%	"wherein the request specifies a unique session identifier for the attachable-and-detachable database session;"	"2 different sessions: connection-specific database sessions and attachable-and-detachable database sessions"	50%
US16/914,111	Gurovich does not disclose or suggest a user interface displaying an icon for the second mobile device in a predetermined position.- The icon's position is based on the location of the second device being within a first spatial region relative to the pointing direction of the first device.- This predetermined position is critical for providing visual context relevant to the user's perspective.	Gurovich and Qui do not disclose or suggest determining, based on distance and angular information, that the second device lies within a pre-defined spatial region relative to the first device's pointing direction.- Qui does not suggest using angle and distance measurements for locating the device within spatial regions relative to the pointing direction of the first device.	75%	"wherein the predetermined position is determined by an importance metric calculated based on a combination of the probability of the second mobile device being located in the first spatial region and an importance score assigned to the first spatial region."	"plurality of spatial regions" which is similar to the tool suggested amendment.	85%
US17/147,806	The use of a machine learning module with a neural network for detecting and identifying noises is not merely the presence of a neural processing unit.- The specific application of machine learning techniques to this problem is not obvious from prior art.- Examiner has not provided evidence suggesting that this application would be obvious to a person skilled in the art.	Nasir does not address deficiencies of Marti.- Nasir does not disclose using a machine learning module with a trained neural network to detect and identify noises in the received sound signal, as recited in claim 1.	90%	"Detecting the noises in the received sound signal using a machine learning module with a neural network" and few other words added.	"detecting the noises in the received sound signal using a machine learning module with a neural network"	90%
US15/703,709	Bennett et al. do not teach 'determining a remote electronic device based on the command.'- This involves understanding the command's intent and context to select the appropriate device.- Haubrich et al. contribute voice command authentication but do not suggest integrating this with determining a specific device.	Bennett does not disclose "determining context information associated with the in-ear device" and then "determining a remote electronic device based on the command and the context information."	95%	"wherein the remote electronic device is determined based on a location of the in-ear device within an environment and the remote electronic device is associated with a user profile specific to the wearer;" "wherein the signal includes a modification of the command based on the user profile."	"determining context information associated with the in-ear device; determining a remote electronic device based on the command and the context information;"	95%

Generative AI for IP: The Magic Quadrant



Conclusion

After a detailed comparison of the three AI-based office action response tools, Bob confidently selects IP Author as the best solution for his needs. IP Author consistently outperforms its competitors by providing precise identification of missing elements, targeted amendments that maintain claim scope, and logical argumentation structures. Its flexibility, speed, and customization options allow Bob to tailor his responses to meet both legal requirements and client preferences.

With IP Author, Bob can handle complex legal arguments, reduce errors, and increase his efficiency without compromising the strength of his claims. This makes IP Author the ideal choice for patent attorneys and firms looking to manage their caseloads effectively while maintaining the quality of their patent applications.



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