

# How To Draft An Application To Minimize Prosecution Time (and Increase The Effective Term Of Your Patent)

By Michael E. Kondoudis

Under U.S. Patent Laws, a patent is enforceable from the date the application issues up to 20 years after the application was filed. It is during this so-called “effective patent term” that the majority of the reward for an applicant’s investment in prosecuting the application is realized. The most direct way to maximize this patent term is to minimize the prosecution time of the application to earn the earliest possible issue date. The following are patent drafting strategies to consider to achieve this goal.

**The Key is To Try to Draft the Application to Appeal to Examiner’s Discretion.** An often overlooked factor in patent prosecution is that examiners have some discretion as to the order in which they choose to “pick up”\_ and examine applications from their docket. Examiners are supposed to take up applications in a specified hierarchy specified by Section 708 of the Manual of Patent Examining Procedure (MPEP), which generally specifies that applications are to be examined in the order of their effective filing dates. The PTO, however, ensures compliance with this requirement by monitoring whether the oldest application on each docket is acted upon every other week (known as a by-week). As a result, after an examiner acts on the oldest case on his/her docket, that examiner has some discretion to “cherry pick”\_ applications from their docket thereafter.

**Why Try to Appeal to Examiner Discretion? Because Sometimes Examiners Need to Find an Easy Application to Examine!** Examiners are under ever increasing production pressures and sometimes they need an easier to examine application to boost their production. For example, consider that an examiner is responsible for ensuring that the application satisfies the Patent Laws and Rules, understanding the claimed invention and conducting a thorough search of the art, and allowing only patentable subject matter. Also, examiners are required to meet certain production quotas measured every by-week. Thus, when an examiner needs to make up ground to meet his/her production quota at the end of a by-week, they tend to look for applications from their docket that will require easier-to-generate first Office Actions, so that they can increase their production. There is, therefore, an opportunity to obtain earlier examination of an application by drafting the application in a manner that makes the application “attractive”\_ to an examiner, when the examiner needs a quick production boost.

**How to Draft an “Attractive” Application.** What exactly makes an application “attractive”\_ to an examiner is impossible to answer with specificity because, as the saying goes, “beauty is in the eye of the beholder.”\_ As a general rule, however, easier to examine applications tend to be more attractive to examiners. And, easier to examine applications share a common trait; they are drafted with the examiner’s job in mind. So, these applications are written clearly and efficiently, and avoid unnecessarily complex sentence structures. Also, these applications include easy to understand figures that correspond well to the written description, are well-labeled, and illustrate every claim

The Law Office of Michael E. Kondoudis, PC ♣ [www.mekiplaw.com](http://www.mekiplaw.com)  
[mkondoudis@mekiplaw.com](mailto:mkondoudis@mekiplaw.com) ♣ 1-202-349-9850

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feature. These applications tend to require an art search of a relatively reasonable scope by keeping the number of claims to a minimum, especially the number of independent claims. Also, these applications use reasonable claim language that accurately and specifically identifies the claimed invention. Sometimes, these applications even describe, at the beginning or the end of the detailed description portion of the written description, some of the subject matter an applicant believes is patentable. All of these traits tend to make an examiner's job easier by: (1) minimizing the time an examiner must spend to understand the invention to be examined; (2) minimizing and focusing the scope of the search for prior art; and (3) minimizing the need to identify objectionable informalities (e.g., inconsistencies between the written description and the drawings, claim features not shown in the drawings).