

# Six Tips That Can Minimize The Prosecution Time Of Your Application (and Increase The Effective Term Of Your Patent)

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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 prosecution strategies to consider to achieve this goal.

**Tip #1: File a Nonprovisional Application Instead of a Provisional Application Whenever Possible.** Provisional applications are NEVER examined; only nonprovisional applications are examined. And a utility application that claims the benefit of a provisional filing date is examined according to its own actual filing date, not the provisional filing date. As a result, the period from a provisional application filing date until the filing of a corresponding nonprovisional application delays the start of examination. Only the filing of a nonprovisional application places the application into line for examination.

**Tip# 2: Convert Provisional Applications Into Nonprovisional Applications as Soon as Possible.** When practical, business, or legal considerations outweigh a need for speedy examination, a provisional application should be considered. Provisional applications can, for example, close off later prior art from being cited against the application and may yield business advantages (i.e., the ability to say “patent pending” ). But, because provisional applications are never examined, it is generally best to start the conversion process as soon as possible.

**Tip #3: Prosecute Applications Efficiently and Quickly.** Responding to all Office Actions as early as possible (hopefully within the typical three month response deadline set by most Office Actions) tends to speed up patent prosecution. To be sure, responding early to an Office Action yields a benefit measurable in days. This benefit, however, is amplified by routinely responding early to Office Actions. Indeed, routinely responding sooner than required can have a significant cumulative effect, especially when one considers those applications that cause several Office Actions to be generated.

**Tip #4: Consider an Examiner Interview.** Maintaining efficient communication with the examiner by interview tends to speed up patent prosecution by helping applicants better understand how an Examiner is interpreting cited art, the basis for rejections, and how an examiner will respond to potential claim amendments, often without many of the estoppel effects of paper prosecution. Additionally, interviews help Examiners understand the claimed invention and help distinguish an application from others on an Examiner's docket. In these ways, interviews may greatly advance

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prosecution by yielding improved Office Actions and making responses to Office Actions more effective.

**Tip #5: File Responses Electronically, by Facsimile, or by Express Mail.** Responses filed electronically or by facsimile are virtually immediately received by the PTO. In contrast, responses filed by first class mail must be delivered to the PTO before they can be processed and, they may be lost. Thus, even though responses filed by first class mail are considered to have been filed on the day they are deposited in the mail, they take longer to process and are not as certain as filing electronically or by facsimile.

**Tip # 6. Take Advantage of Formal Examiner Amendments.** The Manual of Patent Examining Procedure (MPEP) authorizes Examiners to correct informalities in the written portions of the specification as well as all errors and omissions in the claims. When faced with a the necessity for modest formal changes, a formal examiner amendment can avoid at least the time the PTO will take to process a response, even if that response is filed electronically.