What does “Patent Prosecution Experience” Mean in Law Firm Job Advertisements?

I recently received a query back from a law firm with regard to a patent agent candidate's application. The firm said that it was a "bit confused" about the extent of the candidate's patent prosecution experience. The term "patent prosecution experience," which is routinely used by firms in advertising patent agent opportunities, is simple enough on its face, but it is not simple in practice. But while there is no clear standard by which such experience can properly be measured, the guidelines below may aid you in making this determination. One thing you should definitely do is make sure that the firms you are applying to fully understand and consider what patent prosecution experience you do legitimately have, and not give it short shift.

Basically, the term means the estimated amount of time that a candidate has spent doing what patent agents often do, which is preparing or "prosecuting" prospective patents before the United States Patent and Trademark Office (USPTO). This is an important calculation, as the major firms frequently require at least 2-3 years of "patent prosecution experience" before they will consider a candidate. A candidate who can measure who lacks such experience will be at a serious disadvantage when competing for the great majority of patent agent jobs. Thus, when a particular candidate has spent 4 years working as a "patent agent" in a law firm prosecuting patents, then this calculation is an easy one (4 years). But most patent agent candidates do not have patent prosecution experience that is that so clearly defined. What if the patent agent had not been registered with the USPTO during most of those 4 years, and as a result, the patent agent worked more as a "technical assistant" who was heavily supervised by lawyers? Or what if the patent agent's work did not include a lot of patent drafting or prosecution because the firm was short in such work? Now the calculation is less clear. Should the patent agent in either of these examples get credit for the full 4 years, or should there be two numbers - one for the length of time doing only "patent prosecution" and the other for doing other patent activities? One problem with this approach is that patent agents do not normally spend 100% of their time drafting patents. Just as in litigation, there is far more that lawyers do than just trial work.

In the situation above where the law firm had made a query, my candidate had been a Research Scientist for a big corporation. Although he was never formally a patent agent, he was responsible for managing the patents at his company for four years. He did the kind of work that patent agents often do - investigation, prior art evaluation, correspondence with the USPTO, etc. while acting as a "liaison" between the scientists/engineers and the patent lawyers. He also prosecuted nearly 24 of his own patents - just like patent agents in firms do. So I had to explain that while it was true that the candidate was not a formal patent agent, it was incorrect for the firm to infer that he was "just an inventor" with no real patent prosecution experience. Rather, he was a scientist who had both substantial "general patent" experience as well as "patent prosecution" experience during that four year period. Ultimately, the firms will decide what they want "patent prosecution experience" to mean. The best you can do is lay out the facts.