

Sens. Asks USPTO To Review Patent Eligibility Last

By [Tiffany Hu](#)

Law360 (March 23, 2021, 6:26 PM EDT) -- Sens. Thom Tillis, R-N.C., and Tom Cotton, R-Ark., have urged the [U.S. Patent and Trademark Office](#) to create a pilot program that would have patent examiners modify their review of patent applications to reduce the number of "unnecessary and inefficient" rejections based on eligibility.

Published Monday, the letter proposes a "sequenced approach to patent examination" where examiners would first look at whether an application was anticipated or obvious due to prior art, or whether it lacked enablement, which means that the specification fails to teach an ordinarily skilled person how to make the claimed invention without "undue experimentation."

This would "avoid unnecessary and inefficient rejections on grounds of patent eligibility, and in the process improve [the USPTO's] effectiveness," the senators wrote, noting that examination procedures for whether claims are patentable are based on "well-developed and objective criteria under the law" in comparison with the vague guidance involving eligibility.

"Our concern is that by conducting an eligibility analysis as per current practice, patent examiners may be issuing Section 101 [of the Patent Act] rejections without the benefit of addressing prior art, clarity and enablement issues that may well inform the examiner that the claim is eligible under Section 101," they wrote.

The senators added that in "years past," some examiners used this sequenced approach, and found that by giving applicants the chance to amend claims that don't meet the requirements for patentability before evaluating for eligibility, there were fewer rejections based on eligibility.

"We note that this approach in no way shortcuts or truncates examination under Section 101, and the eligibility analysis sequenced this way would be every bit as thorough as under present practice — just conducted at a point in the examination process where it can be conducted effectively," the senators wrote.

The USPTO has been asked to give a response by April 20.

The letter comes as Tillis has promised to focus more on patent eligibility by bringing it up when confirming former USPTO Andrei Iancu's replacement and by filing [amicus briefs](#) at the [U.S. Supreme Court](#).

"Our patent eligibility jurisprudence is in shambles," Tillis said at a [January event](#). "The fact that we have courts saying a [garage door opener](#) is an abstract idea and that innovative [diagnostic tests](#) are just laws of nature is bewildering to me. If we do not provide great clarity and consistency in this area of law, America will lose the 21st century innovation race."

--Additional reporting by Dani Kass. Editing by Michael Watanabe.