

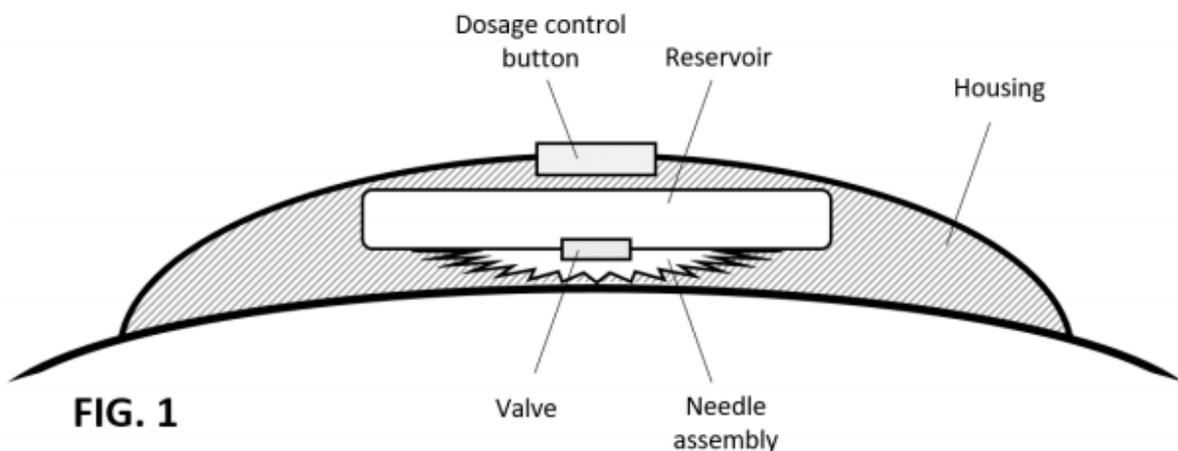
PTO Guidance: Bridging the Swamp

October 18, 2019 /Dennis Crouch

I recently posted a short statement on the new USPTO Eligibility Guidance. I want to make sure that readers spend some time delving into Appendix 1 of the report that includes four very-well written examples of how the guidance should be applied by PTO examiners.

- 43. Treating Kidney Disease
- 44. Denveric Acid
- 45. Controller For Injection Mold
- 46. Livestock Management

Note – these are numbered from 43 as a continuation of prior sets of examples released by the PTO. Each example provides a broadly written claim 1 that is deemed ineligible followed by a set of narrower eligible claims. The examples provide straightforward analysis of how to get from the claims (and specification) to those answers.



Anyone deep in the case-law will understand that the PTO's approach does not match tightly with all of the cases. That would be a philosophical endeavor without much attachment to reality. What you get here from Dir. Iancu, Comm. Hirshfeld, and their team is guidance that PTO examiners can actually follow. Rather than asking

examiners to put on their boots and wade through the swamp, the guidance builds a nice straight bridge right over top. This is the right approach — examiner expertise is prior art and claim definiteness, not whether an invention would be unduly preemptive of freedoms held by all humanity. Now, we can debate on whether the bridge should be veering right vs left — this one certainly favors patentees. But, there is a lot to be said for a clear-pathway even if it leads a bit off center.

Speaking of swamp-walking. I do want examiners to get dirty with their work — but expertise is the swamp known as finding and analyzing the best prior art, not answering amorphous questions of law.

[Read the Examples]