



Tillis and Cotton Urge Hirshfeld to Adopt Pilot Program to Address ‘Inherently Vague and Subjective’ Eligibility Analyses

By Logan Murr / March 23, 2021

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Senators Tillis and Cotton letter

Senators Thom Tillis (R-NC) and Tom Cotton (R-AR) sent a letter on Monday to the acting Director of the United States Patent and Trademark Office (USPTO), Drew Hirshfeld, asking him to “initiate a pilot program directing examiners to apply a sequenced approach to patent examination,” rather than the traditional “compact approach.” This proposed pilot program would require a select group of examiners and applicants who elected to participate in the program “to engage in a full examination of the grounds of patentability and then, once that process is complete, a full examination of the grounds of eligibility.”

Section 101 Scrutiny

The request to initiate the pilot program comes after a letter sent on March 5, 2021 by a bipartisan group of senators that requested Hirshfeld to “publish a request for information on the current patent eligibility jurisprudence in the United States,” and provide a detailed summary to the senators so that they could consider the appropriate legislative action to improve examination under Section 101. In both the March 5 letter and the most recent letter to Hirshfeld, the senators expressed their worry over Section 101 rejections stifling innovation. On March 5, the bipartisan group of senators noted that diagnostics, biopharmaceutical, and life

science industries are particularly disadvantaged by the current Section 101 examination process, and in the midst of a global pandemic no less.

In the letter sent Monday, Senators Tillis and Cotton stated their “concern is that by conducting an eligibility analysis as per current practice, patent examiners may be issuing Section 101 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 added:

By conducting an inherently vague and subjective analysis of eligibility early in the examination process, examiners may be spending inordinate time on Section 101 at a time when it is difficult or impossible to conduct a meaningful examination under Section 101, at the expense of the more rigorous analysis and precise and thoughtful work that can be conducted at the outset of examination under Sections 102, 103, and 112.

A ‘Sequenced Approach’

The senators recognized that, unlike Section 101, which lacks “clarity, consistency, and objectiveness,” the examination “under Sections 102, 103, and 112 is based on well-developed objective criteria under the law.” The senators’ stated their belief, which is based on discussions with prior USPTO officials, that when applications are examined, “by bringing claims into compliance with Sections 102, 103, and 112, examiners inevitably brought the claims into compliance with Section 101 as well.” Senators Tillis and Cotton provided Hirshfeld with three reasons why this “sequenced approach” to examination may improve the examiners’ operating model:

“First, it focuses initial examination on the objective areas of patentability as opposed to the abstract, vague, and subjective questions of eligibility, leaving

eligibility examination to a point in the process where it can be conducted much more efficiently.

Second, it improves efficiency by avoiding the waste of valuable examination and applicant time on vague questions of patent eligibility as a threshold matter.

Third, and finally, this process leads to stronger, more reliable, and higher quality patents by focusing first on the more rigorous and eas[ier] to identify standards of patentability.”

The senators emphasized that this new approach to examination would not diminish the examination of patent eligibility in any way, but rather, would allow that analysis to be conducted when it can be fully informed.

Measuring Success

Senators Tillis and Cotton set an April 20, 2021 deadline for Hirshfeld to decide whether to adopt the proposed pilot program. The senators also requested that the pilot program be conducted broadly enough so that a comparison may be made as to whether this proposed approach produces higher quality patents than the traditional compact examination approach. The senators noted that the proposed pilot program is part of a larger effort “aimed at improving the strength, predictability and reliability of our patent system.”

THE AUTHOR

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