

United States Senate
WASHINGTON, DC 20510

VIA ELECTRONIC TRANSMISSION

March 22, 2021

Mr. Drew Hirshfeld
Commissioner for Patents
Performing the functions and duties of the Director
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Dear Mr. Hirshfeld:

We write you today regarding the impact of current patent eligibility jurisprudence on the patent examination process. In particular, we believe there may be ways to modify the compact patent examination process to avoid unnecessary and inefficient rejections on grounds of patent eligibility, and in the process improve Patent and Trademark Office (PTO) effectiveness.

Our understanding is that under current procedures, examiners review the eligibility of a patent application under 35 U.S.C. Section 101 in conjunction with assessing the patentability of the claim under Sections 102, 103, and 112. Our 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.

As you know, examination under Sections 102, 103, and 112 is based on well-developed and objective criteria under the law. Unfortunately, current patent eligibility jurisprudence lacks the clarity, consistency, and objectiveness the other grounds of patentability possess. Our concern is that 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.

Based on our discussions with prior PTO officials, our understanding is that in years past some examiners sequenced their examinations of applications so that they first examined all grounds of patentability under Sections 102, 103, and 112, before examining for compliance with grounds of eligibility under Section 101. Under this approach, examiners would have applicants amend their claims to overcome rejections under the more objective standards of patentability before examining for 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. Our conversations with former officials suggest that for examiners using this sequenced approach, applicants rarely received a rejection on grounds of patent eligibility. This is because by bringing claims into compliance with Sections 102, 103, and 112, examiners inevitably brought the claims into compliance with Section 101 as well.

We believe this sequenced approach may improve the operating model used by examiners for a three reasons. 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 effectively. 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 easy to identify standards of patentability. And again, we stress that this approach does not diminish in any way the examination for patent eligibility – it simply conducts the eligibility analysis when it can be fully informed.

Accordingly, we ask that you initiate a pilot program directing examiners to apply a sequenced approach to patent examination. This pilot program would require selected examiners—and applicants who voluntarily elect to participate—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. Such a pilot program should conduct a thorough and reasonable number of examinations using this method and measure whether this approach is more effective, and produces higher quality patents, than the traditional compact examination approach.

Please let us know by April 20, 2021 if you will adopt such a pilot program. If you elect not to, please provide us with a detailed explanation of why you will not conduct the requested pilot program. We stand ready and willing to work with you on this, and other matters, aimed at improving the strength, predictability and reliability of our patent system. If you have any questions, please do not hesitate to contact us.

Sincerely,



Thom Tillis
United States Senator



Tom Cotton
United States Senator