USPTO Program Aims to Improve Eligibility Examination

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Have you been rejected by the U.S. Patent and Trademark Office because your invention is said to be ineligible for patent protection?

Have you forgone filing a patent application on a software or biotech invention because of eligibility concerns?

Drawing the line between an eligible and an ineligible invention in these areas of technology has become increasingly difficult in view of caselaw over the last 10 years. Some help may be on the way.

The USPTO recently released details of an upcoming pilot program that will test measures intended to ease the patent application process for applicants whose inventions encounter this particularly difficult type of rejection. The Deferred Subject Matter Eligibility Response (DSMER) Pilot Program is currently scheduled to begin on February 1 and, unless extended due to application data showing improved efficiency or positive feedback from stakeholders, will end on July 30.

To receive an invitation to participate in the pilot program, an applicant's patent application must be subject to a rejection stating that the claims of the invention lack subject matter eligibility. This type of rejection is not a consideration of whether the claimed invention is new, useful, or nonobvious, but rather is based on whether the invention claimed in the application is the type of subject matter that is permitted to be patented. U.S. law has long prohibited inventions claiming abstract ideas, laws of nature, and natural phenomena from receiving patents, largely out of a concern that such patents could be so overbroad as to impede instead of promoting innovation. Over the last decade, however, what is considered to fall within these categories of ineligible subject matter has expanded and seeped into some of the most cutting-edge areas of modern technology, particularly software and biotechnology. Case law and other official guidance attempting to delineate eligible subject matter from the ineligible has left an uncertain standard, raising subject matter eligibility concerns to the forefront of debate in patent law as private practitioners and judges seek clarification on the boundaries.

The DSMER Pilot Program is a step intended to alleviate some of the difficulties encountered by applicants with inventions in these technological areas. If the applicant elects to enter the program after receiving a first action from the USPTO that includes a subject matter eligibility rejection, the eligibility rejection is deferred until all other rejections are resolved. The applicant's response to the first office action can then focus exclusively on addressing all other presented issues, such as a lack of novelty, a contention of obviousness, or concerns with the disclosure. The applicant choosing to enter the program would still need to overcome the hurdle posed by the subject matter eligibility rejection to receive a patent but can wait to address it until all other issues are withdrawn by the USPTO or otherwise removed.

The alternate procedure proposed by the DSMER Pilot Program results in a patent application process that,

interestingly, is somewhat the opposite of the "compact prosecution" policy that led to significant improvement in efficiency and quality at the USPTO. Examiners at the USPTO are encouraged to present all possible issues in as complete detail as possible in the first office action. This allows the applicant to respond to all these issues in the first response, more "compactly" advancing prosecution of the application toward a conclusion than if the examiner were to present the various issues in successive office actions.

Despite shifting the subject matter eligibility issue to a later response, the efficiency theory behind the DSMER Pilot Program is grounded in the amendments and arguments made in the patent application to overcome the other issues. These measures taken by the applicant to avoid other rejections in the patent application may result in a claimed invention that ultimately overcomes the subject matter eligibility rejection. Essentially, if the applicant overcomes the subject matter eligibility rejection merely while addressing the other clearer issues raised in the application, then the examiner at the USPTO and the applicant have likely saved valuable time that would have been spent concurrently arguing over subject matter eligibility. Detractors of the program (who, it should be noted, can elect not to enter the program if presented with an invitation) will likely contend that the amendments and arguments made to address other issues are unlikely to solve the question of eligibility, and that the program merely delays a potentially decisive eligibility rejection until further along in the prosecution of the application.

The progress of the DSMER Pilot Program will be interesting to track in the coming months. The introduction of such a program hopefully signals more significant steps toward clarifying the murky waters of patent eligible subject matter encountered by some important areas of technology. The full notice on the DSMER from the USPTO in the Federal Register can be found here. If you have any questions about the DSMER Pilot Program or any other intellectual property questions, please contact Kevin Myhre, Sal Anastasi or any member of the Barley Snyder Intellectual Property Practice Group.

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