Tom Chen in Daily Journal: New Patent Office Guidelines Expected to Reduce Rejections

By Tom Chen | January 9, 2019

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Daily Journal quoted Haynes Boone Partner Tom Chen in an article about the impact of the U.S. Patent and Trademark Office's (USPTO's) new guidelines on patent cases, which include a new two-pronged inquiry in the first step of the Alice/Mayo test for determining whether a claim is subject to a judicial exception.

Here is an excerpt:

Director Andrei Iancu continues to shake things up at the U.S. Patent and Trademark Office, as new guidelines took effect Monday informing examiners how to determine when subject matter is ineligible for a patent in a move likely to reduce the number of rejections. …

"In the first prong," the document states, "examiners will evaluate whether the claim recites a judicial exception and if so, proceed to the second prong. In the second prong, examiners evaluate whether the claim recites additional elements that integrate the identified judicial exception into a practical application. If a claim both recites a judicial exception and fails to integrate that exception into a practical application, then the claim is 'directed to' a judicial exception. In such a case, further analysis pursuant to the second step of the Alice/Mayo test is required."

Orange County-based Haynes Boone Partner Tom Chen said the new two-pronged test "[likely] will have the effect of having less [Section] 101 rejections."

To read the full article, click here. (Subscription required)

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