

Adam Fowles in Law360: 4 Takeaways From the USPTO's Patent Eligibility Update

October 24, 2019 Adam Fowles

PRACTICES Patent Office Trials, Patents, Patent Prosecution and Counseling, Intellectual Property

Law360 quoted Haynes Boone Associate [Adam Fowles](#) in an article about the U.S. Patent and Trademark Office's (USPTO's) recent eligibility update on invention patents.

Here is an excerpt:

The update, unveiled last week, was designed to answer questions submitted in public comments about the office's broader overhaul of patent eligibility policy in January. While little of the update breaks ground, it does provide more clarity on a few issues, said Adam Fowles of Haynes Boone.

"Anything that makes it clearer or easier for patent applicants and the examining corps to get on the same page is a good thing and a positive step," he said. ...

The problem is that in some cases, examiners will look at claims and basically decide that in their view, the invention is just not something that is patent-eligible under Section 101 of the Patent Act, and the guidance may not be enough to always encourage them to write more thorough explanations.

For instance, the update said that while examiners are all expected to follow the guidance, it doesn't have the force of law, and their failure to follow it "is not, in itself, a proper basis for an appeal" to the Patent Trial and Appeal Board.

"It's certainly disappointing that's there no real recourse. If the examiner is not following these guidelines, there's no way to try to push them to do so," Fowles said. "It would have been nice to have this in a more codified fashion to have some teeth to push the examiners on."

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