

Kelvin Varghese in Law360: 'Delaying Eligibility at USPTO Seems to Have Limited Appeal'

August 4, 2022 Kelvin Varghese

PRACTICES Patents, Patent Prosecution and Counseling, Intellectual Property

[Kelvin Varghese](#), counsel in Haynes Boone's Intellectual Property Practice Group, was quoted in a *Law360* article. Read an excerpt below:

Only about one-third of patent applicants invited to take part in a pilot program allowing them to postpone dealing with patent eligibility rejections have accepted the offer, which attorneys say reflects a sense that doing so often has limited benefits, and can present risks. ...

The limited appeal may be due in part to the fact that participating in the program doesn't make patent eligibility issues go away — it only delays when they will need to be addressed, said Kelvin Varghese of Haynes Boone.

"It really is a kicking-the-can-down-the-road type of program, and maybe practitioners or applicants just weren't interested in a deferral, if they knew that they were going to have to deal with it anyway," he said.

In addition, Varghese noted that the program doesn't defer the issue for very long. Participants in the program can file one response seeking to overcome the eligibility rejection by addressing the other issues, but if they are unsuccessful, they have to address eligibility in their next response.

Therefore, the concern that postponing the issue might not have a substantial impact, along with worries about being a guinea pig for a new program, may have discouraged invitees, he said.

Still, Varghese said the confusing state of the law on what is patent-eligible can require applicants to make extensive arguments or amendments to address a rejection, so he thought more applicants would want to sidestep that.

The one-third acceptance rate "struck me as very low," he said. ...

Varghese said that may point to another reason why applicants opted out of the program.

It's possible that eligibility rejections that are still being made "are difficult ones that practitioners and applicants actually want to engage with early," he said. That can provide a sense of whether eligibility presents a potentially insurmountable obstacle, before sinking time and money into the application, he said. ...

Varghese said that "if a significant portion of the one-third that accepted are getting allowed and they're getting faster, I think that's a pretty good indication that you know that the benefits were real.

To read the full article from *Law360*, click [here](#).