

Vincent Shier Authors Law360 Article: 'Patent Eligibility Reform May Require a Legislative Approach'

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

Haynes Boone Partner Vincent Shier authored an article in *Law360*. Read an excerpt below:

On July 25, U.S. Patent and Trademark Office Director Kathi Vidal used the director's blog to explain that she will be revisiting the 2019 Subject Matter Eligibility Guidance and requested public comment.

Vidal recently issued a Federal Register notice acknowledging "overwhelming interest in this subject matter" and extended the period for providing comment to Oct. 15. In addition, the notice requires that any comments be submitted via the Federal eRulemaking Portal.

What does this mean?

The answer is, probably not much.

First, the director's blog outlines a case that the USPTO is generally providing a consistent result. At least in part, this position is based on a reduction in rejection rate as a mark of consistency.

The blog asserts certain statistics, including:

- Rejections based on eligibility grounds appear in 8% of all office actions compared to 80% being based on obviousness
- A reduction in eligibility rejection rate from about 25% in 2018 to about 8% today
- The 2019 guidance revision resulted in a 25% decrease in the likelihood of Alice-affected technologies receiving a first office action with a rejection for patent-ineligible subject matter
- Uncertainty about determinations of patent subject matter eligibility for the relevant technologies decreased by a 44% as compared to the previous year.

Although these statistics may be an indicator that the USPTO is consistently issuing fewer rejections, these statistics cannot reveal whether the USPTO is consistently applying the proper standard and/or consistently achieving the proper result.

This will only be apparent over time as the patents granted in the past few years come under additional scrutiny. Further, the guidance has not been significantly updated since 2019, yet case law surrounding patent eligibility has continued to evolve.

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