Comments of the Innovation Alliance in Response to the USPTO's Request for Comments Regarding the Patent Subject Matter Eligibility Guidance (Docket No. PTO-P-2022-0026)

October 15, 2022

The Innovation Alliance appreciates the opportunity to submit these comments in response to the Request for Comments (RFC) issued by the U.S. Patent and Trademark office (USPTO) regarding the USPTO's current patent eligibility guidance, specifically with regard to the 2019 Revised Patent Subject Matter Eligibility Guidance, the October 2019 Patent Eligibility Guidance Update, and the *Berkheimer* Memo.

The Innovation Alliance is a coalition of research and development-based technology companies representing innovators, patent owners, and stakeholders from a diverse range of industries that believes in the critical importance of maintaining a strong patent system that supports innovative enterprises of all sizes. The Innovation Alliance is committed to strengthening the U.S. patent system to promote innovation, economic growth, and job creation, and we support legislation and policies that help to achieve those goals.

The USPTO's current guidance on Section 101 has provided applicants with increased clarity and consistency. Any future revisions should be minor and build on what already exists. Since the Supreme Court has not responded to repeated requests to provide clarity in Section 101 law, there is little new case law warranting revisions to the guidance. To remedy this lack of clarity, Congress should pass patent eligibility legislation.

In our October 15, 2021 comments on patent eligibility jurisprudence, we stated that "the [Section 101] guidance from the USPTO has been helpful in providing more concrete direction to patent applicants," and we continue to strongly believe that is the case. As Director Vidal recently noted on the Director's Blog, the recent guidance provided in the 2019 Revised Patent Subject Matter Eligibility Guidance, the October 2019 Patent Eligibility Guidance Update, and the *Berkheimer* Memo "ha[ve] gone a long way toward providing consistent decision-making" at the USPTO, producing "a remarkable drop in the corps-wide eligibility rejection rate from about 25% in 2018 to about 8% today."[1] Indeed, the USPTO's "*Adjusting to Alice*" report "found that the 2019 revisions to [USPTO] eligibility guidance 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" and that "uncertainty about determinations of patent subject matter eligibility for the relevant technologies decreased by a remarkable 44% as compared to the previous year."[2]

---

[1] https://www.uspto.gov/subscription-center/2022/providing-clear-guidance-patent-subject-matter-eligibility

[2] *Id.*

As the USPTO's reports show, the Office's current guidance has given inventors and their patent counsel the clarity they need to submit applications that are in conformity with the requirements of Section 101, despite the confusing nature of the current jurisprudence. And the guidance also appears to have greatly assisted examiners as well—the USPTO's quality metrics show that examiners issued office actions that were compliant under Section 101 98.3% of the time in 2021—the highest percentage of any of the statutory sections examined.[3] It is indeed clear from the recent data that these updates to the USPTO guidance have resulted in the Office issuing patents that are robust and reliable, and the Office should be proud of, and applauded for, that achievement.

Director Vidal's blog post stated that "there is more work to be done" on Section 101 guidance, despite the progress achieved by the recent updates. Any such work should be minimal and should build on, rather than replace, the changes brought about by these recent updates. Specifically, the multi-step framework laid out in the current guidance, along with the accompanying flow charts and groupings of abstract ideas, have led to increased clarity and certainty in 101 decisions and should be left intact with only minor, if any, revisions.

To be sure, there is a significant amount of work to be done on Section 101, but the USPTO's patent eligibility guidance is not the place where that work can—or should—be done. As the Supreme Court has ignored repeated calls to fix the ambiguities its prior decisions have inserted into patent-eligibility law, it falls to Congress to restore clarity to the law around Section 101, and the Innovation Alliance applauds Senator Tillis on the introduction of the Patent Eligibility and Restoration Act of 2022.[4] But the USPTO has already done nearly all that it can to provide clarity and predictability under the current 101 jurisprudence, and the Office should not make significant changes in response to the Supreme Court's inaction.

As we noted in our prior comments on Section 101 jurisprudence, patent eligibility law has significant effects on innovation in key technology areas, including areas that implicate national security and U.S. technology leadership. The recent updates to the USPTO's patent eligibility guidance have been a welcome step in the right direction in an area of the law that has otherwise been detrimental to the country's innovation economy. We therefore urge that the USPTO take a minimalist approach when updating the guidance and avoid undermining the clarity and consistency that the recent updates have provided.

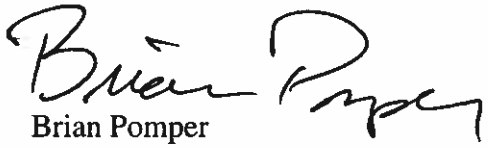
* * *

[3] https://www.uspto.gov/patents/quality-metrics

[4] https://innovationalliance.net/from-the-alliance/innovation-alliance-statement-on-the-patent-eligibility-restoration-act-of-2022/

We appreciate the opportunity to comment on these issues and would welcome the opportunity to discuss them further.

Respectfully submitted,



Brian Pomper
Executive Director
Innovation Alliance