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I am a registered patent attorney with nearly twenty years of experience. The majority of my practice is directed to preparing and prosecuting patent applications before the U.S. Patent Office.

As part of my practice, I frequently encounter and respond to subject matter eligibility rejections. In my experience, the applicability of these subject matter eligibility rejections and the accuracy of these subject matter eligibility rejections varies so greatly from patent examiner to patent examiner that is has become extremely difficult to advise clients on the prospects of their claimed inventions being deemed subject matter eligible by the U.S. Patent Office until after their patent applications are assigned to an examiner. That is, while I advise clients on the current state of the law pertaining to subject matter eligibility prior to filing a patent application (and, as warranted, advise against filing patent applications based on this current state of the law), the reality is that different sets of examiners (even within the same art unit whom report to the same SPE) have vastly different viewpoints on the current state of the law pertaining to subject matter eligibility. To that end, I've even been told by a SPE that they viewed themselves "as a §101 hardliner" which only evidences the subjectivity that certain leadership within the U.S. Patent Office have infused into this already unsettled area of the law.

Far too often, I find that which examiner an application is assigned to (which only occurs after clients have dedicated resources to prepare and file an application) often single-handedly determines the fate of an application. This systemic inconsistency of subject matter eligibility rejections amongst different sets of examiners has created a situation where the subject matter eligibility goalposts are frequently moved based solely on which examiner's docket a patent application winds up on. While some level of subjectivity by different examiners is to be expected (e.g., one examiner once commented to me that he felt sorry for applicants because they encounter hundreds of different U.S. Patent Offices as each of hundreds of different examiners have different nuanced standards for making an obviousness rejection), the divide between different examiners viewpoints on subject matter eligibility has become far too great and needs to be addressed.

Please note that these comments are my personal opinions, and are not made on behalf of my law firm, Neal, Gerber & Eisenberg LLP, and/or any past or present client of Neal, Gerber & Eisenberg LLP.

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