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Question 2.a in section I asked for observations on the impact of subject matter eligibility jurisprudence on patent prosecution and portfolio management. My observation is that subject matter eligibility jurisprudence has significantly increased the cost and time associated with patent prosecution, and has shifted the focus of patent prosecution away from innovation and to arguing about counter-intuitive and constantly shifting legal rules. A good illustration of this is the office action response filed on October 19, 2020 on application 16/189,334. In that response, the applicant devoted only three pages to obviousness, and 15 pages to subject matter eligibility, using the USPTO's 2019 Patent Eligibility Guidance, subsequent October Memorandum[3] and a 2019 Patent Trial and Appeal Board decision in Ex parte Smith, as well as drawing multiple comparisons between the claimed invention and examples provided in USPTO training materials. This disproportionate focus illustrates how current subject matter eligibility jurisprudence can make technical innovation take a back seat to legal argumentation during patent prosecution. Ironically, this appears to be the exact opposite of the effect sought by the U.S. Supreme Court in Alice v. CLS Bank, in which the court espoused the policy that patent eligibility should not depend on "the draftsman's art."

Question 13 in section II asked for identification of how the current state of subject matter eligibility jurisprudence affects the public. One very significant impact of current subject matter eligibility jurisprudence is that it alienates inventors and entrepreneurs from the patent system. While inventors may have a reasonable understanding of traditional patent requirements such as non-obviousness and the need for a sufficient disclosure, subject matter eligibility
jurisprudence is much more counterintuitive and ambiguous. This means that it is more difficult for inventors to understand the rules for obtaining patent protection, and so the availability of such protection is much less likely to provide an incentive for innovators to develop and disclose their ideas. Similarly, it becomes more difficult for competitors to predict which patents are valid and enforceable against their products. In general, because subject matter eligibility adds on a layer of complexity that is difficult even for attorneys to understand, it has the net effect of making the patent system more costly and opaque for everyone who interacts with it. If one accepts the premise that the patent system has a role in driving innovation by providing incentives to inventors, technology companies, and technology investors, one must also conclude

that a patent eligibility jurisprudence that makes the patent system more costly and less predictable will drive up costs and decrease product innovation and availability.

The statements and views expressed in this comment are my own and do not reflect those of my law firm, are intended for general informational purposes only, and do not constitute legal advice or a legal opinion.

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