

February 12, 2016

U.S. Patent and Trademark Office  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Office of Deputy Commissioner for Patent Examination Policy  
Office of Patent Legal Administration  
*Attn: Michael Cygan*  
*Senior Legal Advisor*

*Via email* [TopicSubmissionForCaseStudies@uspto.gov](mailto:TopicSubmissionForCaseStudies@uspto.gov)

**Re: AIPLA Comments on Submission of Topics for USPTO Quality Case Studies 80 Fed. Reg. 79277 (December 21, 2015)**

Dear Mr. Cygan:

The American Intellectual Property Law Association (“AIPLA”) is pleased to present the following comments to the USPTO Request for Submission of Topics for USPTO Quality Case Studies, in response to an invitation for written comments. 80 Fed. Reg. 79277 (December 21, 2015).

AIPLA is a national bar association of approximately 14,000 members who are primarily lawyers engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

***Title: Consistency in rejections under 35 U.S.C. § 101***

***Proposal for study:*** AIPLA proposes a study to review rejections under 35 U.S.C. § 101 across art units for consistent application of USPTO Guidance on Subject Matter Eligibility. Our members have noted that different art units handle rejections under 35 U.S.C. § 101 differently. We believe that some examiners apply the Guidance as it was intended by viewing the examples and discussion while others look for a particular characteristic, such as a computer being used in an unconventional manner, in issuing rejections. Some of our members have noted that the difference in the way these rejections are handled has led applicants to draft applications to be less likely to be assigned to art units that they have found to apply the Guidance inconsistently.

***Explanation:*** The USPTO should identify applications receiving § 101 rejections across different art units and compare the rejections to ensure that a consistent methodology complying with the Guidance is applied across all of the art units. The outcome should result in more consistent, uniform application of §101 Guidance, resulting in more applicant satisfaction when § 101 is applied evenly to all applications.

AIPLA appreciates the opportunity to propose case studies to improve the quality of examination and, thus, to improve the quality of issued patents. We look forward to working with the Office in the implementation of these or any other case studies.

Respectfully Submitted,



Denise W. DeFranco

President

American Intellectual Property Law Association