

**New England Intellectual Property, LLC**  
291 Main Street  
West Newbury, MA 01985  
978-363-1700

March 4, 2019

Andrei Iancu  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
[Eligibility2019@uspto.gov](mailto:Eligibility2019@uspto.gov)  
United States Patent and Trademark Office (USPTO)  
U.S. Department of Commerce

**Re: Comments on 2019 Revised Subject Matter Eligibility Guidance**

Dear Under Secretary Iancu:

New England Intellectual Property would like to support the 2019 Revised Subject Matter Eligibility Guidance, as published in the Federal Register on January 7, 2019. This Guidance provides much needed clarity on patent subject matter eligibility.

The law surrounding 35 U.S.C. § 101 has been in a state of flux for the past decade, with numerous contradictory rulings and a lack of clarity. Federal Circuit Judges Lourie and Newman, in a concurring decision denying the rehearing of the *Berkheimer* decision, stated “I believe the law needs clarification by higher authority, perhaps by Congress, to work its way out of what so many in the innovation field consider are § 101 problems. Individual cases, whether heard by this court or the Supreme Court, are imperfect vehicles for enunciating broad principles because they are limited to the facts presented. Section 101 issues certainly require attention beyond the power of this court.” *Berkheimer v HP*, No. 2017-1437, 2018 WL 2437154 (Fed. Cir. May 31, 2018)

United States Patent and Trademark Office Director Andrei Iancu, in a speech to the U.S. Chamber of Commerce Patent Policy Conference on April 11, 2018, stated that “[f]irst, our current law surrounding patentable subject matter has created a more unpredictable patent landscape that is hurting innovation and, consequently, investment and job creation. Recent cases from the Supreme

Court – *Mayo*, *Myriad*, and *Alice* – have inserted standards into our interpretation of the statute that are difficult to follow. Lower courts applying these cases are struggling to issue consistent results. . . . The current standards are difficult for all: stakeholders, courts, examiners, practitioners, and investors alike.”

As patent practitioners and inventors, we have experienced the lack of clarity and predictability surrounding patent eligibility. As a result, we welcome the USPTO’s efforts to bring certainty, at least at the Patent Office, with regards to subject matter eligibility.

As an administrative agency of the Executive Branch of the US Government, the USPTO has the authority, under the Administrative Procedure Act, to instruct its employees on how to interpret confusing case law. We welcome the Office’s assertion of its authority by instructing its employees how to make decisions regarding patent eligibility.

The Guidance is particularly useful to the tens of thousands of patent examiners, inventors, entrepreneurs and patent practitioners who do not have law degrees and struggle with a body of case law that even the Federal Circuit have difficulty sorting through. The Guidance allows examiners and practitioners to return to the MPEP and the Guidance for patent prosecution, simplifying office actions and responses by removing lengthy citations to case law, and instead examining on the technical merits of the patent claims.

Thank you for the opportunity to comment on the Guidance, and thank you for the Office’s leadership in patent policy.

Sincerely,

A handwritten signature in blue ink, appearing to read 'R. Baker', with a stylized flourish at the end.

Richard Baker  
President of New England Intellectual Property, LLC