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Subject: 2019 Revised Patent Subject Matter Eligibility Guidance

Dear USPTO

And Ms. Nicole D. Haines, Senior Legal Advisor, and Mr. Jeffrey R. West, Senior Senior Legal Advisor
2019 Revised Patent Subject Matter Eligibility Guidance

Concerning applications filed with the USPTO before 7.1.2019 and active. Falling under the new guideline.

In an office reply made before the 7.1.2019 where a 101 rejection has been made. Where the application is in a non-final or a final action. It is impossible for the applicant to address all adverse determines made by the examiner.

When the applicant is replying to such an action or considering the next action that action is not based or up to date with the new guidelines put in place by the USPTO.

As the applicant in her next action or reply must address all adverse determines made by the examiner regardless of whether the 101 is correct or not correct. The applicant cannot perform this as the examiner reply is not based on the guideline. Replying to arguments based on old guidelines is thus not correct.

In the next action the examiner can enter a decision based upon the new guidelines resulting in a final action or another decision. This would be incorrect as the applicant has not been able to reply or maybe unable to reply if a final action is entered.

A new examination should be made where the examiner provides a reply based upon the new guidelines which then can be properly addresses by the applicant. This examination should be made as an extra examination not affecting the current state of the application. Especially as this change, albeit a good one, is due to USPTO action.

In a third case an office reply may not mention 101 at all or a 101 case may have been removed. In the next step a 101 rejection could be entered based upon the new guideline. At this stage the action may be non-final, but it may also be final making a reply difficult.

All these actions may result in more costs or in the worst case a final action without proper chance

for argumentation by the applicant.

The bottom line is that it is impossible to address arguments that are not present or that should be present. And actions that may have not been entered at all under the new guidelines. This can result in considerable financial or other expense.

The USPTO should provide for a reexamination or an extra step in examination procedure that creates allowance for this new guideline.?

Mr. Bremer

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