

Jan 4th, 2019

To: Director Iancu

From: Stakeholder

Thank you for the opportunity to submit comments regarding the just released and very welcome *2019 Revised Patent Subject Matter Eligibility Guidance*. The guidance (p.7) states:

“Rejections will continue to be based upon the substantive law, and it is those rejections that are appealable to the Patent Trial and Appeal Board (PTAB) and the courts. All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance. Failure of USPTO personnel to follow the guidance, however, is not, in itself, a proper basis for either an appeal or a petition.”

Which raises these very important questions:

1. Does “All USPTO personnel” include the APJs? Or just everyone (including the Examiners and their SPEs) *but* the APJs?
2. If the new guidance *does include* the APJs (as it should), how can the failure of such (other) personnel (e.g. Examiners, SPEs) to follow the guidance *not be* a proper basis for an appeal or petition? (And relatedly, does “appeal” as used here refer to only Board appeals?)
3. If the failure of “non-APJs” to follow the new guidance cannot be the basis of a Board appeal, doesn’t this also mean that an intransigent Examiner who refuses to follow the guidance can continue to 101-reject claims knowing that the patent applicant *cannot appeal* to the Board based on such failure to follow the guidance? (Or that if s/he does appeal, that the Board *will not* reverse the rejection/s based on such failure by the Examiner to follow the guidance)?
4. If, “All USPTO personnel” *does not* include APJs, what good do appeals to the Board provide for all those inventors, companies, and their counsel who have been waiting anxiously to file their briefs until this new guidance came out, since — seemingly from the above verbiage — this new guidance cannot be relied upon in current — or future — appeals?
5. Respectfully, if the APJs *aren’t* subject to the same guidance as the non-APJs (e.g., Examiners) are, wouldn’t this apparent guidance applicability divergence be in tension with recent statements confirming that the Patent Office is one agency?

Thank you,
Stakeholder