



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

April 20, 2021

The Honorable Thom Tillis
United States Senate
Washington, D.C. 20510

The Honorable Tom Cotton
United States Senate
Washington, D.C. 20510

Dear Senators Tillis and Cotton:

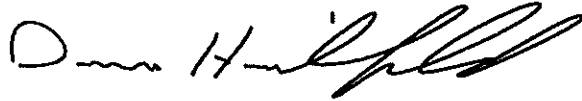
Thank you for your letter of March 22, 2021 regarding the establishment of a pilot program on sequenced patent examination and eligibility determinations made pursuant to 35 U.S.C. § 101. I sincerely appreciate your thoughtful feedback on how the U.S. Patent and Trademark Office (USPTO) can improve its operations and policies to better serve the intellectual property (IP) community.

By way of background, the USPTO reviewed a recent sample of office actions to determine the prevalence of section 101 rejections. Our review revealed that only 6.5% of all patent applications include a section 101 rejection. This percentage is down from 15.5% before the release of the patent examiner subject matter eligibility guidance in 2019. The percentage of section 101 rejections is, of course, not evenly distributed as some technology areas will have a greater number of such rejections than other areas.

In response to your request, the USPTO is planning a pilot program on sequenced examination to evaluate the potential for prosecution efficiencies. While the specific contours of the pilot program are still being finalized, the program would be entirely voluntary. We will also put in safeguards to limit extending prosecution, should there be situations where sequenced examination does not obviate a 101 rejection.

Again, thank you for your thoughtful recommendation and your continued commitment to a strong IP system. We will keep you and your staff apprised of our progress in developing and implementing this new pilot program.

Sincerely,

A handwritten signature in black ink, appearing to read "Andrew Hirshfeld". The signature is fluid and cursive, with a large initial "A" and "H".

Andrew Hirshfeld
Performing the Functions and Duties of the
Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent
and Trademark Office