



Will Change in USPTO Leadership Bring Change to Patentability Issues?

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With the recent arrival of Andrei Iancu as the new United States Patent and Trademark (USPTO) Director, careful optimism has slowly begun to replace a gloomy outlook on what have been challenging years in the wake of a number of Supreme Court decisions. Director Iancu already has issued two noteworthy “pro patent” memos described below to the examiners especially in the area of patentable subject matter.

While many patent examiners rejected claims as unpatentable by applying the Supreme Court decisions in a rather general manner as being solely directed to an “abstract idea” or “natural phenomenon,” the memos provide a welcome sharpening of focus to the two-step analysis required to determine patentable subject matter.

Pursuant to the *Vanda* memo, dealing with the first step of the analysis (“Is the claim directed to a law of nature, a natural phenomenon, or an abstract idea?”), the examiners should **now** evaluate **claim as a whole** in the determination whether or not the claim is “directed to” a judicial exception. The Federal Circuit held that the claims at issue in *Vanda* were indeed patent eligible because they were not simply directed to a judicial exception (the correlation between a specific drug dosage and an adverse effect of the drug was held to be a natural phenomenon), but to an **application of a natural phenomenon**. Now, the memo makes clear that method of treatment claims can be patent eligible, which is of particular importance in the field of personalized medicine.

Pursuant to the *Berkheimer* memo, dealing with the second step of the analysis (“Is any element, or combination of elements, in the claim sufficient to ensure that the claim as a whole amounts to significantly more than the judicial exception?”), when determining whether something is well-understood, routine, and conventional, the examiners must

make a **factual determination**, and must use an express framework to make such determination.

These memos should greatly improve predictability and confidence in the patenting process in the tech and medical sector. Indeed, this year the USPTO granted its 10,000,000th patent, and under new guidance and leadership, we will reach 11,000,000 patents in the not too distant future.

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