

International reports

New USPTO director: predictability!

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The overriding need for predictability in the US patent system is the focus of the new US Patent and Trademark Office (USPTO) Director Andrei Iancu.

On March 22 2018 Iancu spoke to the Patent Trial and Appeal Board (PTAB) Bar Association Annual Conference in Washington DC. He articulated the critical relationship between:

- economic growth;
- innovation; and
- protecting innovation through appropriate IP rights.

Iancu identified several ways that the USPTO could improve certainty during the patent examination process. He intends to encourage investment in innovation by greatly enhancing the degree of certainty surrounding patent validity and clarifying boundaries on those rights for those who attempt to 'invent around' technologies: "For the whole system to work, we all need to know whether the rights are good rights and what the boundaries of those rights are."

The USPTO could improve certainty by ensuring that prior art searches produce the most relevant information. Iancu held that in recent years, the prior art references cited during the application stage simply omitted critically relevant ones which litigation somehow generates. In his opinion, the upsurge and accessibility of publications has contributed to this discrepancy.

Iancu also highlighted the uncertainty over patent eligibility under Section 101 of the Patent Act following the Supreme Court's 2013 ruling that computer-implemented abstract ideas are unpatentable. While the USPTO occasionally issues guidance on Section 101, typically in response to court rulings, Iancu suggested that there may be room for more forward-thinking guidance from the agency about where to draw the lines of patent eligibility.

Further, Iancu addressed the need for consistency in PTAB decisions relating to issues arising under the America Invents Act. He wishes to update the PTAB's rules of practice and the process for patent owners to amend patent claims in America Invents Act reviews following the Federal Circuit's rejection of a USPTO rule requiring patent owners to show that proposed claims are patentable.

Iancu noted that "you want to have consistency, you want to have predictability of process so that people have faith in the process".

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