A BRIEF POST ABOUT USPTO EVENTS

October 19, 2016

The United States Patent and Trademark Office regularly holds events targeted all the various stakeholders it serves — inventors, startups, big companies, attorneys, trademark owners, etc. The events are all listed on the USPTO website, at https://www.uspto.gov/about-us/events.

One event that all inventors should absolutely consider attending is a regional roundtable related to patent subject matter eligibility. Among the patent community, this is sometimes referenced as "101", "Alice", "Mayo", and sometimes "Bilski". The bottom line, though, is that the Supreme Court has issued a series of decisions that created a gigantic gray area in patent law — and that gray area is the answer to this question: "Even if my invention is novel, useful, and not obvious, is it eligible for a patent?"

The impact on patents has been profound. When combined with the new post-grant review procedures that make it easier to challenge a patent and much more expensive to defend a patent (in large part by allowing administrative review that does not use the presumption of validity that courts apply), we are left with a situation that can be illustrated using a housing analogy. Imagine that I have a fantastic house listed for sale. However, the fine print says "there is no longer a presumption that the deed to this house is valid; the deed can be challenged at any time by anybody, and it will cost you at least $300,000 to defend; no title insurance is available; you are purchasing this as-is."

There are reports that patent values are down as much as 90% to 95% in certain art areas, and a lot of anecdotal experience showing that patents are far more difficult to license or sell than the used to be.

While subject matter eligibility is just a piece of the problem, it is an important piece. I strong recommend attending one of the roundtables and letting your voice be heard as to what should be patentable. If you apply by November 14, 2016, you can ask to speak at the event.