



Jan 11, 2022

Categories:

[Publications](#)

Authors:

[William S. Morriss](#)

New PTO Pilot for Deferring Prosecution of Eligibility Issues

On January 6, the patent office announced a [new pilot program](#) under which some applicants could reduce costs by focusing patent prosecution on questions such as whether their inventions are innovative and properly described, while deferring discussion of vaguer issues such as whether the inventions are too abstract or are not significantly more than a natural phenomenon. The program was spurred by a [letter](#) from Senators Thom Tillis and Tom Cotton which noted that whether an invention is innovative and properly described are “based on well-developed and objective criteria under the law,” while eligibility questions such as abstractness are “inherently vague and subjective.” The letter also notes that when examiners were allowed to defer consideration of eligibility, they would generally not issue an eligibility rejection at all, because “bringing claims into compliance with Sections 102, 103, and 112 [i.e., innovation and description], examiners inevitably brought the claims into compliance with Section 101 [eligibility] as well.”

Under the new pilot, if an application was rejected both due to subject matter eligibility and other issues such as innovativeness, the applicant could be invited to defer treatment of the eligibility rejections until either the other issues had been resolved or the application received a final rejection. At that point, if there were any subject matter eligibility issues remaining, the applicant could address them using the same tools that are available as part of standard prosecution, such as filing an appeal or request for continued examination.

While the program has the potential to simplify prosecution, there are also drawbacks, and an applicant who is invited to participate should carefully consider their specific circumstances before deciding whether to defer treatment of eligibility issues. In the best case, an applicant can obtain a patent without having to address the eligibility rejections at all – i.e., essentially the scenario envisioned by Senators Cotton and Tillis’ original letter. However, it is also possible that an applicant who defers treatment of eligibility

will find himself or herself facing a final rejection without the benefit of knowing how the examiner will respond to the applicant's arguments or amendments on the eligibility issue. Accordingly, while there are potential benefits, for some applicants those potential benefits may be outweighed by the program's costs.

For further information, please contact [William Morriss](#) or any other member of Frost Brown Todd's [Intellectual Property](#) practice group.

© 2026 FBT Gibbons LLP. May be considered attorney advertising in some jurisdictions.