AIPPI · JAPAN

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International Association for the Protection of Intellectual Property of Japan

October 28, 2015

United States Patent and
Trademark Office

Re: Comments on "July 2015 Update on Subject Matter Eligibility"

Dear Sirs,

The Japanese Group of AIPPI (AIPPI Japan) appreciates the opportunity to offer comments regarding "July 2015 Update on subject Matter Eligibility".

AIPPI Japan is the local group in Japan of AIPPI, The International Association for the Protection of Intellectual Property, which has more than 9,000 members worldwide. The Japanese group was founded in 1956 and currently has about 1,100 members (approximately 900 individuals and 200 corporate members). It is the largest national/regional group of AIPPI. Its members include patent attorneys, lawyers and other patent practitioners in private and corporate practice, and in the academic community. AIPPI Japan represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property.

Our comments are attached hereto.

Very truly yours,

Kenichi NAGASAWA
President
The Japanese Group of AIPPI

Comments of the Japanese Group of AIPPI (AIPPI Japan) on *July 2015 Update: Subject Matter Eligibility*

1. Section III "Further Information on Identifying Abstract Ideas in Step 2A" of the *July 2015 Update* presents concepts that have previously been found to be abstract ideas by courts in the form of generic key phrases, and indicates that, in Step 2A, a claimed concept that is *similar to* at least one of these concepts is determined to be an abstract idea. The key phrases include *comparing information regarding a sample or test subject to a control or target data* and *collecting and comparing known information*. Presentation of such key phrases, which are also published in the *Quick Reference Sheet*, may prove convenient for examiners in carrying out examination, particularly in terms of efficiency. However, there is a concern that abstract ideas could be applied extremely broadly if examiners make determinations by relying on these generic key phrases alone without sufficiently understanding the contents of the underlying court decisions. In addition, the phrase *similar to* is ambiguous, and allows for an even broader interpretation. Consequently, there will be a risk of many software-related claims being easily determined to be abstract ideas. If a claim is determined to be an abstract idea, an applicant will need to go through Step 2B, and must bear a heavier burden. We request the United States Patent and Trademark Office (USPTO) to address such concern and consider a practice to prevent examiners from easily finding claims to be abstract ideas. At least, we would like the USPTO to further enhance its education and training of examiners on the detailed contents of relevant court decisions.

2. Paragraph 2 of Section IV "Requirements Of A *Prima Facie* Case" sets forth that, when making an eligibility rejection, the examiner should meet his/her burden of proof by providing a *reasoned rationale* in the determination in Steps 2A and 2B. More specifically, the examiner is to identify the judicial exception recited in the claim and explain why it is considered an exception, and also identify the additional elements in the claim (if any) and explain why they do not amount to significantly more than the exception. We welcome this clarification that the examiner must clearly present the rationale for his/her determination of eligibility in an Office action.

   On the other hand, paragraph 3 onward gives examples of how courts make determinations in legal proceedings, and emphasizes that the determination of

eligibility is a *question of law*, and there is no need to present any underlying *evidence* or *factual findings*. It sets forth as follows: when making a determination on a judicial exception in Step 2A, it is sufficient to compare claimed concepts to prior court decisions, as has been done by the Supreme Court and the Federal Circuit; for Step 2B, examiners should rely on *what the courts have recognized*, or *those in the art would recognize*, as elements that are well-understood, routine and conventional, when determining that additional elements do not amount to significantly more because they are well-understood, routine and conventional; and *a rejection should only be made if an examiner relying on his or her expertise in the art can readily conclude that the additional elements do not amount to significantly more* without having to produce evidence (in the last paragraph of the Section). However, there is no guidance as to how examiners should identify and apply *what those in the art would recognize*. Moreover, there is no guidance nor standard as to how the *examiner's own expertise* should specifically be applied. Further, a statement to the effect that evidence is not required could mislead some examiners to understand that there is no need to present grounds or reasons for determination. We are concerned that this could lead to frequent issuance of Office actions subjectively stating that the claims do not amount to significantly more than an exception, without indicating a clear reason for such determination.

As one way to address such a concern, we propose that the following point be mentioned again in the last paragraph of Section IV, so as to at least enable an applicant to rebut effectively: when an examiner determines that a claim does not amount to significantly more than an exception in the Step 2B inquiry, even if he/she has relied on what those in the art would recognize or on his/her own expertise without producing evidence, the examiner is obliged to clearly present the *reasoned rationale* used for deriving the conclusion (as mentioned in paragraph 2 of the Section).