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March 16, 2015

The Honorable Michelle K. Lee  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
United States Patent and Trademark Office  
Alexandria, Virginia  
(2014\_interim\_guidance@uspto.gov)

Re: Comments on 2014 Interim Guidance on Patent Subject Matter Eligibility

Dear Under Secretary Lee:

The Japan Patent Attorney Association (JPAA) was established under the Patent Attorneys Act in Japan in May of 1915, and it is the sole professional bar association of patent attorneys in Japan. At present, the JPAA has about 10,000 members practicing in intellectual property law in Japan. Its members practice in all areas of intellectual property law including patent, trademark and design law as well as copyright and unfair competition.

The JPAA would like to submit comments on the 2014 Interim Guidance on Patent Subject Matter Eligibility.

### **1. Appreciation for Opportunities to Comment on the Guidance**

We sincerely appreciate that the comments from many parties concerned, including the Japan Patent Attorneys Association, on the previous guidance, "2014 Procedure for Subject Matter Eligibility Analysis of Claims Reciting or Involving Laws of Nature/Natural Principles, Natural Phenomena, and/or Natural Products," (hereinafter referred to as the "previous guidance") were well considered and reflected in the revised guidance, "2014 Interim Guidance on Patent Subject Matter Eligibility" (hereinafter referred to as "2014 Interim Guidance"). Moreover, we sincerely appreciate this opportunity to comment on the revised guidance "2014 Interim Guidance." In the following comments, we would like to focus mainly on the two major aspects of the "2014 Interim Guidance." One is "nature-based product" and the other is "abstract idea."

### **2. Comments relating to Nature-Based Product**

#### **a) Summary of Previous Comments from Japan Patent Attorneys Association and General Comments on 2014 Interim Guidance**

With respect to the previous guidance, the JPAA pointed out the following in our comments dated July 30, 2014.



<1> In consideration of the distinctiveness of the *Myriad* decision, the meanings of the decision should not be stretched to nature-based products other than DNA.

<2> The *Funk Brothers* decision cannot be used as a support for stretching the meanings of the *Myriad* decision to nature-based products other than DNA. In the *Funk Brothers* decision, the subject claims were invalidated as obvious.

<3> Not to allow naturally occurring products to possess patent eligibility entails the possibility that a claimed invention which is not known as being a naturally occurring product upon filing the application could be invalidated later, thereby lacking in legal stability.

<4> Global harmonization on patentability should be considered.

We are of the opinion that the 2014 Interim Guidance still may unfairly stretch the interpretation of the Supreme Court decision on the *Myriad* case to nature-based products other than DNA.

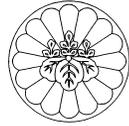
First of all, we have a concern that the Supreme Court decision on the *Myriad* case deviates from the criteria for patentability in many countries around the world including Japan because the decision unfairly restricts the scope of inventions subject to patenting, and the decision has a possibility of violating Article 27 of the TRIPS Agreement in terms of the exception of patent eligibility.

We, in spite of the above, acknowledge that the USPTO must be bound by the Supreme Court decision. However, even though judicial precedents in the U.S. including the Supreme Court decision on the *Myriad* case could be used as the criteria, the examination conducted in accordance with the 2014 Interim Guidance would provide a broader range of judicial exceptions over the range acknowledged by the judicial precedents, and would deny the extent of patent eligibility acknowledged by the judicial precedents. As pointed out in the comments on the previous guidance by many parties concerned, including the comments of October 14, 2014 by Biotechnology Industry Organizations, the Supreme Court has not made a final determination of whether or not nature-based products other than DNA are eligible when the nature-based products are newly found out, isolated and purified by the applicants. It is considered that such an examination according to the 2014 Interim Guidance would exceed the authority of the Administrative Agency.

By the reasons above, we respectfully submit that the USPTO should review whether it is truly appropriate to apply the 2014 Interim Guidance to nature-based products other than DNA and to appropriately allow nature-based products other than DNA to be patentable provided that nature-based products meet other patentability requirements such as 35 U.S.C. 102, 103, 112 and 101 and non-statutory double patenting.

#### **b) Suggestions on 2014 Interim Guidance"**

The 2014 Interim Guidance still has fundamental problems as mentioned



above.

However, even if we acknowledge the USPTO's position in which nature-based products themselves can be ineligible in certain cases, there are points to be reviewed in order to secure predictability of examination results when examinations on requirements under 35 U.S.C. 101 are conducted in accordance with the 2014 Interim Guidance.

(1) "Markedly Different Characteristic Analysis" in Step 2A should be renamed to "Product of Human Ingenuity Analysis." We believe that there is a possibility that "Markedly Different Characteristic Analysis" may be deemed to be an ill-defined and vague label which may precipitate misunderstanding of the important Supreme Court's holdings among the examiners. We respectfully submit that, with respect to nature-based products, "Product of Human Ingenuity Analysis" more accurately and appropriately reflects the holdings by the Supreme Court on patent eligibility.

When considering the patent eligibility of nature-based products, the central holding of the Supreme Court decision is in *Chakrabarty* and its discussion on eligibility under 35 U.S.C. 101 is as follows. His claim is not to a hitherto unknown natural phenomenon, but to a nonnaturally occurring manufacture or composition of matter – a product of human ingenuity "having a distinctive name, character [and] use." *Hartranft v. Wiegmann*, 121 U. S. 615 (1887) (*Diamond v. Chakrabarty*, 447 U. S. 303, 309-310 (1980)).

In the Supreme Court decision on the *Chakrabarty* case, upon determining the patent eligibility of the subject claims, the Supreme Court considered whether a product according to the subject claim falls within the range of "a nonnaturally occurring manufacture or composition of matter" in accordance with the statement under 35 U.S.C. 101. In this case, as the definition of "manufacture," the following definition was adapted.

*"the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties or combinations, whether by hand labor or machinery. American Fruit Growers, Inc., v. Brogdex Co., 283 U. S. 1, 283 U. S. 11 (1931). (Diamond v. Chakrabarty, 447 U. S. 303, 308 (1980))"*

Therefore, the central holding in the *Chakrabarty* decision shows that the threshold of whether or not a claim directed to any product is eligible is whether the product recited in the claim amounts to "a product of human ingenuity having a distinctive name, character or use."

This determination framework has been maintained in the *Myriad* decision by the Supreme Court. The central holding in the *Myriad* decisions is as follows.

*"In this case, by contrast, Myriad did not create anything. To be sure, it found an important and useful gene, but separating that gene from its surrounding genetic*



*materials is not an act of invention." (Association for Molecular Pathology v. Myriad Genetics, Inc., 569 U. S. \_\_\_ slip op. at 12 (2013))"*

This holding in the *Myriad* case, as well as in the *Chakrabarty* case, is considered to show a view of the Supreme Court in which whether the inventor creates or manufactures could be the threshold for patent eligibility.

To the contrary, the wording "markedly different characteristic" is a merely simplified label representing that the product according to the subject claim is "a nonnaturally occurring manufacture or composition of matter – a product of human ingenuity having a distinctive name, character or use."

Therefore, we respectfully submit that in the guidance, the wording "Markedly Different Characteristic Analysis" should be renamed to "Product of Human Ingenuity Analysis." Also, the definition of the word "manufacture," which represents a very important factor in the examination process, should be stated in the text of the guidance.

(2) In "Markedly Different Characteristic Analysis," the patent eligibility of a claim should be determined based on whether the subject matter recited in the claim is or encompasses a naturally occurring product per se or a naturally occurring combination of naturally occurring products per se.

In Section I. A. 3. a. of the 2014 Interim Guidance, it is explained that:

*A claim that recites a nature-based product limitation that does not exhibit markedly different characteristics from its naturally occurring counterpart in its natural state is directed to a "product of nature" exception (Step 2A: YES).*

However, the extent of how "different" would be sufficient for a claim to be patent eligible is not necessarily clear and objective in the guidance. Rather, the principle should be that a claim is patent eligible when the subject matter recited in the claim as a whole does not encompass a naturally occurring product per se or a naturally occurring combination of naturally occurring products per se.

The USPTO appears to have the notion that subject matter in a claim, even if it is man-made product, should have "markedly different characteristics" for the claim to be patent eligible as follows.

*Courts have held that naturally occurring products and some man-made products that are essentially no different from a naturally occurring product are "product of nature." (See Section I. A. 3.a.)*

However, it should be noted that there are only three decisions (the *Myriad* decision, *Funk Brothers* decision and *America Fruit Growers* decision) where the Supreme Court held that the claims were not patent eligible regardless of the fact that



the subject matters in the claims were man-made products. Moreover, as described below, these cases are specific or rare exceptions in light of case law. In principle, if the nature-based product recited in a claim does not encompass a naturally occurring product per se, the claim should have patent eligibility. We have a concern that the USPTO may inappropriately conflate such exceptions.

In the *Myriad* decision, "isolated DNA" is judged as being a judicial exception, though the "isolated DNA" has a structure different from that of naturally occurring DNA per se. The reason therefor is that DNA is a molecule encoding genetic information, and the claim directed the "isolated DNA" is intended to monopolize DNA and genetic information encoded by the DNA. However, no readable medium retaining biologically significant information exists other than DNA and RNA. Therefore, it is not appropriate that this holding is overly applied to a natural-based product other than DNA. Also, as the Japan Patent Attorneys Association and the Chartered Institute of Patent Attorneys have already pointed out in the comments, the Supreme Court decision in the *Funk Brothers* case given in 1948 before the amendments to the U.S. Patent Law held that the claim had no patentability by reason that the claim was obvious and should be rejected under 35 U.S.C. 103. Therefore, it is not appropriate that the *Funk Brothers* decision is applied to claims other than the claim that was at issue in the decision.

The reason described in the *American Fruit Growers* decision that held the claim at issue as ineligible was simply forgotten in both the *Chakrabarty* decision and the *Myriad* decision.

Accordingly, regarding subject matter other than DNA, if a product which is indistinguishable from the subject matter is not proved to exist in nature, and if a "combination of products (components)" which is indistinguishable from the subject matter recited in the claim is not proved to exist in nature, it should be determined that the subject matter has markedly different characteristics in comparison with a naturally occurring product.

(3) The guidance should regulate that the Examiner bears the burdens to determine the "naturally occurring counterpart" corresponding to a nature-based product recited in the subject claim, and to prove that the naturally occurring counterpart product exist in reality.

There may be a case where it is difficult to accurately determine what the naturally occurring counterpart corresponding to a nature-based product recited in the subject claim is, and also, it is difficult to accurately ascertain the real existence of the naturally occurring counterpart corresponding to a nature-based product recited in the subject claim. For example, in the case where the claim recites stem cells which are induced stem cells (iPS cells) produced by introducing genes to skin cells, and can be differentiated to cells X and Y (e.g. nerve cells, cardiomyocytes, etc.), it is difficult to accurately ascertain what the naturally occurring counterpart corresponding to a nature-based product recited in the subject claim is.



In this case, only the supposition that cells having the ability to be differentiated to nerve cells and cardiomyocytes are likely to exist in nature is insufficient as the reason to determine those cells as a naturally occurring counterpart, and the nature-based product recited in the subject claim should not be compared with such a "supposedly determined" naturally occurring counterpart.

Therefore, if claims are rejected by reason that a nature-based product recited in the subject claim encompasses a naturally occurring counterpart per se, an examiner should prove the real existence of the naturally occurring counterpart by publications (patent application, thesis, picture book, technical brochure, etc.) or the specification of the present application itself, and the guidance should clearly regulate that the Examiner bears such a burden.

(4) The guidance should supplement some notes for understanding what "tie up" of a judicial exception means, and what "pre-empt" means for use of a judicial exception by others means.

According to the description in Guidance I. A. 1., it is considered that a claim directed to a judicial exception, including a naturally occurring product and a law of nature, has a risk that it will "tie up" the excepted subject matter and it will "pre-empt" others from using of a judicial exception. Therefore, the question of whether a claim "ties up" or "pre-empts" a judicial exception is a very important question throughout the whole guidance. This is because if it is clear that a claim does not "tie up" a judicial exception, the claim can be considered to be eligible, and thus the claim would not be subject to being examined thereafter based on the guidance (Section I. B. 3.).

However, in the guidance, the meaning in which a claim "ties up" a judicial exception has not necessarily been made clear. As a result, in this regard, we are worried that arbitrary determination would be conducted by an examiner.

If a claim is directed to a "product of nature" and thus a judicial exception, it is considered that implementation with no other specific limitations of naturally-occurring substances per se by others is prohibited by patent right. "Implementation" means to make, use, offer to sell or sell a patented invention (35 U.S.C. 271(a)).

To the contrary, a claim which prohibits only implementation with other specific limitations of naturally-occurring substances per se is not a claim which "ties up" a product of nature per se. For example, in the case of Example 1 (Gunpowder) in "Nature-Based Product Examples," the combination of naturally occurring products corresponding to Gunpowder does not exist in nature.

Also, claims in Gunpowder do not prohibit implementation with no other specific limitations of any components of Gunpowder. This is because any person is permitted to produce and use potassium nitrate if there is no limited combination with



charcoal and sulfur.

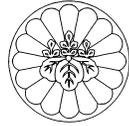
To the contrary, according to the past Supreme Court decision, a method claim directed to a judicial exception by reason of reciting a law of nature has two embodiments in a "tie-up" of a judicial exception.

The first embodiment is to monopolize employment with no other specific limitation of a law of nature per se by patent. That is, a claim of this embodiment only has a limitation of using a law of nature, and thus monopolizes in advance the rights to use not only a method having specific limitations substantially recited in the specification but also a method not having the specific limitations recited in the specification (including the method which may be developed in the future). This embodiment is represented by Claim 8 which was determined as having no patent eligibility in the Supreme Court decision on *Morse* (O'Reilly v. Morse 56 U. S. 62 (1853)). In *Morse*, however, a fact that any practical method among methods employing a judicial exception is not known at present except a method having a specific limitation substantially recited in the specification or any method practicality equivalent to the method having a specific limitation substantially recited in the specification is not known from methods employing a judicial exception, cannot be the reason why a claim has no patent eligibility. The method recited in Claims 1 to 7 which were determined as having patent eligibility in the Supreme Court decision on *Morse* was the only practical method known in industrial use among methods using a law of nature encompassed in those method claims. Therefore, the method could function as monopoly based on a patent.

The second embodiment is the method claim which is represented by the claim subject to judgment in the Supreme Court decision on *Mayo*. As is clear from the following citation, the District Court decided that the person violated the patent of the claim, even though he performed an act which was publicly known and conventional before filing the application; that is to say, the act in which a drug providing 6-thioguanine was administered to a patient with immune-mediated gastrointestinal disorder and the act in which the level of 6-thioguanine in the patient's blood was determined thereafter.

*"The District Court also accepted Prometheus' view that a doctor using Mayo's test could violate the patent even if he did not actually alter his treatment decision in light of the test. In doing so, the court construed the claim's language, "indicate a need to decrease" (or "to increase"), as not limited to instances in which the doctor actually decreases (or increases) the dosage level where the test results suggest that such an adjustment is advisable." (Mayo Collaborative Services v. Prometheus Laboratories, Inc., 566 U. S. \_\_\_ slip op., at 6-7 (2012))*

The claim of *Prometheus* would monopolize ex post facto the act which was freely performed before, and patentability of the claim should also be denied under 35 U.S.C. 102.



In the text of the guidance, the above-described two embodiments should be exemplified as the case of method claim including a law of nature that "ties up" a judicial exception, and it should be noted that if the method claim does not fall under both of the two embodiments, the claim is basically eligible.

(5) Search for "inventive concept" in step 2B should be conducted in accordance with the following steps.

#1: to determine a method recited in a claim based on the description of claim and specification.

#2: to determine all laws of nature used by the method recited in a claim based on prior art, the description of claim and specification.

#3: to determine all laws of nature which are determined by #2, but newly found out by the inventor in the application.

#4: to determine, based on the determinations of #2 and #3, all laws of nature which are used by the method recited in the claim, and newly found out by the inventor in the application.

#5: to compare the method recited in the claim with each law of nature which is used by the method recited in the claim and newly found out by the inventor in the application.

#6: only when the claim is determined as having no "something more" compared to any of the laws of nature which are used by the method recited in the claim and are newly found out by the inventor in the application, the claim is determined as not being eligible.

Here is mentioned an example of a claim similar to the claim subject to the holding in the Supreme Court decision on *Mayo*. If the following laws of nature were not found out before filing the application:

Law of nature 1 - when a certain drug X is administered to a patient with disorder A, a certain metabolite Y is thereby produced in the patient's body.

Law of nature 2 - metabolite Y is a cause of harmful side effects by drug X.

The inventor has newly found out the above laws of nature, and further found out one other law of nature as follows:

Law of nature 3 - if the level of metabolite Y in the blood after administration of drug X is less than a certain amount of Z mg/dl, the amount of said drug is preferably increased; if the level of metabolite Y is greater than W mg/dl, the amount of drug X is preferably decreased.

The inventor 1 filed an application including the following claim.

*A method for optimizing therapeutic efficacy for treatment of disorder A, comprising;*



(a) administering drug X to a subject having disorder A; and  
(b) determining the level of metabolite Y in the serum of said subject,  
wherein the level of metabolite Y less than about Z mg/dl indicates a need to increase the amount of said drug subsequently administered to said subject and wherein the level of metabolite Y greater than about W mg/dl indicates a need to decrease the amount of said drug subsequently administered to said subject.

The method recited in the claim uses at least one of laws of nature 1, 2 and 3. The first law of nature is a law of nature in which metabolite Y is produced in the body of a patient who is given drug X. The second law of nature is a law of nature in which metabolite Y causes harmful side effects, and the third law of nature indicates an accurate threshold of blood concentration of metabolite Y which can be an indicator for determining the amount drug X should increase or decrease.

In the case of comparing the method recited in the claim with Law of nature 1 or Law of nature 2, it is apparent that the method recited in the claim has "something more." Therefore, in the case of comparing the method recited in the claim with Law of nature 3, even if the method recited in the claim is determined as having no "something more," the method recited in the claim should be considered to have patent eligibility. Before filing the application, the measurement of the amount of metabolite Y in the patient's body after administration of drug X, and use of the concentration value of metabolite Y recited in the claim as a threshold for controlling the drug dosage are not "well-understood, routine, conventional activity previously engaged in by researchers in the field."

The reason why the determination of patent eligibility should be conducted as described above is that the determination of whether or not a method claim unfairly "ties up" a law of nature is a relative determination conducted based on a comparison with technical or scientific contribution by the inventor as stated in the Supreme Court decision on *Mayo*.

"But the underlying functional concern here is a *relative* one: how much future innovation is foreclosed relative to the contribution of the inventor." (*Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U. S. \_\_\_ slip op., at 20 (2012))

In addition, the above claim has no problem with unfair "tie up" of a law of nature explained in the claim of the above *Prometheus*. The abovementioned proposed rules on a search for "inventive concept" can embody the following statement in the *Myriad* decision.

"Similarly, this case does not involve patents on new applications of knowledge about the BRCA1 and BRCA2 genes. Judge Bryson aptly noted that, "[a]s the first party with knowledge of the [BRCA1 and BRCA2] sequences, Myriad was in an excellent position to claim applications of that knowledge. Many of its



*unchallenged claims are limited to such applications.” 689 F. 3d, at 1349. (Association for Molecular Pathology v. Myriad Genetics, Inc., 569 U. S. \_\_\_ slip op. at 17 (2013))”*

### **3. Comments relating to Abstract Idea**

#### **a) Potential Scope of Judicial Exceptions**

(1) We understand that the judicial exception of an "abstract idea" may be particularly applied to several fields of computer software. Among others, we have a strong concern about the fairness of examination for a claim "directed to" the following:

- Business practice
- Novel business method
- Concrete business method
- Tangible computer to implement a business method
- Simulator for simulating something (e.g., satellite launching, air resistance acting on a moving car) based on laws of physics
- Simulator based not on laws of physics but on laws of economics/finance, and laws of mathematics

Especially, when a novel business method is embodied by a computer technology, an invention often requires a novel technology which does not necessarily preempt an abstract idea therein. Moreover, it should be noted that, in principle, a computer technology is based on mathematical operations which may be regarded as an abstract idea.

As such, we respectfully request the USPTO to update the Guidance by adding more examples to the Guidance in view of future case law.

(2) We understand that limitations sufficient to qualify as "significantly more" are required as in Step 2B of the subject matter eligibility test. Again, we have a strong concern about the fairness of examination for determining the additional elements that amount to "significantly more," even though we also understand that the 2014 Interim Guidance provides several viewpoints such as "improvements to another technology or technical field," "improvement to functioning of the computer itself" and others. However, we believe that the limitations discussed in the 2014 Interim Guidance do not necessary provide the same interpretation to different examiners.

For example, if an applicant argues about an improvement to the functioning of the computer itself, it is not clearly stated whether such an improvement should be limited to a "technical" perspective. In view of the DDR holding case, which is discussed in "Examples: Abstract Ideas," we assume that improvements mentioned in the 2014 Interim Guidance may not be limited to a technical effect (which may often be objective), but may include a commercial effect (which may often be subjective) and some other types of effect (for example, effects on human senses which may not be objectively evaluated). Similarly, the phrase "technical field" may be narrowly



interpreted especially if a claim is "directed to" a business practice or method.

Accordingly, we respectfully submit that the USPTO should clarify that, as long as the case law allows, the limitations found to be or not to be sufficient to qualify as "significantly more" should not be narrowly interpreted when an examiner applies the 2014 Interim Guidance.

**b) Examination under 2014 Interim Guidance**

(1) We respectfully request that an examiner is obliged to specify in an Office Action how he/she has determined a claimed subject matter as "claims directed to an abstract idea" as discussed in the 2014 Interim Guidance.

(2) With regard to the recitation "ALL CLAIMS ARE TO BE FULLY EXAMINED UNDER EACH OF THE OTHER PATENTABILITY REQUIREMENTS: 35 U.S.C. 102, 103...", we respectfully request that an examiner is obliged to conduct a prior art search and examine the patentability under 35 U.S.C. 102 and 103 in the case where how to use a computer is obvious from the claim language.

(3) "*Diamond v. Diehr*" is introduced in the "2014 Interim Guidance," and the "2014 Interim Guidance" describes that "the claimed repetitive computer recalculation of ... are additional elements that provide 'something more' than mere computer implementation of calculation of the ... equation." In addition, the "2014 Interim Guidance" mentions that "the claimed steps act in concert to transform raw, uncured rubber into cured molded rubber." In reference to these portions of the "2014 Interim Guidance," we respectfully submit the following questions and a request to the USPTO.

- i) Is it acceptable for the USPTO if the applicant submits evidence of patent eligibility (abstract idea), for example, added operations to a calculation of a mere mathematical formula, and in addition, such added operations including "transform"?
- ii) Is it acceptable for the USPTO if the above-described "transform" is obvious for a person skilled in the art?
- iii) If ii) is not acceptable for the USPTO, we believe that an examiner should disclose clear evidence.

**C. Examples: Abstract Ideas**

(1) Regarding "*DDR Holdings, LLC v. Hotels.com et al.*" (hereinafter referred to as "DDR")

The invention of Claim 19 of DDR relates to a system in which a first webpage (host website) includes a hyperlink to another (source) webpage which introduces and/or advertises a commerce object, and it is possible to obtain a small amount of reward when a user clicks the hyperlink. Such a system and/or business method is called "affiliate."

In a conventional system, when the user clicks the hyperlink, the web browser



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leaves the first webpage and displays the source webpage. In Claim 19, in reference to a database, a second webpage (hybrid webpage) shows the user “the plurality of visually perceptible elements visually corresponding to the source page.”

According to the CAFC, Claim 19 is regarded as being not directed to the abstract idea. One reason is that "it does not 'merely recite the performance of some business practice known from the pre-Internet world along with the requirement to perform it on the Internet ...'". In addition, the CAFC mentions that "the host website can instead send its visitors to a webpage on the outsource provider's server that 1) incorporates 'look and feel' elements from the host website," and the CAFC admitted the advantages of the invention in which "the host webpage ... provides visitors with the opportunity to purchase products from the third-party merchant without actually entering that merchant's website." It is not possible to obtain this advantage using the conventional affiliate system. In addition, this advantage of attracting the users (customers) is a novel advantage of the business.

In accordance with this CAFC decision, it may be possible to assume that a claim is not directed to the abstract idea if the claim satisfies the following conditions.

- i) The claim does not merely recite the performance of some business practice known from the pre-Internet (and an infrastructure, for example, a computer and a mobile network) world along with the requirement to perform it on the Internet or infrastructure.
- ii) The claim recites generation (and/or transformation). The claim can generate other matters than a physical matter, for example, a hybrid webpage.
- iii) The claim has an advantage which cannot be obtained using generally well-known business practice. This advantage can be other than a technical advantage, for example, "Improvements to another technology or technical field" and "Improvements to the functioning of the computer itself." In other words, this advantage can include an advantage improving usability of the user and a novel advantage of a business method.

We would like to ask the USPTO whether or not the above assumptions and conditions are appropriate. In the examination process, if the claim satisfies the above-described conditions, do the Examiners admit that the claim is not involved in the abstract idea?

In order to maintain fairness in the examination process, we believe that the Examiner should admit the patent eligibility (abstract idea) of the claim while inventive step can be discussed if i) described above is satisfied. If the claim satisfies ii) described above, the claim should have patent eligibility (abstract idea). If the claim satisfies iii) described above, the claim should have patent eligibility (abstract idea) and should have non-obviousness.

(2) Example 3 (Digital Image Processing Case)



Example 3 shows a feature, which has a first memory and a second memory, similar to Claim 13 of the original case as an example, not Claim 1 of the original case. For this reason, does Example 3 mean that the method itself of the image conversion does not have patent eligibility, and that it is necessary to limit it specifically to processing by hardware including memory and CPUs in computers?

We respectfully submit that the patent eligibility should be admitted without limitation to processing by hardware especially if it is apparent that the method itself of the image conversion can be realized by computers only.

(3) Example 6 (The Game of Bingo)

This example is capable of being interpreted as "A game system viable by a generic computer without other hardware elements is ineligible." Accordingly, the following questions arise.

- i) Does the USPTO not allow patent eligibility to a system that can run by only a generic computer itself (CPU, memory, printer, input and output terminal, and program, etc.)?
- ii) Alternatively, is the judgment applied because it is the well-known bingo game? If it were a new game system instead of a bingo game, would the USPTO admit its patent eligibility?
- iii) Does the USPTO not admit the patent eligibility of multiple hardware for an example system of a server and client consisting of generic computers?
- iv) If the game system is irrelevant to managing risk, does the USPTO change its judgment?

Accordingly, we advocate the following,

A computer-related invention is characterized in information processing by software. Therefore, it should not be deemed the patent eligibility whether it is implemented by a generic computer or not. If an invention has an effect by running a characterized information process, patent eligibility should be allowed even for an invention consisting of a generic personal computer.

(4) Example 8 (Ultramercial Case)

In regard to "particular technological environment," it is desired to be shown that such an environment is explained with an appropriate reference available at the time of the effective filing date along with a clear rationale.

As long as the rationale does not make clear that it is the environment at the time of the effective filing date, the possibility cannot be denied that the Examiner is bound by common sense at the time of examination after the effective filing date.

**D. Examples discussed in the JPO Patent Examination Guidelines**

In Japan, patent eligibility is admitted if the operation or modification of



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information in accordance with the purpose of the invention (namely, information processing) is achieved specifically using hardware resources.

With regard to an invention in which service provided by human beings is simply systemized or an invention in which a known event is simply recreated by computers, patent eligibility is admitted if the information processing by software is achieved specifically using hardware resources. However, such an invention is not patented because it would be easy for a person skilled in the art to invent it and therefore lacks inventive step (non-obviousness).

Thus, in Japan, patent eligibility and inventive step are clearly separated. Please refer to the cases regarding patent eligibility in the JPO patent examination guidelines ([http://www.jpo.go.jp/tetuzuki\\_e/t\\_tokkyo\\_e/Guidelines/7\\_1.pdf](http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/Guidelines/7_1.pdf)), and it would be appreciated if the USPTO would make review to confirm whether there are any examples which may have a different result in terms of patent eligibility.

\* \* \*

The JPAA again appreciates the opportunity to submit comments on the 2014 Interim Guidance on Patent Subject Matter Eligibility. We would be pleased to answer any questions about these comments and look forward to any further opportunities to help ensure that all inventions receive thorough examinations of the highest quality.

Sincerely,

A handwritten signature in cursive script, appearing to read "Fumio Furuya".

Fumio Furuya  
President

Japan Patent Attorneys Association