

Comments by Canon Inc. ("Canon") on "2019 Revised Patent Subject Matter Eligibility Guidance" [Docket No. PTO-P-2018-0053]

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Canon Inc.

We appreciate the continuing efforts of the USPTO to issue guidance for clarifying how it determines subject matter eligibility and are pleased to have this opportunity to comment on the 2019 Revised Patent Subject Matter Eligibility Guidance (2019 PEG).

In the 2019 PEG, USPTO made the procedures for the determination in the step 2A clear by dividing the step 2A into 2 prongs (i.e. the Prong One and the Prong Two.) In the examination before the 2019 PEG, we found some cases where USPTO determined, in the step 2A, that a claim was directed to an abstract idea only because mathematical formulas existed in the claims. We welcome this revise because such cases are expected to decrease.

1. Regarding a flowchart of the Subject Matter Eligibility Test

On the other hand, the 2019 PEG is difficult to understand because it is only described without charts. Therefore, we expect that, by reflecting this revise of the 2019 PEG on a flowchart illustrated in the MPEP 2106 [R-08.2017], USPTO provides us with the visualized flowchart.

2. Regarding cases approved by Technology Center Directors

Also, in the Section III.C of the 2019 PEG, it is described as follows.
"If an additional element or combination of additional elements provides an inventive concept as explained in Section III.B (Step 2B: YES), the claim is eligible (thus concluding the eligibility analysis). If the additional element or combination of additional elements does not provide an inventive concept as explained in Section III.B (Step 2B: NO), the examiner should bring the application to the attention of the Technology Center Director. Any rejection in which a claim limitation, which does not fall within the enumerated abstract ideas (tentative abstract idea), is nonetheless treated

as reciting an abstract idea must be approved by the Technology Center Director (which approval will be indicated in the file record of the application), and must provide a justification for why such claim limitation is being treated as reciting an abstract idea.”

We understand that contents approved by Technology Center Directors (i.e. reasons why claim limitations are treated as reciting an abstract idea) shall be recorded in file records of applications.

Though there may not be many cases approved by Technology Center Directors, such reasons could be beneficial information to both of other examiners and other applicants in examination of other application.

However, the other examiners and the other applicants are likely not to be able to notice these cases only by recording such reasons in the file records. So, in order to enhance prediction of patentability, we expect that some release methods (e.g. releasing a list which describes both of application Nos and summaries of these cases) shall be considered.

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