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August 15, 2018

Attention: Senior Legal Advisors - Carolyn Kosowski and Matthew Sked, Office of
Patent Legal Administration

Subject: Docket No. PTO-P-2018-0033 - Request for Comments on Determining
Whether a Claim Element Is Well-Understood, Routine, Conventional for Purposes of
Subject Matter Eligibility

Dear Sir or Madam,

The Japan Patent Attorneys Association (JPAA) was established in May 1922 under the Patent Attorneys Act, and it is the sole professional bar association of patent attorneys in Japan. At present, the JPAA has more than 11,300 members practicing in intellectual property law throughout Japan. Our members practice in all areas of intellectual property law, including patent, design and trademark law, as well as copyright and unfair competition law.

The JPAA appreciates the opportunity to submit comments on the proposed guidance and would be happy to answer any questions you may have regarding our comments below.

We generally support the memorandum published by the USPTO on April 19, 2018, and we understand that such memorandum provides additional guidance to clarify how the USPTO will determine subject matter eligibility (35 U.S.C. §101), especially regarding whether an additional element represents well-understood, routine, conventional activity.

Nevertheless, we would appreciate it if the USPTO could provide further clarification on some of the instructions contained in the memorandum, such as by providing additional guidance for the examiners, to improve consistency and predictability in examinations on subject matter eligibility. Namely, we would like to propose clarifying the instructions in the memorandum in the manner discussed below.

Proposal 1: Clarification on the relationship between the memorandum and Mayo/Alice step 2 (Step 2B in the USPTO guidance)



We propose clarifying the relationship between the memorandum and the MPEP in order to ensure examiners' better understanding. We are afraid that examiners may rely only on the memorandum and fail to follow the MPEP procedure as a whole.

According to MPEP 2106.05, the finding that an additional element represents "well-understood, routine, conventional activity" alone does not establish patent ineligibility. More specifically, MPEP2106.05(I)(A) provides six categories (i to vi) of "significantly more," and being other than "well-understood, routine, conventional activity" is only one of them. While the memorandum provides guidance on whether an additional element represents well-understood, routine, conventional activity, even if the element represents "well-understood, routine, conventional activity," this element could be "significantly more" provided that this element is included in other categories, for example, if this element acts to improve the functioning of a computer.

Furthermore, MPEP2106.05(I) explains that, in an examination of "substantially more," a claim must be considered in its whole and as an ordered combination. Thus, even if a claim element alone represents "well-understood, routine, conventional activity," the claim as a whole or as an ordered combination could be "significantly more" provided that such element acts in cooperation with other claim elements to achieve, for example, more than "well-understood, routine, conventional activity." As a specific example, even if an additional claim element is to use a component or an agent which is disclosed as a commercially available product in a specification, the claim should not be directly regarded as "well-understood, routine, or conventional activity." A combination of the component or agent with other claim elements can be more than "well-understood, routine, or conventional activity."

Thus, we propose making it clear that even if an additional element is found to be "well-understood, routine, or conventional," this will not directly mean that the claim does not pass the Mayo/Alice step 2 (Step 2B) test. More particularly, we propose making it clear that the Mayo/Alice step 2 (Step 2B) test should be performed under the framework described in the MPEP, that a claim element must be studied in association with the claim as a whole and as an ordered combination, and more specifically, that the examiner must establish that a combination of the element with other claim elements is "well-understood, routine, conventional activity" in formulating this type of §101 rejection.

Proposal 2: Avoiding abstraction of an additional element in an examination of "well-understood, routine, conventional"

We propose clarifying that the determination of "well-understood, routine, or conventional" should be performed based on the actual claim language, and should not deviate therefrom. We are afraid that an examiner may abstract an additional element



and determine whether the abstracted concept is “well-understood, routine, or conventional,” as we have been seeing in some actual cases.

In *Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir 2018), the additional element “storing a reconciled object in the archive without substantial redundancy” was judged as not being “well-understood, routine, or conventional” because the “asset management system,” which archived an asset document in the claimed way, was not conventional in view of the description of the specification. However, as HP Inc. insisted and the District Court accepted, we believe that storing data in reduced redundancy would itself be conventional. We understand that the CAFC judged whether or not the additional element was “well-understood, routine, or conventional” based on the specific limitation such as “reconciled object” and “in the archive” also in view of the specific claim category of an “asset management system.”

Thus, we propose clarifying that the determination on whether an additional element is “well-understood, routine, or conventional” should be based on the words of the additional element, and should not be based on an abstraction of the additional element.

Proposal 3: Providing clear guidance on when and how the examiner can make Official Notice

We propose providing clear guidance on when and how an examiner can make Official Notice as set out in Section III-A-4 of the memorandum.

Section III-A of the memorandum provides four cases where an examiner can find an additional element to be “well-understood, routine, or conventional.” We are of the opinion that cases 1-2 are reasonable as long as the examiner’s rejection is based on the actual claim language, however, we have further comments regarding cases 3-4.

Regarding case 3, “A citation to a publication that demonstrates the well-understood, routine, conventional nature of the additional elements,” we propose further clarifying what sort of publication can be used to demonstrate the “well-understood, routine, conventional nature.” The guidance explains that a copy of a thesis written in German and located in a German university library would not suffice to establish “well-understood, routine, and conventional activity.” The guidance also explains that a single patent or published application would not be sufficient to demonstrate the “well-understood, routine, and conventional” nature. We guess from the guidance that a single patent publication alone cannot establish the “well-understood, routine, and conventional” nature, and also a non-English document alone cannot establish the “well-understood, routine, and conventional” nature. Regardless of whether our understanding is correct or not, we propose further clarifying how the



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number and the language of the documents affect eligibility of the document to establish the “well-understood, routine, and conventional” nature.

Regarding case 4 “A statement that the examiner is taking official notice of the well-understood, routine, conventional nature of the additional element(s),” we propose providing further guidance to caution the examiner to use this procedure very carefully. Although the memorandum states that “This option should be used only when the examiner is certain, based upon his or her personal knowledge...,” the use of this option should be further restricted in view of case law, as explained in MPEP2144.03. For example, this option should only be taken when an additional limitation is capable of instant and unquestionable demonstration as being well-understood, routine, or conventional. This section of the MPEP also explains that the examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support the conclusion, such that an applicant can adequately traverse the rejection.

Thus, we propose clarifying that this option can only be used in limited cases, and clarifying what the examiner should explain in the office action when using this opinion.

Thank you again for this opportunity to provide our comments on the proposed guidance.

Yours sincerely,

A handwritten signature in black ink that reads "K. Watanabe".

Keisuke WATANABE
President
Japan Patent Attorneys Association