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Submitted via email: Eligibility2018@uspto.gov

Re: Determining Whether a Claim Element Is Well-Understood, Routine, Conventional for Purposes of Subject Matter Eligibility

Docket No.: PTO-P-2018-0033

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 April 19, 2018 Memorandum based on the Federal Circuit February 8, 2018 *Berkheimer v. HP Inc.* decision ("*Berkheimer* memorandum").

We support the *Berkheimer* memorandum since it is expected that it contributes to proper §101 rejection practice, particularly step 2B, and examination efficiency by setting clearer standard. It clarifies that determination on whether an additional element or combination of elements is well-understood, routine or conventional is factual determination, and therefore mandates that when an examiner issues a rejection determining an additional element or combination of elements is well-understood, routine or conventional denying "significantly more" status of the invention, he or she must show facts supporting that determination. This would make it difficult for an examiner to issue such a rejection based simply on his or her feeling or arbitrary thinking without specific supporting facts.

However, finding several points that seem to need further clarifications, we would like to comment as follows:

1. §101 rejection in relation to other patentability requirements

Currently, regardless of whether a rejection under §101 is made based on lack of subject matter eligibility, examination under other patentability requirements including §§102, 103 and 112 is also made, realizing efficient examination under MPEP 2106.07(a)¹.

In this situation, a case is occasionally found where after issuance of a first Office action including §§101, 102 and 103 rejections, while §§102 and 103 rejections are overcome by an applicant's response thereto, only §101 rejection remains in a second Office action. We feel further guidance discussing this situation would be helpful.

In the *Berkheimer* memorandum, paragraph III. *Impact on Examination Procedure, A. Formulating Rejections*, it is stated that, in a step 2B analysis, an examiner is required to clearly show at least one of the following as a ground for §101 rejection determining an additional element or combination of elements is well-understood, routine or conventional,:

1. A citation to an express statement in the specification or to a statement made by an applicant during prosecution that demonstrates the well-understood, routine, conventional nature of the additional element(s);
2. A citation to one or more of the court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the additional element(s);
3. A citation to a publication that demonstrates the well-understood, routine, conventional nature of the additional element(s);
4. A statement that the examiner is taking official notice of the well-understood, routine, conventional nature of the additional element(s).

We would like to focus on the above point III.A.3. in discussing §101 and other patentability

¹ *MPEP 2106.07(a): " Under the principles of compact prosecution, regardless of whether a rejection under 35 U.S.C. 101 is made based on lack of subject matter eligibility, a complete examination should be made for every claim under each of the other patentability requirements: 35 U.S.C. 102, 103, 112, and 101 (utility, inventorship and double patenting) and non-statutory double patenting. Thus, examiners should state all non-cumulative reasons and bases for rejecting claims in the first Office action."*

requirements. Under the point III.A.3., a publication that demonstrates the well-understood, routine, conventional nature of the additional element(s) needs to show that the additional element(s) is widely prevalent or in common use in the relevant field, whereas it is not necessary for a publication citable in §102 rejection to show such a point. Namely, requirements are stricter for a publication citable in §101 rejection than for a publication citable in §102 rejection. Thus, It is assumed that a publication citable in §101 rejection is also citable in §102 rejection.

In the case where, as a result of an applicant's response to an Office action including §§ 101, 102 and 103 rejections citing same publications, if §§ 102 and 103 rejections are overcome, the examiner's conclusion would be that there is no other publication citable in §§ 102 and 103 rejections. It is assumed this should lead to a further conclusion of the examiner that there is no other publication citable in §101 rejection since requirements for a publication are stricter under §101 than under §§ 102 and 103 as mentioned above. Additionally, if §103 rejection is overcome, the claimed invention as a whole is deemed to include a subject matter that has been non-obvious to a person having ordinary skill in the art to which the claimed invention pertains, and thus it is naturally understood that some meaningful limitation exists in the claimed invention as a whole.² We wish an additional guidance to clarify whether an examiner can judge that the non-obvious subject matter of the claimed invention is well-understood, routine or conventional in the situation that §103 rejection is overcome. And we wish the additional guidance to clarify how an examiner should provide a reason for the §101 rejection if an examiner maintains the §101 rejection in the second Office action in the situation that §103 rejection is overcome.

² 35 U.S.C. 103 Conditions for patentability; non-obvious subject matter. *A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.*

2. §101 rejection discussing combination of additional elements

If an examiner wishes to cite “one or more of the court decisions” under the above point III.A.2. when determining combination of additional elements of the claimed invention is well-understood, routine or conventional, we understand such court decision cited should discuss and decide on ineligibility referring to the specific combination of additional elements at issue since such combination may possibly lead to eligible subject matter. In this regard, we wish an additional guidance to clarify that, when an examiner determines combination of additional elements of the claimed invention is well-understood, routine or conventional, he or she should explain specifically as a ground for rejection which combination of elements in the court decision deciding on ineligibility correspond to the combination of elements of the claimed invention by pointing out specific portion of the court decision.

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