

AIPPI • JAPAN



Office Address  
AIPPI JAPAN  
4F, Yusei Fukushi Kotohira Bldg.  
14-1, Toranomon 1-chome,  
Minato-ku Tokyo,  
105-0001, Japan  
Telephone : Tokyo (03) 3591-5301  
Facsimile : Tokyo(03)3591-1510

International Association for the Protection of Intellectual Property of Japan

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The United States Patent and  
Trademark Office

AIPPI Japan's Comments regarding the USPTO's Preliminary Examination  
Instructions for Determining Subject Matter Eligibility in view of Alice Corp. v.  
CLS Bank

Dear Sirs,

The Japanese Group of AIPPI (AIPPI Japan) appreciates the opportunity to offer comments regarding the "USPTO's Preliminary Examination Instructions for Determining Subject Matter Eligibility in view of Alice Corp. v. CLS Bank"

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 as follows.

We understand that, according to the Alice Corp. v. CLS Bank Supreme Court Decision, a claim amount to "significantly more" than an abstract idea can be patent eligible. However, we have a concern that the standard for qualifying as a claim amounting to "significantly more" may become different among examiners

because it is currently unclear to what extent a claim as a whole should be limited by an element or a combination of elements. If an examiner applies his or her own standards for patent eligibility, the stability of patent rights will be weakened. Moreover, it will be more difficult to determine whether existing and future patents are valid or not. Therefore, we respectfully propose that the USPTO clarifies the standards relating to the important keywords of patent-eligibility such as "significantly more than," "improvements" and "meaningful limitation," which are discussed in the Preliminary Examination Instructions.

Furthermore, we believe that the international harmonization of patent laws needs to be considered so that the forthcoming USPTO detailed guidance will not be markedly different from the ones in Japan and the other countries.

In view of the foregoing, we respectfully propose that the USPTO will consider the followings, labeled as Items (A) to (F):

(A) In Part 1 of the "Two-part Analysis for Abstract Ideas" of the Preliminary Examination Instructions, four examples are listed. If there are any other examples (especially, ones based on judicial precedents), we respectfully propose that the USPTO adds them into the forthcoming detailed guidance.

(B-1) We respectfully request the USPTO to provide more detailed standards to be used for the "Two-part Analysis for Abstract Ideas" so that a patent application can be properly and fairly examined in light of the factors of "significantly more" and "meaningful limitation," which are held in the Alice Corp. v. CLS Bank Supreme Court Decision.

In the training slides for "2014 Procedure For Subject Matter Eligibility Analysis Of Claims Reciting Or Involving Laws Of Nature/Natural Principles, Natural Phenomena, And/Or Natural Products," the USPTO has presented several examples. We appreciate those examples as a meaningful approach to enhance mutual understanding among public, stakeholders (including applicants and patentees) and the USPTO. Therefore, we respectfully propose that the USPTO presents examples in which several claims relating to similar inventions are discussed with referring to the more detailed standards for the "Two-part Analysis for Abstract Ideas." It is also desirable that such examples will be discussed with reasons why some examples are patent-eligible and the others are not.

(B-2) Especially, with respect to Part 2 of the "Two-part Analysis for Abstract Ideas," we believe that there are many cases where the inventive concept, which is discussed in the Alice Corp. v. CLS Bank Supreme Court Decision, should be acknowledged even if a generic computer is adopted to implement the invention. Therefore, we respectfully propose that, in the forthcoming detailed guidance, the USPTO provides examples of patent-eligible inventions for which a general

computer can be adopted.

(C) We understand that the Alice Corp. v. CLS Bank Supreme Court Decision did not revisit the "Machine-or-Transformation test" that is determined by the Supreme Court in *Bilski v. Kappos*, 561 U.S. 593, 599 (2010) not as the only test for patent-eligibility, but rather as an important clue. We assume that the "Machine-or-Transformation" test can still be an important clue even after the Alice Corp. v. CLS Bank Supreme Court Decision. Therefore, we respectfully propose that the USPTO shows an example, if any, which may satisfy the "Machine-or-Transformation test," but may not satisfy the standards in the forthcoming detailed guidance based on the "Two-part Analysis for Abstract Ideas."

(D-1) In Japan, the issues of patent-eligibility applicable to software-related inventions are discussed in Part VII, Chapter 1 "Computer Software-Related Inventions" of the JPO Examination Guidelines for Patent and Utility Model (provisional English translation available at [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)) in order to deal with issues unique to computer software-related inventions, which are not discussed in the general guidelines and examples as provided in Part II, Chapter 1 "Industrially Applicable Inventions" (provisional English translation available at [http://www.jpo.go.jp/tetuzuki\\_e/t\\_tokkyo\\_e/Guidelines/2\\_1.pdf](http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/Guidelines/2_1.pdf)). Specifically, Section 2.2.1 (See pages 10-11 of the provisional English translation) provides the basic concept to determine whether software-related invention constitutes "a creation of technical ideas utilizing a law of nature," which can be regarded as corresponding to the "Two-part Analysis for Abstract Ideas," as follows:

(1) Where "information processing by software is concretely realized by using hardware resources," the said software is deemed to be "a creation of technical ideas utilizing a law of nature."

(2) Furthermore, the information processing equipment (machine) and operational method thereof which cooperatively work with the said software satisfying the above condition (1), and the computer-readable storage medium having the said software recorded thereon are also deemed to be "creations of technical ideas utilizing a law of nature."

Following the above basic concept, several examples are discussed in Sections 2.2.2 and 2.2.3 (See pages 11-13 of the provisional English translation) and Section 3.2 (See pages 27-56 of the provisional English translation). For the purpose of better understanding among stakeholders, it would be helpful and meaningful if the USPTO reviews those examples in the JPO Examination Guidelines and discusses if they should be patent-eligible or not by the USPTO under the forthcoming detailed guidance.

(D-2) With respect to patent-eligibility issues In Europe, T 258/03 (aka Auction

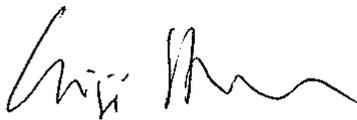
method/HITACHI) is a well-known decision of a Technical Board of Appeal of the EPO (the decision text is available at <http://www.epo.org/law-practice/case-law-appeals/recent/t030258ep1.html>). In addition to the above-mentioned examples in the JPO Examination Guidelines, we respectfully request the USPTO to review T 258/03 and discuss if the USPTO regards the claims in question as patent-eligible or not under the forthcoming detailed guidance.

(E) Part 2 of the "Two-part Analysis for Abstract Ideas" discusses the non-limiting or non-exclusive examples of limitations (such as addition of the words "apply it") not enough to qualify as "significantly more." We respectfully propose that the USPTO forthcoming detailed guidance will request the examiners to specifically explaining why they determine that a claim as a whole does not recite limitations enough to qualify as "significantly more" than an abstract idea.

(F) We gratefully appreciate that, from the viewpoints of shortening the total pendency referred to in the USPTO's Strategic Plan, the final paragraph in the USPTO Preliminary Examination Instructions encourage the examiners to, after conducting the two-part analysis, proceed with examination of the claim, regardless of whether a rejection under § 101 has been made, to determine patentability in accordance with the other requirements of 35 U.S.C. § 101 (utility and double patenting), non-statutory double patenting, and §§ 112, 102, and 103. We respectfully propose that the USPTO forthcoming detailed guidance will expressly oblige the examiners to proceed with examination as encouraged in the final paragraph in the USPTO Preliminary Examination Instructions.

Again, we are grateful to have an opportunity to offer the above comments this time.

very truly yours,

A handwritten signature in black ink, appearing to read 'Eiji Katayama', with a stylized, flowing script.

Eiji Katayama  
President  
The Japanese Group of AIPPI