

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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The Honorable Margaret A. Focarino
Commissioner for Patent
United States Patent and Trademark Office
Alexandria, Virginia

Re: JIPA Comments on the MEMORANDUM of "Preliminary Examination Instructions in view of the Supreme Court Decision in Alice Corporation Pty. Ltd. v. CLS Bank International, et al."

Dear Commissioner Focarino:

We, the Japan Intellectual Property Association, are a private user organization established in Japan in 1938 for the purpose of promoting intellectual property protection, with about 930 major Japanese companies as members. When appropriate opportunities arise, we offer our opinions on the intellectual property systems of other countries and make recommendations for more effective implementation of the systems. (<http://www.jipa.or.jp/english/index.html>)

Having learned that the MEMORANDUM of "Preliminary Examination Instructions in view of the Supreme Court Decision in Alice Corporation Pty. Ltd. v. CLS Bank International, et al.", published by the United States Patent and Trademark Office (USPTO) on June 25, 2014 (in the Federal Register, Vol.79, No.125, on June 30, 2014), we would like to offer our opinions as follows. Your consideration on our opinions would be greatly appreciated.

JIPA again thanks the USPTO for this opportunity to provide these comments and welcomes any questions on them.

Sincerely, yours,

(Sayuri IMAKO)

Managing Director

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**JIPA Comments on the MEMORANDUM of "Preliminary Examination Instructions
in view of the Supreme Court Decision in Alice Corporation Pty. Ltd. v. CLS Bank
International, et al."**

JIPA has given great interest on the Supreme Court decision on the case of Alice Corp. We appreciate that the USPTO's effort on publishing the "Preliminary Examination Instructions" this June in response to the decision.

In view of its impact on the examination practice in the USPTO, however, we have some concerns about examination criteria and approach. We also would like to request to open examples of examination to the public as reference information, so as to clarify the criteria of subject matter eligibility and to reduce variations among examinations by the USPTO.

Points to be considered:

The Supreme Court decision this time held that Alice Corp.'s claims to methods were ineligible because "the claims at issue amount to 'nothing significantly more' than an instruction to apply the abstract idea of intermediated settlement using some unspecified, generic computer". However, lack of objectivity with respect to this 'significantly more' criteria might result in increased variation in examiners' judgment.

We would request that the following points should be clarified in "The Preliminary Alice Corp. Instructions".

■ **In General**

- We would request that it should be clarified which cases will be eligible/ineligible under 35 U.S.C. § 101. We also would like to request to show specific case examples as in the JPO Examination Guidelines, especially specific examples of claims which are not examined to be abstract ideas.

- We would request that the view about how the USPTO considers the relationship between the 'significantly more' criteria and 'Machine Or Transformation Test (MOT test)' prior to the Bilski Supreme Court decision should be clarified. For example, can we understand that if the 'significantly more' criteria are met, there is no need to be subject to the examination according to the 'MOT test'?

■ **Part 1 of "Two-part Analysis for Abstract Ideas"**

This part shows four examples of the "abstract ideas".

We are afraid that these four examples are too vague. We would like to request to show more specific examples of respective cases which are and not included in the "abstract ideas".

In particular, we are concerned that cases will increase where a software-related invention of a processing program running on a generic computer is examined to be included in any of the four examples in the examination of the USPTO. Thus, we would request the USPTO to present a plurality of examples of cases where such a processing program does not fall within any of the four examples.

In addition, we believe that software controlling the operation of hardware is to be considered to be a process, not an abstract idea, which should be clearly shown.

■ **Part 2 of "Two-part Analysis for Abstract Ideas"**

We are afraid that the following description is not clear.

"Requiring no more than a generic computer to perform generic computer functions that are well-understood, routine and conventional activities previously known to the industry." is used as an example not enough to qualify as "significantly more".

We would like to know to what extent we should describe a software-related invention which solves a new problem, in order to satisfy the requirement of "significantly more". A clear guidance would be highly appreciated.

As a clear guidance, we would like to propose to show specific cases, as the JPO does at the Examination Guidelines.

(EOD)