

# JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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To: United States Patent and Trademark Office  
Eligibility2018@uspto.gov

Dear United States Patent and Trademark Office

## **Re: JIPA Comments on Berkheimer Memorandum**

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 950 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.

We appreciate the opportunity you've given us to learn about latest 101 examination guideline, training materials, and so on. We would like to offer our opinions for your request regarding Federal Register Vol. 83 as follows. Your deeply consideration on these matters will be appreciated.

1. When a rejection is formulated according to Memorandum, III. A. 1 or III. A. 3, we request the examiner to cite a portion of description, which is decided to form the basis for the rejection and to explain the reasons for the decision.

2. When a court decision such as described in the MPEP is cited

according to Memorandum, III. A. 2, we request the examiner to explain the reasons why the court decision is applied to the present application. In addition, we consider that in A. 2, there is room for the examiner to interpret the court decision to the examiner's advantage. "Decisions identifying abstract ideas" (quick reference sheet) (posted July 23, 2018) is so useful for applicants, but the contents in the reference sheet are so short that the examiner might reject the application with such simplistic criteria. For instance, although the reference sheet teaches "Encoding and decoding image data" is "Certain Methods of Organizing Human Activity", we don't believe methods of "Encoding and decoding image data" including unprecedented compression ratio are abstract ideas. We request you to consider enhancing useful materials for the understanding of the applicant, for example, categorizing court decisions pertaining to 35 U.S.C. §101 by technical field or reciting a list of further accurate technical contents decided to be abstract ideas.

3. When the examiner makes a decision based on Memorandum, III. A, we request the examiner to make sure to consider not only an element but also a combination of elements although this is also already emphasized in the Training Material (Training: Well-Understood, Routine, Conventional Activity (posted May 7, 2018)). Further, we request the examiner not to directly give an excerpt from the guidelines but to make sure to give a clear description of how the examiner has compared a citation or court decision with the present application, in the rejection.

4. In Memorandum, III. A. 3, when an applicant follows the procedure for

only requesting the presentation of a document which forms the basis for the rejection, please clarify whether or not that procedure is regarded as a response to the office action.

5. In item 4, if the procedure is regarded as a response to the office action, it is considered that the examiner will present the document through a "next office action." In this case, please clarify whether or not the "next office action" always becomes the "final office action." It should be noted that this comment is premised on the assumption that the rejection is formulated only based on 35 U.S.C. §101.

6. In Memorandum, III. A. 2 or III. A. 3, when the "Final Office Action" is issued based on 35 U.S.C. §101 without sufficiently presenting court decisions or documents at the examination stage and then the applicant files an appeal, it is unclear whether (i) an additional court decision or document search is done at the appeal stage or (ii) the rejection of appeal judgement has been settled down without doing any additional search, and thus, please clarify this point. We request you to take into consideration financial burdens on the applicant which are required for an appeal or a CIP.

7. According to Memorandum, III. B., the examiner can obviate the presentation of a document which forms the basis for the rejection by issuing an affidavit or declaration to the applicant under CFR 1.104(d)(2). We request the examiner to prudently issue an affidavit or declaration as in MPEP 2144.03.

8. Memorandum, III. A. 3 uses the following different expressions: "in the relevant field" and "in the relevant industry." Please clarify whether they differ from each other in the meaning.

JIPA again thanks the USPTO for this opportunity.

Sincerely yours,

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Masahiro ASAMI

President

Japan Intellectual Property Association