

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

Asahi-Seimei Otemachi Bldg. 18F.
6-1, Otemachi 2-Chome
Chiyoda-ku, Tokyo 100-0004 JAPAN



Tel: 81 3 5205 3433
Fax: 81 3 5205 3391

April 10, 2012

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
Alexandria, Virginia

Re: JIPA Comments on the “Transitional Program for Covered Business Method Patents –
Definition of Technological Invention”

Dear Under Secretary Kappos:

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 900 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 “Transitional Program for Covered Business Method Patents – Definition of Technological Invention”, published by the United States Patent and Trademark Office (USPTO) in the Federal Register, Vol.77, No.28, on February 10, 2012. 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,

Yoichi Okumura

President

Japan Intellectual Property Association

Asahi Seimei Otemachi Bldg.18F

6-1 Otemachi 2-chome Chiyoda-ku Tokyo, 100-0004,

JAPAN

**JIPA Comments on the “Transitional Program for Covered Business Method Patents
– Definition of Technological Invention”**

JIPA has closely and carefully examined the proposed amendment to 37CFR, publicized in the Federal Register issued by the United States Patent and Trademark Office (USPTO) as of February 10, 2012, under the title of "Transitional Program for Covered Business Method Patents – Definition of Technological Invention" (hereinafter referred to as the "Proposed Amendment"). JIPA hereby presents its comments on this proposed amendment.

1. The Proposed Rules introduce provisions to define the concepts of "covered business method patent" and "technological invention." JIPA would like to express its gratitude for the USPTO to have thus defined a covered business method patent, which is an exception to PGR, in consideration of users' convenience.

2. However, the definition of the concept of "technological invention" is still unclear. The Proposed Rules describe this concept as follows: "the following will be considered on a **case-by-case basis**: whether the claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art; and solves a technical problem using a technical solution."

JIPA understands that in order for the scope of this concept to become clearer, there is nothing to be done except to wait for the accumulation of cases where the "Transitional Program for Covered Business Method," to be separately stipulated, is actually applied.

Nevertheless, JIPA would strongly request that the USPTO provide applicants for PGR with supplementary materials that could help them gain a better understanding of the definition of this concept, while showing specific case examples.

(EOD)