

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

Nihombashi 3-Chome Square Bldg.
6F, 9-1 Nihonbashi 3-chome,
Chuo-ku, Tokyo 103-0027, JAPAN



TEL:+81-3-6262-1570
FAX:+81-3-6262-5655
URL:<http://www.jipa.or.jp/>

Oct 11,2022

Kathi Vidal
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22314

Re:JIPA Comments on the patent subject matter eligibility guidance

Dear Director Kathi Vidal,

We, the Japan Intellectual Property Association “JIPA”, are a private user organization with about 970 major Japanese companies as members.

When appropriate opportunities arise, we offer our opinions on the intellectual property system of other countries and make recommendations for more effective implementation of the systems.

Having learned a consultation, the state of patent eligibility jurisprudence, and its effect on investment and innovation, we would like to offer our opinions as follows.

Your consideration on our opinions would be greatly appreciated.

Sincerely yours,



Yoshihiro ENDO
Managing Director
Japan Intellectual Property Association

Re:JIPA Comments on the patent subject matter eligibility guidance

We, the applicants, feel that the 2019 PEG is beneficial in that clarified criteria for judging the subject matter eligibility and improves the predictability on subject matter eligibility rejections.

We would like to make the following requests 1 to 4 in the expectation that the requests would be of some help in further improving the clarification, the consistency, and the prediction possibility of the judgement of the subject matter eligibility.

1. There are some cases where claims are found to be directed to an Abstract idea by focusing solely on the formal aspects of the claim. Specifically, in the examination on claims of AI inventions, the examiners judge that the claim is directed to an abstract idea on the basis of "machine learning model is not described as Neural Network" and "the training data is not described as images" on the ground of non-limiting hypothetical examples of claims in MPEP 2106.04 (a) (1), or Example 39 in the 2019 PEG. We requested clarification of the description of the MPEP and improvement of the examination practice so that the examination is not based solely on such formalities.

2. It is requested that the criteria for judging insignificant extra-solution activity be clarified. From the applicant's point of view, there is an impression that judgments on insignificant extra-solution activity are varied depending on the examiners. One of the reasons for the different judgments is that the criteria for distinguishing extra-solution activity from the primary process or product are unclear. Thus, our suggestion is that, for example, the explanation on the primary process or product should be made or specific examples should be described in MPEP 2106.05 (g), Insignificant Extra-Solution Activity.

3. It is difficult to judge Step 2B in the process of the judgement on the subject matter eligibility. However, there is only one case in the 2019 PEG cases 37 - 46 that is Yes in Step 2B, we request to add other examples to be determined as Yes in Step 2B.

4. It is useful for applicants to understand the examination criteria for the subject matter eligibility if multiple claim variations for one example in the same manner as in Examples 37, 40 and 42 in the 2019 PEG. In addition to these examples, we would like to see more examples including explanations of several claim variations explained. It is very helpful for applicants to understand the examination criteria for subject matter eligibility if multiple claim variations are explained for a single case, as in 2019 PEG cases 37, 40 and 42.

END