

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

3. Court precedents relating to Eligibility for Patent and Industrial Applicability (Article 29 (1) Main Paragraph of the Patent Act)

Classification	Content	No.	Date of Decision (Case No.)	Relevant Portion of Examination Guideline
31	Whether or not the claimed invention is the statutory "invention"	1	Intellectual Property High Court Decision, Sep. 26, 2006 (2005 (Gyo KE) No.10698)	Part III Chapter1 2.
		2	Intellectual Property High Court Decision, Jun. 24, 2008 (2007 (Gyo KE) No.10369)	
		3	Intellectual Property High Court Decision, Dec. 5, 2012 (2012 (Gyo KE) No.10134)	
		4	Intellectual Property High Court Decision, Jan. 22, 2015 (2014 (Gyo KE) No.10101)	
32	Industrial applicability	1	Intellectual Property High Court Decision, Apr. 27, 2011 (2010 (Gyo KE) No.10246)	Part III Chapter1 3.
32-1	Whether or not the method in question is "methods of surgery, therapy or diagnosis of humans" with regard to "industrial applicability"	1	Intellectual Property High Court Decision, Aug. 28, 2013 (2012 (Gyo KE) No.10400)	Part III Chapter1 3.1.1 and 3.2.1

(31)-1

Relevant portion of Examination Guidelines	Part III, Chapter 1, 2.
Classification of the Case	31: Whether or not the claimed invention is the statutory "invention"
Keyword	Computer-software related invention

1. Bibliographic Items

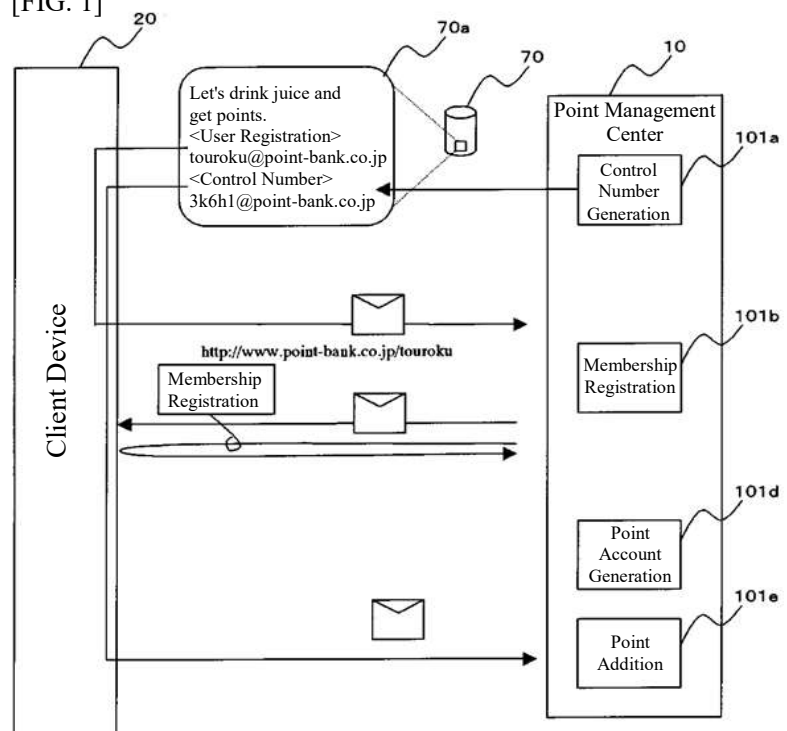
Case	"Point management method" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, September 26, 2006 (2005 (Gyo KE) No. 10698)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2000-319884 (JP 2002-133241A)
Classification	G06F 17/60
Conclusion	Dismissal
Related Provision	First Paragraph of Article 29(1) main paragraph
Judges	IP High Court Third Division, Presiding judge Ryoichi MIMURA, Judge Yuji KOGA, Judge Kazuhide SHIMASUE

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention solves the technical problems of providing a point management technique according to which "cumbersome procedures is not necessary in point collection, much expense is not necessary for application (for a campaign), costs for a campaign organizer can be reduced, and information on the applicants are readily utilized." As the method for point management, the following steps are performed:

[FIG. 1]



(A) receiving transmission information via a network, the transmission information including identification information of a user and a symbol string that is input by the user; and

(B) in response to reception of the transmission information, adding a predetermined point to the cumulative points in the point account database with regard to the point account of the user for the point campaign, the user being determined on the basis of identification information of the user and the point campaign being determined on the basis of the symbol string.

(2) The Claims (prior to the First Amendment) (Only claim 11 is cited therefrom.) (the Claimed Invention) (referred to as "claim 11" in the appeal decision, and "previous claim 11" in the court decision.)

[Claim 11] A method for managing points by referencing a point account database using a point account of a user for each point campaign and storing cumulative points on a per point campaign basis, the method comprising the steps of:

receiving transmission information via a network, the transmission information including identification information of a user and a symbol string that is input by the user, and

in response to reception of the transmission information, adding a predetermined point to the cumulative points in the point account database with regard to the point account of the user for the point campaign, the user being determined on the basis of the identification information of the user and the point campaign being determined on the basis of the symbol string.

### (3) Procedural History

- April 9, 2003 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2003-5927) accompanied by an amendment (First Amendment)
- May 8, 2003 : Amendment (Second Amendment)
- August 2, 2005 : Dismissal of the first and second amendments and Appeal Decision dismissing the appeal

### 3. Portions of Appeal/Trial Decisions relevant to the Holding

Appeal Decision
<p><i>* The "steps" mentioned in the following refer to the underlined two steps recited in "the claims."</i></p> <p>Given the recitations of claim 11, it is noted that two cases are contemplated, i.e., a case where the point management is performed through operation of each of the units made by a human and another case where the point management is carried out by a computer. In this context, the case where a human operates each of the units for point management and the case where a computer carries out the point management are independently examined.</p> <p>(1) A case where a human operates a series of units and performs the point management:</p> <p>... It is recognized that claim 11 substantially recites the point management method as such based on the artificially arranged or defined modes of point management.</p>

Therefore, it is not recognized that the claimed invention is a creation of a technical idea utilizing a law of nature.

(2) A case where a computer performs the point management:

... The claimed invention is a "method for point management," which is an invention of process comprising the steps ... the method being carried out using hardware resources such as a network and a point account database. Accordingly, the claimed invention is so-called a software-related invention, working of which requires software.

Also, in order for a software-related invention utilizing software of this kind to be a "creation of a technical idea utilizing a law of nature," particular features should be presented in a concrete manner, the features enabling the invention to solve a predetermined technical problem as a result of the information processing by software utilizing hardware resources, for an invention has to be constructed as a solution for a predetermined technical problem if it claims to be an invention at all.

As the claimed invention is identified as discussed above, the principal part that provides the basis for the solution to the technical problem in the claimed invention is the step of ...

... With regard to how the processes of the steps are realized by information processing by software utilizing hardware resources such as networks and the point account database, this aspect in question is not concretely described at all.

Also, the claimed invention that includes these steps of ... as its substantial principal part fails to present particular matters that makes it possible to solve the technical problem in a concrete manner, and it in no way constitutes a solution for a predetermined technical problem. Therefore, it cannot be recognized that the claimed invention is a creation of a technical idea utilizing a law of nature.

Decision

Allegations by Plaintiff

(1) With regard to the case where a human operates a series of units and performs the point management

... In the claimed invention, it is almost impossible to contemplate that a human directly "receives via the network the transmission information that includes the identification information of a user and the symbol string that is input by the user." It is necessary to utilize a certain reception circuit, a display device, and the like to receive and recognize the transmission information. However, the old claim 11 does not include such a recitation, and there is no reasonable ground to expect that a human would carry out such reception. In

Allegations by Defendant

(1) With regard to the case where a human operates a series of units and performs the point management

... The claimed invention partly uses the law of nature i.e., uses the "account database" and the "network." However, the utilization of these elements does not have particular technical significance. Accordingly, the claimed invention, when considered in its entirety, is nothing but an artificial arrangement and thus it cannot be recognized as a creation of a technical idea utilizing a law of nature.

(2) With regard to the case where a computer performs the point management

As discussed in the appeal decision, given the

<p>addition, the Detailed Explanation of the Invention does not include any description that would substantiate the existence of such implicit, manually performed processing.</p> <p>(2) With regard to the case where a computer performs the point management</p> <p>Since it is clear that a person skilled in the art can adopt a step or steps of this kind, realize the method of point management, and achieve the above objects and working effects, the claimed invention has the basis for the integrity as an invention. Further, this invention is not at all intended to claim what is not in effect an invention as an invention in the disguise of utilization of a computer. Hence, this invention is sufficiently concrete as a software-related invention.</p>	<p>steps of recited in the old claim 11, i.e., the step of "receiving transmission information via a network, the transmission information including identification information of a user and a symbol string that is input by the user," and the step of "in response to reception of the transmission information, adding a predetermined point to the cumulative points in the point account database with regard to the point account of the user for the point campaign, the user being determined on the basis of the identification information of the user and the point campaign being determined on the basis of the symbol string," <u>it is not possible to grasp a processing procedure or procedures that are concretely stated to the extent that the procedures can be grasped as the information processing of software.</u></p>
<p>Judgment by the Court</p> <p>(1) With regard to the case where a human operates a series of means and performs the point management</p> <p>... In view of the above consideration, it is possible that each action of the claimed invention is performed by a human. Accordingly, <u>although the "network" and the "point account database are used as a means performing the invention, the claimed invention uses these means merely as a tool on the whole, and it is nothing but an artificial arrangement for performing a point management. Therefore, it cannot be recognized that the claimed invention is a creation of a technical idea utilizing a law of nature.</u></p> <p>(2) With regard to the case where a computer performs the point management</p> <p>... A method using a computer may be contemplated as the "method for point management" of the claimed invention from the recitations of the above old claim 11. Meanwhile, there is not recitation that allows understanding of the specific operational method according to the intended use of an information processing device, as a result of reading the software into the computer, by concrete means in which software and hardware resources are cooperatively working so as to realize arithmetic operation or manipulation of information depending on that use purpose.</p> <p>... the claimed invention includes as hardware resources nothing more than the "network" and the "point account database", and includes as the software using these hardware resources, "referencing a point account database," "receiving via the network," and "adding a predetermined point to the cumulative point of the account database." Then, <u>each step of the old claim 11 does not describe, in a concrete manner, how the point management processing and the hardware resources consisting of the "network" and the "point account database" are cooperatively working. Accordingly, although it can be said that there exists the flow of information processing, it cannot be said that the information processing is concretely realized using the</u></p>	

hardware resources. Therefore, it is not recognized that the claimed invention is a creation of a technical idea utilizing a law of nature in light of the Examination Guidelines.

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Relevant portion of Examination Guidelines	Part III Chapter1 2.
Classification of the Case	31: Whether or not the claimed invention is the statutory "invention"
Keyword	

#### 1. Bibliographic Items

Case	"Interactive dental treatment network" (Appeals against an examiner's decision) Intellectual Property High Court Decision, Jun. 24, 2008 (2007 (Gyo KE) No.10369)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No.2000-579144 (Official Gazette No.2002-528832)
Classification	G06F 17/60
Conclusion	Acceptance
Related Provision	Article 29 (1) main paragraph
Judges	IP High Court First Division, Presiding Judge: Tomoichi TSUKAHARA, Judge: Tomonari HONDA, Judge: Koichi TANAKA

#### 2. Overview of the Case

##### (1) Summary of Claimed Invention

The claimed invention is an interactive dental restoration method, and is also a system used between a dentist and a dental restoration laboratory. The method includes: judging a dental restoration need in a patient; designing an initial treatment plan that includes design criteria for preparation of a dental prosthesis to be placed in the patient to satisfy the dental restoration need; transmitting the initial treatment plan via a communication network to the dental restoration laboratory; and transmitting a final treatment plan, including modifications to the initial treatment plan where necessary, to the dentist. The system comprises a network server (1610) with a database (1630), a network (1620) and at least one local computer (14). The database stores information about materials, procedures and preparations concerning the dental prostheses.

##### (2) The Claims (Only Claim 1 is described.)

[Claim 1] A dental treatment system based on a computer, comprising:

a network server with a database storing information about materials, procedures and preparations concerning dental prostheses; a communication network providing access to the network server; one or more

computers installed at least in a dental examination room to access information stored in the database and display such information in human-readable form; means for judging a dental restoration need; and means for designing an initial treatment plan that includes design criteria for preparation of a dental prosthesis for the dental restoration,

wherein the communication network transmits the initial treatment plan to the dental restoration laboratory; and the communication network transmits the final treatment plan, including modifications to the initial treatment plan where necessary, to the dental treatment room.

(3) Procedural History

- April 26, 2005 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No.2005-7446)
- May 26, 2005 : Amendment (See "The Claims" mentioned above)
- June 19, 2007 : Trial decision that "the request for the trial is dismissed".

3. Portions of Appeal/Trial Decisions relevant to the Holding

Trial decision	
<p>... It should be said that the subject of "judging a dental restoration need" and "designing the initial treatment plan that includes design criteria for preparation of a dental prosthesis for the dental restoration" mentioned in Claim 1 is a dentist since it is common sense that a dentist judges a dental restoration need in a patient and designs an initial treatment plan as part of his/her mental activities. Then, it is found that "judging" and "designing" by the dentist as part of his/her mental activities are expressed as "means" in Claim 1.</p> <p>...</p> <p>In Claim 1, the original words and phrases, the invention of "interactive dental treatment method", and "judging" and "designing" were amended to the one of "dental treatment system based on a computer", and "means of judging" and "means of designing", respectively. As stated above, however, the dentist's judging and designing based on his/her mental activities are expressed as the "means" in the matter to define the invention with regard to the "means of judging" and the "means of designing", and therefore, this cannot be said to be the technical creation utilizing a law of nature even judging from the claimed invention in Claim 1 as a whole.</p>	
Decision	
<p>Allegations by Plaintiff</p> <p>... The feature of the claimed invention in Claim 1 is the system that makes it possible to create and implement a final treatment plan by creating and transmitting an initial treatment plan between a dental treatment room and a dental restoration laboratory</p>	<p>Allegations by Defendant</p> <p>... It is not the case that merely adding the word, "means" in lieu of the statement of the method, "doing" automatically leads to the interpretation that the subject in question is not a human being but a machine. Whether the subject of "means of X" is a</p>



<p>through a network server, a communication network and one or more computers. As stated in [0001] of the Exhibit A12 (re-translation from the international patent (laid-open) pamphlet on the claimed invention), specifically, this is an interactive system based on a computer that enables a computer of a dentist and one of a dental restoration laboratory to analyze a color image of a tooth or teeth and a abutment (preparation) and to appropriately design an artificial tooth or teeth, or an artificial crown that precisely fits a tooth or teeth to be replaced through a certain treatment or beauty treatment.</p> <p>... The trial rules that the "means of judging" and the "means of designing" stated in Claim 1 mean "a dentist judges and designs based on his/her mental activities", which inverts and contradicts the meaning in the objective of the claimed invention in Claim 1. Since, in light of the said objective, this invention is aimed at making work to choose suitable materials and methods as little as possible that has been so far very difficult one based on a dentist mental activities, it is obvious that the invention does not include the means as a system whose subject is his/her mental activities themselves.</p>	<p>human being or a machine should be determined substantially, taking into account whether or not there is a definition of "means of X" in the detailed description of the invention as well as common general knowledge and common sense after interpreting the word, "X." "Judging a dental restoration need" and "designing the initial treatment plan that includes design criteria for preparation of a dental prosthesis for the dental restoration "merely state contents of work of the dental treatment, and include no technical contents that demonstrate the process executed by a machine (a computer).</p> <p>Hence, it is not possible at all to determine from the statements that "this is not human mental activities but the process executed by the machine."</p>
<p><b>Judgment by the Court</b></p> <p>... It is understood that an initial treatment plan includes a digital image of a tooth or teeth; materials and the processing method and process/design, etc., used for a dental treatment are chosen based on the digital image; the data necessary for such choice is stored in the database; and the designed initial treatment plan is transmitted between a dental clinic and a dental laboratory through the network. It is also understood that while an act of a dentist is required to acquire and choose the image and to choose the materials, etc., he or she can perform those acts using a terminal that is connected to the network and can display images.</p> <p>... It is understood that the claimed invention, having a scanner, makes it possible to scan a preparation of a tooth or teeth, input their data, compare such data with specifications stored in the database to check whether a the treatment plan should be modified or not. Substantially, it is deemed that a human being checks it.</p> <p>F In light of the above, it is understood while "a means for judging a required dental restoration" and "a means for designing the initial treatment plan that includes design criteria for preparation of a dental prosthesis for the dental restoration" stated in Claim 1 include elements which can be realized by human activities, and</p>	

mental activities such as assessment and judgment are necessary to implement the claimed invention in Claim 1. However, when the objective of the invention stated in the description and the detailed description of the invention taken into consideration, it is hardly right to say that the claimed invention in Claim 1 is directed to mental activities themselves, and as a whole, it is rather understood that the claimed invention provides the technical means for supporting the dental treatment and working based on the computer, which are equipped with "the network server with database", "the communication network", " the computer installed in the dental treatment room" and "the device displaying images and executing the processing".

G Therefore, it can be said that the claimed invention in Claim 1 falls under the "creation of a technical idea utilizing a law of nature", and the trial decision that the said claimed invention 1 does not fall under the "invention" defined in Article 2 (1) of the Patent Act is inadmissible.

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Relevant portion of Examination Guidelines	Part III, Chapter 1, 2.
Classification of the Case	31: Whether or not the claimed invention is the statutory "invention"
Keyword	

1. Bibliographic Items

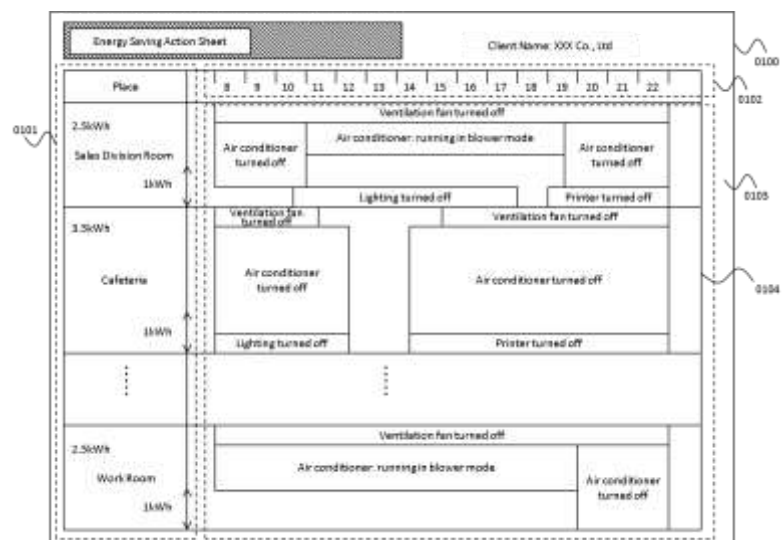
Case	"Energy saving action sheet" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, December 5, 2012 (2012 (Gyo KE) No. 10134)
Source	Website of Intellectual Property High Court, HANREI JIHO No. 2181, page 127, HANREI TIMES No. 1392, page 267
Application No.	Japanese Patent Application No. 2010-82481 (JP 2011-136547A)
Classification	B42D 15/00
Conclusion	Dismissal
Related Provision	First paragraph of Article 29(1) main paragraph
Judges	IP High Court Fourth Division, Presiding judge Akio DOI, Judge Makiko TAKABE, Judge Iwao SAITO

2. Overview of the Case

(1) Summary of Claimed Invention

The "Energy Saving Action Sheet (100)" of the claimed invention comprises a place axis (101) that indicates the name of a place and an electric power per unit hour; a time axis (102) that indicates time; and an energy saving action arrangement area (103) for indicating an energy saving action that should be taken in a predetermined area defined by the place axis and the time axis.

[FIG. 1]



An energy saving action identification area (104) is provided in the energy saving action arrangement area (103). The time and the place in which each energy saving action should be taken can be apparently recognized and a rough electric energy amount that can be reduced by taking each energy saving action can be apparently

recognized by indicating the rough electric energy amount that can be reduced by taking the energy saving action indicated in the energy saving action identification area (104).

(2) The Claims (Amended) (the Claimed Invention)

[Claim 1] An energy saving action sheet comprising:

a first place axis indicating a plurality of names of places within a building, wherein a length of the first place axis in its axis direction indicates an electric per unit hour that can be reduced at each of the places; a first time axis whose scale indicates time of day; a first energy saving action arrangement area for displaying an energy saving action that should be taken, wherein the action is displayed in a predetermined area identified by the first place axis and the first time axis, the first energy saving action arrangement area further including a first energy saving action identification area wherein the electric power per unit hour that can be reduced by the energy saving action is indicated by the length in the first place axis direction and the duration time of the energy saving action is indicated by the length of the first time axis in its axis direction such that the energy saving action indicated in the corresponding first energy saving action identification area and a rough electric energy amount that can be reduced by that energy saving action are indicated (the rough electric energy amount being an electrical power consumption that can be identified by an area obtained by multiplying the electric power per unit hour that can be reduced by the energy saving action by the duration time of the energy saving action ).

(3) Procedural History

- October 27, 2010 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2010-24151)
- February 7, 2012 : Amendment (See the above-described "The Claims.")
- March 6, 2012 : Appeal Decision dismissing the appeal

3. Portions of Appeal/Trial Decisions relevant to the Holding

<p>Appeal Decision</p> <p>... The creative feature of the claimed invention lies in the fact that the first place axis is "a first place axis indicating a plurality of names of places within a building, wherein a length of the first place axis in its axis direction indicates an electric power per unit hour that can be reduced at each of the places" and the first energy saving action identification area is configured such that "the electric power per unit hour that can be reduced by the energy saving action is indicated by the length in the first place axis direction and the duration time of the energy saving action is indicated by the length of the first time axis in its axis direction," in other words, <u>the creative feature of the claimed invention consists in the content represented by the axes and the area illustrated in the figure and the content of information as such that is displayed in that area, so that there is no technical feature found in the presentation of that information and it cannot be said that the claimed invention is a creation of a technical idea utilizing a law of nature.</u></p> <p>It is noted that the claimed invention realizes certain effects such as being readily viewable and readily</p>
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understood by a viewer, but the two-dimensional representation of the axes and the area of the claimed invention, ... is nothing but a generally existing two-dimensional representation, which means that the creative feature of the claimed invention is, in effect, the content as such represented by the axes and the area as well as the content of information as such displayed by that area.

... The claimed invention ... is not a "creation of a technical idea utilizing a law of nature " in the meaning of Article 2(1) ...

**Decision**

**Allegations by Plaintiff**

... The first place axis and the first energy saving action identification area of the claimed invention are the means for "presentation" that is technically used to solve the problem, in other words, they are the constituent features of the claimed invention. Since the technical idea consists in these constituent features and the combination thereof, there should be no obstacles to granting of a patent for the claimed invention, which is apparently eligible for protection as an "invention."

Given the features, ... it is made possible to instantaneously understand which energy saving action in which place should be given priority to achieve optimum energy saving effects. It is clear that any of these visual effects is not the content of information itself such as the "electrical power consumption" and the "place," but what is realized by the method of presentation of information having the features such as the "first place axis" and the "first energy saving action identification area." The technical features lie in.... such presentation of information.

... The claimed invention utilizes the law of nature as long as it always produces predetermined effects for a viewer by virtue of the two-dimensional feature (technical structure) (effects such as being easily viewable and being readily understood) ...

The technical feature of the claimed invention lies in the way of presentation of information, by

**Allegations by Defendant**

... The "axes "and the "area" of the claimed invention are merely a feature associated with expression for defining the layout of a chart, and they do not constitute a technical feature which utilizes a law of nature and is constructed in combination with a particular physical thing. Also, since the visual effects of the claimed invention do not go beyond the effects in terms of expression obtained as a result of creatively arranging the representation of the chart, the "axes" and the "area" of the claimed invention are not technical features utilizing the law of nature and realizing working effects that would change a particular physical thing into another state.

Further, it can be understood that the creative characteristic of the claimed invention consists in the content of information associated with the first axis, the second axis, and the like of the chart as well as the content of information represented in the chart, in other words, it consists in the arrangement of the layout as the chart.

Also, the content of electrical power consumption which is information to be presented is rough electric energy amount "that can be reduced".... and the claimed invention achieves the effect that the amount can be apparently recognized from the size of representation, but ... ensuring that the amount can be apparently recognized is merely a function that the chart should have as long as it is a chart, and, after all, the feature of the claimed invention converges on the

<p>virtue of which the effects of being "easily viewable" and "readily understood" by a viewer is realized. Therefore, the claimed invention is a "creation of a technical idea utilizing a law of nature" in the meaning of Article 2(1) of the Patent act and thus it is an "invention" as provided for in the first paragraph of Article 29(1) of the Act.</p>	<p>point that the content of the electrical power consumption to be presented is the rough electric energy amount "that can be reduced ..."</p> <p>As discussed in the foregoing, the means for recording and presenting the information as alleged by Plaintiff is nothing but <u>arrangement for layout of a chart in which a technique utilizing the law of nature is not involved.</u></p> <p>... Since the Energy Saving Action Sheet of the claimed invention is <u>nothing but ... presentation of the information ... in the form of a chart in accordance with the layout defined by Plaintiff</u>, it does not constitute "a technical idea utilizing a law of nature" ...</p>
<p>Judgment by the Court</p> <p>Article 2(1) of the Patent Act defines an "invention" as "a highly advanced creation of technical ideas utilizing a law of nature." Since a human being has the ability to act and make decisions freely, a human being's act, such as performing a certain mental activity, making a certain decision, adopting a certain behavior, etc., per se may not be directly regarded as the utilization of the laws of nature even if such act is recognized to have beneficial and useful effects.</p> <p>Accordingly, <u>even if the creation of technical ideas made for the purpose of solving a certain problem is very concrete, beneficial, and useful, as long as the problem-solving process solely uses a principle or law involving human mental activities, a principle or law in the field of social science, an artificial arrangement, or a mathematic formula, etc., and does not involve any laws of nature, such creation of technical ideas may not be regarded as an "invention" as provided for in Article 2, paragraph (1) of the Patent Act.</u></p> <p>... the feature is, with regard to the layout of the chart named "Energy Saving Action Sheet," to identify the axes and the area by assigning names to and defining meanings of the axes ("first place axis" and "first time axis ") and the area identified by these axes ("first energy saving action arrangement area" and "first energy saving action identification area"), so that the feature is characterized in respect of the content of the information to be presented, i.e., the names and meanings of the respective "axes" and the "area." The Invention is a layout of a chart named "Energy Saving Action Sheet," which is characterized by the content of information presented in the chart, i.e., the names and meanings of the "axes" and the "area."</p> <p>Further, <u>the presentation per se of the names and meanings of each of the "axes" and the "area" identified by the axes in the chart, such as the "first place axis," the "first time axis," the "first energy saving action arrangement area," and the "first energy saving action identification area" is not the direct utilization of the laws of nature.</u> When the "Energy Saving Action Sheet" of the claimed invention is presented to a person, a person would be able to recognize and assess the size of each area and understand the meaning of ...</p> <p>Also, the "Energy Saving Action Sheet" of the claimed invention <u>is presented to a human and it is not</u></p>	

intended to be read by any device. Further, as means for presenting it to a human, nothing is technically identified with regard to aspects such as the modes of recording it on a medium such as a paper sheet or displaying it on a display screen, or the like. Therefore, it cannot be said that there is disclosed any technical feature that goes beyond simple recording and display of commonly conceivable charts.

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Relevant portion of Examination Guidelines	Part III Chapter1, 2.
Classification of the Case	31: Whether or not the claimed invention is the statutory "invention"
Keyword	

## 1. Bibliographic Items

Case	"Memorization learning material and manufacturing method of the material" (Trial against examiner's decision) Intellectual Property High Court Decision, Jan. 22, 2015 (014 (Gyo KE) No.10101)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2012-277387 (JP 2016-104514A)
Classification	G09B 3/00
Conclusion	Dismissal
Related Provision	Article 29 (1) main paragraph
Judges	IP High Court First Division, Presiding Judge: Yoshinori TOMITA, Judge: Ichiro OTAKA, Judge: Sumiko MASEGI

## 2. Overview of the Case

## (1) Summary of Claimed Invention

[Problem] To provide the memorization learning material, simple and excellent in handling, that supports efficient memorization learning, directing attention to a context of a whole character string, and the manufacturing method of the material.

[Means for solving the problem] The memorization learning material of the claimed invention is a memorization learning material that displays a partially hidden character string 2A for memorization learning generated by replacing part of the character string of the original text with blanks. The partially hidden character string 2A for memorization learning includes a first partially hidden character string 10A prepared about the character string of the original text as an object and provided with a first part of blanks 12A, and a second partially hidden character string 20 A prepared about the character string of the original text as an object separately from the first partially hidden character string 10A and provided with the second part of blanks 22A in portions different from those for the first part of blanks 12A.



(2) The Claims (Only Claim 1 is described.)

[Claim 1] A memorization learning material that displays the partially hidden character string for memorization learning generated by replacing part of the character string of the original text with blanks,

wherein the partially hidden character string for memorization learning includes:

a first partially hidden character string prepared about the character string of the original text as an object and provided with the first part of blanks; and

a second partially hidden character string prepared about the character string of the original text as an object separately from the first partially hidden character string and provided with the second part of blanks in portions different from those for the first part of blanks, and

the character string of the original text includes part or a whole of the works falling under any of the items of Article 13 of the Copyright Act (Act No.48 of May 6, 1970) of Japan that is effective as of the filing date of the patent application.

(3) Procedural History

December 13, 2013 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No.2013-25925)

March 11, 2014 : Trial decision that "the request for the trial is dismissed".

3. Portions of Appeal/Trial Decisions relevant to the Holding

Trial decision	
The claimed invention relates to a material, the learning material, a creative feature of which can be said to be contents of the character string for the purpose of memorization learning themselves. ... Since how to express the contents of the character string for the purpose of memorization learning and to make them suitable for memorization learning is directed at human mental activities themselves, which does not utilize a law of nature at all, it is impossible to regard the claimed invention as a technical idea utilizing a law of nature.	
Decision	
Allegations by Plaintiff ... A feature of the claimed invention is not merely the contents of the character string for the purpose of memorization learning themselves. Its creative feature also includes cooperative relationship between such contents and features found in the conventional technique as well. ... The claimed invention uses an art based on a law of nature in processing information, and the technical idea - to provide questions and answers with each	Allegations by Defendant The trial decision construes the "technical idea" as an idea to provide specific means for solving a certain problem, and does not confuse the requirements:" utilizing a law of nature" and "creation of a technical idea". Also, as the "law of nature" is construed as the repeatable, generic and inevitable relationship between natural events, or a law discovered by experience in the realm of nature, it is obvious that the "principle or

<p>other complementarily by putting blanks in different parts of the two partially hidden character strings - does not remain to be a notion but is embodied as the learning material. It is, therefore, obvious that the claimed invention falls under the "industrially applicable invention" as stipulated in Article 29 (1) main paragraph of the Patent Act, meeting the three requirements for the "invention" in Article 2 (1) of the Patent Act: "highly advanced", "creation of a technical idea" and "utilizing a law of nature".</p>	<p>law with human mental activities interposed", the "principle or law in the social sciences" and the "human decision" do not utilize the "law of nature".</p> <p>...</p> <p>The claimed invention arranges the first and the second partially hidden character strings so that human beings can learn in accordance with the predetermined procedures (they first learn the first part of blanks by looking at the first partially hidden character string, and then learn the second part of blanks by looking at the second partially hidden character string to confirm answers in the first part of blanks.); such character strings are arranged by human decisions; and the effect of the claimed invention is solely based on human mental activities that facilitate memorization by learning comparing the parts of blanks put in different portions of the same sentence.</p>
<p>Judgment by the Court</p> <p>... <u>Whether or not the invention stated in the claims for which a patent is sought falls under the "invention" as defined in Article 2 (1) of the Patent Act needs to be determined by whether or not the claimed invention in question as a whole falls under the creation of a technical idea "utilizing a law of nature", considering the technical significance of the presupposed technical problem, the constitution of technical means for solving such problem and the effect caused by such constitution.</u></p> <p>And since the "invention" is, as stated above, the creation of a technical idea "utilizing a law of nature", it is obvious that mere human mental activities, abstract notions and artificial arrangements by human beings, those of which are not a scientific law established by natural events and order as well as they do not utilize a scientific law, do not fall under the creation of a technical idea "utilizing a law of nature".</p> <p>Therefore, even if the invention stated in the claims for which a patent is sought provides some technical means, it does not fall under the "invention" when, after comprehensive consideration as above, the true nature of such invention is directed to human mental activities, abstract notions and artificial arrangements by human beings.</p> <p>...</p> <p>(A) Technical problem to be solved by the claimed invention</p> <p>... the object of the claimed invention is to provide a memorization learning material which is simple and excellent in handling and supports efficient memorization learning directing attention to a context of a whole character string for solving the above problem of the conventional momorizaion learning materials to be solved</p> <p>(B) Constitution of technical means for solving the problem</p>	

... It is found that the claimed invention is, in terms of technical means for solving the problem, constituted of the display form of the partially hidden character string for memorization learning displayed in the medium i.e. the memorization learning material ([1] mentioned above) and the character string itself, an object of memorization learning ([2] mentioned above).

(C) Effect deriving from the adopted constitution of technical means

According to the claimed invention, the claimed invention causes an effect that it can provide the memorization learning material, that is simple and excellent in handling, and that supports efficient memorization learning directing attention to a context of a whole character string.

...

As described, since the claimed invention is, in terms of technical means for solving the problem, constituted of the display form of the partially hidden character string for memorization learning displayed in the medium, or the memorization learning material, and the character string itself, an object of memorization learning, the effect of which is to support efficient memorization learning, directing attention to a context of a whole character string, it can be said that the technical significance of the claimed invention is the method of memorization learning itself of the matters to memorize that are displayed in the medium, or the memorization learning material.

...

Comprehensive consideration of the technical significance regarding the claimed invention of the technical problem, the constitution of the technical means for solving such problem and the effect deriving from such constitution leads etc., to the finding that the claimed invention is, in terms of technical means for solving the problem, constituted of the display form of the partially hidden character string for memorization learning displayed in the medium, or the memorization learning material, and the character string itself, an object of memorization learning, the effect of which is to support efficient memorization learning, directing attention to a context of a whole character string. Then, it can be said that the technical significance of the claimed invention is the method of memorization learning itself of the matters to memorize that are displayed in the medium, or the memorization learning material, which leads to the finding that the true nature of the claimed invention is solely directed to human mental activities themselves.

Therefore, the claimed invention as a whole does not fall under the creation of a technical idea "utilizing a law of nature" because the true nature of the invention is solely directed at human mental activities, and it is not, or does not utilize, a scientific law on natural events and order.

(32)-1

Relevant portion of Examination Guidelines	Part III, Chapter 1, 3.
Classification of the Case	32: Industrial applicability
Keyword	

## 1. Bibliographic Items

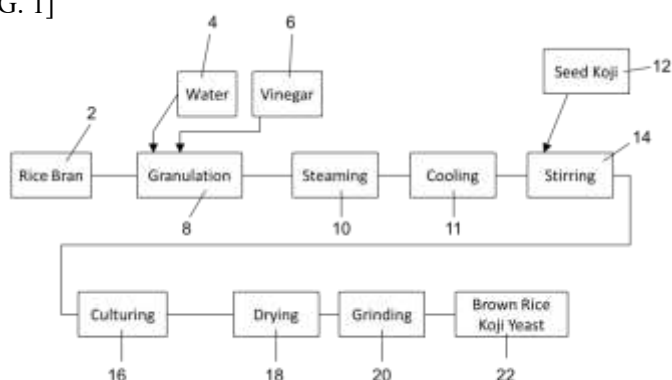
Case	"Method for culturing koji yeast by using rice bran as substrate" (Trial for Invalidation) Intellectual Property High Court Decision, April 27, 2011 (2010 (Gyo KE) No. 10246)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2003-104618 (JP 2004-267178A)
Classification	C12N 1/14
Conclusion	Dismissal
Related Provision	First Paragraph of Article 29(1) main paragraph
Judges	IP High Court Third Division, Presiding judge IIMURA Toshiaki, Judge TAKEMIYA Hideko, Judge SAIKI Norio

## 2. Overview of the Case

[FIG. 1]

## (1) Summary of Claimed Invention

The claimed invention is a method for culturing koji yeast with rice bran used as a substrate, comprising: a first step (8) of adding moisture to powder of rice bran and processing the powder of rice bran in a granular form; a second step (10) of applying steam to the rice bran made in the granular form and steaming the rice bran; a third step (16) of inoculating a seed koji into the steamed rice bran and culturing koji yeast in a straw mat; and a fourth step (18) of drying brown rice koji yeast including the cultivated koji yeast and enzyme produced during the culture.



## (2) Disclosure of Detailed Explanation of the Invention

[0017]

This is ground into an appropriate form of powder by a grinding step (20), and brown rice koji yeast is finished. The foregoing paragraphs have described the method for culturing a koji yeast with rice bran used as a

substrate according to the present invention and the brown rice koji yeast produced by the same method. Even when one wishes to cause the koji mold to act on an as-is basis with the rice bran in the form of a powder body used as the substrate, it is difficult to adjust the moisture content of the moisture that may be mixed therein and the amount of input of the koji mold. The koji mold is aerobic bacteria. However, when blowing air thereto for supplying oxygen is performed and the koji mold is dried, then the action of the mold itself becomes weak. In view of the problem of this kind, water retention and distribution characteristics are improved by use of the granular form, on the basis of which the attempts described in the foregoing have been made and thus the method for culturing according to the present invention has been obtained. It should be noted that the embodiment disclosed herein is only an exemplary one and the claimed invention is not restricted to the described embodiment, for the claimed invention is to be practiced in accordance with the content described in the claims.

(3) The Claims (Only claim 1 is cited therefrom.) (the Invention 1)

[Claim 1] A method for culturing koji yeast with rice bran used as a substrate, comprising: a first step of adding moisture to powder of rice bran and processing the powder of rice bran in a granular form; a second step of applying steam to the rice bran made in the granular form and steaming the rice bran; a third step of inoculating a seed koji into the steamed rice bran and culturing koji yeast in a straw mat; and a fourth step of drying brown rice koji yeast including the cultivated koji yeast and enzyme produced during the culture.

(4) Procedural History

- May 15, 2009 : Registration of establishment of the patent right (See the above-described "The Claims.")
- September 10, 2009 : Filing of a request for a trial for patent invalidation by Plaintiff (Muko No. 2009-800195)
- June 28, 2010 : Trial Decision dismissing the request for trial

3. Portions of Appeal/Trial Decisions relevant to the Holding

Trial Decision	
<p>... the term "brown rice koji yeast" denotes not the brown rice as a whole but the koji yeast cultivated with part of the rice bran used as the substrate, and accordingly it can be produced by fermenting the "rice bran." As such, <u>the Invention 1 does not include content that is against the law of nature.</u> Therefore, the Invention 1 satisfies the requirement as provided for in the first paragraph of Article 29(1) of the Patent Act.</p>	
<p>Allegations by Plaintiff</p> <p>"Brown rice koji yeast," since a large amount of koji mold is cultivated in the portion of "endosperm" is rich in enzyme and suited for fermentation. However, in the "rice bran" which does not have the "endosperm" has small amount of enzyme and cannot</p>	<p>Allegations by Defendant</p> <p>In paragraph [0017] of the Description, the invention at issue defines the brown rice koji yeast as the koji yeast obtained by cultivating the rice bran by the koji mold. Accordingly, the Plaintiff's allegation is constructed on the basis of an erroneous assumption.</p>

<p>serve as "koji yeast for use in fermentation." As a result, ordinary koji yeast manufacturers clearly distinguish "rice bran koji yeast" from "brown rice koji yeast." The Invention which asserts that the "brown rice koji yeast can be made by rice bran powder" is not an industrially applicable invention as long as it is not possible to produce a true brown rice koji yeast from the rice bran powder ...</p>	
<p>Judgment by the Court</p> <p><u>The "Industrially Applicable Invention" as stated in the first paragraph of Article 29(1) of the Patent Act refers to the invention that is industrially applicable in various industries including manufacturing, agriculture, trade, mining, etc. and this provision is intended to clarify the nature of the inventions and exclude inventions that may only be applied for academic or experimental purposes. Whether or not the true brown rice koji yeast can be obtained from the rice bran powder has no relevance to the determination of whether or not the invention is eligible for protection as an "Industrially Applicable Invention" in the above context. Therefore, the allegation by Plaintiff is unreasonable as long as it has no relevance to the interpretation of the provision of the substantive law.</u></p>	

(32-1)-1

Relevant portion of Examination Guidelines	Part II, Chapter 1, 3.1.1. and 3.2.1.
Classification of the Case	32-1: Whether or not the method in question is "methods of surgery, therapy or diagnosis of humans" with regard to "industrial applicability"
Keyword	

#### 1. Bibliographic Items

Case	"Muscle training method" (Trial for Invalidation) Intellectual Property High Court Decision, August 28, 2013 (2012 (Gyo KE) No. 10400)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H5-313949 (JP H7-144027A)
Classification	A63B 21/00
Conclusion	Dismissal
Related Provision	First Paragraph of Article 29(1) main paragraph
Judges	IP High Court First Division, Presiding judge Toshiaki IIMURA, Judge Kimiko YAGI, Judge Shinji ODA

#### 2. Overview of the Case

##### (1) Summary of Claimed Invention

The claimed invention provides a muscle training method that can individually strengthen muscles by effectively generating fatigue in a desired part of the muscles that is the target of the individual strengthening by virtue of moderate blocking of the flow of blood to the desired part of the target muscles with a tightening tool, and reduce the damages to joints and muscles, and further shorten the training time.

##### (2) Disclosure of Detailed Explanation of the Invention

"As the mechanism that may be contemplated associated with the present invention, it is described and disclosed as follows: The strengthening of muscles is effected by super-recovery while the muscles fatigued through training are being recovered from fatigue; The fatigue of muscles is largely related to the supply of energy sources and oxygen to the muscles and the treatment of lactic acid generated in the course of energy metabolism, and these operations are largely dependent upon the flow of blood to the target muscles; Accordingly, the target muscles can be individually strengthened by effectively generating the fatigue in a desired part of the muscles that is the target of the individual strengthening by moderately blocking the flow of blood to the desired part of the target muscles with a tightening tool (paragraphs [0008], [0009])." (extracts

taken from the court decision)

(3) Matters Considered

"It is noted that the claimed invention is used as a treatment method for various diseases accompanied by decrease in or loss of strength of muscles (...), and Defendant and people associated therewith proactively promoted the claimed invention, emphasizing that it can be used in a medical action or other activities similar to medical practices (...)." (extracts taken from the court decision)

(4) The Claims (after Correction) (Only claim 1 is cited therefrom.) (Claimed Invention 1)

[Claim 1] A muscle training method comprising encircling a selected part of muscles with a tightening tool imparting a tightening force upon the muscle; reducing the circumference of the tightening tool and imposing a load upon the muscles to generate a fatigue of the muscles and thereby enlarge the muscles, said load imposed upon the muscles to generate the fatigue of the muscles blocking blood flow without stoppage of the blood flow.

(5) Procedural History

- December 7, 2011 : Filing of a request for trial for patent invalidation by Plaintiff (Muko No. 2011-800252)
- May 7, 2012 : Filing of a request for correction by Defendant (Patentee) (See the above-described "The Claims.")
- October 17, 2012 : Trial Decision admitting the above request for correction and dismissing the request for trial

3. Portions of Appeal/Trial Decisions relevant to the Holding

Appeal Decision (cited from the Court Decision)	
B Since the claimed invention does not correspond to either one of a method of medical activity, an industrially inapplicable invention, and a practically inapplicable invention, the claimed invention is an "industrially applicable invention" in the meaning of the first paragraph of Article 29(1) of the Patent Act.	
Decision	
<p>Allegations by Plaintiff</p> <p>B With Regard to Method of Medical Activity</p> <p>The claimed invention can also be used in muscle pressurization training kinesitherapy, and use for medical purposes was intended and expected. Defendant has been involved in medical activities associated with muscle pressurization training prior to filing of the patent application for the claimed</p>	<p>Allegations by Defendant</p> <p>B With Regard to Method of Medical Activity</p> <p>In the Description, nothing is described that pertains to medical matters, and use of the claimed invention for rehabilitation purposes was not contemplated at the time of filing of the patent application. Further, the use in question is merely found as a result of the developments of research after</p>



<p>invention.</p> <p>The appeal decision erred in determining that the claimed invention is not a method of medical activity.</p>	<p>filing of the patent application. Although examples of clinical applications of pressurization training have been introduced, the claimed invention is an invention that relates to "muscle training" in which a method of medical activity is not involved.</p>
<p><b>Judgment by the Court</b></p> <p>(1) With Regard to Industrial Applicability</p> <p>... it can be said that the claimed invention discloses of a technique applicable in the industry associated with muscular training offered by such as fitnessclubs or atheletic gyms. In addition, in light of the fact that no suggestion that the claimed invention can be used as a medical method is found in the Description, there is no reason to deny the fact that the claimed invention is an "industrially applicable invention" (first paragraph of Article 29(1) of the Patent Act).</p> <p>(2) With Regard to Method of Medical Activity</p> <p>However, even when it is possible to use the claimed invention for a method of medical activity or other activities similar to medical practices, it does not constitute the grounds for denial the fact that the claimed invention is an "industrially applicable invention" (first paragraph of Article 29(1) of the Patent Act).</p>	