Appeal decision

Appeal No. 2011-22685

Tokyo, Japan
Appellant NAGASHIMA, Katsuyoshi

Tokyo, Japan
Patent Attorney SAKAMOTO, Tomohiro

The case of appeal against the examiner's decision of refusal Japanese Patent Application No. 2006-689, entitled "Phishing Fraud Prevention System and Program Thereof" (the application published on July 19, 2007, Japanese Unexamined Patent Application Publication No. 2007-183744) has resulted in the following appeal decision:

Conclusion

The appeal of the case was groundless.

Reason

No. 1 History of the procedures

The present application was submitted on January 5, 2006 as a filing date,
an amendment was filed on January 6, 2006,
a request for examination and an amendment were filed on September 1, 2008,
a notice of reasons for refusal was issued on May 31, 2011 (dispatched on June 7, 2011),
despite the fact that a written opinion and an amendment were filed on June 30, 2011,
a decision of refusal was issued on July 13, 2011 (the copy transmitted on July 20, 2011),
an appeal was requested on October 20, 2011 and an amendment was filed on the same day,
a report under the provisions of Article 164(3) of the Patent Act was made by the examiner on November 18, 2011,

an inquiry under the provisions of Article 134(4) of the Patent Act was made by the body on December 28, 2011 (dispatched on January 10, 2012), and
a response letter was filed on February 29, 2012.

No. 2 Decision to dismissal of the amendment dated October 20, 2011

Conclusion of decision to dismissal of amendment]

The amendment dated October 20, 2011 shall be dismissed.

[Reason]

1. Amendment of the case

The amendment of the case is to amend the descriptions of Claim 1 of the scope of claims for patent, which Claim 1 has been amended by the amendment dated June 30, 2011, from:

"[Claim 1]
A phishing fraud prevention system configured to:
provide a Whois search icon display button on a toolbar of an IE (Internet Explorer) installed on a user personal computer;
extract a domain name from a URL of a Web site which is being displayed and display the domain name on the Whois search icon display button;
upon a click operation on the Whois search icon display button, search for the domain name from a domain information registration center through the Internet; and
store the domain name and an organization name thereof resulted in the search into a buffer of the user personal computer and display the domain name and the organization name on the screen of the Web site." (Hereinafter, this Claim 1 described in the scope of claims for patent is referred to as "Claim 1 before amendment". Note for the body: For easiness of comparison with the Claim 1 after amendment below, line breaks have been inserted in corresponding places.)

to

"[Claim 1]
A phishing fraud prevention system configured to:

provide a Whois search icon display button on a toolbar of an IE (Internet Explorer) installed on a user personal computer;

extract a domain name from a URL of a Web site which is being browsed by a user and display the domain name on the Whois search icon display button;

upon a click operation on the Whois search icon display button, search for the domain name from a domain information registration center through the Internet with the Web site being browsed; and

store the domain name and an organization name thereof resulted in the search into a buffer of the user personal computer and display the domain name and the organization name on the same screen as the screen of the Web site which is being browsed." (Hereinafter, this Claim 1 described in the scope of claims for patent is referred to as "Claim 1 after amendment".)

The above-described amendment of the case consists of:

limiting "a Web site which is being displayed", which is a necessary matter used to specify the invention described in Claim 1 before amendment, to "a Web site which is being browsed by a user"; and

limiting "search for the domain name from a domain information registration center through the Internet" and "display the domain name and the organization name on the screen of the Web site", which are also necessary matters used to specify the invention described in Claim 1 before amendment, to "search for the domain name from a domain information registration center through the Internet with the Web site being browsed" and "display the domain name and the organization name on the same screen as the screen of the Web site which is being browsed", respectively. The amendment thus includes a purpose of restricting the scope of claims according to Article 17-2(4)(ii) of the Patent Act.

Whether the invention described in Claim 1 after amendment of the case (hereinafter referred to as "Amended Invention") can obtain a patent independently at the time of patent application, i.e., whether it falls under the provisions of Article 126(5) of the Patent Act which is applied mutatis mutandis pursuant to the provisions of Article 17-2(5) of the Patent Act before revision by the Act No. 55 of 2006, of which the provisions then in force shall remain applicable according to revision supplement Article 3(1) of the Act No. 55 of 2006, will be examined below.

2. Consideration on independent requirements for patentability

(1) Cited Documents

1) Identification of technical matters and Cited Invention described in Cited Document 1

The cited document "20 skills of the professional for using tools in combination", PC Japan, Japan, SoftBank Publishing K. K., Nov. 1, 2003, vol. 8, No. 11, pp. 121-130 (hereinafter referred to as "Cited Document 1"), which had been distributed before the filing date of the present application and has been cited in the above notice of reasons for refusal dated May 31, 2011 on which the original examination's decision of refusal is based, describes the following technical matters with related drawings. (Note for the body: Underlines added by the body for reference)

A. "First of all, let's take a look at tools useful for network security. Whenever people talk about security, countermeasures against computer virus may first come to your mind. As to countermeasures against computer virus, the most effective way is to install one anti-virus software program and regularly update definition files. It makes almost no sense to install multiple anti-virus software programs. So, here we cover a tool which is preferably used in combination with firewall software, which effectively guards against illegal access (attack) (page 121, FIG. 1).

A firewall program basically assumes every access from unauthorized external entities as illegal access and shuts it out. It is to be noted that there may be cases in which it shuts out necessary access if, for example, settings are insufficient. In such a case, dozens of firewall software programs present a concrete IP address and prompt the user that an access request is coming from that address and whether to accept the request. If you are not sure, you should deny the request as a temporary measure. However, as mentioned before, the access may be in fact non-illegal.

So, let's find out on the strength of an IP address whether the other party is credible or commencing an illegal access with malicious intent." (page 121, right column, line 1 to page 122, left column, line 20)

B. "If you want to carry out a whois search more readily, "HotWhois" is convenient. It connects to whois servers of 88 places over the world, and searches for the whois information of the designated host. Like Magic NetTrace, you can call it from the "Tools" menu of Internet Explorer, or you can by one click from a button on the toolbar of Internet Explorer display the whois information of the server of the Web page being displayed." (page 122, middle column, line 25 to right column, line 3)

C. We will also introduce tools useful for strengthening security of not only your machine but also your whole LAN (FIG. 2). (page 122, right column, lines 22 to 24)

The described matters of Cited Document 1 will be examined below.

(a) The "HotWhois" described in B above can be said to be, according to the description "tools useful for network security" in A above, a tool for network security. In addition, it is understood that "tools useful for strengthening security" of "your machine" in C above refers to the tools described in A and B above. Based on the foregoing, the above-described "HotWhois" can be said to be a tool for strengthening security of a machine and a network.

Here, the machine and the network, in which the above-described "HotWhois" implements the function described in B above, can be said to be a system constituted by the machine and the network. In addition, according to the description "a tool which is preferably used in combination with firewall software, which effectively guards against illegal access (attack)" and the description "let's find out ... whether the other party is ... commencing an illegal access with malicious intent", the system the function of which is implemented by the above-described "HotWhois" can be said to be capable of preventing illegal access. Based on the foregoing, it can be said that Cited Document 1 describes

"a system in which the function of 'HotWhois' is implemented and which consists of a machine and a network for preventing illegal access".

(b) According to the description of B above: "you can call it from the 'Tools' menu of Internet Explorer, or you can by one click from a button on the toolbar of Internet Explorer display the whois information of the server of the Web page being displayed", it can be said that the above-described "HotWhois allows to display the Whois information of the server of the Web page being displayed by one click on a button on the toolbar of Internet Explorer".

(c) With respect to the above-described "Whois information",

according to the description of B above: "It connects to whois servers of 88 places over the world, and searches for the whois information of the designated host", the "Whois information" can be said to be "the result of searching for Whois information of a designated host from Whois servers over the world".

It is recognized that, based on the matters pointed out in (a) to (c) above, the Cited Document 1 describes the following invention (hereinafter referred to as "Cited Invention"):

A system consisting of a machine and a network for preventing illegal access, in which system functions of "HotWhois" are implemented, wherein

the "HotWhois" allows to display Whois information of the server of a Web page being displayed by one click on a button on a toolbar of Internet Explorer, and

wherein the Whois information is result of searching for Whois information of a designated host from Whois servers over the world".

2) Cited Document 2

The document Horiuchi Kahori: "New functions of the software for BYTE LAB security", Nikkei Byte, Japan, Nikkei Business Publications, Inc., November 22, 2005, No. 271, pp. 56-61 (hereinafter referred to as "Cited Document 2"), which had been distributed before the filing date of the application and has been cited in the above-described notice of reasons for refusal dated May 31, 2011 on which the original examination's decision of refusal is based, describes the following technical matters with related drawings. (Note for the body: Underlines added by the body for reference)

D. "Phishing fraud is an act of decoying users to a fake site using an email, making users enter their card information or personal information, and thereby stealing information.

...

Against such a modus operandi, it is crucial for a user to check suspicious matters in an email or Web site." (page 57, middle column, line 4 to right column, line 8)

E. In FIG. 4 on page 58, a toolbar of "Internet Explorer" is displayed showing an aspect in which address information of a page being displayed on the browser is displayed beside an "address" bar of the toolbar, and

in relation to the "address" bar, the display of a URL at a lower column is described as to "display an actually entered URL (you can compare with the address bar to check if you have been redirected to a different site)".

F. "Access to database after response from DNS

FIG. 5 illustrates a flow of accessing to a Web site with these functions enabled. In general, when a URL is entered, ...

After name resolution is completed by the DNS server, VirusBuster 2006 connects to a database of Trend Micro to retrieve evaluation information of the Web site. The evaluation information consists of four items: a domain name, an IP address, a category of the Web site, reliability information (trusted site, phishing fraud site, unregistered site)." (page 58, middle column, line 15 to right column, line 14)

G. The left figure of FIG. 5 on page 58 illustrates a system in which, in order for a user terminal to access a Web site, a site evaluation is carried out in a database of Trend Micro and then the user terminal receives content from the Web server,

and illustrates an aspect in which the user terminal shown at a lower portion in the figure sends a URL to a DNS server (2: ○), then after completion of name resolution, sends "domain information" to the database of Trend Micro (4: ○), from which site evaluation information including a domain name is returned (5: ○). (Note for the body: For purposes of description, an encircled numeral n is indicated by "n: ○")

3) Reference 1

The document Yoshino Mariko: "3rd Lesson for Windows basic operations", Nikkei PC Beginners, Japan, Nikkei Business Publications Inc., December 13, 2001, vol. 6, No. 24, pp. 84-90 (hereinafter referred to as "Reference 1"), which had been distributed before the filing date of the application, describes the following technical matters with drawings. (Note for the body: Underlines added by the body for reference)

H. "To display a list of 'histories', click on the 'History' button having a shape of a clock (FIG. 4). The histories will then be displayed in an assembled fashion in sequence of date on the left side of the window. Click on an icon of a date that you remember to be the day you watched the page (FIG. 5, 1: ○). The home pages you watched in the past will then be displayed per site. Now click on a site name (FIG. 5, 2: ○) to display a pagewise representation of the site, and select and click on a page you want to see (FIG. 5, 3: ○). The page will then be displayed on the right side of the window (FIG. 6)." (page 84, third column, line 15 from right, to page 85,

first column, line 7 from right; note for the body: For purposes of description, an encircled numeral n is indicated by "n: ○")

J. At figure "5" on page 85, a page display screen of a browser is illustrated showing an aspect in which, in the browser display screen, the display screen for a page and the display screen for a list of histories are respectively displayed on the right side and the left side of the same screen, and in the display of the list of histories on the left side, histories in a pagewise representation are displayed in a clickable state with the display of icons and corresponding address information.

4) Reference 2

The Japanese Unexamined Patent Application Publication No. 2002-183024 (published on June 28, 2002, hereinafter referred to as "Reference 2"), which had been distributed before the filing date of the application, describes the following technical matter in a drawing. (Note for the body: Underlines added by the body for reference)

K. FIG. 10 of the drawings illustrates an aspect in which the display of a home page and the display of advertising information related to the home page are contained in the same screen (FIG. 10 (a)) or distributed to separated windows on a screen (FIG. 10 (b)).

5) Reference 3

The document Kawauchi Kiyohito, et al., "Proposal of techniques of using whois service for preventing phishing fraud, 67the (2005) National Conference Papers (3), Databases and Media Networks", Japan, Information Processing Society of Japan, March 2, 2005, No. 3, pp. 337-338 (hereinafter referred to as "Reference 3"), which had been distributed before the filing date of the application, describes the following technical matters. (Note for the body: Underlines added by the body for reference)

L. "The present method stores information of the well-known sites such as those indicated in Table 1 ahead of time in the system. In Table 1, the feature character string represents a character string that characterize the domain name of a respective well-known site (enterprise name part etc.), and the organization name represents a name for use on the WHOIS service as the name of the enterprise registered as the

owner of the domain name. In consideration of the cases in which domain names are registered with multiple registries using an identical feature character string, such as aaa.co.jp and aaa.com, registration of a plurality of organization names is allowed." (No. 3, page 337, left column, line 30 to right column, line 3)

(2) Comparison between Amended Invention and Cited Invention

The Amended Invention and the Cited Invention will be compared.

(2-1) The "phishing fraud" in the Amended Invention is to illegally access to a computer of a user and present fake site information, and thus can be said to be illegal access in broader concept. Therefore, it can be said that the "system consisting of a machine and a network for preventing illegal access" of the Cited invention and the "phishing fraud prevention system" of the Amended Invention have the same aspect of "an illegal access prevention system".

(2-2) Since the functions of "HotWhois" is implemented in the "machine" of the Cited Invention and the "HotWhois" is related to "Internet Explorer's toolbar" on which a user makes "one click", the machine can be said to be used by the user and to have "Internet Explorer" installed, and thus the machine corresponds to the Amended Invention's "user personal computer" on which "IE (Internet Explorer)" is installed. In addition, the "button" on the "Internet Explorer's toolbar" is a button for displaying the "result of searching for Whois information", and that button and the "Whois search icon display button" of the Amended Invention are common in that they are each a "Whois search display button".

Therefore, it can be said that to provide "a button on the toolbar of Internet Explorer" of a "machine" in the Cited Invention and to "provide a Whois search icon display button on a toolbar of an IE (Internet Explorer) installed on a user personal computer" in the Amended Invention are common in that they are to "provide a Whois search display button on a toolbar of an IE (Internet Explorer) installed on a user personal computer."

(2-3) In the Cited Invention, the "Whois servers over the world" where the "Whois information" is to be "searched for" are understood as to have registered "Whois information" to be searched for and thus can be said to be Whois information registration systems. Meanwhile, in the Amended Invention, the "domain name"

can be said to be "Whois information" in broader concept, and, similarly, the "domain information registration center" can be said to be a "Whois information registration system" in broader concept.

Therefore, it can be said that the Cited Invention, the system of which "allows to display Whois information of a server of a Web page being displayed by one click on a button on a toolbar of Internet Explorer, the Whois information being result of searching for Whois information of a designated host from Whois servers over the world", and the Amended Invention, the system of which, "upon a click operation on the Whois search icon display button, searches for the domain name from a domain information registration center through the Internet with the Web site being browsed", are common in that they "upon a click operation on the Whois search display button, search for Whois information from a Whois information registration system through the Internet."

(2-4) It can be said that the Cited Invention, the system of which "allows to display Whois information, the Whois information being result of searching for Whois information of a designated host from Whois servers over the world", and the Amended Invention, the system of which "stores the domain name and an organization name of the search result into a buffer of the user personal computer through the Internet and display the domain name and the organization name on the same screen as the screen of the Web site which is being browsed", are common in that they "store the Whois information, which is resulted in the search, through the Internet into the user personal computer and display the information on the screen".

In view of the foregoing, the Amended Invention and the Cited Invention correspond with each other in the following corresponding feature and differ in the following different features.

(Corresponding feature)

An illegal access prevention system configured to:

provide a Whois search display button on a toolbar of an IE (Internet Explorer) installed on a user personal computer;

upon a click operation on the Whois search display button, search for Whois information from a Whois information registration system through the Internet; and

store the Whois information, which is resulted in the search, through the Internet into the user personal computer and display the information on a screen of the user

personal computer".

(The different feature 1)

The Amended Invention is "a phishing fraud prevention system", whereas the Cited Invention is "an illegal access prevention system".

(The different feature 2)

With respect to the Whois search display button, the Amended Invention provides a "Whois search icon display button", whereas it is not clear whether the Cited Invention displays an "icon" on the "button".

(The different feature 3)

The system of the Amended Invention is configured to "extract a domain name from a URL of a Web site which is being browsed by a user and display the domain name on the Whois search icon display button", whereas the system of the Cited Invention is not configured as such.

(The different feature 4)

With respect to the Whois information search, the system of the Amended Invention searches "with the Web site being browsed", whereas in the Cited Invention there is no mention about such aspect.

(The different feature 5)

With respect to where the search for the Whois information is to be performed, the system of the Amended Invention is configured to "search for the domain name from a domain information registration center", whereas the system of the Cited Invention is not configured as such.

(The different feature 6)

With respect to the Whois information to be displayed, the system of the Amended Invention is configured to display "the domain name and an organization name thereof resulted in the search", whereas in the Cited Invention there is no explicit and concrete description about the content of the Whois information.

(The different feature 7)

With respect to the method for displaying Whois information, the system of the

Amended Invention is configured to "display on the same screen as the screen of the Web site which is being browsed", whereas the system of the Cited Invention is not configured as such.

(The different feature 8)

With respect to the handling of the Whois information to be displayed, the system of the Amended Invention is configured to "store into a buffer of the user personal computer", whereas it is not clear how the Cited Invention handles the Whois information.

(3) Judgment

The above different features 1 to 8 are examined.

(3-1) Regarding different feature 1

It is obvious for a person skilled in the art that phishing fraud is a problem as an illegal access to a Web and that finding and checking suspicious matters of a Web site is a countermeasure to that problem (see for example the above description D of the Cited Document 2). Considering this, a person skilled in the art could have easily conceived of using the system of the Cited Invention for preventing phishing fraud, i.e., employing the configuration relating to the different feature 1.

Therefore, the different feature 1 is not remarkable.

(3-2) Regarding different features 2 and 3

It is well-known at the time of filing the present application to display on a toolbar of a browser, which is commonly used in accessing the Internet, the address information of the page currently displayed (see for example the above description E of the Cited Document 2; in the Cited Document 2, since "the display of a URL at a lower column" is described as "to display an actually entered URL" and as that "can compare with the address bar", the address information to be compared, which is displayed on the "address" bar, is understood as the address information of the page currently and actually displayed, i.e., not the exact URL as inputted).

In addition, to present a clickable button function on a browser with an icon or information related to a page and to form from URL a domain name as information related to the page are each conventional means (for example, with respect to the former, see the above descriptions H and J of Reference 1, and with respect to the

latter, see the above descriptions F and G of the Cited Document 2). Taking these into consideration, when applying the above well-known display technique to the display of a button on a browser, there is no significant difficulty found in incorporating the display of an icon and the display of a domain name as information related to a page into the display of a button.

In view of the above, a person skilled in the art could have easily conceived of applying the well-known art to the Cited Invention's display of a button on a toolbar, thus configuring a "Whois search icon display button", and configuring the system to "extract a domain name from a URL of a Web site which is being browsed by a user and display the domain name on the Whois search icon display button", i.e., employing the configurations relating to the different features 2 and 3.

Therefore, the different features 2 and 3 are not remarkable.

(3-3) Regarding different features 4 to 6

In the Cited Invention, the "search" for "Whois information" with regard to the "Web page being displayed" is triggered by a "one click" operation on a "button", it is thus an obvious matter for a person skilled in the art that the "Web page being displayed" is made remain displayed even after the search has started and that the "Web page" being displayed after the search has started is in a state in which the Web page is browseable.

As to the structure for which the "search" for "Whois information" is to be made, provisioning of a "domain information registration center" is a matter relating to an artificial arrangement for assuring security on the Internet, and how the "search" item is to be registered or set is a matter to be decided as needed. Thus there is no significant technical difficulty found in those matters (see the above description L of Reference 3 for an example which includes, as registration items for inquiry relating to prevention of phishing, a domain name and an organization name).

In view of the above, a person skilled in the art could have easily conceived of: carrying out the search for displaying Whois information in the Cited Invention by searching for "the domain name from a domain information registration center" "with the Web site being browsed"; and retrieving "the domain name and an organization name resulted in the search", i.e., employing the configurations relating to the different features 4 to 6.

Therefore, the different features 4 to 6 are not remarkable.

(3-4) Regarding different features 7 and 8

It is a well-known art to display information of a page displayed by a browser for accessing the Internet on the same screen as the displayed page (see for example the above description J of the Reference 1 and the above description K of the Reference 2), and it is conventional means to, when displaying retrieved information in a computing apparatus, store the retrieved information in a memory such as a buffer, and thus a person skilled in the art could have easily conceived of, by applying the well-known art to the display of the Whois information resulted in the search in the Cited Invention, configuring the system to "store into a buffer of the user personal computer" and to "display on the same screen as the screen of the Web site which is being browsed", i.e., employing the configurations relating to the different features 7 and 8.

Therefore, the different features 7 and 8 are not remarkable.

(3-4) Summary

As examined above, the different features 1 to 8 are not remarkable, and, even taking those different features into consideration from a comprehensive standpoint, the working-effects of the Amended Invention are within the expectation based on the working-effects of the above-described Cited Invention and well-known arts, and thus they cannot be said remarkably prominent.

Therefore, the Amended Invention could be easily made by a person skilled in the art based on the above-described Cited Invention and well-known arts, and it cannot obtain a patent independently at the time of patent application under the provisions of Article 29(2) of the Patent Act.

3. Conclusion regarding the amendment of the case

As examined in 2 above, the Amended Invention cannot obtain a patent independently at the time of patent application under the provisions of Article 29(2) of the Patent Act. Thus, the amendment of the case infringes the provisions of Article 126(5) of the Patent Act which is applied mutatis mutandis pursuant to the provisions of Article 17-2(5) of the Patent Act before revision by the Act No. 55 of 2006, of which the provisions then in force shall remain applicable according to revision supplement Article 3(1) of the Act No. 55 of 2006. Therefore the amendment of the case shall be dismissed under the provision of Article 53(1) of the Patent Act which is applied mutatis mutandis by the reading of terms under Article

159(1) of the same Act.

No. 3 Regarding the invention of the case

1. The invention of the case

As the amendment dated October 20, 2011 is dismissed as described above, the claimed invention of the application is exactly as specified in the claims of the scope of claims for patent which have been amended by the amendment dated June 30, 2011. Thus the invention claimed in Claim 1 (hereinafter referred to as "Invention of the Case") is as exactly described as the Claim 1 before amendment of the case, which amendment is described in "No. 2 Decision to dismissal of the amendment dated n October 20, 2011" at "1. Amendment of the case".

2. Cited Documents

The cited documents which are cited in the reasons for refusal of the examiner's decision and the described matters of the cited documents are as exactly described as in the above "No. 2 Decision to dismissal of the amendment dated October 20, 2011", "2. Consideration on independent requirements for patentability", at "(1) Cited Documents".

3. Comparison/judgment

The Invention of the Case corresponds to an invention resulted by substantially removing "browsed by a user", "with the Web site being browsed", "which is being browsed", and "the same screen as" from the "Amended Invention", which is indicated in the above "No. 2 Decision to dismissal of the amendment dated October 20, 2011" at "1. Amendment of the case".

Thus, the Amended Invention includes all the constituent components of the Invention of the Case and corresponds to the result of adding limitations to specific constituent components of the constituent components. As described in "No. 2 Decision to dismissal of the amendment dated October 20, 2011", "2.Consideration on independent requirements for patentability" at "(3) Judgment", the Amended Invention could be easily made by a person skilled in the art based on the Cited Invention and the well-known arts, and therefore the Invention of the Case is for the same reason could be easily made by a person skilled in the art based on the Cited

Invention and the well-known arts.

4. Conclusion

Since, as described above, the invention according to Claim 1 of the present application cannot obtain a patent under the provisions of Article 29(2) of the Patent Act, the present application shall be rejected without mentioning about other claims.

Therefore, the appeal decision shall be made as described in the conclusion.

March 26, 2013

Chief administrative judge: NAKAMA, Akira
Administrative judge: TANAKA, Hideto
Administrative judge: NAGASHIMA, Takashi