

Trial decision

Invalidation No. 2011-800222

Tokyo, Japan

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The case of trial regarding the invalidation of Japanese Patent No. 3401228, entitled "Point Total Management System" between the parties above, has resulted in the following trial decision.

## Conclusion

The patent regarding the inventions according to Claims 1 to 5 of Japanese Patent No. 3401228 was invalidated.

The costs in connection with the trial shall be borne by the demandee.

## Reason

### No. 1 History of the procedures

The Japanese Patent No. 3401228 (hereinafter, referred to as the "Patent") relates to Patent Application No. 2000-60720 filed on March 6, 2000, and the establishment of patent right of the invention according to Claims 1 to 5 was registered on February 21, 2003.

A trial for invalidation of the case, with regard to the Patent, with CONET CORPORATION which is a patentee of the Patent as the demandee, was demanded by NTT Communications Corporation (hereinafter, referred to as the "demandant") on November 1, 2011.

The history of the main procedures after that is summarized and shown as follows.

December 9, 2011	Application for intervention
February 1, 2012	Notice of procedure suspension
February 15, 2013	Notice of cancellation of procedure suspension
April 4, 2013	Decision on acceptance or non-acceptance of intervention
April 22, 2013	Submission of written reply
June 14, 2013	Oral proceeding statement brief (the demandant)
June 14, 2013	Oral proceeding statement brief (the demandee)
June 28, 2013	1st oral proceeding
July 12, 2013	Written statement (the demandant)
July 25, 2013	Written statement (the demandee)

The application for intervention above was not approved according to the decision on acceptance or non-acceptance of intervention above.

Also, the trial of the case was demanded before the enforcement of Act 63 of 2011, so that Article of the Patent Act before revision by Act No. 63 of 2011, the provisions of

which then is force shall remain applicable according to revision supplement Article 2(18) of the Act No. 63 of 2011, but in the trial of the case, it is just mentioned as "Article of the Patent Act."

#### No. 2 The demandant's allegation and means of proof

The demandant demands the trial decision that the inventions according to Claims 1 to 5 of the Patent (hereinafter, respectively referred to as the "patent invention 1" to "patent invention 5") are invalid and the costs in connection with the trial shall be borne by the demandee, the demandant alleges reasons for invalidation as follows, and submitted Evidence A No. 1 to A No. 6 as means of proof.

(Reasons for invalidation)

The patent inventions 1 to 5 could have been easily provided by a person skilled in the art according to the invention described in Evidence A No. 1, and the well-known arts described in Evidence A No. 2 to A No. 3.

Therefore, since the patent of the patent inventions 1 to 5 violates the provisions of Article 29(2) of the Patent Act, it falls under Article 123(1)(ii) of the Patent Act and should be invalidated.

[A means of proof]

\*Evidence A No. 1: Korean Patent Publication No. 1999-0078768 and translation thereof

\*Evidence A No. 2: A copy of the web page with articles titled "American Airlines AAdvantage Program joins Hilton HHonors Reward Exchange" Business Wire, June 7, 1999, the Internet <URL: [http://findarticles.com/p/articles/mi\\_m0EIN/is\\_1999\\_June\\_7/ai\\_54811197/](http://findarticles.com/p/articles/mi_m0EIN/is_1999_June_7/ai_54811197/)>, and the abstract translation

\*Evidence A No. 3: Randy Petersen "THE OFFICIAL Frequent Flyer GUIDEBOOK" 3rd Edition, July 1995, AirPress, Cover, Spine, Pages 2 to 3, 6 to 7, 396 to 397 and Abstract Translation

\*Evidence A No. 4: Judicial Precedent Times No. 754 (June 15, 1991) Page 141 to Page 148

\*Evidence A No. 5: "KOJIEN 5th Edition" (edited by Izuru SHIMMURA, Iwanami Shoten) November 11, 1998 (First printing) Page 583

\*Evidence A No. 6: Examination Guidelines, JPO, Part VII, Chapter 1, Pages 10 to 11

No. 3 The demandee's allegation and means of proof

The demandee requests the trial decision that demand for invalidation trial of the case is not accepted and the costs in connection with the trial shall be borne by the demandant, alleges that the reasons for invalidation alleged by the demandant are groundless, and submitted Evidence B No. 1 and B No. 2 as means of proof.

[Means of proof]

\*Evidence B No. 1: "Korean Japanese Dictionary" issued by Minshu Shorin (the cover and imprint)

\*Evidence B No. 2: "Korean Japanese Dictionary" issued by Minshu Shorin (the contents)

No. 4 The invention relating to the Patent

The patent invention 1 to the patent invention 5 are acknowledged as follows, as specified by the matters described in Claims 1 to 5 of the scope of claims attached to the application.

"[Claim 1] A point total management system comprising:

exchange rate storage means which stores an exchange rate for exchanging points of a first client company to common points;

common point accumulation storage control means which exchanges the points of the first client company to common points based on the exchange rate, and accumulates and stores the points at a common point storage part;

settlement rate storage means which stores a settlement rate for settling the common points stored in the common point storage part as points of a second client company; and

point settlement means which settles the common points stored in the common point storage part as the points of the second client company based on the settlement rate, the point total management system respectively having the plurality of exchange rates and settlement rates.

[Claim 2] A point total management system comprising:

point exchange information reception means which receives point exchange information for exchanging points of a first client company to common points;

exchange rate storage means which stores an exchange rate for exchanging the points of the first client company specified by the point exchange information to common points;

common point accumulation storage control means which exchanges the points of the first client company to common points based on the exchange rate, and accumulates and stores the points at a common point storage part;

point settlement information reception means which receives point settlement information for settling the common points stored in the common point storage part as points of a second client company;

settlement rate storage means which stores a settlement rate for settling the common points stored in the common point storage part as the points of the second client company specified by the point settlement information; and

point settlement information transmission means which settles the common points stored in the common point storage part based on the settlement rate as the points of the second client company, and transmits point settlement information to a point management device of the second client company, the point total management system respectively having the plurality of exchange rates and settlement rates.

[Claim 3] The point total management system according to Claim 2, wherein the point exchange information includes a number of exchange demand points to be exchanged to common points, and wherein the common point accumulation storage control means, when a number of the points stored in the point management device of the first client company is equal to or more than the number of the exchange demand points, exchanges the points of the first client company to common points.

[Claim 4] The point total management system according to any one of Claims 2 to 3, wherein the point exchange information reception means receives point exchange information through a communication medium, and wherein the point settlement information reception means receives point settlement information through a communication medium.

[Claim 5] The point total management system according to any one of Claims 2 to 3, wherein the point exchange information reception means receives point exchange

information through a data input device, and wherein the point settlement information reception means receives point settlement information through a data input device."

#### No. 5 Described matters in Evidence A

##### 1. Evidence A No. 1

In Evidence A No. 1 which is a publication distributed before the application of the Patent, the following matters are described. Furthermore, although Japanese translation of a summary part is written as follows, the Japanese translation cited the abstract translation submitted by the demandant. Also, concerning words that are disputed between the parties with regard to translations, the translations by the respective parties are written side by side with "/".

(Evidence A No. 1 a) Page 1 "Abstract" column

"Abstract

The present invention relates to a method of exchanging bonus points provided from individual companies to bonus points or cyber money (Cyber Money; electronic money) of another company, and includes: an order receiving step of inputting the kind and quantity of the bonus points to be sold or bought; storing quantity obtained by deducting the above mentioned quantity from holding quantity and the cyber money calculated based on a predetermined exchange/exchange rate from the above mentioned quantity of the bonus points in a point information DB (database), if a member holds the above mentioned quantity or more of the above mentioned kinds of the points in a case of a selling order; and an order executing step of exchanging the kind and quantity of the points to be bought to cyber money, and storing the amount of money obtained by deducting the calculated cyber money from cyber money held by the member and the kind and quantity of the points in the point information DB.

According to the method of the present invention, consumers can earn actual bonus benefits early, and companies selected as member companies can secure collective fixed customers; namely, members, and have the more excellent competitiveness than other companies in the same industry."

(Evidence A No. 1b) Page 2, lines 24 to 27

"Technical problem to be solved by the invention

The present invention provides a method of forming a bonus point exchange pool (Exchange Pool) by selecting companies implementing a bonus point system, and exchanging bonus points provided from individual companies to bonus points or cyber

money of other companies."

(Evidence A No. 1c) Page 2, lines 28 to 39

"Constitution and function of the invention

The present invention for achieving the object relates to a method of exchanging bonus points includes: an order receiving step for inputting the kind and quantity of points to be sold from a member planning to exchange bonus points held by himself/herself to cyber money, or inputting the kind and quantity of points to be bought from a member planning to purchase bonus points with cyber money held by himself/herself; in a case of a selling order, storing from which member company the inputted points are provided and the quantity thereof, and by searching the points held by the member in a point information DB, when a member holds the above mentioned quantity or more of the above mentioned kinds of points, storing quantity obtained by deducting the above mentioned quantity from holding quantity and cyber money calculated based on a predetermined exchange/exchange rate from the above mentioned quantity of the bonus points in the point information DB; and an order executing step of, in a case of a buying order, exchanging the kind and quantity of points to be bought to cyber money based on a predetermined exchange/exchange rate decided in advance with reference to the points, searching cyber money held by the member in the point information DB, and when the holding cyber money is equal to or greater than the cyber money calculated based on the exchange/exchange rate, storing the amount of money obtained by deducting the calculated cyber money from the holding cyber money, and the kind and quantity of the points in the point information DB."

(Evidence A No. 1d) Page 2, lines 44 to 54

"Terms used in the present invention will be defined.

'A bonus point system' indicates a system in which a company provides points at a certain percentage of a purchase price when its own product is purchased so as to induce customers and in which if a predetermined number or more of points are accumulated, a predetermined article, service, money, and the like are given as a bonus, and at that time, the number of the points are called bonus points. 'Cyber money' indicates electronic money, electronic checks, electronic wallets, electronic payment transfer, or the like which is not money in the real world, is valid in cyber space, and can be used for purchasing articles by e-commerce if necessary, or exchanged to money in the real world. 'A member company,' for example, if there is a brokerage center intermediating exchange of points by the method

of the present invention, refers to a company that contracted so that service points provided by the company can be exchanged with a product according to a contract with the brokerage center, and 'a member' is a person accumulating the service points provided by the member company, and a person contracted to use the brokerage center. 'An exchange/exchange rate' indicates a number of service points corresponding to one cyber money unit; namely, an exchange unit, and is decided in advance according to the value of bonus points provided by the member company."

(Evidence A No. 1e) Page 3, lines 3 to 16

"On the other hand, the order receiving step can be performed on a wire or wireless telephone or on the Internet, and a member can order directly face-to-face with a staff member of the brokerage center. That is, the member carries out a transaction face-to-face, and on a telephone or an ARS telephone, and can also carry out a transaction via a line through various computer networks.

In the method of the present invention, an information transmission relationship between transaction members is shown in Fig. 1. If a specified member purchases an article or service from a specific member company in a user pool, the member company provides fixed bonus points to the member in proportion to a purchase price, and the points provided at that time are immediately stored in a point information DB of a brokerage center. A member holding bonus points or cyber money can connect to the brokerage center according to the present invention to sell or buy the bonus points, a kind and number of the bonus points changed at that time and the amount of the cyber money are stored in the point information DB of the brokerage center, and the changed matters in the kind and number of the bonus points are immediately transmitted to the member company providing the bonus points. On the other hand, if a member holding bonus points bought at the brokerage center or accumulated through an article-service purchase presents the points to a member company providing the bonus points, the member company receives the points, simultaneously provides a bonus such as a predetermined article, amount of money, or the like to the member, and immediately transmits the fact that the member consumed the points to the brokerage center. Therefore, the changed matters in the points and cyber money between the transaction members are immediately transmitted, and are stored in the point information DB of the brokerage center."

(Evidence A No. 1f) Page 3, lines 17 to 21

"By selling and buying various kinds of points, from a standpoint of a member company, a



case of providing a bonus larger than a bonus corresponding to the total quantity of bonus points actually issued by itself and the opposite case come to occur. Therefore, it is preferable to construct a system in which the brokerage center additionally collects difference from a member company which provided a bonus smaller than a bonus corresponding to the total quantity of bonus points at every certain period and compensates a member company which provided a larger bonus."

(Evidence A No. 1g) Page 3, lines 22 to 28

"A network between transaction parties is briefly shown in Fig. 2. Each user and each member company are coupled to a web site applying the method of the present invention through the Internet network and a telephone network. In the web server, a normal firewall for protection and security of individual information and point information of transaction parties can be installed, and an application program for applying the method of the present invention can be equipped. There can be provided a member company information DB for storing information on a member company, information relating to an exchange/exchange rate, information relating to cost settlement and the like, a member information DB for storing the personal information and bonus card information of a member, and a point information DB for storing information relating to bonus points and cyber money of a member."

(Evidence A No. 1h) Page 3, lines 29 to 45

"One example of a specific flow when implementing the method of the present invention equipped with the system and network above is shown in Fig. 3.

First, when a user (1) connects to a web site (3) applying the method of the present invention through a communication network (4) such as the Internet, the web server (3) checks whether or not the user is a member (step 101). In a case of a member, it is checked whether or not the user holds a bonus card of a newly added kind (step 102), and if there is one to be added, card information is inputted/stored (step 106) and the process returns to step 102. If there is no card to be added, it is checked whether points are sold or bought (step 103). In a case of selling, the kind and quantity of bonus points to be sold are inputted (step 104), and are compared with point information stored in a point information DB (step 105) to check whether or not the kind and quantity of points to be sold exist (step 106). If the points exist, after exchanging that to cyber money, related information is stored in the point information DB, and details thereof are transmitted to a related member company (step 107).... (Omitted)... when the buying of points is selected in step 103, the kind and

quantity of the points to be bought are inputted (step 110), and the cyber money of a member stored in the point information DB is checked (step 111) to check whether or not the cyber money of the member company corresponding to the point quantity exist (step 112). If the cyber money is sufficient, after exchanging that to the points, information about that is stored in the point information DB and transmitted to the member company. After that, the process returns to step 108. If the cyber money of the member does not sufficiently exist, the process returns to step 103 to adjust the quantity of buying."

According to the descriptions above and illustrated contents of the drawings, Evidence A No. 1 describes the following invention (hereinafter, referred to as "Invention A-1").

"A method of exchanging bonus points which are points provided from a company at a certain percentage to a purchase price when a consumer purchases a commodity product from the company, and with which a predetermined article, service, money, or the like is given as a bonus, to bonus points of another company or cyber money such as electronic money, electronic checks, electronic wallets, or electronic payment transfer which is valid in cyber space, and can be used for purchasing articles by e-commerce if necessary, or exchanged to money in the real world, the method comprising: an order receiving step in which a member planning to exchange bonus points held by himself/herself to cyber money inputs the kind and quantity of bonus points to be sold through a communication network such as the Internet or face-to-face, or a member planning to purchase bonus points by cyber money held by himself/herself inputs the kind and quantity of the points to be bought through the communication network such as the Internet or face-to-face; an order executing step of, when the order is a selling order, if the member holds the above mentioned quantity or more of the above mentioned kind of the bonus points, storing the bonus points of quantity obtained by deducting the above mentioned quantity from holding quantity and cyber money calculated based on a predetermined exchange/exchange rate decided in advance according to the value thereof from the above mentioned quantity of the bonus points, in a point information DB, and when the order is a buying order, exchanging the kind and quantity of bonus points to be bought to cyber money calculated based on the predetermined exchange/exchange rate decided in advance according to the value thereof to store the amount of the cyber money obtained by deducting the exchanged cyber money from the cyber money held by the member and the kind and quantity of the bought bonus points in the point information DB; and carrying out storage to the point information DB and immediately transmitting changed

matters in the kind and number of the bonus points, to a member company providing the bonus points."

## 2. Evidence A No. 2

Evidence A No. 2 is a copy of the web page on which an article dated June 7, 1999 distributed by Business Wire Corporation was posted, and describes the following matter. Also, although a Japanese translation of a summary part is written as follows, the Japanese translation mainly cites the abstract translation submitted by the demandant.

(Evidence No. 2a) Title

"American Airlines AAdvantage Program Joins Hilton HHonors Reward Exchange"

(Evidence NO. 2b) the body lines 8 to 11

"In celebration of this new alliance, joint program members will receive double the usual number of HHonors points for all miles-to-point exchanges through Aug. 31, 1999. For every 5,000 AAdvantage miles exchanged, travelers will receive 10,000 HHonors points instead of the regular 5,000 HHonors points."

## 3. Evidence A No. 3

In Evidence A No. 3 which is a publication distributed in 1995 before the application of the Patent, the following matters are described. Also, although a Japanese translation of a summary part is written as follows, the Japanese translation mainly cites the abstract translation submitted by the demandant.

(Evidence A No. 3a) Cover

"THE OFFICIAL Frequent Flyer GUIDEBOOK 3<sup>rd</sup> edition"

(Evidence A No. 3b) Page 6, table of contents

"Hotel program...(Omitted)...HILTON: HHonors 395"

(Evidence A No. 3c) Page 396, the right and upper column

"Point exchange: exchange mileages of partner airlines to HHonors points:

5,000 airline mileage=10,000 point miles exchange:

Exchange HHonors points to airline miles:

10,000 points=1,500 airline miles

20,000 points=3,500 airline miles

50,000 points=10,000 airline miles"

No. 6 Judgment by the body

1. The patent invention 1

1-1 Comparison

The patent invention 1 and Invention A-1 are compared.

(A) It is obvious that "a company" and "another company" of Invention A-1 correspond to "a first client company" and "a second client company" of the patent invention 1, and "bonus points (of the company and another company)" of Invention A-1 correspond to "points of the first and second client companies)" of the patent invention 1.

(B) Although "cyber money" of Invention A-1 "is valid in cyber space, and can be used for purchasing articles by e-commerce if necessary," it can be obtained by calculating bonus points provided by various companies based on a predetermined exchange/exchange rate decided in advance according to the value of the bonus points; namely, by exchanging the bonus points of each company, and can buy the bonus points of each company based on the predetermined exchange/exchange rate decided in advance according to the value by using that; namely, can be exchanged to the bonus points of each company.

On the other hand, "common points" of the patent invention 1 can be obtained by exchanging the points of the first client company at an exchange rate, and can be exchanged to the points of the second client company based on a settlement rate.

Therefore, the "cyber money" of Invention A-1 and the "common points" of the patent invention 1 have no difference in a point that they can be obtained by exchanging the points of each company based on a predetermined rate and can be exchanged to the points of each company based on the predetermined rate, so that the "cyber money" of Invention A-1 corresponds to the "common points" of the patent invention 1.

(C) According to a correspondence relationship examined in (A) and (B) above, "a predetermined exchange/exchange rate decided in advance according to the value thereof (of the bonus points to be sold)" used for calculating the cyber money "when the order is a selling order" of Invention A-1, corresponds to "an exchange rate (for exchanging to common points)" of the patent invention 1, and similarly, "a predetermined exchange/exchange rate decided in advance according to the value thereof (of the bonus points to be bought)" used for calculating the cyber money "when the other is a buying order" of Invention A-1 corresponds to "a settlement rate for settling as the points of the second client company)" of the patent invention 1.

(D) It is obvious that "a point information DB" of Invention A-1 stores at least information about the "cyber money," so that it corresponds to "a common point storage part" of the patent invention 1.

Also, in addition to "the point information CB" above, from the descriptions of "a web saver," "a control part," and "an application program" in Fig. 2 of Evidence A No. 1, it is obvious that "a method of exchanging bonus points" of Invention A-1 is a method implemented by a predetermined system equipped with a database or a control part, and it can be said that the system performs the management of points while executing "the method of exchanging bonus points."

Furthermore, when control means generally performs certain processing, it is commonly carried out to use suitable storage means or calculation means, so that in the light of respective contents executed in each step of the method of Invention A-1, it is obvious that the system can be said to be a system substantially equipped with each means such as means for storing "the predetermined exchange/exchange rate decided in advance," means for performing calculation relating to "the selling order" and "the buying order" based on the stored rate, and means for controlling to write accumulation information in "the point information DB," from technical common sense.

Then, it can be said that Invention A-1 substantially corresponds to "a point total management system" of the patent invention 1.

Therefore, Invention A-1 and the patent invention 1 are substantially identical in a point that each of them is "point total management system" equipped with "exchange rate storage means," "settlement rate storage means," "common point accumulation storage control means," and "point settlement means."

According to the above, the patent invention 1 and Invention A-1 are identical in a point of "A point total management system comprising:  
exchange rate storage means which stores an exchange rate for exchanging points of a first client company to common points;

common point accumulation storage control means which exchanges the points of the first client company to common points based on the exchange rate, and accumulates and stores the points at a common point storage part;

settlement rate storage means which stores a settlement rate for settling the common points stored in the common point storage part as points of a second client company; and

point settlement means which settles the common points stored in the common

point storage part as the points of the second client company based on the settlement rate," and are different in the following point.

<The different feature>

Concerning the exchange rate and the settlement rate, the patent invention 1 "respectively has a plurality" of them, whereas in Invention A-1, both of them are "a predetermined exchange/exchange rate decided in advance," and there is no particular specification about respectively having the plurality of rates.

## 1-2 Judgment

The different feature above is examined

In 1995, both being well known as a service which a company provides to customers, HILTON HOTEL had a point program called HILTON HHonors and gave HHonors points to members participating in the program on the basis of the program, and the members could exchange acquired points to various rewards, and the airline industry had a point program called a frequent flyer program, in which each airline company gave points called miles to passengers on the basis of the program, and the passengers could exchange acquired miles to various rewards.

Based on such a background, looking at the descriptions of Evidences A No. 3a to A No. 3c in Evidence A No. 3, it can be seen that HILTON HHonors member can acquire the HHonors points by exchanging the miles of an airline company cooperating with HILTON HOTEL to the HHonors points at a predetermined rate, the member can exchange the acquired HHonors points to the airline company miles which is one of the rewards at a predetermine rate, and a rate for exchanging the HHonors points to the airline company miles is set in three stages. Also, it is obvious from a numerical value of each rate that it is aimed to promote the usage of the point program by the member and to improve service to the member by setting these three rates.

In addition, according to the descriptions of Evidence A No. 2a to A No. 2b in Evidence A No. 2, it can be seen that American Airlines joined as one of the airline companies cooperating with HILTON HOTEL in 1999, the miles of American Airlines can be exchanged to the HHonors points at a predetermined rate, and the rate for exchanging the mileage of American Airlines to the HHonors points is set in two stages according to an exchange period. Also, it is obvious from each numerical value of the two rates that it is aimed to promote the usage of the point program in a specified period and to improve

service to members, by setting these two rates.

Then, it can be grasped that the HILTON HHonors program is a program capable of exchanging at least the miles of American Airlines to the HHonors points at the two rates, and capable of exchanging the acquired HHonors points to miles of another airline company at the three rates, so that at least before the application of the patent, it can be said that the service enabling miles of an airline company to be exchanged to the HHonors at a predetermined rate, or enabling the HHonors points to be exchanged to the miles of another airline company at a predetermined rate, and having a plurality of rates as the respective predetermined rates, was a well-known matter in the light of the descriptions of Evidence A No. 2 and A No. 3. Also, it is obvious that by such a well-known service, the usage of the point program is promoted, and the service to the members is improved, thereby trying to secure good customers, in the light of the descriptions of Evidence A No. 2 and Evidence A No. 3.

Then, "the miles of a certain airline," "the HHonors points," "the miles of another airline company" in the well-known service can be respectively said to be "the points of the first client company," "the common points," and "the points of the second client company," so that the well-known service can be also said to be "a service exchanging points of a first client company to common points based on a predetermined rate, exchanging the common points to points of a second client company based on a predetermined rate, and having a plurality of rates as the respective predetermined rates."

On the other hand, in Evidence A No. 1, it is shown as "consumers can earn actual bonus benefits early, and companies selected as member companies can secure collective fixed customers; namely, members, and have the more excellent competitiveness than other companies in the same industry." (the description of Evidence A No. 1a), also in Invention A-1, further securing of good customers is an obvious challenge.

Therefore, it could be easily conceived by a person skilled in the art that matters relating to the well-known service above is applied to Invention A-1 so as to further secure good customers by promoting the usage of bonus points or cyber money by members and improving member service, and concerning an exchange/exchange rate when bonus points are changed to cyber money, namely at a selling order, or an exchange/exchange rate when cyber money is changed to bonus points, namely at a selling order, a plurality of respective rates are prepared in advance to make matters specifying the patent invention 1 relating to the different features above.

Also, the effect of the patent invention 1 could be predicted by a person skilled in the art from Invention A-1 and the well-known matters, and cannot be remarkable.

### 1-3 Summary regarding the patent invention 1

Therefore, the patent invention 1 could be provided easily by a person skilled in the art according to Invention A-1 and the well-known arts, so that it should not be granted a patent under the provisions of Article 29(2) of the Patent Act.

### 2 The patent invention 2

The patent invention 2 substantially corresponds to the invention which is equipped with "point exchange information reception means which receives point exchange information for exchanging points of a first client company to common points," "point settlement information reception means which receives point settlement information for settling the common points stored in the common point storage part as points of a second client company," and "point settlement information transmission means which transmits point settlement information to a point management device of the second client company," in addition to the patent invention 1, and respectively adds the limitations of "specified by the point exchange information" and "specified by the point settlement information" to "the first client company" and "the second client company."

#### 2-1 Comparison

Then, the patent invention 2 and Invention A-1 are compared while considering the examinations of (A) to (D) above.

(E) It is obvious that "order receiving" in "an order receiving step" of Invention A-1 corresponds to "receives point exchange information" and "receives point settlement information" of the patent invention 2. Also, it is obvious that "the kind of bonus points to be sold" and "the kind of bonus points to be bought" of Invention A-1 respectively correspond to points of a client company "specified by the point exchange information" and points of a client company "specified by the point settlement information" of the patent invention 2.

Then, as examined in (D) above, Invention A-1 can be substantially said to be "a point total management system," so that it can be said that the system is substantially equipped with means for carrying out "order receiving."

Therefore, the patent invention 2 and Invention A-1 are identical in a point of "a point total management system" equipped with "point exchange information reception means which receives point exchange information for exchanging points of a first client company to common points" and "point settlement information reception means which



receives point settlement information for settling the common points stored in the common point storage part as points of a second client company."

(F) Since Invention A-1, about the bought bonus points, "carrying out storage to the point information DB and immediately transmitting changed matters in the kind and number of the bonus points, to a member company providing the bonus points," at least it can be said that Invention A-1 transmits change information on the bonus points to "another company" providing the bonus points to be bought, so that "immediately transmitting changed matters in the kind and number of the bonus points, to a member company providing the bonus points" of Invention A-1 corresponds to "transmits point settlement information to the second client company" of the patent invention 2.

Then, it can be said that Invention A-1 is substantially "a point total management system," and it is technically obvious that suitable transmission means is used when "immediately transmitting changed matters in the kind and number of the bonus points, to a member company providing the bonus points," and that equipment to which matters are to be transmitted should be a suitable device for managing bonus points in the member company.

Therefore, it can be said that Invention A-1 is substantially equipped with "point settlement information transmission means which transmits point settlement information to a point management device of the second client company."

According to the examinations of (A) to (F) above, the patent invention 2 and Invention A-1 are different in <the different features> above, and are identical in the remaining features.

## 2-2 Judgment

The different features are as examined in "1-2 Judgment" above.

## 2-3 Summary regarding the patent invention 2

Therefore, the patent invention 2 could be provided easily by a person skilled in the art according to Invention A-1 and the well-known arts for reasons similar to those described about the patent invention 1, so that it should not be granted a patent under the provisions of Article 29(2) of the Patent Act.

## 3 The patent invention 3

The patent invention 3 substantially corresponds to the invention adding the limitation "when a number of points stored in the point management device of the first client company is equal to or more than the number of exchange demand points" to an exchange condition for "exchanging points of a first client company to common points," in the patent invention 2.

### 3-1 Comparison

Then, the patent invention 3 and Invention A-1 are compared while considering the examinations of (A)-(F).

(G) Invention A-1 calculates cyber money from bonus points "when the order is a selling order, if the member holds the above mentioned quantity or more of the above mentioned kind of the bonus points," so that "if the member holds the above mentioned quantity or more of the above mentioned kind of the bonus points" of Invention A-1 corresponds to "when a number of points" of the first client company is equal to or more than the number of exchange demand points" of the patent invention 3.

Also, it can be said that Invention A-1 is substantially "a point total management system," so that it is as examined in (F) above that the system is substantially equipped with a suitable device for managing bonus points in the member company.

Then, it can be said that Invention A-1 substantially comprises "when a number of points stored in the point management device of the first client company is equal to or more than the number of exchange demand points, exchanging points of the first client company to common points."

Therefore, according to the examinations of (A)-(G) above, the patent invention 3 and Invention A-1 are different in <the different features> above, and are identical in the remaining features.

### 3-2 Judgment

The different features are as examined in "1-2 Judgment" above.

### 3-3 Summary regarding the patent invention 3

Therefore, the patent invention 3 could be provided easily by a person skilled in the art according to Invention A-1 and the well-known arts for reasons similar to those described about the patent invention 2, so that it should not be granted a patent under the provisions of Article 29(2) of the Patent Act.

#### 4. The patent invention 4

The patent invention 4 corresponds to the invention adding the limitation that information about exchange and settlement thereof is "received through a communication medium" to "a point exchange information reception means" and "point settlement information reception means" which are matters specifying the invention, in the patent invention 2 or 3.

##### 4-1 Comparison

Then, the patent invention 4 and Invention A-1 are compared while considering the examinations of (A)-(G).

(H) Invention A-1 "inputs" "the kind and quantity of bonus points to be sold" or "the kind and quantity of the points to be bought by cyber money held by himself/herself" "through the communication network such as the Internet," and "the communication network such as the Internet" is a kind of communication medium, so that it can be said that means for "order receiving" of Invention A-1 examined in (E) above receives "the kind and quantity of the bonus points to be sold" or "the kind and quantity of the points to be bought" through a communication medium.

Then, it can be said that Invention A-1 substantially comprises the matter "wherein the point exchange information reception means receives point exchange information through a communication medium, and wherein the point settlement information reception means receives point settlement information through a communication medium."

Therefore, according to the examinations of (A)-(H) above, the patent invention 4 and Invention A-1 are different in <the different features> above, and are identical in the remaining features.

##### 4-2 Judgment

The different features are as examined in "1-2 Judgment" above.

##### 4-3 Summary regarding the patent invention 4

Therefore, the patent invention 4 could be provided easily by a person skilled in the art according to Invention A-1 and the well-known arts for reasons similar to those described about the patent invention 2, so that it should not be granted a patent under the provisions of Article 29(2) of the Patent Act.

## 5. The patent invention 5

The patent invention 5 corresponds to the invention adding the limitation that information about exchange and settlement thereof is "received through a data input device" to "a point exchange information reception means" and "point settlement information reception means," which are matters specifying the invention, in the patent invention 2 or 3.

### 5-1 Comparison

Then, the patent invention 5 and Invention A-1 are compared while considering the examinations of (A)-(H).

(I) As examined in (D) above, it can be said that Invention A-1 is substantially "a point total management system," and Invention A-1 "inputs" information about selling or buying "through a communication network such as the Internet or face-to-face," so that it can be said that the system is substantially equipped with suitable means for inputting information transmitted through the Internet and the like or face-to-face to a control part and the like in the system.

Then, it can be said that Invention A-1 is substantially equipped with the matters that the point exchange information reception means receives point exchange information through a data input device, and "the point settlement information reception means receives point settlement information through a data input device."

Therefore, according to the examinations of (A)-(I) above, the patent invention 5 and Invention A-1 are different in <the different features> above, and are identical in the remaining features.

### 5-2 Judgment

The different features are as examined in "1-2 Judgment" above.

### 5-3 Summary regarding the patent invention 5

Therefore, the patent invention 5 could be provided easily by a person skilled in the art according to Invention A-1 and the well-known arts for reasons similar to those described about the patent invention 2, so that it should not be granted a patent under the provisions of Article 29(2) of the Patent Act.

No. 7 Closing

As described above, the patent regarding the patent invention 1 to the patent invention 5 violates the provisions of Article 29(2) of the Patent Act, falls under Article 123(1)(ii) of the Patent Act, and therefore should be invalidated.

The costs in connection with the trial shall be borne by the demandee under the provisions of Article 61 of the Code of Civil Procedure which is applied mutatis mutandis in the provisions of Article 169(2) of the Patent Act.

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

September 3, 2013

Chief administrative judge: YOKOBAYASHI, Shujiro

Administrative judge: SEKIYA, Kazuo

Administrative judge: HONGO, Toru