

## Appeal decision

Appeal No. 2018-15070

Appellant	Trust Companies Association of Japan
Patent Attorney	U'sfi Patent Attorneys International Office
Appellant	NAKAMOTO, Masaki
Patent Attorney	U'sfi Patent Attorneys International Office

The case of appeal against the examiner's decision of refusal of Japanese Patent Application No. 2018-74999, entitled "SET OF SHEET-LIKE OBJECT AND TRUST AGREEMENT" (the application published on October 24, 2019, Japanese Unexamined Patent Application Publication No. 2019-181792) has resulted in the following appeal decision.

### Conclusion

The appeal of the case was groundless.

### Reason

#### No. 1 History of the procedures

The application was filed on April 9, 2018, a notice of reasons for refusal was issued on April 27, 2018, and despite submission of a written opinion and a written amendment on July 13, 2018, an examiner's decision of refusal was issued on August 6, 2018. Against this, a demand for appeal against the examiner's decision of refusal was made on November 13, 2018.

#### No. 2 The Invention

The inventions according to claims of the present application are acknowledged as specified by the matters described in Claims 1 to 5 of the Scope of Claims, as viewed from the patent specification after the amendment by the written amendment dated July 13, 2018 and the description of the Scope of Claims and the Drawings, and the invention relating to Claim 1 thereof is as follows.

"A set of: a sheet-like object displaying a trustee certificate which includes a trustee display section that displays information for specifying a trustee, and a trust property display section that displays information for specifying a trust property;

a sheet-like object displaying a beneficiary certificate which includes a beneficiary display section that displays information for specifying a beneficiary, and a trust property display section that displays information for specifying a trust property; and

a trust agreement." (hereinafter, referred to as "the Invention")

#### No. 3 Reasons for refusal stated in the examiner's decision

Reason 1, which relates to the notice of reasons for refusal issued on April 27, 2018, is as outlined below.

Since the Invention does not fall under a creation of a technical idea utilizing a law of nature, it cannot be said that it is an "invention" stipulated in Article 2(1) of the Patent Act. Further, it does not meet the requirement stipulated in the main paragraph of Article 29 (1) of the Patent Act, and therefore the applicant should not be granted a patent for the Invention.

#### No. 4 Judgment by the body

(1) Regarding the meaning of an "invention" prescribed in Article 2(1) of the Patent Act.

The patent system is a system which imparts a monopolistic right called a patent right under certain conditions, to a person who has disclosed an invention that is a new technology, for a fixed time period, in return for the disclosure of the invention, and on the other hand, gives third parties the opportunity to use the disclosed invention. The purpose of the patent system is to encourage inventions through promoting the protection and utilization of inventions, and thereby contribute to the development of industry (Article 1 of the Patent Act.). Further, "invention" that is the subject of a patent is "the highly advanced creation of technical ideas utilizing a law of nature" (Article 2(1) of the Patent Act), and may be completed by a series of steps of: setting a certain technical problem; adopting the technical means for solving the problem to be solved; and confirming the effects of achieving the desired object by the technical means.

Accordingly, whether or not it can be said that the invention for which a patent is sought described in claims is an "invention" stipulated in Article 2(1) of the Patent Act should be judged based on whether or not it can be said that it falls under "a creation of a technical idea utilizing a law of nature" in light of a predetermined technical problem, the constitution of the technical means for solving the problem to be solved, and the effects

and the like to be led from that constitution, as a result of comprehensive consideration.

Then, "invention," as described above, is "a creation of a technical idea utilizing a law of nature," and it cannot be said that mere human mental activity, decision-making, abstract concepts, and artificial arrangements themselves are natural laws, or are a law of nature, and they do not utilize a law of nature, and thus it cannot be immediately said that they "utilize a law of nature".

Therefore, even if in the invention for which a patent is sought described in claims, some technical thought is presented there, as described above, in light of its technical meaning, as a result of comprehensive consideration, in solving the problem, when it is exclusively directed to human mental activities, decision making, abstract concepts, and artificial arrangements themselves and cannot be said to be utilizing a law of nature, it cannot be said that it falls under an "invention" stipulated in Article 2(1) of the Patent Act.

From the above point of view, the applicability of the Invention will be examined as follows.

## (2) Description of the Invention

The Description of the present application includes the following statement (underlines were added by the body).

"[Problem to be solved by the invention]

[0004]

The trust is composed of three roles: entrustor, trustee, and beneficiary, but the same person can also serve concurrently in more than one of these roles, and the contract contents are diverse. Among them, especially in civil trusts, due to the passage of time after the trust agreement and the occurrence of inheritance, there has been a situation in which the role of each person has become unclear between the parties and the property was not fully utilized. To confirm the role of each person in the trust contract, the content of the trust agreement can be checked, but it is difficult for each person to immediately understand their role, because the content of the trust agreement is complicated."

"[0006]

The present invention has been made in view of the above circumstances, and an object thereof is to provide means for easily confirming the contents of a trust contract."

"[Advantage of the Invention]

[0009]

According to the present invention, with the above configuration, it is possible to provide means for easily confirming the contents of the trust contract. As a result, people who are unfamiliar with the trust in ordinary daily life, for example, the use of the civil trust between families, can be promoted, and the activation of economic activities is expected. For example, according to a civil trust, assuming a parent as entrustor, a child as a trustee, and a grandchild as a beneficiary, the child (trustee) can manage, operate, dispose, etc. the trust property transferred from the parent (entrustor) according to a certain purpose, and give the trust property and the profit generated from it to the grandchild (beneficiary). That is, the property can be freely managed even during the parents' lives, and the right to manage and dispose of the property can be entrusted to a reliable child and the like, and the generated profit can be given to a desired grandchild and the like. In addition, the details of inheritance can be determined by the civil trust, the inheritance destination of the property can be determined up to the second generation, and property management can be performed for those who have difficulty managing the property, such as elderly people and patients with dementia. According to such a civil trust, since the property can be managed, operated, disposed of, inherited, etc. smoothly, it is expected that economic activities will be activated by the spread of the civil trust."

"[0012]

<Display Object Displaying Trustee Certificate>

FIG. 1 is a diagram showing the surface of the display object displaying the trustee certificate of the present invention. As shown in FIG. 1, a display object 10 displaying a trustee certificate 1 of the present invention (hereinafter, may be simply referred to as a 'trustee certificate display object 10') includes a trustee display section 11 that displays information for specifying a trustee, and a trust property display section 12 that displays information for specifying a trust property.

[0013]

The trustee display section 11 is not particularly limited so long as the information specifying the trustee is displayed, but for example, it is preferable that the name or name of the trustee and the address or whereabouts of the trustee are displayed. This makes it easier to specify the trustee.

[0014]

The trust property display section 12 is a part where information for specifying the trust property is displayed. The trust property display section 12 makes it easy to understand the contents of the trust property. Examples of the trust property include

stocks, securities such as bonds, real estate, money, intellectual property, and the like.

[0015]

As the trustee certificate 1, a trustee certificate that certifies that the person described in the trustee display section 11 is a trustee, or a trustee confirmation that confirms that the person described in the trustee display section 11 is a trustee are given."

"[0018]

When the trustee certificate display object 10 is a sheet-like object, it is preferable that a trustee certificate title section 13 indicating that the sheet-like object is the trustee certificate 1, the trustee display section 11, and the trust property display section 12 are provided on the surface 10A of the sheet-like object. Further, as shown in FIG. 2, it is preferable that some excerpts of the trust contract are described on the back surface 10B of the sheet-like object."

"[0020]

By providing the trustee certificate title section 13, the trustee display section 11, and the trust property display section 12 on the surface 10A of the sheet-like object, it becomes easy to confirm the trustee and the contents of the trust property at first glance. Furthermore, the back surface 10B of the sheet-like object contains some excerpts from the trust right of the trust contract, so that the trustee can easily confirm the information related to his/her role without reading the complicated trust agreement."

"[0025]

<Display Object Displaying Beneficiary Certificate>

FIG. 3 is a diagram showing the surface of the display object displaying the beneficiary certificate of the present invention. As shown in FIG. 3, the display object 20 displaying the beneficiary certificate 2 of the present invention (hereinafter, may be simply referred to as a 'beneficiary certificate display object 20') includes a beneficiary display section 21 that displays information for specifying a beneficiary, and a trust property display section 22 that displays information for specifying a trust property.

[0026]

The beneficiary display section 21 is not particularly limited so long as the information specifying the beneficiary is displayed, but for example, it is preferable that the name or name of the trustee and the address or whereabouts of the beneficiary are displayed. This makes it easy to specify the beneficiary.

[0027]

The trust property display section 22 is a part where information for specifying the trust property is displayed. The trust property display section 22 makes it easy to understand the contents of the trust property. Examples of the trust property include stocks, securities such as bonds, real estate, money, intellectual property, and the like.

[0028]

As the beneficiary certificate 2, a beneficiary certificate that proves that the person described in the beneficiary display section 21 is a beneficiary, and a beneficiary confirmation that confirms that the person described in the beneficiary display section 21 is a beneficiary are given."

"[0031]

When the beneficiary certificate display object 20 is a sheet-like object, it is preferable that a beneficiary certificate title section 23 indicating that the sheet-like object is the beneficiary certificate 2, the beneficiary display section 21, and the trust property display section 22 are provided on the surface 20A of the sheet-like object. Further, as shown in FIG. 4, it is preferable that some excerpts of the trust contract are described on the back surface 20B of the sheet-like object."

"[0033]

By providing the beneficiary certificate title section 23, the beneficiary display section 21, and the trust property display section 22 on the surface 20A of the sheet-like object, it becomes easy to confirm the beneficiary and the contents of the trust property at first glance. Furthermore, the back surface 20B of the sheet-like object contains some excerpts from the beneficiary right of the trust contract, so that the beneficiary can easily confirm the information related to his/her role without reading the complicated trust agreement."

"[0039]

<Set of Trustee Certificate Display Object, Beneficiary Certificate Display Object, and Trust Agreement>

The present invention also includes a set of the trustee certificate display object 10, the beneficiary certificate display object 20, and a trust agreement. By storing the trustee certificate display object 10, the beneficiary certificate display object 20, and the trust agreement together, the contents that are not described in the trustee certificate display object 10 or the beneficiary certificate display object 20 can be checked by the trust agreement. The trust agreement need not be the original, but may be a copy of the trust agreement."

### (3) Regarding the technical significance of the Invention

A According to the description of the specification described in (2) above, the fact that to confirm the role of each person in the trust contract, the content of the trust agreement can be checked, but it is difficult for each person to immediately understand their role because the content of the trust agreement is complicated, is recognized as a "predetermined technical problem" of the Invention ([0004]).

Then, in order to solve the "predetermined technical problem" and to provide means for easily confirming the contents of a trust contract ([0006]), the Invention adopts the constitution that is "a set of: a sheet-like object that includes a trustee display section that displays information for specifying a trustee, and a trust property display section that displays information for specifying a trust property; a sheet-like object that includes a beneficiary display section that displays information for specifying a beneficiary, and a trust property display section that displays information for specifying a trust property; and a trust agreement" as "the constitution of the technical means for solving the problem to be solved" (Claim 1, [0012], [0018], [0025], and [0031]).

Then, it is recognized that the Invention has "the effects led from the constitution of the technical means" that "a sheet-like object displaying a trustee certificate" of "the constitution of the technical means for solving the problem to be solved" includes "a trustee display section that displays information for specifying a trustee, and a trust property display section that displays information for specifying a trust property," and thus it becomes easy to confirm the trustee and the contents of the trust property at first glance ([0020]), has "the effects led from the constitution of the technical means" that "a sheet-like object displaying a beneficiary certificate" of "the constitution of the technical means for solving the problem to be solved" includes "a beneficiary display section that displays information for specifying a beneficiary, and a trust property display section that displays information for specifying a trust property," and thus it becomes easy to confirm the beneficiary and the contents of the trust property at first glance ([0033]), and has "the effects led from the constitution of the technical means" that by making a "set" of "a sheet-like object displaying the trustee certificate," "a sheet-like object displaying the beneficiary certificate," and "the trust agreement", the contents that are not described in the sheet-like object displaying the trustee certificate or the sheet-like object displaying the beneficiary certificate can be checked by the trust agreement ([0039]).

B Therefore, it is recognized that the technical significance of the invention is the following (A) to (C).

(A) It uses a psychological law of a human (recognition mechanism) in which by presenting "information for specifying a trustee" and "information for specifying a trust property" recognized as characters, which are displayed on a medium that is "a sheet-like object displaying a trustee certificate" to a human who is a user, the user is enabled to easily understand the contents of the trust contract, and is exclusively directed to mental activities themselves of a human. Even if the selected information such as "information for specifying a trustee" and "information for specifying a trust property" has characteristics, it is merely a selection based on an artificial arrangement that is a trust contract, so that, accordingly, it cannot be said that the technical significance is directed to utilizing a law of nature.

(B) It uses a psychological law of a human (recognition mechanism) in which by presenting "information for specifying a beneficiary" and "information for specifying a trust property" recognized as characters, which are displayed on a medium that is "a sheet-like object displaying a beneficiary certificate" to a human who is a user, the user is enabled to easily understand the contents of the trust contract, and is exclusively directed to mental activities themselves of a human. Even if the selected information such as "information for specifying a beneficiary" and "information for specifying a trust property" has characteristics, it is merely a selection based on an artificial arrangement that is a trust contract, so that, accordingly, it cannot be said that the technical significance is directed to utilizing a law of nature.

(C) It uses a psychological law of a human (recognition mechanism) in which by making a set of "a sheet-like object displaying the trustee certificate," "a sheet-like object displaying the beneficiary certificate," and "a trust agreement," and presenting information recognized as characters, which are displayed in respective media, to a human who is a user, the user is enabled to check the contents of the trust contract that are not described in the sheet-like object displaying the trustee certificate and the sheet-like object displaying the beneficiary certificate by the trust agreement, and is exclusively directed to mental activities themselves of a human.

Here, although making a "set" of three media that are "a sheet-like object displaying the trustee certificate," "a sheet-like object displaying the beneficiary certificate," and "a trust agreement" on which information is recognized as characters, these media do not have any physical action on each other, and even considering a



working effect that the contents of the trust contract that are not described in the sheet-like object displaying the trustee certificate and the sheet-like object displaying the beneficiary certificate can be checked by the trust agreement, it is should be said that the working effect uses a psychological law of a human (recognition mechanism) made by presenting information recognized as characters, which are displayed in respective media, to a human who is a user, and is exclusively directed to mental activities themselves of a human.

Accordingly, since all of (A) to (C) above are dedicated to mental activities of a human, and cannot be said to be a law of nature or utilizing a law of nature, the Invention in which (A) to (C) above are the technical significance does not fall under "a creation of a technical idea utilizing a law of nature" as a whole.

As described above, the Invention does not fall under an "invention" stipulated in Article 2(1) of the Patent Act.

#### (4) Appellant's allegation

The appellant, in the written request for appeal, alleges that the essence of the Invention resides in physical technical means that are a sheet-like object displaying a trustee certification produced separately from a trust agreement, and a sheet-like object displaying a beneficiary certificate, and since the effect of enabling the trustee and the like to easily check the contents of the trust contract by the physical technical means is shown, the essence of the Invention assists mental activities of a human or provides a technical means to be replaced with it, and thus the Invention uses a law of nature and falls under an "invention" stipulated in Article 2 (1) of the Patent Act.

However, as examined in (3) above, although making a "set" of three media that are "a sheet-like object displaying the trustee certificate," "a sheet-like object displaying the beneficiary certificate," and "a trust agreement" on which information recognized as characters is presented, these media do not have any physical action on each other, and even considering a working effect that the contents of the trust contract that are not described in the sheet-like object displaying the trustee certificate and the sheet-like object displaying the beneficiary certificate can be checked by the trust agreement, the working effect uses a psychological law of a human (recognition mechanism) made by presenting information recognized as characters, which are displayed in respective media, to a human who is a user, is exclusively directed to mental activities themselves of a human, and cannot be said to be a law of nature or utilizing a law of nature, so that it does not fall under "a creation of a technical idea utilizing a law of nature" as a whole.

No. 5 Closing

As described above, the Invention is not applicable to "an industrially applicable invention" under the main paragraph of Article 29(1) of the Patent Act, and thus the appellant should not be granted a patent under the provision of Article 29 (1).

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

November 26, 2019

Chief administrative judge: OZAKI, Atsushi

Administrative judge: FUJITA, Toshihiko

Administrative judge: FUJIMOTO, Yoshihito