Appeal decision

Appeal No. 2019-1157

Appellant MUFG Bank, Ltd.

Patent Attorney Takahashi Hayashi and Partner Patent Attorneys

The case of appeal against the examiner's decision of refusal of Japanese Patent Application No. 2018-193836, entitled "METHOD FOR SETTLING ELECTRONICALLY RECORDED RECEIVABLES AND CLAIMS MANAGEMENT SERVER", has resulted in the following appeal decision.

Conclusion

The appeal of the case was groundless.

Reason

No. 1 History of the procedures

The present patent application was filed on October 12, 2018 (Internal priority claim: October 17, 2017, March 19, 2018). The history of the procedures thereof is as follows.

Dated October 25, 2018:	Notice of reasons for refusal
November 27, 2018:	Submission of Written opinion and Written amendment
Dated December 4, 2018:	Examiner's decision of refusal
January 29, 2019:	Submission of Written Appeal
Dated March 14, 2019:	Notice of reasons for refusal
April 25, 2019:	Submission of Written opinion and Written amendment

No. 2 Regarding the Invention

Claim 1 of the scope of claims amended by the written amendment submitted on April 25, 2019 is as follows (hereinafter referred to as "the Invention").

"[Claim 1]

A settlement method of electronically recorded claims comprising:

transmitting a first transfer signal for transferring to a creditor's account an amount of money in accordance with the amount of electronically recorded claims;

transmitting a first withdrawal signal for withdrawing a discount fee equivalent to the discount fee of the electronically recorded claims from an account of a debtor of the electronically recorded claims; and

transmitting a second withdrawal signal for withdrawing the amount of electronically recorded claims from the debtor's account."

No. 3 Reasons for refusal

The notice of reasons for refusal issued by the body on March 14, 2019 is as follows.

• Reason 1 (Applicability to an invention)

The inventions recited in Claims 1 to 11 of this application do not satisfy the requirements stipulated in the main paragraph of Article 29(1) of the Patent Act. Thus, the Appellant should not be granted a patent for the inventions.

• Reason 2 (Inventive step)

The inventions according to Claims 1 to 11 of this application could have been easily made by a person ordinarily skilled in the art of the invention prior to the filing of the application, on the basis of inventions described in the Cited Documents 1 and 2 which were distributed, or inventions that were made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the application. Thus, the Appellant should not be granted a patent for the inventions under the provisions of Article 29(2) of the Patent Act.

Cited Document 1: Japanese Unexamined Patent Application Publication No. 2014-235435

Cited Document 2: "Government stringently applies Subcontract Act - to review transmittal of 'payment of draft'", Nikkan Kogyo Shinbun, Ltd., October 14, 2016, P.2

No. 4 Description in the Cited Documents and Cited Invention

1. Description in Cited Document 1

(A) Cited Document 1

Cited Document 1 describes the following matters. (The underlines were added by the body.)

(A-1) "relates to an electronic recording credit processing method and system for financial institution, more specifically, a method and system for processing electronic recording credit related to bulk factoring across a plurality of financial institutions" ([0001])

(A-2) "In transactions between companies, a payment company (especially a big company) has many seller companies and often issues electronic recording credits to the seller companies. According to the scheme of the bulk factoring disclosed in Patent Document 1, regarding electronic recording credits between a payment company as a debtor and many seller companies as originators, a record of an assignment is made for a factoring company (hereinafter referred to as 'SPC' (Special Purpose Company)) simultaneously with a record of the occurrence. For example, upon receiving detail data specified with a credit regarding the bulk factoring from a terminal of a payment company, a bulk factoring server creates billing data including occurrence record billing data for recording the occurrence of an electronic recording credit in a database of a recording institution and record-of-assignment billing data for recording that each credit has been assigned to the SPC, to be transmitted to the recording institution, thereby creating a record of occurrence and a record of assignment of the electronic recording credit related to the bulk factoring at the same time." ([0005])

(A-3) "This invention provides, for achieving the objects as above, in a first aspect, a method for notification of clearance information related to remittance clearance between accounts from a bulk factoring server in a banking system to a clearing bank in bulk factoring using electronic recording credit. The bulk factoring server in a banking system is connected to a recording institution system having a registry of electronic recording credit, and it is also connected, over a network, to a terminal of a seller company, a terminal of a payment company, a terminal of the SPC that conducts bulk factoring of electronic recording credit, and a terminal of a clearing bank which is

different from the banking system and has a clearance account of the payment company being a debtor. This method includes: a step of generating remittance information for performing remittance clearance between accounts in such a manner that a bulk factoring server receives clearance information on individual electronic recording credits whose payment due date comes from a recording institution system, and totals the individual electronic recording credits by a payment company having a clearance account in a clearing bank and SPC unit, and by a payment due date unit; a step of transmitting the remittance information to the clearing bank; and a step of generating payments record billing data to the individual electronic recording credits settled in remittance clearance between the accounts, and transmitting the generated payments record billing data to the recording institution system, upon receiving clearance results of the remittance clearance between the accounts from the clearing bank, after performing the remittance clearance between the accounts of the credit amount of the gross amount of the electronic recording credit totaled by the payment company and SPC unit, and by the payment due date unit from the clearance account of the payment company being a debtor to the clearance account of the SPC." ([0010])

(A-4) "Upon receiving a request for early funding from a seller company, the SPC is required to transfer the amount equivalent to the credit (the amount of advance payment) to the seller company. The SPC issues an instruction, in Step S408, from an SPC terminal 3, to a receiving processing unit 21 of a bulk factoring server 12, with a designation of a creation date of transfer data, to generate transfer data for paying the amount of advance payment to the seller company. Upon receiving the instruction to generate the transfer data from the SPC terminal 3, a clearance processing unit 23 of the bulk factoring server 12 calculates, in Step S410, the amount to be paid (the amount of advance payment) by the SPC to each seller company having made the early funding request. The amount to be paid (the amount of advance payment) is calculated on the basis of the amount of credit corresponding to electronic recording credit and a discount rate specified by master data stored in a master data storage unit 24 (e.g., the amount of advance payment=the amount of credit - discount). The clearance processing unit 23 generates, in Step S412, transfer data including the SPC as a transfer requestor, the seller company as a recipient, and the amount of advance payment calculated in Step S410 as the amount to be transferred. The transfer data are generated as general transfer data based on a record format specified by Japanese Bankers Association, by which money can be transferred in bulk to one or a plurality of recipients.

See FIGS. 11 and 12. FIG. 11 illustrates one example of a transaction menu

screen which can be displayed on the SPC terminal 3. FIG. 12 illustrates one example of a screen to be displayed when the SPC terminal 3 downloads general transfer data. When "Download of general transfer data" 1101 is selected from a transaction menu 1100 displayed on the SPC terminal 3, for generating transfer data for transferring funds to a seller company, for example, a screen 1200 is displayed on the SPC terminal 3. On the screen 1200 of the SPC terminal 3, when an instruction to generate transfer data is issued with a designation of a creation date of general transfer date (S408), the bulk factoring server 12 calculates the amount to be paid (the amount of advance payment) by the SPC to the seller company (S410). The SPC may have a plurality of clearance accounts each of which is assigned for a corresponding one of payment companies. Regarding the general transfer data, each of transfer details is generated by clearance account. For example, in the example of FIG. 12, a plurality of transfer details are grouped by clearance account and listed in a general transfer data transmittal table 1210, which shows that the amount of transfer (or the total of the amount to be paid) designated on September 26, 2012 is 143,784,070 yen for 32 transactions in total. For example, the transfer settled by the clearance account "8780001" includes transfer details for 4 transactions to each seller company as shown in a transfer details list 1220.

Returning to FIG. 4, when the SPC terminal 3 issues an instruction to download general transfer data, the general transfer data are transmitted from the bulk factoring server 12 to the SPC terminal 3 (Step S414). When downloading the general transfer data, the SPC terminal 3 transmits the downloaded general transfer data to a clearing bank system 5 (e.g., an EB (electronic banking) system 15) and requests general transfer (Step S416). The clearing bank system 5 executes transfer to the seller company via an accounting system 16 to remit the amount of advance payment to a receipt account of the seller company (Step S418)." ([0045] to [0047])

(A-5) "FIG. 7 illustrates a process of liquidation from a payment company to SPC on a payment due date of electronic recording credit. The payment of the amount of credit of electronic recording credit from a payment company to SPC on a payment due date is conducted by remittance clearance between accounts.

In Step S702, the recording institution system 13 extracts, for example, electronic recording credits whose due date will soon come, e.g., two days before the payment due date, from a registry 32. Electronic recording credits liquidated early are not extracted in Step S702, because claims have been expired by payments record after a report of receipt confirmation of the early liquidation.

In Step S704, the recording institution system 13 transmits to the bulk factoring

server 12 a request notification message of remittance clearance between accounts on the extracted electronic recording credits so that remittance clearance between accounts may be made on the electronic recording credits. In remittance clearance between accounts, information including at least payment due date, the amount of credit, a debtor account, and a creditor account of each electronic recording credit legislatively must be provided. For example, information on a clearance date (payment due date), account information of a debtor (payment company), account information of a creditor (SPC), and the amount of credit of each electronic recording credit are included.

In Step S706, the clearance processing unit 23 of the bulk factoring server 12 creates transfer data for performing remittance between accounts of the amount of credit on a payment due date from a clearance account of a debtor (payment company) to a clearance account of a creditor (SPC). There may be a plurality of electronic recording credits to be paid on a certain payment due date from a debtor (payment company) to a creditor (SPC). The clearance processing unit 23 is configured to settle a plurality of electronic recording credits on the same payment due date between the same debtor and creditor in bulk by one remittance clearance between accounts. For example, the clearance processing unit 23 can create transfer data for remittance clearance between accounts to be cleared on a payment due date, for electronic recording credits for the same payment due date, the same debtor, and the same creditor, including the total of the amount of credits as the amount of transfer, a clearance account of a payment company as a withdrawal account, and a clearance account of SPC as a receipt account. The transfer data are generated as single general transfer data with the total amount of transfer, which is aggregated in single transfer details, and may be a transfer slip, or the like, from which the details of transfer instruction can be confirmed.

The created transfer data are downloaded to the clearing bank system 5 (Step S708). The clearing bank system 5 processes the downloaded transfer data by means of the EB system 15 (or using a transfer slip, or the like), to execute remittance clearance between accounts by withdrawing the amount of transfer from the account of the payment company and remitting it to the account of the SPC (Step S710). As such, fund transfer is conducted from an account of a payment company to an account of the SPC." ([0062] to [0066])

In light of the above matters described in (A-1) to (A-5), Cited Document 1 describes the following invention (hereinafter referred to as "Cited Invention").

"A method for processing electronic recording credit by notification of clearance

information related to remittance clearance between accounts from a bulk factoring server in a banking system to a clearing bank in bulk factoring using electronic recording credit, ([0001], [0010]) wherein

the bulk factoring server in a banking system is connected to a recording institution system having a registry of electronic recording credit, and is also connected, over a network, to a terminal of a seller company, a terminal of a payment company, a terminal of an SPC that conducts bulk factoring of electronic recording credit, and a terminal of a clearing bank which is different from the banking system and has a clearance account of the payment company being a debtor, ([0010])

upon receiving a request for early funding from a seller company, the SPC issues an instruction, from an SPC terminal 3, to a receiving processing unit 21 of a bulk factoring server 12, with a designation of a creation date of transfer data, to generate transfer data for paying the mount of advance payment to the seller company, and upon receiving the instruction to generate the transfer data from the SPC terminal 3, a clearance processing unit 23 of the bulk factoring server 12 calculates the amount to be paid (the amount of advance payment) by the SPC to each seller company having made the early funding request, the amount to be paid (the amount of advance payment) is calculated on the basis of the amount of credit corresponding to electronic recording credit and a discount rate specified by master data stored in a master data storage unit 24 (e.g., the amount of advance payment=the amount of credit - discount), the clearance processing unit 23 generates transfer data including the SPC as a transfer requestor, the seller company as a recipient, and the calculated amount of advance payment as the amount to be transferred, and when the SPC terminal 3 issues an instruction to download general transfer data, the general transfer data are transmitted from the bulk factoring server 12 to the SPC terminal 3, when downloading the general transfer data, the SPC terminal 3 transmits the downloaded general transfer data to a clearing bank system 5 (e.g., an EB system 15) and requests general transfer, the clearing bank system 5 executes transfer to the seller company via an accounting system 16 to remit the amount of advance payment to a receipt account of the seller company, ([0045], [0047])

the payment of the amount of credit of electronic recording credit from a payment company to the SPC on a payment due date is conducted by remittance clearance between accounts, ([0062])

the recording institution system 13 transmits a request notification message of remittance clearance between accounts on the extracted electronic recording credits so that remittance clearance between accounts may be made on the electronic recording credits, to the bulk factoring server 12, the clearance processing unit 23 of the bulk

factoring server 12 creates transfer data for performing remittance between accounts of the amount of credit on a payment due date from a clearance account of a debtor (payment company) to a clearance account of a creditor (SPC), the created transfer data are downloaded to the clearing bank system 5 (Step S708), and the clearing bank system 5 processes the downloaded transfer data by means of the EB system 15 (or using a transfer slip, or the like), to execute remittance clearance between accounts by withdrawing the amount of transfer from the account of the payment company and remitting it to the account of the SPC ([0064] to [0066])."

2. Description in Cited Document 2

(B) Cited Document 2

Cited Document 2 describes the following matters. (The underlines were added by the body.)

(B-1) "... in light of the above circumstances, in this review of the Subcontract Act (the Act against Delay in Payment of Subcontract Proceeds, Etc. to Subcontractors), we request parent companies to pay not by check but by cash to subcontractors. Even if a check is used, we ask parent companies having placed an order to pay a discount charge for cashing the check without imposing the cost on the subcontractors. ..."

No. 5 Judgment by the body

We examine the reasons for refusal notified by the body, "Reason 1 (Applicability to an invention)" and "Reason 2 (Inventive step)", as follows.

1. Regarding "Reason 1 (Applicability to an invention)"
(1) Regarding the viewpoint "creation of technical ideas utilizing a law of nature"

Article 2(1) of the Patent Act stipulates as follows: "'Invention' in this Act means the highly advanced creation of technical ideas utilizing the laws of nature". The main paragraph of Article 29(1) of the Patent Act stipulates as follows: "An inventor of an invention that is industrially applicable may be entitled to obtain a patent for said invention, except for the following."

Therefore, an invention related to a patent application which is not "a creation of

technical ideas utilizing a law of nature" does not satisfy the requirements stipulated in the main paragraph of Article 29(1) of the Patent Act, and the inventor should not be granted a patent for the invention.

We examine whether or not the Invention is "a creation of technical ideas utilizing a law of nature".

(1-1) The constituent component in the Invention, "transmitting a first transfer signal for transferring the amount of money in accordance with the amount of electronically recorded claims to a creditor's account", specifies a service procedure in a financial transaction that transmits a first transfer signal for "transferring" "a predetermined amount of money", which is "the amount of money in accordance with the amount of electronically recorded claims", to "an account" of "a predetermined person" being a "creditor".

The matter "transmitting a first transfer signal" means that a computer transmits a command to request processing for "transferring the amount of money in accordance with the amount of electronically recorded claims to a creditor's account". According to the description in [0046] of the specification, "... specifically, a transfer/withdrawal command unit 122f transmits a transfer signal to an account management server ...", the transmission is transfer of information between a credit management server and an account management server. Therefore, the above command to be transmitted as a signal over a network or a communication line is an inevitable technical matter.

The Invention does not specify any technical feature exceeding an inevitable technical matter in using a computer, regarding the matters, "fist transfer signal" and "transmitting".

Accordingly, in light of the problem to be solved by the Invention, "to provide a method for clearance of electronically recorded claims for which a discount fee can be paid by debtors without increasing administrative burdens or administrative costs on the debtors and creditors, while conforming to investment standard of the revised Subcontract Act", the nature of the constituent component, "transmitting a first transfer signal for transferring the amount of money in accordance with the amount of electronically recorded claims to a creditor's account", is for a business rule per se based on an arbitrary arrangement, which is a service procedure in a financial transaction. Even if it includes inevitable technical matters in using a computer, such as "first transfer signal" and "transmitting", it is not recognized that a law of nature is used in the whole of the constituent component.

(1-2) The constituent component in the Invention, "transmitting a first withdrawal signal for withdrawing a discount fee equivalent to the discount fee of the electronically recorded claims from an account of a debtor of the electronically recorded claims" specifies, in a similar way to that described above (1-1), a service procedure in a financial transaction that transmits a first withdrawal signal for "withdrawing" "a predetermined amount of money", which is "a discount fee equivalent to the discount fee of the electronically recorded claims", from "an account" of "a predetermined person" being a "debtor of the electronically recorded claims". The nature of the constituent component, "transmitting a first withdrawal signal for withdrawing a discount fee equivalent to the discount fee of the electronically recorded claims from an account of a debtor of the electronically recorded claims", is for a business rule per se based on an arbitrary arrangement, which is a service procedure in a financial transaction. Even if it includes inevitable technical matters in using a computer, such as "first withdrawal signal" and "transmitting", it is not recognized that a law of nature is used in the whole of the constituent component.

(1-3) The constituent component in the Invention, "transmitting a second withdrawal signal for withdrawing the amount of electronically recorded claims from the debtor's account" specifies, in a similar way to that described above (1-1), a service procedure in a financial transaction that "withdraws" "a predetermined amount of money", which is "the amount of electronic recording credit", from "an account" of "a predetermined person" being a "debtor". The nature of the constituent component, "transmitting a second withdrawal signal for withdrawing the amount of electronically recorded claims from the debtor's account ", is for a business rule per se based on an arbitrary arrangement, which is a service procedure in a financial transaction. Even if it includes inevitable technical matters in using a computer, such as "second withdrawal signal" and "transmitting", it is not recognized that a law of nature is used in the whole of the constituent component.

(1-4) As indicated in (1-1) to (1-3), it is considered that the nature of the constituent components constituting the Invention are for a business rule per se based on an arbitrary arrangement, which is a service procedure in a financial transaction. Thus, it is considered that the nature of the Invention is also for a business rule per se based on an arbitrary arrangement, which is a service procedure in a financial transaction.

On the whole, in the Invention, no reason is recognized for the nature of the

Invention being not for a business rule per se based on an arbitrary arrangement, which is a service procedure in a financial transaction.

Accordingly, the Invention, which includes inevitable technical matters in using a computer, such as "first transfer signal", "first withdrawal signal", "second withdrawal signal", and "transmitting", only specifies a service procedure in a financial transaction, which is a business rule based on an arbitrary arrangement, as a whole. The Invention cannot be considered as "a creation of technical ideas utilizing a law of nature" stated in Article 2(1) of the Patent Act, and does not satisfy the requirements stipulated in the main paragraph of Article 29(1) of the Patent Act. Thus, the Appellant should not be granted a patent for the invention.

(2) Regarding the viewpoint "computer software-related invention"

The Invention, which specifies inevitable technical matters in using a computer, such as "first transfer signal", "first withdrawal signal", "second withdrawal signal", and "transmitting", is considered as a "computer software-related invention". The Invention is examined from this viewpoint as follows.

The concept that a software-related invention is "a creation of technical ideas utilizing a law of nature" is basically as follows.

Regarding software in software-related inventions, when "information processing by software is concretely realized using hardware resources", the software is "a creation of technical ideas utilizing a law of nature".

The representation, "information processing by software is concretely realized using hardware resources", means that an information processing equipment or its operational method particularly suitable for the application purpose is constructed by cooperative working of software and hardware resources. (See Appended Document B Application example of "Examination Guidelines for Patent and Utility Model" to a specific technical field "2. 1. 1. 2 Concept based on the viewpoint of software")

(2-1) The constituent components constituting the Invention, "transmitting a first transfer signal for transferring the amount of money in accordance with the amount of electronically recorded claims to a creditor's account" (1-1), "transmitting a first withdrawal signal for withdrawing a discount fee equivalent to the discount fee of the electronically recorded claims from an account of a debtor of the electronically recorded

claims" (1-2), and "transmitting a second withdrawal signal for withdrawing the amount of electronically recorded claims from the debtor's account" (1-3), are to transmit a command for requesting a computer for processing, and do not means that a credit management server being a computer executes special information processing for generating the command. Thus, the constituent components are considered as inevitable technical matters in information transmission between computers, such as a credit management server and an account management server, and it cannot be said that there is a technical feature exceeding it.

(2-2) Accordingly, it cannot be said that the Invention describes a matter indicating that "an information processing equipment or its operational method particularly suitable for the application purpose is constructed by cooperative working of software and hardware resources". Thus, the Invention being "a computer software-related invention" is not considered as "a creation of technical ideas utilizing a law of nature" from that viewpoint.

Therefore, the Invention is not considered as "a creation of technical ideas utilizing a law of nature" stated in Article 2(1) of the Patent Act, and does not satisfy the requirements stipulated in the main paragraph of Article 29(1) of the Patent Act. Thus, the Appellant should not be granted a patent for the invention.

2. Regarding "Reason 2 (Inventive step)"

(1) Comparison

The Invention and the Cited Invention are compared below.

(1-1) The "seller company" and the "payment company" in the Cited Invention correspond to the "creditor" and the "debtor" in the Invention, respectively.

(1-2) The "amount to be paid to the seller company (the amount of advance payment)" in the Cited Invention, which is "calculated on the basis of the amount of credit corresponding to electronic recording credit and a discount rate specified by master data stored in a master data storage unit 24 (e.g., the amount of advance payment=the amount of credit - discount)", corresponds to the "amount of money in accordance with the amount of electronically recorded claims" in the Invention.

(1-3) In the Cited Invention, "... the clearance processing unit 23 of the bulk factoring server 12 ... generates transfer data including the SPC as a transfer requestor, the seller company as a recipient, and the calculated amount of advance payment as the amount to be transferred, when the SPC terminal 3 issues an instruction to download general transfer data, the general transfer data are transmitted from the bulk factoring server 12 to the SPC terminal 3, when downloading the general transfer data, the SPC terminal 3 transmits the downloaded general transfer data to a clearing bank system 5 (e.g., EB system 15) and requests general transfer, the clearing bank system 5 executes transfer to the seller company via an accounting system 16 to remit the amount of advance payment to a receipt account of the seller company". Thus, the "transfer data including the calculated amount of advance payment as the amount to be transferred" generated by the clearance processing unit 23 of the bulk factoring server 12 correspond to the "first transfer signal for transferring to a creditor's account" in the Invention.

It is obvious that the general transfer data transmitted from the bulk factoring server 12 to the SPC terminal 3 include the "transfer data including the calculated amount of advance payment as the amount to be transferred" generated by the clearance processing unit 23 of the bulk factoring server 12. Thus, the description in the Cited Invention, "(the general transfer data) are transmitted (from the bulk factoring server 12 to the SPC terminal 3)", corresponds to the description in the Invention, "transmitting (a first transfer signal for transferring to a creditor's account)".

Accordingly, in light of the results of comparison in (1-1) and (1-2), it can be said that the Cited Invention includes a configuration of "transmitting a first transfer signal for transferring the amount of money in accordance with the amount of electronically recorded claims to a creditor's account" in the Invention.

(1-4) In the Cited Invention, "the clearance processing unit 23 of the bulk factoring server 12 creates transfer data for performing remittance between accounts of the amount of credit on a payment due date from a clearance account of a debtor (payment company) to a clearance account of a creditor (SPC), the created transfer data are downloaded to the clearing bank system 5 (Step S708), the clearing bank system 5 processes the downloaded transfer data by means of the EB system 15 (or using a transfer slip, or the like), to execute remittance clearance between accounts by withdrawing the amount of transfer from the account of the payment company and remitting it to the account of the SPC". Thus, the "transfer data for performing remittance between accounts of the amount of credit on a payment due date from a clearance account of a debtor (payment company) to a clearance account of a creditor

(SPC)" created by the clearance processing unit 23 of the bulk factoring server 12 correspond to the "second withdrawal signal for withdrawing the amount of electronically recorded claims from the debtor's account" in the Invention.

Since the created "transfer data" are downloaded to the clearing bank system 5 over a network, it is obvious that the "transfer data" are "transmitted" from the bulk factoring server to the clearing bank system 5.

Accordingly, it can be said that the Cited Invention includes a configuration of "transmitting a second withdrawal signal for withdrawing the amount of electronically recorded claims from the debtor's account" in the Invention.

(1-5) It is obvious that the "method for processing electronic recording credit" in the Cited Invention corresponds to the "settlement method of electronically recorded claims" in the Invention.

(2) Corresponding Feature and Different Feature

In light of the matters compared in "(1) Comparison", the Invention and the Cited Invention are identified in the following point:

"A settlement method of electronically recorded claims comprising:

transmitting a first transfer signal for transferring to a creditor's account the amount of money in accordance with the amount of electronically recorded claims; and

transmitting a second withdrawal signal for withdrawing the amount of electronically recorded claims from the debtor's account."

The Invention and the Cited Invention are different in the following point.

[Different Feature 1]

The Invention specifies a configuration of "transmitting a first withdrawal signal for withdrawing a discount fee equivalent to the discount fee of the electronically recorded claims from an account of a debtor of the electronically recorded claims", while the Cited Invention does not include such configuration.

(3) Judgment

[Different Feature 1] is examined below.

As described in Cited Document 2, the concept (business rule) in financial transactions, "Even if a check is used, we ask parent companies having placed an order to pay a discount charge for cashing the check without imposing the cost on the subcontractors", had been publicly known before October 17, 2017, which is the earliest priority date of the application.

Considering that it is extremely general practice that a business rule is modified appropriately or a computer program is modified or upgraded in response to revision of a law or revision of investment standard, it is recognized that a person skilled in the art can easily add the configuration of "transmitting a first withdrawal signal for withdrawing a discount fee equivalent to the discount fee of the electronically recorded claims from an account of a debtor of the electronically recorded claims" to the Cited Invention in order to implement the business rule disclosed in the Cited Document 2.

The Appellant alleges in the written opinion submitted on April 25, 2019 as follows: "The technical problem to be solved by the invention is to provide a method for clearance of electronically recorded claims for which a discount fee can be paid by debtors without increasing administrative burdens or administrative costs on the debtors and creditors, while conforming to investment standard of the revised Subcontract Act (see [0005] and [0006]), while the technical problem to be solved by the invention described in Cited Document 1 (Cited Invention 1) is to provide a system which can enable discount of electronic recording credits even in a bank which is not equipped with a bulk factoring system in cooperation with an electronic recording institution system (see [0007] and [0009]). There is no commonality between them. Therefore, Cited Invention 1 lacks eligibility as a prior art document."

However, as described in Cited Document 2 and [0005] and [0006] in the Specification, the problem in commercial transactions that payment of a discount fee for cashing a credit is imposed on a creditor had been well known before the filing of the application.

The Cited Invention described in Cited Document 1 is directed to a method for clearance related to electronic recording credits to be generated in transactions between a payment company being a big company and a plurality of seller companies ([0005]), and belongs to the same technical field as the Invention.

Furthermore, the Cited Invention may be configured to modify a business rule or a computer program so that the burdens of discount fee may be imposed on a debtor in conformity to revision of investment standard.

In light of the above circumstances, the Appellant's allegation that Cited Document 1 lacks eligibility as a prior art document is unreasonable.

No. 6 Closing

As above, the Invention does not satisfy the requirements stipulated in the main paragraph of Article 29(1) of the Patent Act. Thus, the Appellant should not be granted a patent for the invention.

The Invention could have been easily made by a person ordinarily skilled in the art of the invention before the filing of the application on the basis of the invention described in Cited Document 1 and the matters described in Cited Document 2. Thus, the Appellant should not be granted a patent for the invention under the provisions of Article 29(2) of the Patent Act.

The present application should be rejected without examining inventions concerning other claims.

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

June 24, 2019

Chief administrative judge: KANEKO, Koichi
Administrative judge: SATO, Tomoyasu
Administrative judge: AIZAKI, Hirotsune