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 CLAIMS 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 Date: 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 method for settlement of electronically recorded claims comprising:

transmitting a first transfer signal for transferring to a creditor's account an amount corresponding to the amount of the electronically recorded claim;

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

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

No. 3 Reasons for refusal

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

•Reason 1 (Patent eligibility)

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

•Reason 2 (Inventive step)

The Inventions recited in Claims 1 to 11 of this application 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 inventions described in the following Cited Documents 1 and 2 distributed prior to the filing of the application, or on the basis of inventions 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 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: "The Government to Improve Application of the Subcontract Act - Re-examination on Notice of 'Payment by Draft'", Nikkan Kogyo Newspaper, NIKKAN KOGYO SHIMBUN, LTD., October 14, 2016, P. 2

No. 4 Description in the Cited Documents and Cited Invention

<u>1. Description in Cited Document 1</u>

(A) Cited Document 1

 Cited Document 1 includes the following descriptions. (The underlines were added by the body.)

(A-1) "A method and system for processing electronically recorded claims for financial institutions, more specifically, <u>a method</u> and system <u>for processing electronically recorded claims relating to bulk factoring</u> for multiple financial institutions" ([0001])

(A-2) "In transactions between companies, a payment company (especially a large company) has a lot of supplier companies and usually issues electronically recorded claims to the supplier companies. According to the bulk factoring scheme disclosed in Patent Document 1, for electronically recorded claims between a payment company as a debtor and each of multiple supplier companies as originators, a record of the assignment is made to a factoring company (hereinafter referred to as 'SPC' (Special Purpose Company)) as well as a record of accrual. For example, upon receipt of specification data specified with claims relating to bulk factoring from a terminal of the payment company, the bulk factoring server generates billing data including record-of-accrual billing data for recording accrual of electronically recorded claims in a database of a recording institution and record-of-assignment billing data for recording that each of claims has been assigned to the SPC, and transmits the data to the recording institution. Therefore, the record of accrual and the record of assignment of the electronically recorded claims relating to the bulk factoring are made simultaneously." ([0005])

(A-3) "This invention <u>provides</u>, for achieving the above object, in a first aspect, <u>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 electronically recorded claims. The bulk factoring server of the banking system is connected to a recording institution system including a registry of electronically recorded claims, and the server is also connected to a terminal of a supplier company, a terminal of a payment company, a terminal of the SPC which</u>

conducts bulk factoring of electronically recorded claims, and a terminal of the clearing bank, which is different from the banking system, in which the payment company as a debtor has an account for clearance, over a network. This method includes: a step of, when a bulk factoring server receives until payment due date, clearance information on individual electronically recorded claims, the payment due date of which will come, from a recording institution system, totaling the individual electronically recorded claims by a payment company having an account for clearance in the clearing bank and SPC unit, and by a payment due date unit; a step of transmitting the remittance information to a clearing bank generating remittance information for performing remittance clearance between accounts; and a step of generating payments record billing data of remittance clearance between the accounts to the individual electronically recorded claims 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 electronically recorded claims 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 via the clearing bank on the basis of the remittance information." ([0010])

(A-4) "Upon receipt of a request for early cashing from a supplier company, the SPC needs to transfer the amount equivalent to the claims (advance payment amount) to the supplier company. The SPC issues, in Step S408, from an SPC terminal 3, an instruction to a reception processing part 21 of the bulk factoring server 12 to generate transfer data for paying the advance payment amount to the supplier company, with a designated creation date of the transfer data. Upon receipt of the instruction to generate the transfer data from the SPC terminal 3, a clearance processing part 23 of the bulk factoring server 12 calculates, in Step S410, the amount to be paid to each of the supplier companies (advance payment amount) for which the SPC has requested early cashing. The amount paid (advance payment amount) is calculated on the basis of the amount of claims corresponding to the electronically recorded claims and a discount rate specified in master data stored in a master data storage part 24 (e.g., advance payment amount=the amount of claims-the discount amount). The clearance processing part 23 generates, in Step S412, transfer data with the SPC as a transfer requester, the supplier company as a recipient, and the advance payment amount calculated as the amount to be transferred in Step S410. The transfer data are

generated as general transfer data based on a record format set by Japanese Bankers Association, which can be used for bulk transfer to one or multiple recipients.

See FIG. 11 and Fig. 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 screens to be displayed when the SPC terminal 3 downloads the general transfer data. For example, when the SPC selects 'Download general transfer data 1101' from the transaction menu screen 1100 displayed on the SPC terminal 3 to start generating transfer data for transferring a fund to a supplier company, the screen 1200 is displayed on the SPC terminal 3.   When a creation date for generating the general transfer data is designated on the screen 1200 of the SPC terminal 3 (S408), the bulk factoring server 12 calculates the amount to be paid (advance payment amount) by the SPC to the supplier company to generate transfer data (S410).   The SPC may have a plurality of clearance accounts for each of payment companies.   Regarding the general transfer data, each of transfer details is generated for each clearance account.   For example, in the example in FIG. 12, in the general transfer data transmission table 1210, multiple transfer details are grouped by clearance account.   The amount to be transferred (or the total amount to be paid) on the designated transfer date September 26, 2012, is ¥143,784,070 for 32 in total.   For example, the transfer using the clearance account No. '8780001' includes four transfer details to each supplier company as shown in the transfer detail list 1220.

In 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).   The SPC terminal 3 having downloaded the general transfer data transmits the downloaded general transfer data to a clearing bank system (e.g., EB system 15), and requests general transfer (Step S416).   The clearing bank system 5 executes transfer to the supplier company via a core banking system 16, and the advance payment amount is transferred to an account of the supplier company (Step S418)." ([0045] to [0047])

(A-5) "FIG. 7 illustrates processing of liquidation from a payment company to SPC on a payment due date of electronically recorded claims.   Payment of the amount of electronically recorded claims from a payment company to the SPC on a payment due date is conducted by remittance clearance between accounts.

In Step S702, for example, the recording institution system 13 extracts electronically recorded claims whose payment due date comes soon, e.g., two business days before the payment due date, from the registry 32.   Electronically recorded claims,

which have been liquidated earlier and expired by payments record after a report of remittance confirmation for the early liquidation, are not extracted in Step S702.

Next, in Step S704, the recording institution system 13 transmits to the bulk factoring server 12 a request notification telegram for remittance clearance between accounts relating to the electronically recorded claims, to conduct the remittance clearance between accounts for the extracted electronically recorded claims. In remittance clearance between accounts, information including at least payment due date, the amount of the electronically recorded claims, account of the debtor, and account of the creditor are legislatively required for each of the electronically recorded claims. For example, information on the clearance date (payment due date) of each of the electronically recorded claims, account information of a debtor (payment company), account information of a creditor (SPC), and the amount of claims are included.

In Step S706, the clearance processing part 23 of the bulk factoring server 12 generates transfer data for remittance between accounts for the amount of claims from a clearance account of the debtor (payment company) to a clearance account of the creditor (SPC) on the payment due date. When there are multiple electronically recorded claims to be paid by the debtor (payment company) to the creditor (SPC) on a certain payment due date, the clearance processing part 23 performs settlement for all of the multiple electronically recorded claims between the same debtor and the same creditor on the same payment due date at once by one remittance clearance between accounts. For example, the clearance processing part 23 can generate transfer data, for remittance clearance between accounts for electronically recorded claims for the same payment due date, the same debtor, and the same creditor, including the total amount of claims as transfer amount, the clearance account of the payment company as a payment account, the clearance account of the SPC as a deposit account, and the payment due data as a clearance date. The transfer data, which are generated as single general transfer data using the total amount to be transferred, are aggregated in details for a single transfer, and may be a transfer slip, or the like, in which the contents of transfer instruction can be confirmed.

The generated transfer data are downloaded to the clearing bank system 5 (Step S708), and the clearing bank system 5 processes the downloaded transfer data by an EB system 15 (or processes with a transfer slip, or the like) and executes remittance clearance between accounts by withdrawing the amount to be transferred from the account of the payment company and transferring it to the account of the SPC (Step S710). In this manner, fund transfer is conducted from the account of the payment company to the account of the SPC." ([0062]-[0066])

According to the 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 electronically recorded claims, in bulk factoring using electronically recorded claims, 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 electronically recorded claims ([0001] [0010]) wherein

the bulk factoring server of the banking system is connected to a recording institution system including a registry of electronically recorded claims, and the server is also connected to a terminal of a supplier company, a terminal of a payment company, a terminal of the SPC which conducts bulk factoring of electronically recorded claims, and a terminal of the clearing bank, which is different from the banking system, in which the payment company as a debtor has an account for clearance, over a network, ([0010])

upon receipt of a request for early cashing from a supplier company, the SPC issues, from an SPC terminal 3, an instruction to a reception processing part 21 of the bulk factoring server 12 to generate transfer data for paying the advance payment amount to the supplier company, with a designated creation date of the transfer data, upon receipt of the instruction to generate the transfer data from the SPC terminal 3, a clearance processing part 23 of the bulk factoring server 12 calculates the amount to be paid to each of the supplier companies (advance payment amount) for which the SPC has requested early cashing, the amount paid (advance payment amount) is calculated on the basis of the amount of claims corresponding to the electronically recorded claims and a discount rate specified in master data stored in a master data storage part 24 (e.g., advance payment amount=the amount of claims - the discount amount), the clearance processing part 23 generates transfer data with the SPC as a transfer requester, the supplier company as a recipient, and the advance payment amount calculated 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, the SPC terminal 3 having downloaded the general transfer data transmits the downloaded general transfer data to a clearing bank system (e.g., EB system 15), and requests general transfer, the clearing bank system 5 executes transfer to the supplier company via a core banking system 16, and the advance payment amount is transferred to an account of the supplier company, ([0045], [0047])

payment of the amount of electronically recorded claims 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 telegram for remittance clearance between accounts relating to the electronically recorded claims, to the bulk factoring server 12, to conduct the remittance clearance between accounts for the extracted electronically recorded claims, the clearance processing part 23 of the bulk factoring server 12 generates transfer data for remittance between accounts for the amount of claims from a clearance account of the debtor (payment company) to a clearance account of the creditor (SPC) on the payment due date, the generated transfer data are downloaded to the clearing bank system 5 (Step S708), and the clearing bank system 5 processes the downloaded transfer data by EB system 15 (or processes with a transfer slip, or the like) and executes remittance clearance between accounts by withdrawing the amount to be transferred from the account of the payment company and transferring it to the account of the SPC ([0064]-[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) "... Based on the above circumstances, in this re-examination of the Subcontract Act, the government asks parent companies to make payment to a subcontracting company not by draft but by cash, in principle.　The government asks the ordering parent companies to pay a discount burden fee for cashing even when a draft is used without burdening the subcontracting company. ..."

No. 5 Judgment by the body

"Reason 1 (Patent eligibility)" and "Reason 2 (Inventive step)" which are the reasons for refusal notified by the body are examined below.

1. Regarding "Reason 1 (Patent eligibility)"

<u>(1) Regarding the viewpoint of "creation of a technical idea utilizing the laws of nature"</u>

Article 2(1) of the Patent Act stipulates that "'Invention' in this Act means the highly advanced creation of a technical idea utilizing the laws of nature".   The main paragraph of Article 29(1) of the Patent Act stipulates that " A person that invents an invention with industrial applicability may obtain a patent for that invention, unless the invention is as follows".

Accordingly, when an invention relating to a patent application is not "creation of a technical idea utilizing the laws of nature", 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.

We will examine whether the Invention is "creation of a technical idea utilizing the laws of nature" below.

(1-1) The constituent component of the Invention, "transmitting a first transfer signal for transferring an amount corresponding to the amount of the electronically recorded claim to a creditor's account", is to <u>specify the</u> following <u>business procedure on a financial transaction</u>: <u>transmitting a first transfer signal for "transferring" "a predetermined amount</u>", which is "an amount corresponding to the amount of the electronically recorded claim", <u>"to an account" of "a predetermined person"</u>, which is a "creditor".

The matter "transmitting a first transfer signal" means transferring an instruction to request processing of a computer to "transfer an amount corresponding to the amount of the electronically recorded claim to a creditor's account".   According to the description in [0046] of the specification, "... Specifically, a transfer/withdrawal instruction part 122f transmits a transfer signal to an account management server ...", the above transmission is transfer of information between computers, such as a claims management server and an account management server.   Therefore, the matter that the above instruction is transmitted as a signal over a network or a communication line is an inevitable technical matter.

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

Accordingly, based on the problem to be solved by the Invention, "to provide a method for settlement of electronically recorded claims which conforms to operation standard of the revised Subcontract Act and allows a debtor to pay a discount fee

without increasing workload or management cost of the debtor and a creditor", the essence of the constituent component, "transmitting a first transfer signal for transferring an amount corresponding to the amount of the electronically recorded claim to a creditor's account", is directed to a business rule per se based on an artificial agreement; i.e., a business procedure on a financial transaction.   Even if the inevitable technical matters in using a computer, "first transfer signal" and "transmitting", are included, the laws of nature are not utilized in the constituent component as a whole.

(1-2) As with (1-1), the constituent component, "transmitting a first withdrawal signal for withdrawing a discount fee equivalent to the discount fee of the electronically recorded claims from the account of a debtor of the electronically recorded claims", is to specify the following business procedure on a financial transaction: transmitting a first withdrawal signal for "withdrawing" "a predetermined amount", which is "a discount fee equivalent to the discount fee of the electronically recorded claims", "from an account" of "a predetermined person", which is a "a debtor of the electronically recorded claims".   The essence 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 the account of a debtor of the electronically recorded claims", is directed to a business rule per se based on an artificial agreement; i.e., a business procedure on a financial transaction.   Even if the inevitable technical matters in using a computer, "first withdrawal signal" and "transmitting", are included, the laws of nature are not utilized in the constituent component as a whole.

(1-3) As with (1-1), the constituent component, "transmitting a second withdrawal signal for withdrawing the amount of the electronically recorded claim from the debtor's account", is to specify the following business procedure on a financial transaction: "withdrawing" "a predetermined amount", which is "the amount of the electronically recorded claim", from "an account" of "a predetermined person", which is "a debtor". The essence of the constituent component, "transmitting a second withdrawal signal for withdrawing the amount of the electronically recorded claim from the debtor's account", is directed to a business rule per se based on an artificial agreement; i.e., a business procedure on a financial transaction.   Even if the inevitable technical matters in using a computer, "second withdrawal signal" and "transmitting", are included, the laws of nature are not utilized in the constituent component as a whole.

(1-4) As mentioned in (1-1) to (1-3), the essence of the constituent components

constituting the Invention is directed to a business rule per se based on an artificial agreement; i.e., a business procedure on a financial transaction. Thus, it is recognized that the principle of the Invention is also directed to a business rule per se based on an artificial agreement; i.e., a business procedure on a financial transaction.

Even considering the Invention as a whole, there is no circumstance where the essence of the constituent components constituting the Invention is not directed to a business rule per se based on an artificial agreement; i.e., a business procedure on a financial transaction.

Accordingly, even if the inevitable technical matters in using a computer, "first transfer signal", "first withdrawal signal", "second withdrawal signal", and "transmitting", are included, the Invention is, as a whole, only to specify a business procedure per se on a financial transaction, which is a business rule based on an artificial agreement, 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 of "computer software related invention"

Considering the fact that the inevitable technical matters in using a computer, "first transfer signal", "first withdrawal signal", "second withdrawal signal", and "transmitting", are specified, the Invention is considered a "computer software related invention". The Invention is examined from this viewpoint below.

The basic concept for identifying a software related invention as "creation of a technical idea utilizing the laws of nature" is as follows.

When for software of software-related invention, "information processing by the software is concretely realized by using hardware resources", said software is "a creation of a technical idea utilizing the laws of nature".
"Information processing by the software is concretely realized by using hardware resources" means that a specific information processor or an operation method thereof depending on intended use is constructed through cooperation of the software and the hardware resources. (See "Examination Handbook for Patent and Utility Model in Japan" Annex B: Application examples of the specific technical fields"2. 1. 1. 2 Idea based on the standpoint of software".)

(2-1) The following constituent components constituting the Invention, "transmitting a

first transfer signal for transferring an amount corresponding to the amount of the electronically recorded claim 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 the account of a debtor of the electronically recorded claims" (1-2), and "transmitting a second withdrawal signal for withdrawing the amount of the electronically recorded claim from the debtor's account" (1-3), are to transmit an instruction to request a computer for processing, and do not indicate that the claims management server, which is a computer, executes special information processing for generating the instruction. Thus, the above constituent components are inevitable technical matters in transferring information between computers; i.e., the claims management server and the account management server, and there is no technical feature exceeding it.

(2-2) Accordingly, it cannot be said that the Invention describes the matter, "a specific information processor or an operation method thereof depending on intended use is constructed through cooperation of the software and the hardware resources". Thus, the Invention which is a "computer software related invention" is not "a creation of a technical idea utilizing the laws of nature" even from that viewpoint.

Thus, the Invention, which is not "a creation of a technical idea utilizing the laws of nature" stipulated in Article 2(1) of the Patent Act, does not satisfy the requirements stipulated in the main paragraph of Article 29(1) of the Patent Act. Therefore, 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 "supplier 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 supplier companies (advance payment amount)" in the Cited Invention, which is "calculated on the basis of the amount of claims corresponding to the electronically recorded claims and a discount rate specified in master data stored in a master data storage part 24 (e.g., advance payment amount=the amount of claims - the discount amount), corresponds to the "amount corresponding to

the amount of the electronically recorded claim" in the Invention.

(1-3) In the Cited Invention, "... the clearance processing part 23 of the bulk factoring server 12 ... generates <u>transfer data with the SPC as a transfer requester</u>, the supplier company as a recipient, and <u>the advance payment amount calculated as the amount to be transferred</u>, when the SPC terminal 3 issues an instruction to download general transfer data, <u>the general transfer data is transmitted from the bulk factoring server 12 to the SPC terminal 3</u>, the SPC terminal 3 having downloaded the general transfer data transmits the downloaded general transfer data to a clearing bank system (e.g., EB system 15), and requests general transfer, the clearing bank system 5 executes transfer to the supplier company via a core banking system 16, and the advance payment amount is transferred to an account of the supplier company".   The "transfer data with the advance payment amount calculated as the amount to be transferred" generated by the clearance processing part 23 of the bulk factoring server 12 corresponds to the "first transfer signal for transfer to a creditor's account" in the Invention.

The general transfer data <u>transmitted from the bulk factoring server 12</u> to the SPC terminal 3 obviously includes the "transfer data with the advance payment amount calculated as the amount to be transferred" generated by the clearance processing part 23 of the bulk factoring server 12.   Thus, the matter in the Cited Invention, "(the general transfer data are) transmitted (from the bulk factoring server 12 to the SPC terminal 3)", corresponds to the matter in the Invention, "transmitting (a first transfer signal for transfer to a creditor's account)".

Accordingly, as a result of the comparison in (1-1) and (1-2), it can be said that the Cited Invention includes the constituent component of the Invention, "transmitting a first transfer signal for transferring an amount corresponding to the amount of the electronically recorded claim to a creditor's account".

(1-4) In the Cited Invention, "<u>the clearance processing part 23 of the bulk factoring server 12 generates transfer data for remittance between accounts for the amount of claims from a clearance account of the debtor (payment company) to a clearance account of the creditor (SPC) on the payment due date, the generated transfer data are downloaded to the clearing bank system 5</u> (Step S708), and the clearing bank system 5 processes the downloaded transfer data by EB system 15 (or processes with a transfer slip, or the like) and executes remittance clearance between accounts by withdrawing the amount to be transferred from the account of the payment company and transferring it to the account of the SPC".   The "transfer data for remittance between accounts for

the amount of claims from a clearance account of the debtor (payment company) to a clearance account of the creditor (SPC) on the payment due date" generated by the clearance processing part 23 of the bulk factoring server 12 correspond to the "second withdrawal signal for withdrawing the amount of the electronically recorded claim from the debtor's account" in the Invention.

The generated "transfer data", which are downloaded to the clearing bank system 5 over a network, are "transmitted" obviously from the bulk factoring server to the clearing bank system 5.

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

(1-5) The "method for processing electronically recorded claims" in the Cited Invention corresponds to the "method for settlement of electronically recorded claims" in the Invention, obviously.

(2) Corresponding Feature and Different Feature

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

"A method for settlement of electronically recorded claims comprising:

transmitting a first transfer signal for transferring an amount corresponding to the amount of the electronically recorded claim to a creditor's account; and

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

The Invention and the Cited Invention have the following different feature.

[Different Feature 1]

The Invention specifies the constituent component, "transmitting a first withdrawal signal for withdrawing a discount fee equivalent to the discount fee of the electronically recorded claims from the account of a debtor of the electronically recorded claims". However, the Cited Invention does not include the above constituent component.

(3) Judgment

The above [Different Feature 1] is examined below.

As described in Cited Document 2, the concept on financial transactions (business rule), "The government asks the ordering parent companies to pay a discount burden fee for cashing even when a draft is used without burdening the subcontracting company", had been well-known before October 17, 2017, which is the earliest priority date of the present application.

It is extremely common that business rules are modified or computer programs are modified or upgraded in response to revision of a law or revision of operation standard. Accordingly, it is recognized that a person skilled in the art could have easily added the constituent component, "transmitting a first withdrawal signal for withdrawing a discount fee equivalent to the discount fee of the electronically recorded claims from the account of a debtor of the electronically recorded claims", to the Cited Invention in order to implement the business rule disclosed in 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 or system for settlement of electronically recorded claims which conforms to operation standards of the revised Subcontract Act and allows a debtor to pay a discount fee without increasing workload or management cost of the debtor and a creditor (see [0005] and [0006]). However, the problem to be solved by the invention described in Cited Document 1 (Cited Invention 1) is to provide a system which can execute discount of electronically recorded claims even in a bank which does not have a bulk factoring system associated with an electronic recording institution system (see [0007] and [0009]). There is no commonality between them. Therefore, Cited Document 1 lacks eligibility as a prior technical document."

However, as described in Cited Document 2 and paragraphs [0005] and [0006] of the specification of the present application, the problem in commercial transactions to ask a creditor to pay a discount fee in cashing claims had been well-known before the filing of the application.

The Cited Invention described in Cited Document 1, which takes into consideration a settlement method relating to electronically recorded claims which are generated due to transactions ([0005]) between a large payment company and a lot of supplier companies, belongs to the same technical field as the Invention.

The Cited Invention may modify business rules or computer programs so as to comply with revised operation standard; i.e., to burden a debtor with payment of a discount fee.

In light of the above circumstance, the Appellant's allegation that Cited Document 1 lacks eligibility as a prior technical 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 under the provisions of Article 29(2) of the Patent Act.

The present application should be rejected without examining inventions according to 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