

## Appeal Decision

Appeal No. 2019-14077

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The case of appeal against the examiner's decision of refusal of Japanese Patent Application 2016-67886, entitled "Information Processing Device, Method, and Program" (Japanese Unexamined Patent Application Publication No. 2016-201106 published on December 1, 2016) has resulted in the following appeal decision.

### Conclusion

The appeal of the case was groundless.

### Reason

#### No. 1 History

##### 1. Procedures

The present application is a divisional patent application filed on March 30, 2016, as a part obtained by dividing Japanese Patent Application No. 2015-80124 filed on April 9, 2015, and the summary of the procedures is as follows:

Written Amendment	April 9, 2018
Notice of Reasons for Refusal	February 5, 2019 (Drafting date)
Written Amendment	April 15, 2019
Decision for Refusal	July 10, 2019 (Drafting date)
Request for Appeal against Decision for Refusal	October 23, 2019
Written Amendment	October 23, 2019

##### 2. Examination

The reasons for examination during the original trial are summarized as follows:

Reason 1 (Novelty) : Because the inventions according to Claims 1, 5 to 7, 12, and 13 of the present application (according to the Written Amendment submitted on April 15, 2019) are inventions described in the Cited Documents that had been distributed, or become available to the public through electric communication lines, in Japan or a foreign country prior to the filing of the application, the patent should not be granted under the provisions of Article 29-1(3) of the Patent Act.

Reason 2 (Inventive Step) : Because the inventions according to Claims 1 to 13 of the present application (according to the Amendment of Procedures submitted on April 15, 2019) would have been easily made by a person who had ordinary skill in the art belonging to the inventions, based on the invention described in the following Cited Documents and the well-known art, the patent should not be granted under the provisions of Article 29(2) of the Patent Act.

Note

Cited Example 1: JP-A-2007-11876

Cited Example 2: JP-A-2001-306852

## No. 2 Decision to Dismiss the Amendment

Decision regarding the Written Amendment submitted on October 23, 2019 (hereinafter referred to as "The Amendment") is as follows.

### Conclusion

The Amendment submitted on July 8, 2016 is dismissed.

### Reasons

#### 1. Detail of the Amendment

The Amendment submitted on October 23, 2019 includes the following amended matters for amending the statement of Claim 1 before the Amendment into the statement of Claim 1 after the Amendment.

(Before the Amendment)

[Claim 1]

An information processing device to be operated by a first user, comprising:

a bulletin notification unit configured to notify a server of information on a bulletin related to an intellectual property right desired by the first user to be utilized, as first

information that includes information based on which second information and third information is extracted by the server; and

a receiving unit configured to receive seventh information when in the server,

a predetermined character, figure, symbol, or a combination thereof is extracted as the second information from among contents of a first document that is included in the bulleting specified by the first information that is notified by the bulleting notification unit,

a character, figure, symbol, or a combination thereof related to the extracted second information is extracted as the third information from among contents of a second document that is included in the bulleting,

a person who registers fourth information related to the extracted third information is determined as a notification object person from among a plurality of second users each of whom registers a predetermined character, figure, symbol, or a combination thereof as the fourth information in advance,

information related to the intellectual property right is notified as fifth information to a terminal of the notification object person,

sixth information indicating that the notification object person has an interest in the intellectual property right related to the fifth information is acquired from the terminal of the notification object person,

information at least indicating that a person having an interest in the intellectual property right exists among the plurality of second users is generated as seventh information based on the sixth information, and

the seventh information that is generated as a result of the notification of the first information issued by the information processing device is transmitted to the information processing device.

(After the Amendment: the amended portions are underlined)

[Claim 1]

An information processing device to be operated by a first user, comprising:

a bulleting notification unit configured to notify, after an intellectual property right that is not used in business but is desired by the first user to be utilized is specified from among one or more intellectual property rights held by the first user, a server of information on a bulleting related to the intellectual property right as first information that includes information based on which second information and third information is extracted by the server; and

a receiving unit configured to receive seventh information when in the server

a predetermined character, figure, symbol, or a combination thereof is extracted as the second information from among contents of a first document that is included in the bulleting specified by the first information that is notified by the bulleting notification unit,

a character, figure, symbol, or a combination thereof related to the extracted second information is extracted as the third information from among contents of a second document that is included in the bulleting,

a person who registers fourth information related to the extracted third information is determined as a notification object person from among a plurality of second users each of whom registers a predetermined character, figure, symbol, or a combination thereof as the fourth information in advance,

information related to the intellectual property right is notified as fifth information to a terminal of the notification object person,

sixth information indicating that the notification object person has an interest in the intellectual property right related to the fifth information is acquired from the terminal of the notification object person,

information at least indicating that a person having an interest in the intellectual property right exists among the plurality of second users is generated as seventh information based on the sixth information, and

the seventh information that is generated as a result of the notification of the first information issued by the information processing device is transmitted to the information processing device.

## 2. Acceptability of the Amendment

### (2-1) Scope of the Amendment, Unity of Inventions

The Amendment is based on the specification originally attached to the application, and is an amendment made within the scope of the matters described in the specification or drawings originally attached to the application.

Further, as to be discussed in (2-2) below, it is clear that the invention specified by the matters described in the scope of claims after the Amendment satisfy unity with the inventions before the Amendment.

### (2-2) Purpose of the Amendment

a) The amended matter amends a configuration of "information on a bulleting related to

an intellectual property right desired by the first user to be utilized" of Claim 1 before the Amendment into description "after an intellectual property right that is not used in business but is desired by the first user to be utilized is specified from among one or more intellectual property rights held by the first user, ...information on a bulleting related to the intellectual property right" by the Amendment, so as to make the configuration of "information on a bulleting related to an intellectual property right desired by the first user to be utilized" to include specific matters of "after an intellectual property right that... but is desired by the first user to be utilized is specified from among one or more intellectual property rights held by the first user, ...information on a bulleting related to the intellectual property right".

Based on the amendment, it can be said that, concerning the configuration of "an intellectual property right desired by the first user to be utilized" before the amendment, a limitation of "that is not used in business" is added in the amendment i), and concerning the configuration of "information on a bulleting related to an intellectual property right desired by the first user to be utilized", a limitation of "information on a bulleting related to the intellectual property right" "after an intellectual property right that is not used in business but is desired by the first user to be utilized" "is specified from among one or more intellectual property rights held by the first user" is added in the amendment ii).

Therefore, the Amendment limits the matters necessary to specify the invention according to Claim 1 before the amendment, and the industrial field of the invention and the problems to be solved are same between before and after the Amendment, so that it is recognized that the Amendment includes amendments that fall under restriction of the scope of claims as stipulated in Article 126(7) of the Patent Act, which is applied mutatis mutandis in the provisions of Article 17-2(6) of the Patent Act.

### (2-3) Independent Requirements of Patentability

Therefore, we will examine below whether the invention according to Claim 1 after the Amendment satisfies the independent requirements of patentability.

#### (a) Invention Described in Claim 1 after the Amendment

The invention described in Claim 1 after the Amendment is tentatively as follows.

((A) to (J) were given in the trial of this case. Hereinafter "constituent component (A)", etc. will be cited.)

[Claim 1]

(E) An information processing device (A) to be operated by a first user, comprising:

(B) a bulleting notification unit configured to notify, after an intellectual property right

that is not used in business but is desired by the first user to be utilized is specified from among one or more intellectual property rights held by the first user, a server of information on a bulleting related to the intellectual property right as first information that includes information based on which second information and third information is extracted by the server; and

(D) a receiving unit configured to receive seventh information when

(C) in the server,

(C1) a predetermined character, figure, symbol, or a combination thereof is extracted as the second information from among contents of a first document that is included in the bulleting specified by the first information that is notified by the bulleting notification unit,

(C2) a character, figure, symbol, or a combination thereof related to the extracted second information is extracted as the third information from among contents of a second document that is included in the bulleting,

(C3) a person who registers fourth information related to the extracted third information is determined as a notification object person from among a plurality of second users each of whom registers a predetermined character, figure, symbol, or a combination thereof as the fourth information in advance,

(C4) information related to the intellectual property right is notified as fifth information to a terminal of the notification object person,

(C5) sixth information indicating that the notification object person has an interest in the intellectual property right related to the fifth information is acquired from the terminal of the notification object person,

(C6) information at least indicating that a person having an interest in the intellectual property right exists among the plurality of second users is generated as seventh information based on the sixth information, and

(C7) the seventh information that is generated as a result of the notification of the first information issued by the information processing device is transmitted to the information processing device.

(b) Concerning Invention after the Amendment

(b-1) Concerning Constituent Components that Specify Information Processing Device

The invention described in Claim 1 after the Amendment is an invention related to "an information processing device (to be operated by a first user)" according to the description of the constituent components (A) and (E).

In view of the description of the above claim, the matters specifying the information

processing device are the constituent components (A), (B), (D), and (E), and the constituent components (C), and (C1) to (C7) are constituent components that specify a server that is notified of the information on a bulleting (as the first information) by the information processing device, and that transmits the seventh information received by the information processing device, and are not constituent components that directly specify the information processing device.

In view of above discussion, it can be said that the constituent components (A), (B), (D), and (E) are constituent components that specify the invention after the Amendment.

(b-2) Concerning Constituent Component (B)

Next, we will examine the constituent component (B).

The description "a bulleting notification unit configured to notify, after an intellectual property right that is not used in business but is desired by the first user to be utilized is specified from among one or more intellectual property rights held by the first user, a server of information on a bulleting related to the intellectual property right as first information that includes information based on which second information and third information is extracted by the server" in the constituent component (B) can be said to be a configuration that directly specifies the bulleting notification unit included in the information processing device.

On the other hand, the description "(notify, ...the server of) (information on a bulleting) as first information that includes information based on which second information and third information is extracted by the server" can be recognized as description that further limits the information on the bulleting to be notified to the server, but the description is based on the premise that extraction processing is performed by the server, and is not a specific matter that directly limits the information processing device. In view of the description of the claims, concerning the extraction processing of the second information and the third information,

"(C1) a predetermined character, figure, symbol, or a combination thereof is extracted as the second information from among contents of a first document that is included in the bulleting specified by the first information that is notified by the bulleting notification unit,

(C2) a character, figure, symbol, or a combination thereof related to the extracted second information is extracted as the third information from among contents of a second document that is included in the bulleting," are specified.

The detailed description of the invention corresponding to the above specific matters can be recognized to be:

"[0021]

A patentee notifies in advance the server 1 of information (for example, patent number) of a patent right that is desired to be utilized. That is, contents of a bulleting (patent publication bulleting or application publication bulleting) of the patent right are stored as data in the bulleting information DB 61.

Here, the patent right that is desired to be utilized is assumed to be a patent right that is not used in the business of an entrepreneur, or a patent right that have not been granted an exclusive license or a non-exclusive license.

[0022]

In other words, the bulleting information DB 61 stores contents of various patent bulletings notified by the patentee terminals 2-1 to 2-n as data. Here, the data of the contents of the bulleting does not necessarily have to be data of transcript of the bulleting, and as the name suggests, it is sufficient if the contents of the bulleting can be specified, and any form of data is acceptable.

[0023]

The claim word extraction unit 51 extracts, as a claim word, a predetermined word from contents of the claims (contents of the claims) included in a bulleting related to a predetermined patent right that is desired by a predetermined patentee to be utilized (hereinafter referred to as "patent right desired to be utilized").

Here, the extraction method and the number of claim words are not limited and can be freely set. However, the claims are what determines the technical scope of the patent right (at a filing stage, determines the invention for which a patent is sought), and are the contents of the rights deed. Therefore, at least at the time of acquisition of the rights, contents that the patentee is particularly focusing on in advancing the business are often described in the claims. Thus, words that appear in large numbers are more likely to be important to the patentee and to represent the point of the invention (one of the special technical features).

Therefore, in the present embodiment, the claim word extraction unit 51 creates a frequency distribution of words appearing in the claims, and extracts a word with the highest frequency (the number of appearances) as the claim word.

[0024]

The specification word extraction unit 52 extracts, as a related specification word, a word that is relevant to the extracted claim word from contents of the specification included in the bulleting related to the patent right desired to be utilized.

Here, a method of extracting a word relevant to the claim word is not particularly limited. For example, a method of extraction by referring to a known synonym dictionary or the



like may be adopted, or a method of extraction using a predetermined algorithm based on machine learning or the like may be adopted", and it is recognized that the constituent component (C1) corresponds to the configuration for extraction as the claim word described in Paragraph [0023], and the constituent component (C2) corresponds to the configuration for extraction as the related specification word described in Paragraph [0024].

Here, the information on the bulleting used for these extraction processes is described as "contents of a bulleting (patent publication bulleting or application publication bulleting) of the patent right are stored as data in the bulleting information DB 61" in Paragraph [0021]. However, "Here, the data of the contents of the bulleting does not necessarily have to be data of transcript of the bulleting, and as the name suggests, it is sufficient if the contents of the bulleting can be specified, and any form of data is acceptable." is described according to paragraph [0022], so that contents of a patent bulleting that is normally published are sufficient, and it is clear that the information on the bulleting related to the intellectual property right notified to the server as the first information does not contain any contents more special than information representing the contents of the bulleting of a patent right that is normally published (that is, the information on a bulleting related to the intellectual property right).

From the above discussion, it is recognized that the matters specified in the constituent component (B) are (B') a bulleting notification unit configured to notify, after an intellectual property right that is not used in business but is desired by the first user to be utilized is specified from among one or more intellectual property rights held by the first user, a server of information on a bulleting related to the intellectual property right.

(b-3) Concerning constituent component (D)

Concerning the "seventh information," in view of the description of the constituent components (C6) and (C7), the constituent component is specified as

"(C6) information at least indicating that a person having an interest in the intellectual property right exists among the plurality of second users is generated as seventh information based on the sixth information, and

(C7) the seventh information that is generated as a result of the notification of the first information issued by the information processing device is transmitted to the information processing device".

That is, it can be said that the seventh information is "information at least indicating that a person having an interest in the intellectual property right exists" and is information "generated as a result of the notification of the first information (to the server) issued by the information processing device", and "transmitted (from the server) to the

information processing device, and the "first information" is "information on a bulleting related to the intellectual property right" as discussed in the above (a-2), so that the seventh information is "information at least indicating that a person having an interest in the intellectual property right exists, generated as a result of notifying the server of the information on a bulleting related to the intellectual property right by the information processing device, and transmitted to the information processing device from the server". The detailed description of the invention corresponding to the above specific matters is be recognized to be:

"[0029]

The response receiving unit 55 receives a predetermined response from a terminal of the notification object person (business operator terminal 3) and issues a notification to the notification unit 54. The notification unit 54 notifies the patentee terminal 2 of the response."

"[0040]

Similarly, in Step S21-3, the business operator terminal 3-3 receives the patent publication bulleting.

In Step S22-3, the business operator terminal 3-3 transmits an interested response.

In Step S16, the response receiving unit 55 of the server 1 receives and accepts the interested response.

In Step S17, the notification unit 54 transmits, to the patentee terminal 2, a list of information on two or more business operators each of whom has responded to interested response (in this example, business operators respectively operating the business operator terminals 3-2 and 3-3) in which information for specifying the two or more operators is excluded (for example, anonymously) (hereinafter referred to as "anonymous business operator list").

[0041]

The patentee to whom the list of anonymous business operators is presented via the patentee terminal 2 selects a business operator with whom the patentee wishes to negotiate a license, etc. (hereinafter referred to as "negotiator for license, etc.").

In Step S3, the patentee terminal 2 notifies the server 1 of an instruction to instruct the negotiator for license, etc. to disclose (e.g., de-anonymize) information for specifying the negotiator for license, etc.

In Step S18, the response receiving unit 55 of the server 1 receives the instructions as a response from the patentee.

In Step S19, the notification unit 54 notifies the terminal of the negotiator for license, etc. (in this example, the business operator terminal 3-2) of a disclosure request

(response from the patentee terminal 2).

When the business operator selected as the negotiator for license, etc., agrees to negotiate with the patentee, in Step S25-2, the business operator terminal 3-2 of the business operator discloses the information for specifying the business operator to the patentee terminal 2.

In Step S4, the patentee terminal 2 accepts the information disclosure."

That is, the seventh information is information that is notified to the patentee terminal by the notification unit of the server, and includes at least a list of business operators (anonymous business operator list) each of whom shows an interest response to the patent publication bulleting registered by the patentee on the server. This is not particularly different from the seventh information specified based on the description of the scope of claims.

In view of the above description of the scope of claims and the detailed description of the invention, it can be recognized that the seventh information is "information at least indicating that a person having an interest in the intellectual property right exists, generated as a result of notifying the server of the information on a bulleting related to the intellectual property right by the information processing device, and transmitted to the information processing device from the server", and the constituent component (D) can be recognized as "a receiving unit configured to receive information at least indicating that a person having an interest in the intellectual property right exists, generated as a result of notifying the server of the information on a bulleting related to the intellectual property right by the information processing device, and transmitted to the information processing device from the server" (constituent component (D')).

(b-4) Invention after the Amendment

In the view of the above discussion, the invention according to Claim 1 after the Amendment (hereinafter referred to as the "Invention after the amendment") can be recognized as the following invention.

- (A) An information processing device (A) to be operated by a first user, comprising:
- (B') a bulleting notification unit configured to notify, after an intellectual property right that is not used in business but is desired by the first user to be utilized is specified from among one or more intellectual property rights held by the first user, a server of information on a bulleting related to the intellectual property right; and
- (D') a receiving unit configured to receive information at least indicating that a person having an interest in the intellectual property right exists, generated as a result of notifying

the server of the information on a bulleting related to the intellectual property right by the information processing device, and transmitted to the information processing device from the server.

(c) Described Matters in Cited

JP-A-2007-11876 (hereinafter referred to as the Cited Document 1) which is a publication cited in the reasons for refusal in the examiner's decision, describes the following matters with the drawings.

[0005]

However, the patent search system described in Patent Document 1 has the following problems.

In a search system in the related art, a user searches a huge amount of document data in a database by inputting a keyword, but in order to grasp in which specific field the intellectual property right described in each document is used and what kind of business the intellectual property right can be applied, the user has to examine contents of each document one by one, which requires a great deal of efforts and time.

Thus, it is difficult for a business owner, for example, to specify an intellectual property right related to his/her business, and as a result, the business owner may get in trouble in the procedures necessary for conducting the business, such as purchase and licensing (permission of use) of the intellectual property rights, and proposals for business partnerships, which may lead to unnecessary rights infringement.

On the other hand, even though having registered the intellectual property rights, plenty of intellectual property rights holders wish to transfer their intellectual property rights for a fee or enter into a license agreement because of difficulties in implementation and utilizing them caused by lack of facilities or funds. However, as mentioned above, it is difficult for those who wish to use the intellectual property rights to grasp the contents of the intellectual property rights, and there are few opportunities for the rights holders to actively promote a value of the intellectual property rights, so that effective utilization of intellectual property rights is difficult.

[0016]

<First Embodiment>.

(Summary of First Embodiment)

First, a summary of the first embodiment of the invention will be briefly described. In an intellectual property information provision system according to the present

embodiment, a rights holder of an intellectual property right (hereinafter simply referred to as the "rights holder") registers information indicating that he/she wish to transfer or license(permit use) of the intellectual property right held by himself/herself (hereinafter referred to as "transfer and license information") in a system database. The transfer and license information includes document information that promotes values of the intellectual property rights.

Subsequently, a person who wishes to receive a transfer or license (permission of use) of an intellectual property right from a third party (hereinafter referred to as a "prospective user") refers to the transfer and license information (PR document) in the database and selects an intellectual property right that he/she wishes to receive a transfer or license (permission of use).

When receiving a request for use of the intellectual property right, the intellectual property information provision system notifies the rights holder of the intellectual property right of the request to use the intellectual property right and acts as an intermediary for the transfer or license (permission of use) of the intellectual property right.

In this way, since the information that actively promotes the utility value of the intellectual property right is presented to the user of the intellectual property right, effective mediation of the transfer or license (permission of use) of the intellectual property right and effective utilization of the intellectual property right can be realized.

Hereinafter, a configuration of the intellectual property information provision system according to the present embodiment will be described, and then operations thereof will be described.

[0017]

(Configuration of First Embodiment)

(1) Overall Configuration

FIG. 1 shows a configuration of the intellectual property information provision system according to an embodiment of the present invention. An overall configuration of the intellectual property information provision system will be described with reference to the drawing, and then a server and configurations of terminals within the system will be described.

The intellectual property information provision system includes an intellectual property information provision server 10 that receives requests for transferring or licensing (permission of use) of intellectual property rights of patents or the like; a database 20 that manages information on the transfer or licensing (permission of use), etc. of these intellectual property rights; a transfer and license information registration terminal 30 for

registering transfer or licensing (permission of use) of the intellectual property rights in the database 20; and a transfer and license information utilization terminal 40 that accesses the database 20 and applies for the transfer or licensing (permission of use) of the intellectual property rights. The server and the terminals are connected to each other via a network 1 such as the Internet.

Each of these components of the intellectual property information provision system will be described individually below.

[0018]

The intellectual property information provision server 10 is an information processing device such as a workstation that is managed by a management side of the system together with the database 20, and receives an offer for transferring or licensing (permission of use) of the intellectual property rights from the transfer and license information registration terminal 30 on a rights holder side and registers the offer in the database 20.

Further, the intellectual property information provision server 10 extracts the transfer and license information in the database 20 in response to a request from the transfer and license information utilization terminal 40, and transmits the extracted transfer and license information to the transfer and license information utilization terminal 40.

[0019]

The transfer and license information registration terminal 30 is a communication-enabled information processing device such as a PC or a mobile terminal to be operated by the rights holder, and transmits the transfer and license information to the intellectual property information provision server 10, and registers the transfer and license information in the database 20.

The transfer and license information includes, for example, various types of information such as contents of the intellectual property right, PR information, and conditions under which the transfer or licensing (permission of use) of the intellectual property right is performed.

[0020]

The transfer and license information utilization terminal 40 is a communication-enabled information processing device such as a PC or a mobile terminal operated by the prospective user. The transfer and license information utilization terminal 40 displays the transfer and license information by accessing the transfer and license information registered in the database 20, and transmits, to the intellectual property information provision server 10, information indicating request for a transfer or license (permission

of use) of the intellectual property right indicated in the transfer and license information.  
[0021]

The database 20 is a database managed by the management side of the system, and manages intellectual property rights and personal information of the rights holders and prospective users.

As shown in the figure, the database 20 includes a rights holder DB 21 that manages the personal information of the rights holders, a prospective user DB 22 that manages the personal information of the prospective users, a transfer and license information DB 23 that manages information on intellectual property rights of the rights holders, a prospective use condition DB 24 that manages conditions of use requested by the prospective user when receiving the transfer or license of the intellectual property right (hereinafter referred to as the prospective use conditions), an intellectual property document DB 25 that manages document information on the intellectual property rights, and a deadline management DB 26 that manages deadlines for procedures for the intellectual property rights and the like.

Each of the areas (databases) that constitute the database 20 will be individually described below.

[0024]

Further, the transfer and license information is managed in the transfer and license information DB 23.

The transfer and license information includes contents and numbers (application number, registration number, etc.) of a corresponding intellectual property right, PR information, and the like. The contents of the transfer and license information will be discussed in detail later.

[0025]

Further, the prospective use conditions are managed in the prospective use condition DB 24.

The prospective use conditions include various conditions (budget, period, etc.) requested by the prospective user when the intellectual property right is transferred or licensed (permitted for use) from the rights holder side. The details of the prospective use conditions will be described in detail below.

[0026]

The intellectual property document DB 25 manages information on intellectual property documents, such as patent bulletings and trademark bulletings.

[0032]

(Operations of First Embodiment)

The intellectual property information provision system according to the present embodiment is configured as described above, and operates as follows.

That is, first, in the intellectual property information provision system, the personal information of the rights holders and prospective users and the transfer and license information is registered in the database 20 (1. registration operation of the personal information and the transfer and license information). Then, when receiving a presentation of the prospective use conditions of an intellectual property right from the prospective user side, the intellectual property information provision system provides the transfer and license information to the prospective user side to promote the distribution and effective utilization of the intellectual property rights (2. provision operation of the transfer and license information).

Further, the intellectual property information provision system manages deadlines for intellectual property rights procedures in response to requests from rights holders, and the like (3. management operation of the intellectual property rights).

Furthermore, the intellectual property information provision system can accumulate document information on the intellectual property rights and provide the document information upon request (4. registration operation of document information on the intellectual property rights).

Each of these operations (1) to (4) performed by the intellectual property information provision system of the present embodiment will be described in detail below.

[0033]

(1) Registration Operation of Personal Information and Transfer and License Information

First, the rights holder of the intellectual property right and the prospective user inputs his/her own personal information using a keyboard or the like on the terminal 30 and the terminal 40 respectively, and each of the terminal 30 and the terminal 40 transmits the input personal information to the intellectual property information provision server 10.

When receiving the personal information, the intellectual property information provision server 10 assigns a unique ID to the rights holder or the prospective user who is the sender of the personal information, and registers the ID in the database 20 in association with the personal information.

At this time, the intellectual property information provision server 10 registers the personal information of the rights holder in the rights holder DB 21 and the personal information of the prospective user in the prospective user DB 22. Contents of the



personal information to be registered are as described above for each database.

In this way, when receiving the personal information from the rights holder side or the prospective user side, the intellectual property information provision server 10 assigns the ID and performs the registration operation of the personal information.

[0040]

When receiving the screen information for presenting the prospective use conditions, the transfer and license information utilization terminal 40 displays the screen information, and the prospective user uses the transfer and license information utilization terminal 40 to input the prospective use conditions by using the keyboard or the like at an input field on the screen (Step S102).

FIG. 4 shows an example of the screen information for presenting the prospective use conditions.

As shown in the figure, the prospective user can use the transfer and license information utilization terminal 40 to input, for example, the following prospective use conditions:

- Fields of intellectual property rights (bio-chemicals, software, ...)
- Types of intellectual property rights (patents, trademarks, copyrights, ...)
- Use methods of intellectual property rights (transfer, exclusive license/permission of use, normal license/permission of use, ...)
- Budget to be paid for the transfer or license (permission of use)
- Final date for accepting offer for transfer from rights holder side (deadline for acceptance).

[0041]

The transfer and license information utilization terminal 40 transmits the input prospective use conditions to the intellectual property information provision server 10 (Step S103).

When receiving the prospective use conditions, the intellectual property information provision server 10 registers the received prospective use conditions in the prospective use condition DB 24 (Step S104).

[0042]

Then, the intellectual property information provision server 10 refers to the transfer and license information DB 23, and searches for transfer and license information that matches the registered prospective use conditions (Step S105).

Here, for example, when conditions such as fields of intellectual property rights: software; types: patent; use methods: transfer; scope of use: all over Japan, ....., and the like, are shown for the prospective use conditions, the intellectual property information

provision server 10 extracts transfer and license information of the intellectual property rights showing similar conditions from the transfer and license information DB 23.

[0043]

When extracting the transfer and license information that matches those conditions, the intellectual property information provision server 10 creates screen information that shows a list of the extracted transfer and license information, and transmits the created screen information of the list to the transfer and license information utilization terminal 40 (Step S106).

When receiving the screen information that shows the list of transfer and license information, the transfer and license information utilization terminal 40 displays the screen information (Step S107). When one piece of transfer and license information is selected on the screen of list by the prospective user, the transfer and license information utilization terminal 40 transmits the selected information to the system server 10 (Step S108).

[0044]

When receiving the selected information, the intellectual property information provision server 10 extracts the transfer and license information selected in the selected information from the transfer and license information DB 23 (Step S109), creates screen information showing details of the extracted transfer and license information, and transmits the screen information to the transfer and license information utilization terminal 40 (Step S110).

When receiving the screen information showing the details of the transfer and license information, the transfer and license information utilization terminal 40 displays the screen information (Step S111).

FIG. 5 shows an example of the screen information showing the details of the transfer and license information selected by the prospective user.

As shown in the figure, on the screen information showing the details of the transfer and license information, types of intellectual property rights: patent; fields: software; possible use methods: transfer; and the like are shown as well as PR information of the intellectual property right and reference estimates for the use. In this way, the rights holder makes the usefulness of the intellectual property right appeal by showing the prospective user a specific use method of his/her intellectual property right and an expected profit from the use.

Further, on the screen of the transfer and license information, an input field for questions and requests with respect to the rights holder of the intellectual property right is provided, and the prospective user can input questions and requests, if necessary, by

using the transfer and license information utilization terminal 40.

When the prospective user requests transfer or licensing (permission of use) of the intellectual property right shown on the screen, the prospective user performs a key operation, and the like on the transfer and license information utilization terminal 40 to input the request. With the operation, the transfer and license information utilization terminal 40 transmits information showing that the prospective user requests transfer or licensing (permission of use) of the intellectual property right on the screen (hereinafter referred to as "prospective use information") to the intellectual property information provision server 10 (Step S112).

In addition, the prospective use information includes the ID of the prospective user, numbers of the intellectual property right, and the input contents of the questions and requests.

[0045]

When receiving the prospective use information, the intellectual property information provision server 10 extracts the personal information of the prospective user who requests transfer or licensing (permission of use) of the intellectual property right from the prospective user DB 22 (Step S113), creates screen information that includes the extracted personal information of the prospective user and the prospective use information, and transmits the created screen information to the transfer and license information registration terminal 30 of the rights holder who holds the intellectual property right that is desired to be used this time (Step S114).

[0046]

When receiving the screen information from the intellectual property information provision server 10, the transfer and license information registration terminal 30 displays the received screen information (Step S115).

Then, the rights holder confirms the personal information of the prospective user or the prospective use information displayed on the screen, uses the transfer and license information registration terminal 30 to input answers to the use request, questions, and the like (Step S116), and transmits the answers to the transfer and license information utilization terminal 40 (Step S117). At this time, the rights holder may additionally register the PR information that makes the value of the intellectual property right appeal, by using the transfer and license information registration terminal 30.

The rights holder then contacts the prospective user and proceeds with procedures such as an agreement for the transfer or licensing (permission of use) of the intellectual property right.

[0049]

First, the rights holder registers basic information (numbers of the intellectual property right to be managed, etc.) necessary for receiving deadline management service of the intellectual property information provision system (Steps S201 to S206).

First, when the rights holder accesses the intellectual property information provision server 10 by using the transfer and license information registration terminal 30 (Step S201), the intellectual property information provision server 10 transmits screen information for registration of the basic information to the transfer and license information registration terminal 30 (Step S202).

[0050]

When receiving the screen information, the transfer and license information registration terminal 30 displays the received screen information (Step S203).

FIG. 7 shows an example of the registration screen of the basic information for management of intellectual property right.

The rights holder uses the transfer and license information registration terminal 30 to input the basic information at an input field on the screen for registration by using a keyboard or the like (Step S204).

For example, the following can be input:

- Numbers of the intellectual property right to be managed
- Notification destination when the deadline approaches (rights holder himself/herself, co-rights holder, ...)
- Period/deadline for notification (the period of request for the examination , the period during which priority may be claimed, ...).

[0051]

The transfer and license information registration terminal 30 transmits the input basic information (numbers of the intellectual property right, notification destination, deadline for notification, ...) to the intellectual property information provision server 10 (Step S205).

When receiving the basic information, the intellectual property information provision server 10 registers the basic information in the deadline management DB 26 (Step S206).

[0052]

Then, the intellectual property information provision server 10 calculates an actual due date by referring to a record date (filing date, etc.) registered in the transfer and license information DB 23 and a type of the period or deadline to be managed (examination claim deadline, etc.) registered in the deadline management DB 26 (Step S207).

For example, in principle, when it is assumed that the record date (filing date) is January 1, 2005, and the deadline to be managed is the examination claim deadline (1 year and 6 months from the filing date), the actual due date is calculated to be July 1, 2006.

[0053]

Here, it is assumed that information indicating a predetermined period is stored in advance in the intellectual property information provision server 10 for each type of deadline to be managed.

FIG. 8 shows an example of information indicating the predetermined period.

For example, as shown in the figure, it is determined that the predetermined period is three months for the deadline of request for the examination, is two months for the deadline within which priority may be claimed, ....

The intellectual property information provision server 10 determines, as an actual notification date, a date that is the predetermined period before the actual due date calculated above (Step S208).

For example, when it is assumed that the deadline to be managed is the examination claim deadline, since the predetermined period is three months, the day on April 1, 2006, three months before July 1, 2006, is determined as the notification date.

[0054]

The intellectual property information server 10 compares a current time and the determined notification date at regular intervals (Step S209), and when the notification date arrives (Step S209/Yes), the intellectual property information server 10 transmits notification information about the approaching deadline to the notification destination terminal (such as the transfer and license information registration terminal 30) registered in the deadline management DB 26 (Step S210).

Further, at this time, the intellectual property information provision server 10 may calculate fees that need to be paid by the rights holder in procedures before this deadline based on types of procedures, the number of claims, the number of categories, a time of filing or claiming, etc., and send the fees as notification information to the notification destination terminal.

FIG. 9 shows an example of notification information about the approaching a deadline.

As shown in the figure, the notification destination terminal receiving the notification information displays, on the screen, the notification information indicating that there are three months for the deadline of request for the examination and the notification information indicating the fees for the request for the examination, etc., and the person who is the notification destination can view the contents displayed on the

screen to check the deadlines of the intellectual property right related to himself/herself.

[0055]

Accordingly, when a deadline to be managed and a notification destination are designated by the rights holder, etc., the intellectual property information provision server 10 manages the deadline of the intellectual property right to be managed. When the deadline approaches, the intellectual property information provision server 10 automatically transmits notification information about the approaching deadline to the designated notification destination, so that the rights holder, etc. can check the deadline of the intellectual property right related to himself/herself by simply viewing the notification information on the screen of the terminal.

[0056]

The notification destination of the deadline may vary depending on each deadline to be managed, for example, the rights holder and the agent can be notified when notifying the period of request for the examination, and only the rights holder may be notified when notifying pension payment.

[0057]

#### (4) Registration Operation of Document Information on Intellectual Property Rights

In the intellectual property information provision system, by registering the document information on intellectual property rights such as patent bulletings in the intellectual property document DB 25, the user can access the intellectual property information provision server 10 by using the own terminal, so as to view the document information.

The document information on the intellectual property rights is registered in the intellectual property document DB 25 by the intellectual property information provision server 10.

This operation may be performed such that the rights holder of the intellectual property right transmits the document information on the intellectual property right he/she holds to the intellectual property information provision server 10 by using the transfer and license information registration terminal 30, and the intellectual property information provision server 10 registers the received document information.

Alternatively, the intellectual property information provision server 10 can access a not-shown server and the like of a public organization, download the document information provided on the server and the like of the public organization, and register the downloaded document information in the intellectual property document DB 25.

[0058]

In this way, since the document information on the intellectual property rights such

as patent bulletings and trademark bulletings is registered in the document DB 25, the rights holders of the intellectual property rights, the prospective users, and other users can access the intellectual property information provision server 10 by using a portable terminal such as a PC or a mobile phone to easily view the document information in the intellectual property document DB 25.

(d) Invention described in Cited Document 1

(d-1) Overall Configuration of Intellectual Property Information Provision System

According to the description of Paragraph [0017], the "intellectual property information provision system" described in the Cited Document 1 includes "an intellectual property information provision server 10 that receives requests for transferring or licensing (permission of use) of intellectual property rights of patents or the like; a database 20 that manages information on the transfer or licensing (permission of use), etc. of these intellectual property rights; a transfer and license information registration terminal 30 for registering transfer or licensing (permission of use) of the intellectual property rights in the database 20; and a transfer and license information utilization terminal 40 that accesses the database 20 and applies for the transfer or licensing (permission of use) of the intellectual property rights. The server and the terminals are connected to each other via a network 1 such as the Internet.". Therefore, it can be said that the intellectual property information provision system is a system in which the intellectual property information provision server 10, the database 20, the transfer and license information registration terminal 30, and the transfer and license information utilization terminal 40 are connected via the network 1. Therefore, from the perspective of the transfer and license information registration terminal 30, it can be said that the transfer and license information registration terminal 30 is a terminal used in the intellectual property information provision system, and is connected to the intellectual property information provision server 10 and database 20 via the network 1.

Further, because according to the description of Paragraph [0018], "The intellectual property information provision server 10 is an information processing device such as a workstation that is managed by a management side of the system together with the database 20", the intellectual property information provision server 10 and the database 20 can be referred together as a management side device.

Furthermore, according to the description of Paragraph [0021], "the database 20 includes a rights holder DB 21 that manages the personal information of the rights holders, a prospective user DB 22 that manages the personal information of the prospective users, a transfer and license information DB 23 that manages information on intellectual

property rights of the rights holders, a prospective use condition DB 24 that manage conditions of use requested by the prospective user when receiving the transfer or license of the intellectual property right (hereinafter referred to as the prospective use conditions), an intellectual property document DB 25 that manages document information on the intellectual property rights, and a deadline management DB 26 that manages deadlines for procedures for the intellectual property rights and the like", so that it is described that the management side device includes the intellectual property information provision server 10 and the database 20, and the database includes the transfer and license information DB 23 that manages information on intellectual property rights of rights holders, the prospective use condition DB 24 that manages the conditions of use requested by the prospective user when receiving the transfer or license of the intellectual property right (hereinafter referred to as the prospective use conditions), and the intellectual property document DB 25 that manages the document information on the intellectual property rights.

Based on the above description, it can be said that an invention related to the transfer and license information registration terminal 30 is disclosed, which is a terminal used in the intellectual property information provision system, and which is connected, via the network, to the management side device including the intellectual property information provision server 10 and the database 20 that includes the transfer and license information DB 23, the prospective use condition DB 24, and the intellectual property document DB 25.

(d-2) Transfer and License Information Registration Terminal 30.

i) According to the description of Paragraph [0019], "The transfer and license information registration terminal 30 is a communication-enabled information processing device such as a PC or a mobile terminal to be operated by the rights holder, and transmits the transfer and license information to the intellectual property information provision server 10, and registers the transfer and license information in the database 20." and "The transfer and license information includes, for example, various types of information such as contents of the intellectual property right, PR information, and conditions under which the transfer or licensing (permission of use) of the intellectual property right is performed."

(ii) According to the description of Paragraph [0057], "In the intellectual property information provision system," it is possible to "... registering the document information on intellectual property rights such as patent bulletings in the intellectual property document DB 25", "the document information on the intellectual property rights is registered in the intellectual property document DB 25 by the intellectual property information provision server 10", and "the operation may be performed such that the



rights holder of the intellectual property right transmits the document information on the intellectual property right he/she holds to the intellectual property information provision server 10 by using the transfer and license information registration terminal 30, and the intellectual property information provision server 10 registers the received document information".

#### (d-3) Prospective Use Information

Based on the description "When receiving the screen information for presenting the prospective use conditions, the transfer and license information utilization terminal 40 displays the screen information, and the prospective user uses the transfer and license information utilization terminal 40 to input the prospective use conditions by using the keyboard or the like at an input field on the screen" ([0040]), "transmits the input prospective use conditions to the intellectual property information provision server 10" and "When receiving the prospective use conditions, the intellectual property information provision server 10 registers the received prospective use conditions in the prospective use condition DB 24" ([0041]), "the intellectual property information provision server 10 refers to the transfer and license information DB 23, and searches for transfer and license information that matches the registered prospective use conditions" ([0042]), "When extracting the transfer and license information that matches those conditions, the intellectual property information provision server 10 creates screen information that shows a list of the extracted transfer and license information, and transmits the created screen information of the list to the transfer and license information utilization terminal 40" ([0043]), "When receiving the screen information that shows the list of transfer and license information, the transfer and license information utilization terminal 40 displays the screen information (Step S107). "When one piece of transfer and license information is selected on the screen of list by the prospective user, the transfer and license information utilization terminal 40 transmits the selected information to the system server 10" ([0043]), "When receiving the selected information, the intellectual property information provision server 10 extracts the transfer and license information selected in the selected information from the transfer and license information DB 23 (Step S109), creates screen information showing details of the extracted transfer and license information, and transmits the screen information to the transfer and license information utilization terminal 40 (Step S110). When receiving the screen information showing the details of the transfer and license information, the transfer and license information utilization terminal 40 displays the screen information" ([0044]), and "When the prospective user requests transfer or licensing (permission of use) of the intellectual property right shown on the screen, the prospective user performs a key operation, and

the like on the transfer and license information utilization terminal 40 to input the request. With the operation, the transfer and license information utilization terminal 40 transmits information showing that the prospective user requests transfer or licensing (permission of use) of the intellectual property right on the screen (hereinafter referred to as "prospective use information") to the intellectual property information provision server 10" ([0044]),

so that it is described that the prospective use information is information to be transmitted to the server from the transfer and license information utilization terminal 40 as a result of the following process:

"the prospective user uses the transfer and license information utilization terminal 40 to input the prospective use conditions by using the keyboard or the like at an input field on the screen,

transmits the input prospective use conditions to the intellectual property information provision server 10,

the intellectual property information provision server 10 refers to the transfer and license information DB 23, and searches for transfer and license information that matches the prospective use conditions,

when extracting the transfer and license information that matches each of those conditions, the intellectual property information provision server 10 creates screen information that shows a list of the extracted transfer and license information, and transmits the created screen information of the list to the transfer and license information utilization terminal 40,

the transfer and license information utilization terminal 40 displays the received screen information showing the list of transfer and license information,

when one piece of transfer and license information is selected on the screen of list by the prospective user, the transfer and license information utilization terminal 40 transmits the selected information to the system server 10,

when receiving the selected information, the intellectual property information provision server 10 extracts the transfer and license information selected in the selected information from the transfer and license information DB 23 (Step S109), creates screen information showing details of the extracted transfer and license information, and transmits the screen information to the transfer and license information utilization terminal 40,

when receiving the screen information showing the details of the transfer and license information, the transfer and license information utilization terminal 40 displays the screen, and

when the prospective user requests transfer or licensing (permission of use) of the intellectual property right shown on the screen, the prospective user performs a key operation, and the like on the transfer and license information utilization terminal 40 to input the request, and with the operation, the transfer and license information utilization terminal 40 transmits information showing that the prospective user requests transfer or licensing (permission of use) of the intellectual property right on the screen (hereinafter referred to as "prospective use information") to the intellectual property information provision server 10".

#### (d-4) Prospective Use Information and Screen Information including Prospective Use Information

According to the description of Paragraph [0045], "When receiving the prospective use information, the intellectual property information provision server 10 extracts the personal information of the prospective user who requests transfer or licensing (permission of use) of the intellectual property right from the prospective user DB 22 (Step S113), creates screen information that includes the extracted personal information of the prospective user and the prospective use information, and transmits the created screen information to the transfer and license information registration terminal 30 of the rights holder who holds the intellectual property right that is desired to be used this time (Step S114)" is described,

and according to the description of Paragraph [0046], "When receiving the screen information from the intellectual property information provision server 10, the transfer and license information registration terminal 30 displays the received screen information (Step S115)." is described.

#### (d-5) Overview (Cited Invention)

In view of the above discussion, the following invention (hereinafter referred to as the "Cited Invention") is described in the Cited Document 1.

An invention related to the transfer and license information registration terminal 30, which is used in the intellectual property information provision system, and which is connected, via the network, to the management side device including the intellectual property information provision server 10 and the database 20 that includes the transfer and license information DB 23, the prospective use condition DB 24, and the intellectual property document DB 25, wherein

the transfer and license information registration terminal 30 is

the communication-enabled information processing device such as a PC or mobile terminal to be operated by the rights holder,

that transmits the transfer and license information to the intellectual property information provision server 10, and registers the transfer and license information in the database 20,

the transfer and license information including various types of information such as contents of the intellectual property right, PR information, and conditions under which the transfer or licensing (permission of use) of the intellectual property right is performed,

that displays the received screen information when receiving the screen information from the intellectual property information provision server 10,

in the intellectual property information provision system, document information on intellectual property rights such as patent bulletings can be registered in the intellectual property document DB 25,

the information document on the intellectual property rights is registered in the intellectual property document DB 25 by the intellectual property information provision server 10, and the rights holder of the intellectual property right may transmit the document information on the intellectual property right he/she holds to the intellectual property information provision server 10 by using the transfer and license information registration terminal 30, and the intellectual property information provision server 10 may register the received document information,

the prospective use information is information to be transmitted to the server from the transfer and license information utilization terminal 40 when

the prospective user uses the transfer and license information utilization terminal 40 to input the prospective use conditions by using the keyboard or the like at an input field on the screen,

transmits the input prospective use conditions to the intellectual property information provision server 10,

the intellectual property information provision server 10 refers to the transfer and license information DB 23, and searches for transfer and license information that matches the prospective use conditions,

when extracting the transfer and license information that matches those conditions, the intellectual property information provision server 10 creates screen information that shows a list of the extracted transfer and license information, and transmits the created screen information of the list to the transfer and license information utilization terminal 40,

the transfer and license information utilization terminal 40 displays the received screen information showing the list of transfer and license information,

when one piece of transfer and license information is selected on the screen of list

by the prospective user, the transfer and license information utilization terminal 40 transmits the selected information to the system server 10,

when receiving the selected information, the intellectual property information provision server 10 extracts the transfer and license information selected in the selected information from the transfer and license information DB 23 (Step S109), creates screen information showing details of the extracted transfer and license information, and transmits the screen information to the transfer and license information utilization terminal 40,

when receiving the screen information showing the details of the transfer and license information, the transfer and license information utilization terminal 40 displays the screen, and

when the prospective user requests transfer or licensing (permission of use) of the intellectual property right shown on the screen, the prospective user performs a key operation, and the like on the transfer and license information utilization terminal 40 to input the request, and with the operation, the transfer and license information utilization terminal 40 transmits information showing that the prospective user requests transfer or licensing (permission of use) of the intellectual property right on the screen (hereinafter referred to as "prospective use information") to the intellectual property information provision server 10, and

when receiving the prospective use information, the intellectual property information provision server 10 extracts the personal information of the prospective user who requests transfer or licensing (permission of use) of the intellectual property right from the prospective user DB 22 (Step S113), creates screen information that includes the extracted personal information of the prospective user and the prospective use information, and transmits the created screen information to the transfer and license information registration terminal 30 of the rights holder who holds the intellectual property right that is desired to be used this time.

#### (e) Comparison

##### (e-1)

The "rights holder" of the Cited Invention is described in Paragraph [0016] of the detailed description of the invention in the Cited Document "a rights holder of an intellectual property right (hereinafter simply referred to as the "rights holder") registers information indicating that he/she transfers or licenses (permission of use) of the intellectual property right held by himself/herself (hereinafter referred to as "transfer and license information") in a system database", and the "first user" in the invention after

Amendment in Paragraph [0047] of the detailed description of the invention in the present application "the first user (for example, the patentee)", so that it can be said that both the "rights holder" in the Cited Invention and the "first user" in the Invention after the Amendment are the patentee and have no difference.

Further, the "transfer and license information registration terminal 30" in the Cited Invention is "a communication-enabled information processing device such as a PC or a mobile terminal to be operated by the rights holder", the "information processing device" in the Invention after the Amendment is "an information processing device to be operated by a first user", and as described above, the "rights holder" in the Cited Invention and the "first user" in the Invention after the Amendment have no difference, so that the "transfer and license information registration terminal" of the Cited Invention is equivalent to the "information processing device" of the Invention after the Amendment.

Therefore, the Cited Invention includes the constituent components (A) and (E).

(e-2)

The "transfer and license information registration terminal" of the Cited Invention "transmits the transfer and license information to the intellectual property information provision server 10 and registers the transfer and license information in the database 20", and the configuration of "the transfer and license information includes, for example, various types of information such as contents of the intellectual property right, PR information, and conditions under which the transfer or licensing (permission of use) of the intellectual property right is performed" is first specified.

Further, due to the configuration that "in the intellectual property information provision system,", and "the rights holder of the intellectual property right may transmit the document information on the intellectual property right he/she holds to the intellectual property information provision server 10 by using the transfer and license information registration terminal 30, and the intellectual property information provision server 10 may register the received document information", it can be said that the above configuration is a configuration in which the document information on the intellectual property rights such patent bulletings is transmitted to the transfer and license information provision server 10 and registered in the intellectual property document DB 25.

It is evident that in order to transmit the document information on the intellectual property rights such patent bulletings to the transfer and license information provision server 10 by using the transfer and license information registration terminal 30, the transfer and license information registration terminal 30 needs to include a transmission unit for transmitting the document information on the intellectual property rights such

patent bulletings to the transfer and license information provision server 10.

It is clear that the "document information on the intellectual property rights such as patent bulletings" and the "transmission unit" of the Cited Invention are equivalent to the "information on a bulleting related to an intellectual property right" and the "bulleting notification unit" of the Invention after the Amendment.

In the configuration described in the Cited Invention, the rights holder of the intellectual property rights transmits the document information on the intellectual property right held by himself/herself by using the transfer and license information registration terminal 30, and the "document information on the intellectual property rights such as patent bulleting" to be transmitted to the intellectual property information provision server 10 and registered is determined by the rights holder of the intellectual property rights from among the intellectual property rights held by himself/herself, so that the document information is document information specified by the rights holder of the intellectual property rights.

Furthermore, it can be said that the patent to be registered in the server by the rights holder in the Cited Invention is an intellectual property right that is desired by the patentee to be utilized, according to the description such as:

[0016]

"In this way, since the information that actively promotes the utility value of the intellectual property right is presented to the user of the intellectual property right, effective mediation of the transfer or licensing (permission of use) of the intellectual property right and effective utilization of the intellectual property right can be realized."

[0029]

"In this way, since the rights holder registers, in the transfer and license information DB 23, PR document for transfer or license (permission of use) of the intellectual property right, such as what kind of business the intellectual property right can be used for and how much profit can be obtained, in addition to the personal information of the rights holder and the contents on the intellectual property rights, selling points of the intellectual property rights can appeal to those who wish to use the intellectual property rights, and effective utilization of the intellectual property rights can be realized."

[0047]

"As described above, in the present embodiment, the utilization method of the intellectual property rights and the expected profit when the intellectual property right is utilized and the like are registered in the database 20, and the usefulness of the intellectual property rights is actively appealed to the prospective users, so that it is possible to increase opportunities for the intellectual property rights to be licensed or used by third parties

other than the rights holders, and promote the distribution and effective utilization of intellectual property rights."

[0059]

"According to the description "As described above, in the present embodiment, rights information on intellectual property right and the PR information that actively promotes the value of intellectual property right is registered in the database 20, the person who requests transfer or licensing (permission of use) of an intellectual property right can easily grasp the contents of the intellectual property right by viewing the registered information, so that as a result, it is possible to increase opportunities for the intellectual property rights to be transferred or licensed to the third parties other than the rights holder and promote effective utilization of intellectual property rights."

Based on the above discussion, it can be said that the Cited Invention includes "a bulleting notification unit configured to notify, after an intellectual property right that is desired by the first user to be utilized is specified from among one or more intellectual property rights held by the first user, a server of information on a bulleting related to the intellectual property right", but the Cited Invention does not has the configuration of "that is not used in business" that specifies the intellectual property right that is desired by the first user (patentee) to be utilized, and in this respect, the Cited Invention differs from the Invention after the Amendment.

(e-3)

In view of the specific matters in the Cited Invention that "when the prospective user requests transfer or licensing (permission of use) of the intellectual property right shown on the screen, the prospective user performs a key operation, and the like on the transfer and license information utilization terminal 40 to input the request, and with the operation, the transfer and license information utilization terminal 40 transmits information showing that the prospective user requests transfer or licensing (permission of use) of the intellectual property right on the screen (hereinafter referred to as "prospective use information") to the intellectual property information provision server 10", the "prospective user" and the "prospective use information" of the Cited Invention are equivalent to the "person having an interest in the intellectual property right" and the "information at least indicating that a person having an interest in the intellectual property right exists" of the Invention after the Amendment.

Further, in view of the process of obtaining the prospective use information, the "prospective use information" of the Cited Invention is information obtained by the prospective user as a result of the intellectual property information provision server 10 performing searching by referring to the transfer and license information DB 23.



Further, since the information registered in the transfer and license information DB 23 by the intellectual property information provision server 10 is information that is registered after "the rights holder of the intellectual property right transmits the document information on the intellectual property right he/she holds to the intellectual property information provision server 10 by using the transfer and license information registration terminal 30", as examined in (e-2), information that has not been registered is not displayed, so that in this regard, the information is information registered "as a result of notifying the server of the information on a bulleting related to the intellectual property right by the information processing device".

That is, it can be said that the "prospective use information" is "information registered as a result of notifying the server of the information on a bulleting related to the intellectual property right by the information processing device", and is information that is generated as a result of searching for the information registered in the transfer and license information DB 23 by the intellectual property information provision server 10 and performing further processing, and that is transmitted from the transfer and license information utilization terminal 40 to the intellectual property information provision server 10.

Further, when receiving the prospective use information, the intellectual property information provision server 10 creates the screen information that includes the prospective use information, and transmits the created screen information to the transfer and license information registration terminal 30 of the rights holder who holds the intellectual property right that is desired to be used this time, and when receiving the screen information from the intellectual property information provision server 10, the transfer and license information registration terminal 30 displays the received screen information, so that it can be said that the transfer and license information registration terminal 30 includes a receiving unit for receiving the screen information that includes the prospective use information.

Based on the above discussion, the Cited Invention includes "a receiving unit configured to receive information at least indicating that a person having an interest in the intellectual property right exists, generated as a result of notifying the server of the information on a bulleting related to the intellectual property right by the information processing device, and transmitted to the information processing device from the server".  
(e-4) Overview (Corresponding Features/Different Feature)

In summary, according to the above discussion, the Invention after the Amendment and the Cited Invention have the following corresponding features and a different feature.

<Corresponding Features>

An information processing device to be operated by a first user, comprising:  
a bulleting notification unit configured to notify, after an intellectual property right that is desired by the first user to be utilized is specified from among one or more intellectual property rights held by the first user, a server of information on a bulleting related to the intellectual property right; and

a receiving unit configured to receive information at least indicating that a person having an interest in the intellectual property right exists, generated as a result of notifying the server of the information on a bulleting related to the intellectual property right by the information processing device, and transmitted to the information processing device from the server.

<A Different Feature>

With respect to the "intellectual property right that is not used in business but is desired by the first user to be utilized" in the Invention after the Amendment, the Cited Invention does not include a configuration "not used in business" that specifies the intellectual property right that is desired by the first user (patentee) to be utilized, and in the regard, the Invention after the Amendment and the Cited Invention are different.

(f) Judgment

There is a plurality of patent rights held by the patentee (first user), and then it is a matter of course for the patentee to appropriately perform, based on a business plan of the patentee, determination on the patent rights, such as whether to utilize the patent rights to his/her business, or whether the patent rights can be utilized by other business operators (by establishment of a license, transfer of rights, or the like).

Further, as described in Paragraph [0005] in the Cited Document 1 that "On the other hand, even though having registered the intellectual property rights, plenty of intellectual property rights holders wish to transfer their intellectual property rights for a fee or enter into a license agreement because of difficulties in implementation and utilizing them caused by lack of facilities or funds.", it is also common to assume that the patentee makes the patent rights held by himself/herself available to others although the patentee does not implement the patent rights.

Therefore, in the above judgment, a case in which the patentee makes the patent rights held by himself/herself available to other business operators although the patentee does not implement the patent rights is also a natural assumption, and it can be common to assume to register the naturally assumed patent rights by using the information

processing device (transfer and license information registration terminal 30) of the Cited Invention, so that it could have been easy for a person skilled in the art to make the Invention after the Amendment by adding a configuration related to the differences to the Cited Invention.

(g) Effect

As described above, the differences are easily conceivable by a person skilled in the art, and are not exceptional in terms of the invention of the present application as a whole, and the operations and effects are merely to the extent foreseeable with adoption of the configuration related to the differences.

(h) Concerning the Appellant's allegation

In the Request for Appeal, the appellant states that:

"In comparison between the invention of the present application according to Claim 1 and the inventions described in the Cited Documents 1 and 2, the invention of the present application according to Claim 1 includes at least the technical features (A) and (B) among the technical features mentioned above. In conclusion, the technical features (A) and (B) are as follows: an information processing device to be operated by a first user extracts, from among one or more intellectual property rights held by the first user, information on a bulleting related to an intellectual property right that is not used in business of the first user but is desired by the first user to be utilized, and notifies a server of the information as first information that includes information based on which second information and third information is extracted by the server.

That is, in the invention of the present application according to Claim 1, as described in paragraphs [0021] to [0022], (α) The patentee terminal 2 (an embodiment of the information processing device according to the present application) specifies a patent right (an example of the "intellectual property right" in Claim 1 of the present application) that is not used in business of a business operator and is desired by the patentee (an example of the "first user" in Claim 1 of the present application) to be utilized, and notifies the server 1 (an example of the "server" in Claim 1 of the present application) of the information (such as a patent number).

(β) The server 1 that receives the patent right information that is specified and notified by the patentee terminal 2 includes a claim word extraction unit 51 and a specification word extraction unit 52, as described in paragraph [0020] of the original specification.

The claim word extraction unit 51 extracts, as a claim word, a predetermined word

from contents in the scope of the claims (contents of the claims) included in a bulleting related to a predetermined patent right that is desired by a predetermined patentee to be utilized (hereinafter referred to as "patent right desired to be utilized").

The specification word extraction unit 52 extracts, as a related specification word, a word that is relevant to the extracted claim word from contents of the specification included in the bulleting related to the patent right desired to be utilized. (the underline, and symbols ( $\alpha$ ) and ( $\beta$ ) are added in the trial of this case), and asserts that "Therefore, the patent right information that is specified and notified by the patentee terminal 2 includes information (an example of the "first information" in Claim 1 of the present application) based on which the server 1 extracts the claim word and the related specification word.

That is, the server can extract the second information and the third information only because the first information is specified and notified by the information processing device (the "patentee terminal 2" in the original specification)."

Here, in discussion of the above assertion, as recognized in the above (b-2) in the trial of this case, the above ( $\alpha$ ) is recognized as the configuration of the bulleting notification unit (included in the information processing device), and there is no difference between the recognition in the trial of this case and the appellant's recognition.

On the other hand, the extraction processing is described as processing performed by the server 1, as being described to be "the server ... extracts..." according to the description of the above ( $\beta$ ), so that the appellant also recognizes the extraction processing as unspecified processing of the information processing device.

The appellant states that it is necessary to specify the "first information", the "second information", and the "third information" respectively while specifying the invention of the present application, because eventually, the server "can extract the second information and the third information only because the first information is specified and notified". However, as discussed with reference to the description of the specification of the present application in the above (b-2), "the first information" itself can be rephrased as information on a bulleting related to the intellectual property right, and in this regard, there is no misinterpretation in the above recognition that the "first information" is the "information on a bulleting related to the intellectual property right".

Further, the processing of information using what kind of configuration of the first information (what kind of description in the bulleting) is processing in which the information can be extracted as long as the "information on a bulleting related to the intellectual property right" exists speaking of the relationship between the processing performed by the server itself, including the extraction processing of the "second

information" and the extraction processing of the "third information" and the information transmitted to the information processing device in the Invention after the Amendment, so that it is evident from the description in the specification of the present application that the "first information" does not need to include any more special configuration than beyond the above.

Thus, it can be said that the above appellant's assertion that "the server can extract the second information and the third information only because the first information is specified and notified by the information processing device (the "patentee terminal 2" in the original specification)" is correct, but the second information and the third information can be extracted as long as the first information is the "information on a bulleting related to the intellectual property right" described in the Cited Invention, and the first information has no technical meaning beyond that, so that the appellant's assertion that "we think that the technical features (A) and (B) can be understood as specifying the structure, functions, and the like of the invention of the sub-combination according to Claim 1 as specific matters related to "other sub-combinations" cannot be adopted.

(i) Summary (Independent Requirements of Patentability)

According to the above discussion, the Invention after the Amendment could have been easily invented by a person skilled in the art based on the invention described in the Cited Document 1 and matters known prior to the filing of the present application. Thus, the Appellant should not be granted a patent for it independently at the time of patent application under the provisions of Article 29(2) of the Patent ACT.

Therefore, since the Amendment violates the provisions of Article 126(7) of the Patent ACT which is applied mutatis mutandis pursuant to the provisions of Article 17-2(6) of the Patent ACT, it shall be dismissed under the provisions of Article 53(1) of the Patent ACT applied mutatis mutandis by replacing certain terms pursuant to Article 159(1) of the Patent ACT.

No. 3 Concerning Invention in Present Application

1. Invention in the Present Application

(A) Invention described in Claim 1 before the amendment

Since the Written Amendment submitted on October 23, 2019 was dismissed as described above, the inventions according to Claims 1 to 13 of the present application are inventions according to Claims 1 to 13 in the scope of claims amended according to the Written Amendment submitted on April 15, 2019, and the invention according to Claim

1 before the amendment is as follows (Constituent components (a) to (e) are given in the trial of this case. Hereinafter "Constituent component (a)", etc. will be cited.).

[Claim 1]

(e) An information processing device (a) to be operated by a first user, comprising:

(b) a bulleting notification unit configured to notify a server of information on a bulleting related to an intellectual property right desired by the first user to be utilized, as first information that includes information based on which second information and third information is extracted by the server; and

(d) a receiving unit configured to receive seventh information when

(c) in the server,

(c1) a predetermined character, figure, symbol, or a combination thereof is extracted as the second information from among contents of a first document that is included in the bulleting specified by the first information that is notified by the bulleting notification unit,

(c2) a character, figure, symbol, or a combination thereof related to the extracted second information is extracted as the third information from among contents of a second document that is included in the bulleting,

(c3) a person who registers fourth information related to the extracted third information is determined as a notification object person from among a plurality of second users each of whom registers a predetermined character, figure, symbol, or a combination thereof as the fourth information in advance,

(c4) information related to the intellectual property right is notified as fifth information to a terminal of the notification object person,

(c5) sixth information indicating that the notification object person has an interest in the intellectual property right related to the fifth information is acquired from the terminal of the notification object person,

(c6) information at least indicating that a person having an interest in the intellectual property right exists among the plurality of second users is generated as seventh information based on the sixth information, and

(c7) the seventh information that is generated as a result of the notification of the first information issued by the information processing device is transmitted to the information processing device.

(B) Invention of Present Application

When the invention described in Claim 1 before the amendment is compared with

the invention described in Claim 1 after the amendment, the constituent components (a), and (c) to (e) are common to the constituent components (A), and (C) to (E), and are recognized to be the same as the recognition in the above "No. 2-2(2-3)(b)".

When the constituent component (b) "a bulleting notification unit configured to notify a server of information on a bulleting related to an intellectual property right desired by the first user to be utilized, as first information that includes information based on which second information and third information is extracted by the server" is amended according to the Amendment into the constituent component (B) "a bulleting notification unit configured to notify, after an intellectual property right that is not used in business but is desired by the first user to be utilized is specified from among one or more intellectual property rights held by the first user, a server of information on a bulleting related to the intellectual property right as first information that includes information based on which second information and third information is extracted by the server", the specific matters of "notify, ..., a server of information on a bulleting related to the intellectual property right as first information that includes information based on which second information and third information is extracted by the server" can be recognized as, as examined in the above "No. 2-2(2-3) (b) (b-2), "notify, ..., a server of information on a bulleting related to the intellectual property right", so that it is evident that "notify, ..., a server of information on a bulleting related to the intellectual property right as first information that includes information based on which second information and third information is extracted by the server" described the invention before the amendment can also be recognized to be the same as the Invention after the amendment.

Therefore, the constituent component (b) of the invention before the amendment is recognized as "a bulleting notification unit configured to notify a server of information on a bulleting related to an intellectual property right desired by the first user to be utilized" (hereinafter referred to as "constituent component (b)').

In view of the above discussion, the invention of the present application is recognized to be:

- (e) An information processing device (a) to be operated by a first user, comprising:
- (b') a bulleting notification unit configured to notify a server of an intellectual property right desired by the first user to be utilized; and
- (d') a receiving unit configured to receive information at least indicating that a person having an interest in the intellectual property right exists, generated as a result of notifying the server of the information on a bulleting related to the intellectual property right by the information processing device, and transmitted to the information processing device from

the server.

## 2. Description of Cited Document 1

Cited Document 1 cited by the examiner in the decision of refusal describes the matters as described in the above No. 2-2(2-3)(c).

## 3. Invention described in Cited Document 1

Cited Document 1 describes the Cited Invention shown in No. 2-2(2-3)(d).

## 4. Comparison and Judgment

The invention of the present application is as recognized in the above 1(B), and the constituent components (a), (d'), and (e) are common to the constituent components (A), (D'), and (E) of the Invention after the amendment, so that, as compared in No. 2-2(2-3)(e), there is no difference between the invention of the present application and the Cited Invention.

When examining the constituent component (b'), as compared in the above "No. 2-2(2-3)(e)(e-2)", "the Cited Invention includes a 'bulleting notification unit configured to notify, after an intellectual property right that is desired by the first user to be utilized is specified from among one or more intellectual property rights held by the first user, a server of information on a bulleting related to the intellectual property right", so that it is evident that the Cited Invention includes the constituent component (b').

Based on the above discussion, there is no difference between the Cited Invention and the invention of the present application.

Therefore, the invention of the present application is the invention described in the Cited Document 1.

## 5. Closing

As described above, the invention of the present application is not patentable under the provisions of Article 29-1(3) of the Patent ACT because it is an invention described in the Cited Document 1.

Therefore, the present application should be rejected, without examining the inventions according to the remaining Claims 2 to 13.

March 11,2021

Chief administrative judge: SATO, Satoshi



Administrative judge: WATANABE, Satoshi

Administrative judge: MATSUDA, Naoya