

Appendix 2 Answers for Hypothetical Claim Sets (Group1)

2.1 Hypothetical Claim Set A: Point-granting service

(1) Claim interpretation

	USPTO	JPO
1	<p>The claim was not literally interpreted for the lack of clarity. The preamble of the claim calls for granting points, yet no step appears in the body of the claim to actually grant the points. The first step designates a name, next an address is selected or registered. The next step requires storing "the value of the points granted" but note that no point determining or granting step is explicitly recited. Relatedly, in line 9, "the value of the points granted" lacks antecedent basis, and "points" that were granted as recited in line 11 is not clear in that it does not refer to any points necessarily related to the transaction. These ambiguities did not affect the ability to understand the invention for purposes of review/consideration under this section of the questionnaire.</p>	<p>The scope of the claim is interpreted in accordance with the language of the descriptions of the claim.</p> <p>Since none of the terms described in the claim are obscure, the claim was literally interpreted.</p> <p>Therefore, the scope of the claimed invention was interpreted as the broadest-possible scope within a reasonable limit when the invention is judged for the statutory subject matter or for its novelty and an inventive step.</p>
2	<p>The claim was not literally interpreted for the lack of clarity. The preamble of the claim recites that "points are granted", yet no step appears in the body of the claim to actually grant the points. The first step designates a name, next an address is selected or registered. The next step requires storing "the value of the points granted" but note that no point determining or granting step is explicitly recited. Relatedly, in line 10, "the value of the points granted" lacks antecedent basis, and "points" that were granted as recited in line 12 is not clear in that it does not refer to any points necessarily related to the transaction. These ambiguities did not affect the ability to understand the invention for purposes of review/consideration under this section of the questionnaire.</p>	<p>Same as above.</p>

3	<p>The claim was not literally interpreted for the lack of clarity. The preamble of the claim calls for "granting points", yet no step appears in the body of the claim to actually grant the points. The first step designates a name, next an address is selected or registered. The next step requires storing "the value of the points granted" but note that no point determining or granting step is explicitly recited. Relatedly, in line 10, "the value of the points granted" lacks antecedent basis, and "points" that were granted as recited in line 12 is not clear in that it does not refer to any points necessarily related to the transaction. These ambiguities did not affect the ability to understand the invention for purposes of review/consideration under this section of the questionnaire.</p>	Same as above.
4	<p>The claim was not literally interpreted for the lack of clarity. The preamble of the claim calls for "granting points", yet no step appears in the body of the claim to actually grant the points. The first step designates a name, next an address is selected or registered. The next step requires storing "the value of the points granted" but note that no point determining or granting step is explicitly recited prior to this step. While the claim includes the recitation on line 15 that "points" are calculated in a certain manner, this does not positively require the step of "calculating" as one of the steps of the method. Relatedly, in line 10, "the value of the points granted" lacks antecedent basis, and "points" that were granted as recited in line 12 is not clear in that it does not refer to any points necessarily related to the transaction. These ambiguities did not affect the ability to understand the invention for purposes of review/consideration under this section of the questionnaire.</p>	Same as above.

5	<p>The claim was not literally interpreted for the lack of clarity. The preamble of the claim calls for "granting points", yet no step appears in the body of the claim to actually grant the points. The first step designates a name, next an address is selected or registered. The next step requires storing "the value of the points granted" but note that no point determining or granting step is explicitly recited. Relatedly, in line 10, "the value of the points granted" lacks antecedent basis, and "points" that were granted as recited in line 12 is not clear in that it does not refer to any points necessarily related to the transaction.. Further, "the number of points awarded" is not clear in that no awarding step is found. Also, "the number of points normally awarded" is not clear in that "normal" has not been established. These ambiguities did not affect the ability to understand the invention for purposes of review/consideration under this section of the questionnaire.</p>	Same as above.
6	<p>The claim was not literally interpreted for the lack of clarity. The preamble of the claim calls for "granting points", yet no step appears in the body of the claim to actually grant the points. The first step designates a name, next an address is selected or registered. The next step requires storing "the value of the points granted" but note that no point determining or granting step is explicitly recited. Relatedly, in line 10, "the value of the points granted" lacks antecedent basis, and "points" that were granted as recited in line 19 is not clear in that it does not refer to any points necessarily related to the transaction. These ambiguities did not affect the ability to understand the invention for purposes of review/consideration under this section of the questionnaire.</p>	Same as above.

(2) Answers and analysis about statutory subject matter

	USPTO	JPO
1	<p>No: The claim is supported by a specification that describes only a computer implemented version of the method. Thus the method is within the technological arts. However, the claim does not provide a practical application. The result of the method is the sending of a notice that points are granted. Note that the points themselves are not associated in the claim with any real world value or use. No provisions are recited for any redemption of or exchange of value for these points. Sending a notice of generic points to the designated person merely alerts the person that points exist and does not provide that person with useable value. As a result, no practical application is recited.</p>	<p>No: None of the claimed steps describe a distinctive process executed by a computer, but include procedures presumably used by store staff to offer services. Procedures presumably used by store staff to offer services fall under “arbitrary arrangements” under “non-statutory inventions” set forth in “Implementing Guidelines for Industrially Applicable Inventions.” Therefore, the claimed invention does not constitute statutory subject matter for the reason that it utilizes a law as a whole other than a law of nature.</p>
2	<p>No: The claim is supported by a specification that describes only a computer implemented version of the method. Although the claim recites that the shop is on the Internet, this additional limitation does not change this analysis. Thus the method is within the technological arts. However, the claim does not provide a practical application. The result of the method is the sending of a notice that points are granted. Note that the points themselves are not associated in the claim with any real world value or use. No provisions are recited for any redemption of or exchange of value for these points. Sending a notice of generic points to the designated person merely alerts the person that points exist and does not provide that person with useable value. As a result, no practical application is recited.</p>	<p>No: The claimed steps cannot be regarded as describing a specific computer-process for providing a point-award service via the Internet by merely targeting users of a “shop” on the “Internet” or limiting “addresses” to “e-mail addresses.” Accordingly, the invention falls under “arbitrary arrangements” under “non-statutory inventions,” and it does not fall under “information processing in which hardware resources are used.” Therefore, the claimed invention does not constitute statutory subject matter for the reason that it utilizes a law as a whole other than a law of nature.</p>

3	<p>No: The claim is supported by a specification that describes only a computer implemented version of the method and the recited method explicitly includes operations performed by a server. Thus the method is within the technological arts. However, the claim does not provide a practical application. The result of the method is the sending of a notice that points are granted. Note that the points themselves are not associated in the claim with any real world value or use. No provisions are recited for any redemption of or exchange of value for these points. Sending a notice of generic points to the designated person merely alerts the person that points exist and does not provide that person with useable value. As a result, no practical application is recited.</p>	<p>Yes: The claim not only discloses that the server (computer) comprises a “customer list storage unit,” but also discloses a specific process to be executed with the “customer list storage unit” by the server (computer). Thereby, the point-award service method is construed to be realized on a computer network system (the Internet). Accordingly, the point-award service method cannot be considered as an “arbitrary arrangement,” but falls under “information processing in which hardware resources are used.” Thus, the claimed invention constitutes statutory subject matter for the reason that it is a creation of technical ideas by which a law of nature is utilized.</p>
4	<p>No: The claim is supported by a specification that describes only a computer implemented version of the method and the recited method explicitly includes operations performed by a server. Thus the method is within the technological arts. However, the claim does not provide a practical application. The result of the method is the sending of a notice that points are granted. Note that the points themselves are not associated in the claim with any real world value or use. No provisions are recited for any redemption of or exchange of value for these points. Sending a notice of generic points to the designated person merely alerts the person that points exist and does not provide that person with useable value. The additional limitation of making the award point calculation to be inclusive of the applicable taxes, this does not change the resulting analysis. As a result, no practical application is recited.</p>	<p>Yes: Same as above.</p>

<p>5</p>	<p>No: The claim is supported by a specification that describes only a computer implemented version of the method and the recited method explicitly includes operations performed by a server. Thus the method is within the technological arts. However, the claim does not provide a practical application. The result of the method is the sending of a notice that points are granted. Note that the points themselves are not associated in the claim with any real world value or use. No provisions are recited for any redemption of or exchange of value for these points. Sending a notice of generic points to the designated person merely alerts the person that points exist and does not provide that person with useable value. The additional limitation of potentially increasing the number of granted points by a factor of ten does not change the above analysis and the result. As a result, no practical application is recited.</p>	<p>Yes: Same as above.</p>
<p>6</p>	<p>Yes: The claim is supported by a specification that describes only a computer implemented version of the method and the recited method explicitly includes operations performed by a server. Thus the method is within the technological arts. Further, the claim recites that merchandise available merely by redeeming the point value is distinguished in a converted list and attached to the notice that points were granted. This effectively associates the points with a real world value and use and thus provides a practical application; the ability to redeem the points for merchandise.</p>	<p>Yes: Same as above.</p>

(3) Novelty, Inventive step (Obviousness) case 1

	USPTO	JPO
1	<p>Novelty : No, Inventive step : No Claim 1 lacks novelty by definition in that it is indicated as prior art to applicant.</p>	<p>Novelty : No, Inventive step : No The claimed invention is not novel in view of Prior Art Document (a) disclosing an art constituted from this claim.</p>
2	<p>Novelty : Yes, Inventive step : No Claim 2 lacks an inventive step. The prior art of claim 1 teaches all the limitations of claim 2 save for the use of e-mail and an Internet shop. However, e-mail addresses and Internet shops are well known in the art and have been used as known alternatives to standard shops and addresses. Since the prior art of claim 1 teaches at least manually performing the same steps, this difference represents the mere, general automation of steps known to have been previously performed manually, which automation is well known in the art. Thus, it would have been obvious to those of ordinary skill in the art to modify the teachings of claim 1 to include known Internet shops and e-mail addresses for the advantage of enticing shopping at the Internet shop.</p>	<p>Novelty : Yes, Inventive step : No Compared to Claim 1, the claim 2 includes additional descriptions to target users of a “shop” on the “Internet” or to limit “addresses” to “e-mail addresses.” Since the claimed service does not utilize an item (distinctiveness) specific to the Internet, targeting users of a “shop” on the “Internet” is a mere application of the service to another field with common functions and effects, which can easily be arrived at by a person skilled in the art. The “e-mail addresses” in the claim means nothing more than the means of specifying the destination, such as postal addresses or telephone numbers. To limit “addresses” to “e-mail addresses” is a mere supplement or replacement by a commonly known means for systematization, which can easily be arrived at by a person skilled in the art. Therefore, the claimed invention does not involve an inventive step.</p>

<p>3</p>	<p>Novelty : Yes, Inventive step : No Claim 3 lacks an inventive step. The prior art of claim 1 teaches all the limitations of claim 3 save for the use of e-mail, an Internet shop and a server to provide selection, registration and storage. However, e-mail addresses and Internet shops are well known in the art and have been used as known alternatives to standard shops and addresses. Since the prior art of claim 1 teaches at least manually performing the same steps, this difference represents the mere, general automation of steps known to have been previously performed manually, which automation is well known in the art. Thus, it would have been obvious to those of ordinary skill in the art to modify the teachings of claim 1 to include known Internet shops and e-mail addresses for the advantage of enticing shopping at the Internet shop. With respect to the use of the server to perform the selecting and storage, again the prior art of claim 1 teaches the steps performed. Further, servers are well known in the art as part of the Internet and as providing storage and powerful processing abilities. Thus, it would have been obvious to those of ordinary skill in the art to employ a well known server to implement the recited selection and storage for the advantage of using common, off-the-shelf components.</p>	<p>Novelty : Yes, Inventive step : No The claimed invention is “systematization of existing human transactions in an applied field by means of a computer, since the transactions are such that they can be realized by a routine application of usual system analysis and system design technologies.” Accordingly, the invention does not involve an inventive step as it falls within the exercise of ordinary creative ability expected of a person skilled in the art.</p>
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<p>4 Novelty : Yes, Inventive step : No Claim 4 lacks an inventive step. The prior art of claim 1 teaches all the limitations of claim 4 save for the use of e-mail, an Internet shop, a server to provide selection, registration and storage, and the points being calculated against the cost of the transaction inclusive of taxes. However, e-mail addresses and Internet shops are well known in the art and have been used as known alternatives to standard shops and addresses. Since the prior art of claim 1 teaches at least manually performing the same steps, this difference represents the mere, general automation of steps known to have been previously performed manually, which automation is well known in the art. Thus, it would have been obvious to those of ordinary skill in the art to modify the teachings of claim 1 to include known Internet shops and e-mail addresses for the advantage of enticing shopping at the Internet shop. With respect to the use of the server to perform the selecting, registration and storage, again the prior art of claim 1 teaches the steps performed. Further, servers are well known in the art as part of the Internet and as providing storage and powerful processing abilities. Thus, it would have been obvious to those of ordinary skill in the art to employ a well known server to implement the recited selection and storage for the advantage of using common, off-the-shelf components. Further, it is indicated that a service method for granting points against the cost of the merchandise transaction taking taxes into account is prior art. As a result, it would have been obvious to those of ordinary skill in the art to modify the teachings of claim 1 to include granting points against the cost of the merchandise transaction taking taxes into account for the obvious advantage of maximizing the amount of points delivered to the designated person.</p>	<p>Novelty : Yes, Inventive step : No The claimed invention adds the following feature to Claim 3: “points issued against the merchandise transaction are calculated as those issued against the cost of the merchandise transaction inclusive of taxes.” This feature is described in Document (b), thus the invention does not involve an inventive step.</p>
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5	<p>Novelty : Yes, Inventive step : Yes Claim 5 meets the criteria for novelty and inventive step as the stated prior art fails to teach that the number of points awarded in a service method for granting points are increased to 10 times the number of points normally awarded for the merchandise transaction in one out of every twenty transactions.</p>	<p>Novelty : Yes, Inventive step : No The claimed invention adds the following feature to Claim 3: “the number of points awarded are increased to 10 times the number of points normally awarded for that merchandise transaction in one out of every twenty transactions.” This feature is neither described in Document (a) nor Document (b). However, it is well-known to provide frequent customers with special services. Given that granting points is one of the services for customers, it would be easy to grant special points to frequent customers. Here, it is a matter of mere design modification to specify as to how many times of points are granted as the special points and how often the special points are granted. Thus the invention does not involve an inventive step.</p>
6	<p>Novelty : Yes, Inventive step : Yes Claim 6 meets the criteria for novelty and inventive step as the stated prior art fails to teach calling by the server a comprehensive list of merchandise, converting by the server the list into a list such that the merchandise available merely by redeeming the point value can be distinguished from other merchandise and sending by the server the converted list to the e-mail address of the designated person.</p>	<p>Novelty : Yes, Inventive step : Yes The claimed invention adds the following features to Claim 3: “calling by the server, a comprehensive list of merchandise from a merchandise information storing means for storing a list of merchandise corresponding with the name and price of the merchandise purchased or the number of points necessary for the purchase thereof; converting by the server, the comprehensive list of merchandise into a list, such that the merchandise available merely by redeeming the point value can be distinguished from other merchandise; and sending by the service, the notice that points were granted, attaching thereto the comprehensive list of merchandise as converted, to the e-mail address of the designated person.” These features are neither described in Document (a) nor Document (b), thus the invention involves an inventive step.</p>

(4) Novelty, Inventive step (Obviousness) case 2

	USPTO	JPO
1	Novelty : No, Inventive step : No Claim 1 lacks novelty as the indicated prior art of claim 3 meets each of the steps recited. Note that claim 1 is merely broader than, a non-computer implemented version of the invention, claim 3 but includes all of the same limitations and is therefore clearly lacks novelty.	Novelty : No, Inventive step : No The claimed invention is not novel in view of Document (c) disclosing an art constituted from the claim.
2	Novelty : No, Inventive step : No Claim 2 lacks novelty as the indicated prior art of claim 3 meets each of the steps recited.	Novelty : No, Inventive step : No Same as above.
3	Novelty : No, Inventive step : No Claim 3 lacks novelty by definition in that it is indicated as prior art to applicant.	Novelty : No, Inventive step : No Same as above.
4	Novelty : Yes, Inventive step : No Claim 4 lacks an inventive step. The prior art of claim 3 teaches all the limitations of claim 4 save for the points being calculated against the cost of the transaction inclusive of taxes. However, it is indicated that a service method for granting points against the cost of the merchandise transaction taking taxes into account is prior art. Thus, it would have been obvious to those of ordinary skill in the art to modify the teachings of claim 3 to include granting points against the cost of the merchandise transaction taking taxes into account for the obvious advantage of maximizing the amount of points delivered to the designated person.	Novelty : Yes, Inventive step : No The claimed invention adds the following feature to Claim 3: "points issued against the merchandise transaction are calculated as those issued against the cost of the merchandise transaction inclusive of taxes." This feature is an item described in Document (d), thus the invention does not involve an inventive step.

<p>5</p>	<p>Novelty : Yes, Inventive step : Yes Claim 5 meets the criteria for novelty and inventive step as the stated prior art fails to teach that the number of points awarded in a service method for granting points are increased to 10 times the number of points normally awarded for the merchandise transaction in one out of every twenty transactions.</p>	<p>Novelty : Yes, Inventive step : No The claimed invention adds the following feature to Claim 3: “the number of points awarded are increased to 10 times the number of points normally awarded for that merchandise transaction in one out of every twenty transactions.” This feature is neither described in Document (c) nor Document (d). However, it is well-known to provide frequent customers with special services. Given that granting points is one of the services for customers, it would be easy to grant special points to frequent customers. Here, it is a matter of mere design modification to specify as to how many times of points are granted as the special points and how often the special points are granted. Thus the invention does not involve an inventive step.</p>
<p>6</p>	<p>Novelty : Yes, Inventive step : Yes Claim 6 meets the criteria for novelty and inventive step as the stated prior art fails to teach calling by the server a comprehensive list of merchandise, converting by the server the list into a list such that the merchandise available merely by redeeming the point value can be distinguished from other merchandise and sending by the server the converted list to the e-mail address of the designated person.</p>	<p>Novelty : Yes, Inventive step : Yes The claimed invention adds the following features to Claim 3: “calling by the server, a comprehensive list of merchandise from a merchandise information storing means for storing a list of merchandise corresponding with the name and price of the merchandise purchased or the number of points necessary for the purchase thereof; converting by the server, the comprehensive list of merchandise into a list, such that the merchandise available merely by redeeming the point value can be distinguished from other merchandise; and sending by the service, the notice that points were granted, attaching thereto the comprehensive list of merchandise as converted, to the e-mail address of the designated person.” These features are neither described in Document (c) nor Document (d), thus the invention involves an inventive step.</p>