

## **Trial decision**

Correction No. 2015-390097

Tokyo, Japan

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The case of trial for correction of Japanese Patent No. 5585946 has resulted in the following trial decision:

### **Conclusion**

The trial of the case was groundless.

### **Reason**

#### **No. 1 History of the procedures**

The patent application for the Japanese Patent No. 5585946 (hereinafter referred to as "the Patent"), for which the request for trial for correction of the case (hereinafter

referred as "the request of the case") was filed, had been filed on January 17, 2013 (Priority Date January 20, 2012) and the establishment of the patent was registered on August 1, 2014. The request of the case was filed on September 3, 2015 and the body notified the reason for refusal of correction on September 28, 2015 (drafting date) and gave the Demandant an opportunity to submit a written opinion within a designated period. Meanwhile, the Demandant has filed no response thereto.

#### No. 2 Object of the request and the content of the correction

The object of the request for case is to seek a trial decision, for the Patent in its entirety, to the effect that the correction to the Description and the scope of claims of the Patent shall be approved as described in the corrected Description and the corrected scope of claims attached to the written request for trial of the case. The content of the correction sought by the Demandant (hereinafter referred to as "the correction of the case") is as follows:

##### Correction A:

"decoded image" in Claims 1, 10, 11, 12, 17, 26, 27, and 28 of the scope of claims is to be corrected to read "current image."

##### Correction B:

"decoding the encoded image and generating the decoded image" in Claims 16 and 32 of the scope of claims is to be corrected to read "decoding the current image and generating the decoded image."

#### No. 3 Outline of the reason for refusal of correction

The outline of the reasons for refusal of correction notified by the body on September 28, 2015 is as follows: The correction of the case seeking Corrections A and B do not comply with the provision of Article 126(6) of the Patent Act and therefore the correction of the case cannot be approved.

#### No. 4 Judgment by the body

##### 1. Requirement under Article 126(6) of the Patent Act

##### (1) Regarding Correction A

Correction A is intended to correct "decoded image" in Claims 1, 10, 11, 12, 17, 26, 27, and 28 of the scope of claims to read "current image."

First of all, the term "current" does not appear in the Description that was

attached to the application. Accordingly, it is noted that the meaning of "current" should be interpreted according to its ordinary meaning as a person skilled in the art would generally use it.

Since the meaning of "current" in "current image" as corrected is, in normal cases, "of the present time," the term at issue does not involve a technical meaning such as "being decoded" or "being encoded."

In addition, as the term "of the present time" is used to restrict the "image" in a conceptually different way from the terms "being decoded" or "being encoded" and the image restricted by the term at issue can encompass an image that "is decoded," another image that "is encoded," or still another image that is neither encoded nor decoded. Accordingly, in contrast to the "decoded image" prior to the correction, the feature of the "current image" after the correction encompasses as its meaning the image that "is decoded," the image that "is encoded," or the image that is neither encoded nor decoded.

Hence, the matters of correction at issue enlarge or alter the scope of claims.

## (2) Regarding Correction B

Correction B is intended to correct "decoding the encoded image and generating the decoded image" in Claims 16 and 32 of the scope of claims to read "decoding the current image and generating the decoded image."

As has been stated in the previous section, the term "current" does not appear in the Description that was attached to the application and the meaning of "current" in "current image" as corrected is, in normal cases, "of the present time," so that the term at issue does not involve a technical meaning such as "being decoded" or "being encoded."

In addition, the term "of the present time" is used to restrict the "image" in a conceptually different way from the terms "being decoded" or "being encoded" and the image restricted by the term at issue can encompass an image that "is decoded," an image that "is encoded," or an image that is neither encoded nor decoded. Accordingly, in a literal sense, in contrast to "decoding the encoded image" prior to the correction, the feature of "current image" after the correction encompasses as its meaning the image that "is decoded," the image that "is encoded," or the image that is neither encoded nor decoded.

Therefore, the matters of correction at issue enlarge or alter the scope of claims.

Further, Claims 16 and 32 of the scope of claims refer back to the recitations of Claims 1 and 17 of the scope of claims, respectively. When the description of the scope of claims is corrected by incorporation of the Corrections A and B, then the "decoded

image" in Claim 1 (or Claim 17) prior to the correction should be read as "current image" after the correction whilst the "encoded image" of Claim 16 (or Claim 32) that further refers back to their recitations prior to the correction should be read as the "current image" after the correction. Hence, two distinct images; i.e., the "decoded image" appearing in Claim 1 (or Claim 17) prior to the correction and the "encoded image" appearing in Claim 16 (or Claim 32) prior to the correction, should denote one and the same "current image" after the correction.

Hence, the matters of correction at issue enlarge or alter the scope of claims.

#### No. 5 Closing

Accordingly, the request for trial of the case does not comply with the provision of Article 126(6) of the Patent Act.

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

December 1, 2015

Chief administrative judge: FUJII, Hiroshi

Administrative judge: WATANABE, Satoshi

Administrative judge: WATANABE, Tsutomu