

Trial decision

Correction No. 2016-390005

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The case of trial for correction for Japanese Patent No. 5759172 has resulted in the following trial decision.

Conclusion

The correction of the description and the scope of claims of Japanese Patent No. 5759172 to the corrected description and the scope of claims attached to the written demand for trial of the case shall be approved.

Reason

No. 1 History of the procedures

The patent application of Japanese Patent No. 5759172 in connection with the demand for trial for correction of the case was filed on Dec. 28, 2010, and the establishment of the patent right of the inventions according to claims 1 to 4 was registered on Jun. 12, 2015. Then, the trial for correction of the case was demanded on Jan. 14, 2016.

No. 2 Object of the demand and details of the correction

1. Object of the demand and details of the correction

The object of the demand for trial for correction of the case is to request, relative to the patent right of Japanese Patent No. 5759172 as a whole, correction of the description and the scope of claims to the corrected description and the corrected scope

of claims attached to the written demand for trial of the case, and the details of the correction are as follows. (Note added by the trial decision: Underlined portions are corrected portions.)

A Correction A

To correct "A fixing member used for a heat fixing device for an electrophotographic apparatus, the fixing member comprising: a base material; an elastic layer made of foamed silicone rubber; and a surface layer in this order, wherein, by causing a liquid silicone rubber mixture including silica gel as a foaming agent to be foamed and hardened, the foamed silicone rubber is formed." stated in claim 1 in the scope of claims of the patent of the case to "A method of producing a fixing member used for a heat fixing device for an electrophotographic apparatus, the fixing member including a base material, an elastic layer made of foamed silicone rubber, and a surface layer in this order, The method comprising forming the foamed silicone rubber by causing a liquid silicone rubber mixture including silica gel as a foaming agent to be foamed and hardened."

B Correction B

To correct "The fixing member" of claim 2 in the scope of claims of the patent of the case to "The method of producing the fixing member."

C Correction C

To correct "The fixing member" of claim 3 in the scope of claims of the patent of the case to "The method of producing the fixing member."

D Correction D

To delete claim 4 in the scope of claims of the patent of the case.

E Correction E

To correct "FIXING MEMBER AND FIXING DEVICE" stated in [Title of Invention] of the description of the patent of the case to "METHOD OF PRODUCING FIXING MEMBER."

F Correction F

To correct "The present invention relates to a fixing member used for an electrophotographic apparatus and to a fixing device using the same." described in paragraph [0001] of the description of the patent of the case to "The present invention relates to a method of producing a fixing member used for an electrophotographic apparatus."

G Correction G

To correct "Therefore, an object of the present invention is to provide a fixing

member including an elastic layer whose hardness decline is small even when it has been used as a fixing member of a heat fixing device for a long time. Furthermore, another object of the present invention is to provide a fixing device that exhibits stabilized fixing performance for a long term." stated in paragraph [0008] of the description of the patent of the case to "Therefore, an object of the present invention is to provide a method of producing a fixing member including an elastic layer whose hardness decline is small even when it has been used as a fixing member of a heat fixing device for a long time."

H Correction H

To correct "The present invention is of a fixing member used for a heat fixing device for an electrophotographic apparatus, and the fixing member includes a base material, an elastic layer made of foamed silicone rubber, and a surface layer in this order. The foamed silicone rubber is formed by causing a liquid silicone rubber mixture including silica gel as a foaming agent to be foamed and hardened." stated in paragraph [0009] of the description of the patent of the case to "The present invention is of a method of producing a fixing member used for a heat fixing device for an electrophotographic apparatus, the fixing member includes a base material, an elastic layer made of foamed silicone rubber, and a surface layer in this order. The method includes forming the foamed silicone rubber by causing a liquid silicone rubber mixture including silica gel as a foaming agent to be foamed and hardened."

I Correction I

To delete paragraph [0010] of the description of the patent of the case.

J Correction J

To correct "According to the present invention, there is provided a fixing member that is used for a heat fixing device for an electrophotographic apparatus and that is a fixing member of a small hardness decline under a high temperature and low oxygen atmosphere. In addition, by making the fixing device include the fixing member, a fixing device that expresses stabilized image performance for a long term is obtained." stated in paragraph [0011] of the description of the patent of the case to "According to the present invention, there is provided a method of producing a fixing member that is used for a heat fixing device for an electrophotographic apparatus and that is a method for producing a fixing member having a small hardness decline under a high temperature and low oxygen atmosphere."

No. 3 Judgment by the body

1. Regarding the correction A

(1) Purpose of the correction

The statement of claim 1 before correction is "A fixing member used for a heat fixing device for an electrophotographic apparatus," and, therefore, it is obvious that the subject of the invention of claim 1 before correction is a "fixing member," which is a "product."

Then, because it is specified in claim 1 before correction as "wherein, by causing a liquid silicone rubber mixture including silica gel as a foaming agent to be foamed and hardened, the foamed silicone rubber is formed," there is described a "production method" regarding "foamed silicone rubber" constituting an elastic layer provided in the fixing member.

Here, it has been held that " it is appropriate to construe that when a claim of a patent for an invention of a product recites the manufacturing process of the product, the recitation of the claim should be held to meet the requirement that the claimed invention is clear as prescribed in Article 36, paragraph (6), item (ii) of the Patent Act, only if there are circumstances where it was impossible or utterly impractical to directly define the product subject to the invention by means of its structure or characteristics at the time of the filing of the application " (the court decision on Jun. 5, 2015 by Second petty bench of Supreme court (2012 (Ju) No. 1204)).

Therefore, when examined based on the above holding, because there is described a method of producing "foamed silicone rubber" as "causing a liquid silicone rubber mixture including silica gel as a foaming agent to be foamed and hardened" in claim 1 before correction, there is a possibility of failing to meet the requirement of "invention shall be clear."

Then, correction A is a correction to revise claim 1 before correction that has a risk of failing to meet the requirement of "invention shall be clear" to claim 1 after correction that specifies, as "a method of producing a fixing member used for a heat fixing device for an electrophotographic apparatus, the fixing member including a base material, an elastic layer made of foamed silicone rubber, and a surface layer in this order" "forming the foamed silicone rubber by causing a liquid silicone rubber mixture including silica gel as a foaming agent to be foamed and hardened," and, thus, it satisfies the requirement of "invention shall be clear."

Accordingly, the correction in question is for the purpose of "clarification of an ambiguous statement" as prescribed in proviso item (iii) of Article 126(1) of the Patent Act.

(2) Regarding whether or not the correction is within the scope of the matters that have been described in the description, the scope of claims, and the drawings attached to the application

In paragraph [0009] of the description affixed to the application of the case, there is described as "The foamed silicone rubber is formed by causing a liquid silicone rubber mixture including silica gel as a foaming agent to be foamed and hardened," which corresponds to the invention of claim 1 after correction. Therefore, correction A is within the scope of the matters that have been described in the description, the scope of claims, and the drawings attached to the application of the case.

Therefore, correction A conforms to the prescription of Article 126(5) of the Patent Act.

(3) Regarding whether or not the correction is a correction that substantially expands or changes the scope of claims

A Regarding problem to be solved by the invention and a means for solving the problem

Article 126(6) of the Patent Act prescribes to the effect that a correction prescribed in the first paragraph shall not substantially expand or change the scope of claims under any circumstances.

In addition, in Article 24-2 of the Regulations under the Patent Act delegated under the provisions of Article 36(4)(i) of the Patent Act, there is prescribed that "A statement stipulated in the Ordinance of the Ministry of Economy, Trade and Industry for Article 36(4)(i) of the Patent Act shall be made by stating matters necessary for a person having common knowledge in the field of technology to which an invention pertains to understand the technical significance of the invention such as a problem to be solved by the invention, a means for solving the problem, and others." Therefore, whether or not the technical significance of the invention of claim 1 after correction is one that has substantially expanded or changed the technical significance of the invention of claim 1 before correction will be examined in terms of whether or not a problem to be solved by the invention and a means for solving the problem have been substantially changed between the invention of claim 1 before correction and the invention of claim 1 after correction.

From the statements of paragraphs [0008]-[0011] of the description of the patent of the case before correction, the problem to be solved by the invention of claim 1 before correction is "to make hardness decline of an elastic layer of a fixing member be

small even after long term of use," and the means for solving the problem is, regarding "an elastic layer made of foamed silicone rubber," "to form the foamed silicone rubber by causing a liquid silicone rubber mixture including silica gel as a foaming agent to be foamed and hardened."

On the other hand, from the statements of paragraphs [0008]-[0011] of the patent description of the case after correction, the problem to be solved by the invention of claim 1 after correction is "to make hardness decline of an elastic layer of a fixing member be small even after long term of use," and the means for solving the problem is, regarding "an elastic layer made of foamed silicone rubber," "to form the foamed silicone rubber by causing a liquid silicone rubber mixture including silica gel as a foaming agent to be foamed and hardened."

Consequently, there is no change at all between the problems to be solved by the invention of claim 1 before correction and by the invention of claim 1 after correction, and also there is no substantial change in the means for solving the problem between the invention of claim 1 before correction and the invention of claim 1 after correction.

Accordingly, the technical significance of the invention of claim 1 after correction is not one that substantially expands or changes the technical significance of the invention according to claim 1 before correction.

B Regarding unanticipated disadvantage to a third party due to the correction

The scope of claims is a scope in which "all of matters recognized as necessary to specify an invention for which a patent is sought" are described (Article 36(5) of the Patent Act).

In addition, Article 126(6) of the Patent Act is an article that prescribes that a correction prescribed in Article 126(1) of the Patent Act shall not expand or change the scope of claims substantially under any circumstances. When an invention that has been deemed not to be included in the scope of claims before correction comes to be included in the scope of claims after correction; that is, when an action that has been deemed not to fall under "working" of the invention before correction comes to be an action that falls under "working" of the invention after correction, there is a risk that an unanticipated disadvantage arises to a third party. For this reason, the Article 126(6) of the Patent Act secures that such situations are not caused.

Based on the above, whether or not an action falling under "working" of the invention of claim 1 after correction substantially expands or changes an action falling under "working" of the invention of claim 1 before correction will be examined by determining whether there is a difference between the actions falling under "working"

of each of the invention of claim 1 before correction and the invention of claim 1 after correction.

Here, working of "invention of product" prescribed in Article 2(3)(i) of the Patent Act (the invention of claim 1 before correction) and working of "invention of process of manufacturing the product" prescribed in Article 2(3)(iii) of the Patent Act (the invention of claim 1 after correction) will be compared.

Working of "invention of product" (item (i)) is an "action of producing, using, assigning and the like, exporting, or importing the product, or offering assignment and the like of the product," and working of "process of manufacturing the product" (item (iii)) is an "action of using the process" (item (ii)) as well as "an action of using, assigning and the like, exporting, or importing the product, or offering assignment and the like of the product" produced by that method. Here, "action of using the process" in working of "process of manufacturing the product" is understood as an "action of producing the product produced by use of that method," and, therefore, it corresponds to an action to "produce the product in question" in working of "invention of product."

Therefore, although there is a difference in a point that, in working of "invention of product," a method of manufacturing the product is not specified, whereas, in working of "invention of process of manufacturing the product," a method of manufacturing the product is specified to "that method," the aspects of the working actions correspond to each other entirely.

Then, the invention of claim 1 before correction is "invention of product" in which a product as a "fixing member" is specified by a production method of "as the foamed silicone rubber, liquid silicone rubber mixture including silica gel as a foaming agent is caused to be foamed and hardened" (hereinafter, referred to as a "specified production method"). Therefore, in addition to a "fixing member" manufactured by the specified production method, a product having a structure and attributes identical with those of the "fixing member" manufactured by the specified production method is also included in working of the patent invention.

On the other hand, because the invention of claim 1 after correction is "invention of process of manufacturing the product" in which a method of "the method of producing a fixing member" is specified by the specified production method mentioned above, a "fixing member" manufactured by the specified production method is included in working of the patent invention.

Accordingly, the actions falling under "working" of the invention of claim 1 after correction are totally included in actions falling under "working" of the invention of claim 1 before correction, and there is no risk of causing an unanticipated disadvantage for a third party, and, therefore, it cannot be said that they substantially expand or change the actions falling under "working" of the invention of claim 1 before correction.

C Summary

The technical significance of the invention of claim 1 after correction does not substantially expand or change the technical significance of the invention of claim 1 before correction, and it cannot be said that an action falling under "working" of the invention of claim 1 after correction substantially expands or changes an action falling under "working" of the invention of claim 1 before correction. Therefore, the correction A is not one that substantially expands or changes the scope of claims, and it conforms to the prescriptions of Article 126(6) of the Patent Act.

2. Regarding the corrections B and C

Due to reasons similar to that of the above-mentioned "1.", the corrections in question fall under corrections aiming at "clarification of an ambiguous statement" prescribed in proviso item (iii) of Article 126(1) of the Patent Act, and, in addition, they conform to the prescriptions of Article 126(5) and Article 126(6) of the Patent Act.

3. Regarding the correction D

The correction D mentioned above is one to delete claim 4, and, thus, it is a correction aiming at restriction of the scope of claims.

Therefore, the correction in question corresponds to one aiming at "restriction of the scope of claims" prescribed in proviso item (i) of Article 126(1) of the Patent Act, and, in addition, it conforms to the prescriptions of Article 126(5) and Article 126(6) of the Patent Act. Furthermore, because a reason that the demandant should not be granted a patent for the invention of claim 1 after correction independently at the time of patent application is not found, the correction in question conforms to the prescriptions of Article 126(7) of the Patent Act.

4. Regarding the corrections E-J

The corrections E-J above are ones that, in association with the corrections A-D

mentioned above, match statements in the scope of claims and the description, and, therefore, they are ones that aim at clarification of an ambiguous statement.

Therefore, the corrections in question fall under ones aiming at "clarification of an ambiguous statement" prescribed in proviso item (iii) of Article 126(1) of the Patent Act, and, in addition, conform to the prescriptions of Article 126(5) and Article 126(6) of the Patent Act.

No. 4 Closing

As described above, the corrections A to J concerning the demand for trial of the case are ones that aim at the matters prescribed in proviso item (i) and item (iii) of Article 126(1) of the Patent Act, and, in addition, they conform to the prescriptions of Article 126(5), (6), and (7) of the Patent Act.

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

Mar. 15, 2016

Chief administrative judge: TANJI, Akira

Administrative judge: KUROSE, Masakazu

Administrative judge: FUJIMOTO, Yoshihito

Administrative judge: YOSHIMURA, Hisashi

Administrative judge: CHIBA, Shigenari