

Trial decision

Correction No. 2016-390083

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Demandant

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The case of trial for correction regarding patent No. 4638950 has resulted in the following appeal decision.

Conclusion

The correction of the scope of claims of Japanese Patent No. 4638950 shall be approved as the corrected scope of claims attached to the written demand for trial of the case.

Reason

No. 1 History of the procedures

Application for Japanese Patent No. 4638950 (hereinafter referred to as the "Patent") subjected to the demand for trial for correction was filed on April 30, 2009 (Internal Priority Date: on September 1, 2008) and the patent right was registered on December 3, 2010.

The trial for correction was requested on June 22, 2016.

No. 2 Object of the demand

The gist of the request for trial is to demand the appeal decision that the correction of the scope of claims of Japanese Patent No. 4638950 is approved as the corrected scope of claims attached to the written demand for trial of the case.

No. 3 Details of the Correction

The details of the Correction are as follows.

Correction A

"Metal salts" in claim 2 in the scope of claims is corrected to "zinc salts."

Claims 3-5 which are dependent on claim 2 are corrected equally.

No. 4 Judgment by the body

1. Propriety of the purpose of the correction

Correction A is a correction that change "metal salts" stated in claim 2 in the scope of claims into "zinc salts." Since the relation of "metal salts" and "zinc salts" is apparently that of a generic concept and a more specific concept in light of common general knowledge, the correction aims at restriction of the scope of claims.

The correction of claims 3-5, which are directly or indirectly dependent on claim 2, are also those that restrict the scope of claims equally.

Therefore, correction matter 1 aims at the restriction of the scope of claims in accordance with item (i) of the proviso to Article 126(1) of the Patent Act.

2. Presence or absence of addition of new matter

It is stated in the paragraph [0018] in the description attached to the application that "The fatty acid and/or the derivative of the fatty acid is not particularly limited. Examples of the fatty acid may include aliphatic carboxylic acids derived from vegetable oils such as coconut oil, palm kernel oil, camellia oil, olive oil, almond oil, canola oil, peanut oil, rice bran oil, cacao butter, palm oil, soybean oil, cottonseed oil, sesame oil, linseed oil, castor oil, and rapeseed oil; aliphatic carboxylic acids derived from animal oils such as beef tallow; aliphatic carboxylic acids chemically synthesized from petroleum or the like; stearic acid; palmitic acid; myristic acid; lauric acid; caprylic acid; oleic acid; and linoleic acid. Examples of the derivative may include metal salts such as zinc salt, calcium salt, and magnesium salt. Also, commercially available processing aids containing these fatty acids can be suitably used. Among them, the metal salts of an aliphatic carboxylic acid, particularly a zinc salt of an aliphatic carboxylic acid, are desirably used, due to their good vulcanization reversion resistance." (the underlines are applied by the body.) "Zinc salt" is considered to be stated as a specific example of "metal salts".

Therefore, Correction A is a correction within the scope of the matters stated in the description, the scope of claims, or the drawings attached to the application and falls under the provisions of Article 126(5) of the Patent Act.

3. Presence or absence of substantial enlargement and alteration of the scope of the claims

Correction A is a correction that restricts "metal salts" stated in claim 2 in the scope of claims into "zinc salts" as stated in 1 above. Therefore, the correction aims at the restriction of the scope of claims.

Accordingly, Correction A is not a correction that aims at altering category, target, or purpose and therefore it does not substantially enlarge or alter the scope of claims and falls under the provisions of Article 126(6) of the Patent Act.

4 Judgment on independent requirements for patentability

No reason is found to conclude that the invention stated in the corrected claims 2-5 in the scope of claims should not be granted a patent.

Therefore, the invention stated in the corrected claims 2-5 in the scope of claims falls under the provisions of Article 126(7) of the Patent Act.

No. 5 Closing

As described above, the correction subjected to the demand for trial for correction aims at a correction in accordance with item (i) of the proviso to Article 126(1) of the Patent Act and falls under the provisions of Article 126(5) to (7) of the Patent Act.

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

August 16, 2016

Chief administrative judge: WADA, Yuji
Administrative judge: KOHARA, Ichiro

Administrative judge: SHIMADA, Shinichi