

## Trial Decision

Correction No. 2016-390092

UK

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With respect to the case of trial for correction of Japanese Patent No. 5581328, a decision is made as follows.

### Conclusion

It is approved that the specification and the scope of claims of Japanese Patent No. 5581328 are corrected to the corrected claims [14-17], as described in the corrected specification and the corrected scope of claims attached to the present Written Trial for Correction.

### Reason

#### No. 1 History of the procedures

Japanese Patent No. 5581328 was established on July 18, 2014 for claims 1-17 of Japanese Patent Application No. 2011-538056, filed on the international filing date, November 27, 2009, with priority under the Paris Convention (Priority Data: November 27, 2008 (GB); December 11, 2008 (EPO)), and the present trial for correction against the patent right was then demanded on July 5, 2016.

#### No. 2 Object of the demand and content of Correction

The object of the demand for trial of the case is to request corrections of the specification and the scope of claims of Japanese Patent No. 5581328, to a group of claims consisting of claims 14-17, as described in the corrected specification and the corrected scope of claims attached to the present Written Trial for Correction, and the content of the corrections are as stated in the following Corrections A-C.

#### 1 Correction A

Claims 14, 15, 16, and 17 prior to the correction are cancelled.

#### 2 Correction B

Paragraphs [0051], [0052], [0078]-[0084], and [0109]-[0111] in the specification originally attached to the request, are cancelled.

#### 3 Correction C

Of "... produced by the spray method outlined in Example 12 using ..., " described in paragraph [0115] of the specification originally attached to the request, the description "outlined in Example 12" is deleted.

#### No. 3 Judgment by the Body

##### 1 A group of claims

(1) All of claims 15-17 prior to correction refer to claim 14 prior to correction, and therefore claims 14-17 correspond to a group of claims, and thus demanding a correction for "a group of claims consisting of claims 14-17" complies with the provisions of Article 126, paragraph 3 of the Patent Law.

(2) It is deemed that corrections of the specification originally attached to the request, Corrections B and C, are involved in a group of claims (claims 14-17) according to Correction A, as stated in the following "items 2 (2) and (3)," and the corrections according to Corrections B and C are directed to all of the above group of claims; and therefore the corrections comply with the provisions of Article 126, paragraph 4 of the Patent Law.

##### 2 Purpose of correction

(1) Correction A is intended to cancel claims 14-17, and therefore this aims at restriction of the scope of claims which complies with the provisions of Article 126, paragraph 1, the proviso, item 1 of the Patent Law.

(2) Correction B is to cancel paragraphs [0051], [0052], [0078]-[0084], and [0109]-[0111] in the present specification. The invention of claim 14 to be cancelled by Correction A relates to adding silver to cellulose alkylsulfonate, while paragraphs [0051], [0052], and [0078]-[0084] explain "adding silver to cellulose alkylsulfonate," and <Example 12> in paragraphs [0109]-[0111] describes that a solution of silver is

sprayed on cellulose ethylsulfonate; and therefore all of the deletions of these paragraphs correspond to deletion of "adding silver to cellulose alkylsulfonate," and correspond to deletion of a part of the Detailed Description of the Invention, which has been inconsistent with the corrected claims, as a result of the correction according to the above Correction A, thereby allowing the descriptions of the Detailed Description of the Invention to be consistent with the corrected claims. Thus, the deletion is intended to achieve clarification of an ambiguous description, as prescribed in Article 126, paragraph 1, the proviso, item 3 of the Patent Law.

(3) Correction C is to delete "outlined in Example 12" in paragraph [0115]. As a result of deleting <Example 12> by the above Correction B, the Detailed Description of the Invention does not include <Example 12>, and since such deletion corresponds to deletion of an ambiguous description, Correction C is intended to achieve clarification of an ambiguous description, as prescribed in Article 126, paragraph 1, the proviso, item 3 of the Patent Law.

### 3 Not add new matter, and not substantially extend or change the scope of claims

Since all of Correction A-3 are intended to deletion, it is obvious that the corrections were made within the scope of the matters described in the specification, the claims, or the drawings originally attached to the request, and they do not substantially extend or change the scope of claims.

Therefore, the corrections according to the above Corrections A-C comply with the requirements prescribed in Article 126, paragraphs 5 and 6 of the Patent Law.

### 4 Judgment on independent requirements for patentability

No reason has been found, for which the inventions specified by the matters described in the corrected claims could not have been independently patentable at the time the present application was filed.

Therefore, the corrections according to the above Corrections A-C comply with the requirements prescribed in Article 126, paragraph 7 of the Patent Law.

### No. 4 Closing

For the above reasons, the corrections of a group of claims in the present correction appeal are intended to the matters provided in the provisions of Article 126, paragraph 1, the proviso, items 1 and 3 of the Patent Law, and comply with the provisions of Article 126, paragraphs 3 to 7 of the Patent Law.

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

August 22, 2016

Chief administrative judge: NAITO, Shinichi

Administrative judge: OGAWA, Keiko

Administrative judge: SAITO, Mitsuko