

33-00 P U D T

Oral Proceeding Method

1.Oral Proceeding Method and Its Advantage

A method of oral proceedings includes document proceedings and oral proceedings. An invalidation trial is supposed to be conducted by oral proceedings in principle (the Patent Act Article 145, the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Article 56).

Oral proceedings have advantages that the panel may correctly understand the issues by drawing out the allegation of a party concerned that cannot be fully stated in documents through the inquiry of a chief administrative judge. Oral proceedings have another advantage that the panel may understand accurately the technical contents by receiving an explanation of a party concerned.

Since sufficient oral statements are made in oral proceedings, a party concerned may not be necessary to submit a second written reply or written refutation, and as a result, there is one aspect that oral proceedings may be carried out faster than document proceedings.

In addition, there is another aspect in oral proceedings that positive presidency of the proceedings are conducted so that a party concerned may allege only on the necessary issues and allegation and proof other than the issues may be omitted.

2.Difference of Oral Proceedings in Civil Litigation

Oral proceedings of the JPO are different from ones in civil litigation in that presidency of the proceedings based on ex officio may be conducted. Thereby, oral proceedings of the JPO may lead an optimal solution of a case

by devising different ways according to the case.

The proceedings of the JPO may be conducted by oral proceedings or documentary proceedings. Therefore, even when oral proceedings are conducted, all submitted documents are deemed to be valid statements at a trial/appeal.

Therefore, oral proceedings of the JPO are different from ones in civil litigation: they are significant to realize appropriate allegation and proof of a party concerned by the inquiry and organization of issues by a chief administrative judge, but they do not have a legal significance to orally state what was submitted in documents in front of administrative judges.

(Revised Feb 2015)

33-00.1 P U D T

Trial and Appeal Cases Subject to Oral Proceedings and Timing for Selecting Those Cases

1. Trial and Appeal Cases Subject to Oral Proceedings

Application of oral proceedings is considered particularly valid for the following types of cases.

- (i) Trial for invalidation (patent, utility model, design, trademark)
- (ii) Trial for rescission (trademark)
- (iii) Opposition to registration of trademark (trademark)
- (iv) Advisory opinion (patent, utility model, design, trademark)

Regarding a trial for invalidation, for promptly organizing issues and conducting the proceedings precisely, and for enhancing reliability between parties concerned and satisfaction, all cases except the cases below shall be conducted by oral proceedings in principle (→ 51-09 2.).:

(1) when a demand for trial or procedures for a demand for trial (a written demand for trial) should be rejected;

Example: when the present demand for invalidation trial is rejected because invalidation is fixed and binding by another invalidation trial on the same patent right, etc.

(2) when it is apparent that parties concerned do not dispute;

Example: when a written reply or refutation is not submitted, claims subject to an invalidation trial are all cancelled by a request for correction, parties concerned state not to dispute, etc.

(3) when all parties concerned (and intervenors) allege documentary proceedings; and

(4) other than the above, when it is determined that there is no need to conduct oral proceedings.

2. Timing for Selection

It is preferable to select the timing for oral proceedings as below.

(1) Case of inter-partes trial

A. At the stage of submission of a written reply from a demandee (it includes when there is no reply to the demand for a trial. When a request for correction is filed, after refutation if necessary.)

B. At the early stage of the proceedings, such as before filing a written reply, immediately after filing a written reply (a request for correction).

It is considered for the following situations that oral proceedings focused on explanation of a party concerned are conducted at the early stage of the proceedings: when,

- (A) the technical content is complex and sophisticated so that it takes time to understand the details;
- (B) it is difficult to understand the background of the art and theory which is the premise of the statement;
- (C) a statement of parties concerned is unclear or is contradictory each other;
- (D) lots of evidence are submitted so that it takes time to organize and understand the details of the evidence; and
- (E) it is unclear a purpose of submitted evidence.

(2) Opposition to registration of trademark

A. When starting the proceedings of the case

B. When a written opinion is submitted from a trademark owner to a notice of reasons for refusal

(Revised Feb 2015)

33-01 P U D T**Designating a Date of Oral Proceedings**

1. A date of oral proceedings may be adjusted by a written request for adjustment of date (Form 1) between a demandant, a demandee, an opponent of an opposition to registration of trademark, and a right holder or an agent. In that case, a written notice of proceeding matters (→ 33-08), etc. shall be sent by facsimile or e-mail to parties concerned with a written request for adjustment of date. A date is sometimes decided before sending a written notice of proceeding matters.

2. Summons for appearance date shall be made by a simple method such as a telephone, facsimile or e-mail (the Patent Act Article 151 → Code of Civil Procedure Article 94, the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Article 56). A written confirmation of date (Form 2) is requested for parties concerned to confirm the appearance by facsimile or e-mail. A summons informing oral proceeding date shall be served under Form 3 to parties concerned in the following cases:

- (i) when it is not able to contact with a party concerned on the phone; and
- (ii) when a party concerned requests a summons.

3. A summons informing oral proceeding date shall be in principle served 2 weeks before the date.

4. When a summons informing oral proceeding date is not possible to serve, it is served by public notification.

When the oral proceeding date is designated before the day when service by public notification shall take effect (following the duration of 20 days from the

day the notification is published in the Official Gazette), public notification shall be served after the date is changed (→ 33-02.2).

5. When it is necessary to conduct another oral proceedings after the oral proceedings, it is preferable to inform the date for parties concerned appeared in court (→ 33-01.1).

(Revised Dec 2020)

[Form 1] Request for adjustment of date

Facsimile Transmission Sheet

Date:

TO: Mr./Ms.

(Name of patent firm)

Tel

Fax

Number of pages
(including this sheet)

Request for adjustment of oral proceeding date and
a written notice of proceeding matters for Invalidation Trial Case of
Invalidation No. 20XX-800○○○○

Patent No.○○○○○○○○

Demandant ○○○○

Demandee ○○○○

1. Request for adjustment of oral proceeding date

A date for the oral proceedings is scheduled to be one of the following
dates by a chief administrative judge. Please adjust the date and send
this form back to the sender by facsimile or e-mail.

The oral proceedings are scheduled for about ○ hours.

Date	Starting time	Your convenience
20○○/month/date (Wednesday)	From PM(time)	
20○○/month/date (Thursday)	From PM(time)	
20○○/month/date (Friday)	From PM(time)	

※ Please fill in ○ for the convenient day or × for the inconvenient day

2. A written notice of proceeding matters

Matters proceeding at the oral proceedings are listed in a written notice of proceeding matters in a separate sheet (a date for oral proceedings is blank) for your advance preparation.

After the date is fixed, the same notice with the fixed date shall be sent again by mail (there is no change made in proceeding matters).

Sender ○○○○

Infringement and Invalidation Affairs Office,
Trial and Appeal Department, JPO

Tel:03(3581)1101

(Ext. XXXX)

FAX:03(3584)XXXX

[Form 2] Request for Date

Written Confirmation of Date

Date:

To: Chief Administrative Judge, JPO

Agent of Demandant

Agent of Demandee

Demandant ○○○○○

Demandee ○○○○○

Regarding Invalidation No.20XX—800○○○

Invalidation trial case on Patent No. ○○○○○○○ between the above parties,
 we confirmed the date of oral proceedings held by a court of the JPO
 on 20XX/month/date (day of the week) AM • PM(time)

Note: This form can be used for simple summons, a verbal notice of date
 for oral proceedings, etc.

[Form 3] Summons informing oral proceeding date

Summons Informing Oral Proceeding Date

Trial Number Invalidation No.20XX－800○○○

(Patent No.) (Patent No.○○○○○○○○)

Draft Date

Chief Administrative Judge

Agent for Demandant Mr./Ms.

Demandant for Trial ○○○○

Demandee for Trial ○○○○

The oral proceeding date for this trial case is designated on 20XX/month/date (day of the week), PM(time). You are requested to appear in court of the JPO (○th Floor).

If a person who is summoned does not appear in court without any legitimate reasons, that person may be punished with a fine of 100,000yen or less.

(Note)

If you have any query on this letter, please contact below.

Infringement and Invalidation Affairs Office, Trial and Appeal Department, JPO

Tel: 03(3581)1101 (Ext. XXXX) FAX: 03(3584)XXXX

(Revised December 2020)

33-01.1 P U D T**Notification of the Designated Date of Oral Proceedings**

The chief administrative judge may notify the date of oral proceedings to parties concerned or interveners who appeared in court for the case in question. It is not necessary to serve a summons informing a date of oral proceedings at this time (the Patent Act Article 145(4) → Code of Civil Procedure Article 94, the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Article 56).

1. Those who notify of the date

A chief administrative judge shall notify of the date.

2. Those who receive the notification

Parties concerned or interveners who appeared in court, or their agent may receive the notification of the date/

A person who “appeared in court for the case in question” means the person appeared at the JPO is intended to conduct the matters related to the trial case in question including the proceedings, inquiry, interview, access to records, etc.

When a person appeared at the JPO for another case, the notification of the date cannot be given.

3. Matters to be notified

A date and a place for the oral proceedings shall be notified.

A date shall be determined after adjusting the schedules of a panel, both parties and a trial clerk, thus, in principle, this notification is given during

both parties appeared at the JPO.

A place shall be specified any of a trial court, the first trial court, the second trial court, a shared meeting room or an interview room.

4. Matters that require attention in notifying the date

When a chief administrative judge notifies the date, he/she shall sufficiently discuss with a trial clerk in advance on a date of oral proceedings including availability of a trial court, etc.

Even if the oral proceedings include examination of evidence, such as examination of witness, it is possible to notify a date to parties concerned who appeared at the JPO.

5. Records of notification of the date

A chief administrative judge shall record to the effect that the date of oral proceedings is designated and such the date in a trial record, or a record of interview.

(Revised July 2005)

33-02 P U D T

Change of the Designated Date of Oral Proceedings

When a chief administrative judge designates the date of oral proceedings, he/she may change the date by request or ex officio (the Patent Act Article 5(2), the Utility Model Act Article 2-5(1), the Design Act Article 68(1), the Trademark Act Article 77(1)).

1. Change of Date by Request

A request for changing the date should clear the reason of change the date (Enforcement Regulations of the Patent Act Article 4-2(2)(3), Enforcement Regulations of the Utility Model Act Article 23(1), Enforcement of Regulations of the Design Act Article 19(1), Enforcement of Regulations of the Trademark Act Article 22(1), Rules of Civil Procedure Article 36).

(1) In a case where change of the date is accepted

A. When consent of the other party (Note 1) is indicated in a request for change of the date

B. When a good reason (Note 2) is specifically described in a request for change of the date. It does not matter whether there is consent of the other part.

(2) In a case where change of the date is not accepted (Enforcement Regulations of the Patent Act Article 4-2(4), Enforcement Regulations of the Utility Model Act Article 23(1), Enforcement Regulations of the Design Act Article 19(1), Enforcement Regulations of the Trademark Act Article 22(1), Rules of Civil Procedure Article 37).

A. When one of the parties has two or more agents, and one of the agents has a reason of requesting for change of the date.

B. When the same date and time is designated for the date of another case after the date of the case is fixed.

C. When there is a request for change of the date immediately before the designated date, and there is no likelihood of announcing the change to a witness and other persons who are summoned on the designated date. It does not matter whether there is consent of the other party

2. Change of Date Ex Officio

A chief administrative judge changes a date of oral proceedings ex officio only when there is an unavoidable reason.

3. Procedures for Change of Date

(1) When the date is changed by request or ex officio, a new date should be determined as early as possible after the designated date unless there are special circumstances.

(2) Procedures for a new designated date (→ 33-01)

(Note 1) The other party means the other party as a party concerned, and it does not include an intervener, an applicant for intervention and an opponent of opposition to registration of trademark.

However, if a party concerned requests the change of the date to examine a witness who is offered by an intervener, an applicant of intervention and an opponent of opposition to registration of trademark, the intervener, the applicant for intervention and the opponent of opposition to registration of trademark shall be considered as the other party.

(Note 2) [Examples of a good reason]

(1) When a reason for not being able to appear is clear under the situation that a party concerned without an agent, an agent or a witness is sick and a medical certificate of doctor

is attached.

- (2) When the designated date is competed with the previously designated date of court or oral proceedings of trial.
- (3) When a reason for not being able to appear is clear under the situation that a party concerned without an agent, an agent or a witness is in official business or other unavoidable conditions.
- (4) When there is a reason equivalent to (1), (2) or (3) with the third party's certificate, and a chief administrative judge admits as a good reason.

(Revised March 2012)

33-03 P U D T**Procedure for Handling a Situation Where a Person Is not
Appearing on the Designated Date****1. Those who appear in court**

(1) Those who may appear in oral proceedings are a party concerned (a representative for corporation), an agent, an intervener and an interpreter.

An example of an agent is shown below.

A. A patent attorney, a lawyer, a designated agent, etc. who has already taken procedures to become an agent before the JPO.

B. A patent attorney or a lawyer who brings a power of attorney

That's all for the desired appearance. When a party concerned clarifies unavoidable circumstances and a chief administrative judge admits such circumstances, an employee, etc. of said party concerned who brings a power of attorney is also accepted. This corresponds to an inventor who explains highly specialized technical matters, for example.

(2) In a case where a person who appears in court does not show a power of attorney and desires to appear in oral proceedings, when a chief administrative judge admits it is appropriate the appearance, the proceedings are conducted upon asking the other party's opinion and a power of attorney shall be submitted later. If there is no submission of a power of attorney, the statement made in court becomes invalid, thus such circumstances shall be clarified in a trial record.

(3) A person who may not become an appearance, he/she is considered as an audience.

The staff of a patent firm who do not have a qualification of a patent attorney, etc. may not be an appearance.

An employee who belongs to a corporation different from a corporation of a party concerned may not be an appearance.

2. When Not Appearing on the Designated Date

A person who is summoned to the JPO fails to appear without any legitimate reasons, he/she is subject to punishment by fines not exceeding of 100,000 yen (the Patent Act Article 203, the Utility Model Act Article 63, the Design Act Article 76, the Trademark Act Article 84).

3. When Both Parties Not Appearing on the Day of Oral Proceedings

When both parties do not appear on the day of oral proceedings, the oral proceedings may not be conducted substantially. In that case,

(1) When an examination of witness is not scheduled on the same date of oral proceedings, only a trial record of oral proceedings (→ 33-04) is prepared describing the fact that both parties are not appearing.

(2) When an examination of witness is scheduled on the same date of oral proceedings,

A. if a witness does not appear in court, apply the above (1).

B. if a witness appears in court, only an examination of witness may be conducted (the Patent Act Article 151, the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4), Code of Civil Procedure Article 183). In this case, a chief administrative judge examines a witness mainly based on a document describing the examination matters submitted by a person who requests an examination of witness. As a result, a trial record of oral proceedings describing the fact that both parties did not appear in oral proceedings and an examination record of witness both are prepared.

4. When One of the Parties Not Appearing on the Date of Oral Proceedings

When one of the parties is not appearing on the date of oral proceedings, the oral proceedings is conducted in principle.

- (1) When an examination of witness is not scheduled on the same date of oral proceedings, only a trial record of oral proceeding is prepared.
- (2) When an examination of witness is scheduled on the same date of oral proceedings,

A. if a witness does not appear in court, apply the above 3. (1).

B. if a witness appears in court, an examination of witness may be also conducted (the Patent Act Article 151, the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4), Code of Civil Procedure Article 183). As a result, a trial record of oral proceedings and an examination record of witness are both prepared.

In an examination of witness,

- (A) When a party concerned on the side of requesting an examination of witness appears in court, such a party concerned mainly examines the witness.
- (B) When a party concerned on the side of requesting an examination of witness does not appear in court, but the other party appears in court, an examination of witness is conducted in a similar manner of the above 3. (2) B. However, the other party is obviously given an opportunity of a cross-examination.

(Revised October 2015)

33-04 P U D T**Guidelines for Trial Records of Oral Proceedings**

1. A trial record of oral proceedings shall be prepared by a trial clerk by each trial date (the Patent Act Article 147(1), the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)).

2. A trial record of oral proceedings is an official document prepared to notarize the content of oral proceedings.

3. The formal information is entered in the designated places of a trial record of oral proceedings under Form 1, such as a trial case number, a date, public or private proceedings (and a reason thereof), a place, a name of person appearing in court, a name of members of panel (a name of administrative judges), a name of trial clerk, and then a name of persons making a statement and a brief statement of the main point of the statement are also recorded in the form.

The record allows to include a document, a photo, a recording tape, a video tape, and things that the judges deem appropriate for citing, and they may become a part of the record by attaching therewith (Enforcement Regulations of the Patent Act Article 56, Enforcement Regulations of the Utility Model Act Article 23(12), Enforcement Regulations of the Design Act Article 19(8), Enforcement Regulations of the Trademark Act Article 22(6), Rules of Civil Procedure Article 69).

Please note the following points in preparing the statement.

(1) When a statement is made based on a document such as a written demand for trial or a written reply, the record includes that a statement is as stated in such a document by specifying the document, a submission date, and applicable parts (page, item) of the document if necessary.

Other items such as the content of presidency of the proceedings of a chief administrative judge, or a statement of opinion, allegation and objection of parties concerned are clearly indicated in the record. If a chronological order is required for remarks of parties concerned or a chief administrative judge, the remarks are described in a chronological order.

The details are described in the record when allegation or means of proof is withdrawn, or establishment of evidence is asked to approve.

(2) When a statement is made on the matters not included in a written demand for trial, a written reply, etc., a chief administrative judge repeats the statement to confirm the content of the statement of a party concerned and a trial clerk is directed to record such matters.

When a content to be stated is rather long and complicated or unclear, a chief administrative judge may order to submit in writing later. In that case, the record includes such direction and later submission of a written statement (a due date and means of submission).

(3) When a chief administrative judge notifies of a conclusion of the proceedings, reaching the point at which a

decision on the trial can be rendered of the case, or document proceedings in future, a trial clerk records accordingly.

(4) When a decision of permissibility of amendment not in writing, a notice of reasons for invalidation, or a notice of reasons for rejection of correction, etc. is notified, a trial clerk records accordingly.

(5) In oral proceedings, an examination of evidence (→35-01) may be conducted at the same time. In that case, an examination of evidence is conducted as stated in an examination record of evidence (→35-02) prepared separately from a trial record of oral proceedings, a trial clerk records accordingly and indicates at what stage of the oral proceedings an examination of evidence is the made.

(6) When exclusion or recusation is requested orally, presidency of the proceedings of a chief administrative judge is specifically recorded accurately and closely, if a written explanation is submitted within 3 days and a trial for exclusion or recusation (→58-01~05) is filed, the procedure is taken to duplicate this part of the record and continuously file in a case record.

4. After preparing, a trial clerk shall send a copy of a trial record of oral proceedings to both parties concerned by facsimile or e-mail (excluding an examination record of evidence, a record citing a recording tape, etc.).

(Revised December 2020)

[Form 1] Trial Record of Oral Proceedings

1 st Trial Record of Oral Proceedings	
Trial No.	
Invalidation 2 0 ○ ○ – 8 0 0 ○ ○ ○	
Date	
Date and Time (AM/PM)	
Place and Open/Close to the Public	
Open to the Public at Trial Court at the JPO	
Chief Administrative Judge	○ ○ ○ ○
Administrative Judge	○ ○ ○ ○
Administrative Judge	○ ○ ○ ○
Trial Clerk	○ ○ ○ ○
Those Who Appear in Court(Parties Concerned, etc.)	
Patent Attorney of Demandant	○ ○ ○ ○
Patent Attorney of Demandant	○ ○ ○ ○
Patent Attorney of Demande	○ ○ ○ ○
Patent Attorney of Demande	○ ○ ○ ○
Point of Statement	
Demandant	
1	< Point of statement of a party concerned >
2	< Matters to be described by order of a chief administrative judge >
3	< Matters permitted to be described by a chief administrative judge by a request of a party concerned >
4	< Other necessary matters >
Demande	
1	< Point of Statement of a party concerned >
2	< Matters to be described by order of a chief administrative judge >
3	< Matters permitted to be described by a chief administrative judge by a request of a party concerned >
4	< Other necessary matters >
Chief Administrative Judge	
1	< Matters to be described by order of a chief administrative judge >
2	< Matters permitted to be described by a chief

administrative judge by a request of a party
concerned >

3 < Other necessary matters >

Chief Administrative Judge

Administrative Judge at JPO

Trial Clerk

○ ○ ○ ○

○ ○ ○ ○

(Revised June 2019)

33-05 P U D T
Order of Oral Proceedings

1. Preparation

(1) Place for oral proceedings

A. When an examination of evidence is not conducted with oral proceedings, in principle, any one of the Trial Court (the JPO), the First Trial Court (METI Annex (1st floor)), the Second Trial Court (METI Annex (1st floor)) shall be selected. However, if the oral proceedings are certainly open to the public, a conference room or an interview room is also possible to use for the oral proceedings (→ 07-01).

B. When an examination of evidence is conducted with oral proceedings, the Trial Court or the First Trial Court is used for the proceedings. The Trial Court is an IT trial court equipped with IT equipment, and it is possible to provide technical explanation using a video, etc. and inspection of an actual thing and an object using a document camera.

C. In addition to the above A and B, a circuit trial examination is another possibility as a place to conduct oral proceedings where a panel visits every region of the country.

(2) Pre-meeting of oral proceedings and a notice of proceeding matters

A. A chief administrative judge, an administrative judge panel, and a trial clerk have a pre-meeting on how to proceed the oral proceedings including a brief explanation of the case, major issues, a point for recording, etc.

B. For smooth conduct of productive proceedings, a panel notifies the parties concerned of the matters to be examined on the proceeding date by a notice of proceeding matters (→ 33-08) beforehand, and based on that, encourages preparation of oral proceeding statement brief, etc. A notice of

proceeding matters is, in principle, sent after the date of oral proceeding is fixed, but for allowing a sufficient preparation period, even before the date is fixed, the details of the notice sent afterwards is provided by a facsimile or e-mail.

(3) Proceeding open to the public

- A. The oral proceedings should be open to the public for enhancing the fairness of a trial. However, if the disclosure is likely to be contrary to public order and morality, or if a trade secret obtaining a party concerned or an intervener is likely to become public, the oral proceedings is not open to the public.
- B. In each case, after the case adopts oral proceedings, a panel decides whether the oral proceedings should be open to the public.
- C. A date and place of oral proceedings are publicly notified for enhancing transparency.

(4) Preparation of a trial clerk

- A. A schedule of trials in court for each month is notified on a bulletin board in the lobby, the first floor of the JPO. It is also notified on the JPO's website.
- B. In the morning of the date of oral proceedings, a trial court case of the day is displayed on a bulletin board at the front of each trial court.

2. From Opening of Court to Adjourning Court

(1) Opening of court

After a court attendant calls the case, a chief administrative judge shall confirm those who appear in court such as parties concerned and agents individually. A trial clerk may also call the case (→ 07-02).

(2) Statement of a demandant

A. Purport and reasons of demand

A chief administrative judge invites a demandant or his/her agent to state

a purport or reasons of demand (Oral Proceedings Statement Brief → 33-07).

- (A) If a reason for demand is the same as described in a written demand for trial, it is not necessary to make a statement. There is no need to make a ritual statement such as “we state according to the written demand for trial”.
- (B) A demandant or his/her agent may state what he/she would like to emphasize and to organize for making statements on the purport and reasons for demand.
- (C) Matters described in a written demand for trial, a refutation, an oral proceedings statement brief, etc. become a basis of trial decision even they are not stated in court.

B. It is preferable to explain a point of issue.

C. The art of the present case, background of the art, actual conditions of product transactions may be explained.

(3) Statement of a demandee

A. Purport and reasons of reply

A chief administrative judge, then, invites a demandee or his/her agent to state a purport or reasons of reply (Oral Proceedings Statement Brief → 33-07).

- (A) If a reason for reply is the same as described in a written reply, it is not necessary to make a statement. There is no need to make a ritual statement such as “we state according to the written demand for trial”.
- (B) A demandee or his/her agent may state what he/she would like to emphasize and to organize for making statements on the purport and reasons for reply.
- (C) Matters described in a written reply, an oral proceedings statement brief, etc. become a basis of trial decision even they are not stated

in court.

B. A point of issue may be explained.

C. The art of the present case, background of the art, actual conditions of product transactions may be explained.

(4) Refutation and re-reply

Furthermore, if there is a refutation of a demandant or his/her agent against the reply of a demandee or his/her agent, or if there is a reply of a demandee or his/her agent against the refutation of the demandant or his/her agent, a chief administrative judge invites them to state such a refutation and reply.

(5) Examination of a chief administrative judge

A chief administrative judge orders to explain unclear statements (descriptions) on a purport and reasons for demand of the demandant, and a purport and reasons for reply of the demandee.

(6) Statement of the other party

A chief administrative judge asks a statement of opinion of the other party to the explanation.

(7) Handling of evidence

A chief administrative judge asks whether confirmation and establishment of the original of evidence are approved, if necessary (→ 34-01).

(8) Decision of acceptance or rejection of witness in court

If there is a request of a witness in court, an acceptance or rejection of the request is determined by consultation.

(9) Conclusion of the proceedings, notice of specifying a date or document proceedings

It is notified a conclusion of the proceedings (it is preferable that oral proceedings are possibly concluded only once), designation of the next date or continuation date, or document proceedings for further proceedings if that is the case. When it is necessary to submit any documents, it is preferable

that the time limit is designated in a shortest period (the standard designated time → 25-01.2) under the agreement of parties concerned.

(10) Examination of evidence

When an examination of evidence is also conducted on the date of oral proceedings, it may conduct before a statement of parties concerned.

When an examination of witness (→ 35-05) is conducted, it follows the order of 35-04.

(11) Statement of opinion on the results of examination of evidence

A chief administrative judge invites both parties concerned to make a statement of opinion.

(12) Adjourning court

A chief administrative judge confirms matters to be described in a trial record (→ 33-04) with parties concerned after the case is fully discussed.

In principle, a chief administrative judge notifies that the oral proceedings are concluded or reach the point at which a decision on the trial can be rendered of the case, and prepares the trial record accordingly. In an exceptional case, a date of next oral proceedings is designated, a submission date of document to be submitted is designated, or document proceedings are notified.

A chief administrative judge declares adjourning court.

(Revised December 2020)

33-06 P U D T**Use of Recording Devices, etc. in Oral Proceedings**

1. A chief administrative judge may, when finding it necessary, record the whole or a part of the statements of oral proceedings (including an examination of evidence) by using a recording device by request or ex officio (Enforcement Regulations of the Patent Act Article 53, Enforcement Regulations of the Utility Model Act Article 23(12), Enforcement Regulations of the Design Act Article 19(8), Enforcement Regulations of the Trademark Act Article 22(6), Rules of Civil Procedure Articles 76, Rules of Criminal Procedure Article 40).

2. When a party concerned intends to record the whole or part of the statements of oral proceedings (including an examination of evidence) by using a recording device, a permission of a chief administrative judge is required. It is preferable to submit a request for permission of use attached with a written consent of the other party (Enforcement Regulations of the Patent Act Articles 53, 54, Enforcement Regulations of the Utility Model Act Article 23(12), Enforcement Regulations of the Design Act Article 19(8), Enforcement Regulations of the Trademark Act Article 22(6), Rules of Civil Procedure Articles 76, 77, Rules of Criminal Procedure Article 215).

3. When there is not sufficient time to submit a request for permission of use in the previous item, a party concerned may request orally to a chief administrative judge before use, possibly before opening of court. In this occasion, a chief administrative judge determines whether to adopt the use upon confirming an intension of the other party and orders a trial clerk to record the progress in a record of examination of evidence, if necessary.

4. A party concerned or an intervenor may receive a recording tape of the statements of a witness, etc. of examination of evidence (examination of witness) upon request. He/she may ask for preparing “a document of statements of a witness, etc.” by the time of service of a transcript of trial decision.

(Revised Feb 2015)

33-07 P U D T

Oral Proceedings Statement Brief

An oral proceedings statement brief (Enforcement Regulations of the Patent Act Article 51, Enforcement Regulations of the Utility Model Act Article 23(12), Enforcement Regulations of the Design Act Article 19(8), Enforcement Regulations of the Trademark Act Article 22(6)) allows to effectively conduct oral proceedings even if facts are complex and wide-ranging, by not dropping out any statements of parties concerned and the hearings thereof and by enabling of elaborate theoretical composition in the statements.

Therefore, when submitted documents such as a written demand for trial, a written replay, etc., are appropriate and clearly described, or when there is no submission of oral proceedings statement brief by the due date, it is not necessary to submit a brief as an obligation.

Consequently, it does not require an order, etc. for submission even if there is no submission of the brief.

A submission of oral proceedings statement brief is as follows:

(1) A request for submission of oral proceedings statement brief is, in principle, made at the same time of dispatching a notice of proceeding matters.

A due date of submission of the brief is normally 1-2 weeks before the court considering a period of preparing the brief, a period of reviewing the brief by the other party, and a period of understanding the content in advance for the panel, etc.

In a case of submitting an oral proceedings statement brief, a party concerned submits the original (1 original), the duplicates (one more two

according to the number of the other party + one for the proceedings) and the copies thereof are sent to the JPO and the other party by facsimile or e-mail.

(2) The standard forms of oral proceedings statement brief are Form 1 (for a demandant, an opponent) and Form 2 (for a demandee, a right owner).

(3) A party concerned consults with a trial clerk in advance when he/she uses a special equipment, such as a projector, a screen, etc. in oral proceedings.

(Revised December 2020)

[Form 1] Oral Proceedings Statement Brief (for Damandant • Opponent)

Oral Proceedings Statement Brief	
	Date
TO: Chief Administrative Judge, JPO	
1. Trial Number	
Invalidation No. 20xx-800001	
(Opposition No. 20xx-900001)	
2. Demandant (Opponent)	
Address	
Name	
3. Agent	
Address	
Tel	
Fax	
Name	
4. Demandee	
Address	
Name	
<p>Regarding the above trial (opposition) case, a demandant (opponent) shall prepare a statement brief for the oral proceedings on (Date and Time).</p>	
5. Brief of Statement	
6. Means of Evidence	
7. List of Attached Documents	
Oral Proceedings Statement Brief	Duplicate copy/copies

(Note) Matters described in "5. Brief of Statement" has no particular regulations. The brief could include, for example, (i) Explanation required in the notice of proceeding matters, (ii) Supplement of reasons for reply (iii) Argument against the damandee's assertion (iv) Reasons and evidence of withdrawal, (v) Summary of all statement so far, etc.

[Form 2] Oral Proceedings Statement Brief (for Damandee • Right owner)

Oral Proceedings Statement Brief	
	Date
TO: Chief Administrative Judge, JPO	
1. Trial Number	
Invalidation No. 20xx-800001	
(Opposition No. 20xx-900001)	
2. Demandee	
Address	
Name	
3. Agent	
Address	
Tel	
Fax	
Name	
4. Demandant (Opponent)	
Address	
Name	
Regarding the above trial (opposition) case, a demandee (trademark owner) shall prepare a statement brief for the oral proceedings on (Date and Time).	
5. Brief of Statement	
6. Means of Evidence	
7. List of Attached Documents	
Oral Proceedings Statement Brief	Duplicate copy/copies

(Note) Matters described in "5. Brief of Statement" has no particular regulations. The brief could include, for example, (i) Explanation required in the notice of proceeding matters, (ii) Supplement of reasons for reply (iii) Argument against the damandant's assertion (iv) Reasons and evidence of withdrawal, (v) Summary

of all statement so far, etc.

(Revised June 2019)

33-08 P U D T**Notice of Proceeding Matters****1. Purpose of Notice of Proceeding Matters**

A purpose of a notice of proceeding matters is to notify parties concerned a scheduled proceeding matters on the oral proceeding day, to encourage them to prepare an oral proceedings statement brief, etc. based on the notified proceeding matters, to develop the oral proceedings smoothly, and to collect necessary materials for a trial decision.

A notice of proceeding matters shall be filed in the record with other notices (→37-00 2.) , and is a subject for inspection to enhance transparency of the procedures. A trial decision includes this notice as one of the procedures.

2. Matters to Be Described in Notice of Proceeding Matters

A notice of proceeding matters (Form 1) is considered to include the following (1)~(3) principally to collect necessary materials for a trial decision, but the details of the matters to be described are made based on the determination of the panel depending on the case.

(1) Provisional view of a panel

Descriptions of a notice includes a provisional view of a panel on the finding of facts of the present invention, cited inventions, points in common and points of difference between them, etc.

(2) Opinion of parties

Parties concerned are requested their opinions on the provisional view of a panel on the finding of facts in (1). A panel specifically points issues, etc. on matters that parties are at issue and matters that a panel is discussing for drafting a trial decision. Thereby, the parties concerned may make sufficient

statement and proof.

Furthermore, a panel points out unclearness, etc. in a written demand for trial, a written reply, a request for correction, a written refutation, etc., and asks for explanation. In some cases, a panel encourages the withdrawal of the statement.

(3) Others

A panel encourages parties concerned to explain technical matters on the present invention and the background thereof, if necessary.

In an invalidation trial for patent, there is a related infringement lawsuit and defense of patent invalidity, a panel asks parties an explanation on difference in the reasons and evidence.

If there is evidence requiring confirmation of original, a panel encourages parties to bring on the date of oral proceedings.

At the end of a notice of proceeding matters, it is preferable to describe as “the same content of the notice of proceeding matters is notified to the other party”.

3. Sending Procedure of Notice of Proceeding Matters

(1) A trial clerk shall send a request for adjustment of date (→ 33-01 Form 1) and a notice of proceeding matters drafted by a panel (the date is not filled in because it has not been decided yet) to parties concerned by facsimile or e-mail.

For shortening the period of time for proceedings, it is possible to adjust date by a trial clerk and to draft a notice of proceeding matters by a panel at the same time. At that time, a panel should keep in mind that a preparation period of time for oral proceedings of parties becomes unreasonably short.

(2) A trial clerk adjusts the date with parties, and a template of acknowledgment of date shall be sent to parties concerned by facsimile or e-mail after obtaining acceptance of a panel.

- (3) A trial clerk informs a panel of a determined date when an acknowledgment of the date is prepared by both parties.
- (4) A panel fills in the date in a notice of proceeding matters on the day the date is informed in principle, and they finally approve.
- (5) A trial clerk shall send a notice of proceeding matters with the date of oral proceedings to parties concerned.

(Revised December 2020)

[Form 1] Notice of Proceeding Matters

Notice of Proceeding Matters

Date

Chief Administrative Judge, JPO

Trial Number

Invalidation No. 20xx-800xxx

(Patent Number)

(Patent No. xxxxxxxx)

Demandant

Mr/Ms

Patent attorney as an agent

Mr/Ms

This notice informs you the proceeding matters which are to be examined in the oral proceedings on (date).

In submission of an oral proceedings statement brief, the brief should be prepared based on the following points and submitted or sent to Application Service Desk at the JPO two weeks prior to the oral proceedings date. On the same day as the submission of the brief to the JPO, the brief is also sent to a trial clerk in charge and the other party by facsimile or e-mail according to the instruction of the trial clerk in charge.

Note

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If you have any query on this notice, please contact below.

Administrative Judge XXXX

X Board of Trial and Appeal

Trial and Appeal Department, JPO

TEL: 03(3581)XXXX (Ext. XXXX) FAX: 03(3584)XXXX

(Revised December 2020)