

34-01 P U D T
Inspection of Documents and Important Points Concerning
Producing Evidence

1. Means of Proof

Means of proof includes a document, a witness, an expert, a party concerned and an object for inspection, referring to a tangible object subject to an examination of evidence.

2. Submission of Evidence and Withdrawal of Evidence

(1) Principle

Evidence may be submitted by the end of the proceedings. Therefore, when a request of submission of evidence is accepted after the end of the proceedings, it is necessary to provide the other party with an opportunity of reply and submission of evidence related to the reply after reopening the proceedings (→ 42-00 2.) (Enforcement Regulations of the Patent Act Articles 47-2(1), 47-3(1), 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)).

Withdrawal of evidence is allowed at any time before initiating an examination of evidence, however, once it is started, a consent of the opposing party is required for withdrawal. In a case where evidence is favorable also to the other party, it sometimes happens that the other party's consent of the withdrawal cannot be obtained. Thus, it is required for the party concerned to carefully choose evidence to be submitted. After the examination of evidence, there is no choice for withdrawal since the panel has already had firm conviction.

(2) Addition and/or change of evidence for opposition

Addition and/or change of evidence for an opposition are admitted until the time period for opposition has been passed or a notification of reasons for rescission is issued whichever comes earlier (A proviso to Article 115(2) of the Patent Act)(→ 67-04).

Addition and/or change of evidence for an opposition of trademark is admitted by 30 days after the time period of an opposition to registration of trademark has been passed (A proviso to Article 43-4 (2) of the Trademark Act)(→ 66-03).

3. Procedure of Submission of Evidence

For a demand for trial, a written reply, and other trials/appeals, a necessary means of proof shall state in the document and an exhibit shall attach to the document filed to the JPO (Enforcement Regulations of the Patent Act Article 50 (1), 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(5)(6)).

When submitting evidence, it is necessary to specify the evidence by a document (a demand for trial, an offer of evidence, etc.) and clarify facts to be proved and a relation between the facts and the evidence (Patent Act Article 131(2), Enforcement Regulations of the Patent Act Article 57-3 (Form 65-11, 65-12), Utility Model Act Article 38(2), Enforcement Regulations of the Utility Model Act Article 23(12), Design Act Article 52, Enforcement Regulations of the Design Act Article 19(8), Trademark Act Articles 56(1), 68(4), Enforcement Regulations of the Trademark Act Article 22 (6)) (similar laws and regulations: Code of Civil Procedure Article 180(1), Rules of Civil Procedure Article 99(1), Code of Civil Procedure Article 221(1), Rules of Civil Procedure Article 150, Rules of Civil Procedure Article 153).

A panel considers any deficiencies in submitted documents accordance with a type of evidence such as documents, a witness, etc., and encourages a

voluntary amendment or orders an amendment, if necessary (→ 35-01 1.).

4. Documents

When an examination of evidence in which a document is used for means of evidence and a content of thoughts described in the document is used as an evidential material, it is called documentary evidence. In practice, the document itself is sometimes called documentary evidence.

(1) Evidence number

Documentary evidence indicates A (Kou), B (Otus) or C (Hei) depending on a submitter, either a demandant, demandee or intervenor, and after A, B or C indicate the number in order of submission. For example, the first documentary evidence submitted by a demandant is “Exhibit A No. 1”.

(2) Submission of copies

Anyone who requests an examination of evidence using a document as means of proof is required to submit a copy of the document to the JPO and as many as the number of the other parties (including intervenors) (Enforcement Regulations of the Patent Act Article 50(2), 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)). These copies to be submitted include pages required for proof and also the necessary parts to specify the document such as the front cover, return cover, colophon, back cover, and spine, etc. of the book. If these are not completed, an amendment shall be ordered.

(3) Original, Copy

In a case of offering of documentary evidence, a document to be submitted or dispatched shall be the original, an authenticated copy or a certified copy (hereinafter referred to as “the original, etc.” in this section 34-01). An administrative judge may order submission or dispatch of the original (Enforcement Regulations of the Patent Act Article 61-5, 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 143). The original may be asked for return after the proceedings (Enforcement Regulations of the Patent Act Article 15) (→ 16-01). In that case, after confirming if there is no difference between the original and a copy, this shall be noted on the copy.

In practice, submission of a copy instead of the original, etc. (an uncertified copy. The same applies to this section 34-01) is allowed for requesting an examination of documentary evidence. However, if it is not found an existence of the original only with a corresponding copy to the original, submission of the original, etc. may be encouraged ex officio or a request of an opposing party in the oral proceedings, etc. A copy to be submitted needs the necessary parts to specify the document in addition to pages describing matters to be proved.

In a case where the original, etc. has been lost, or the original is not possible to be submitted and the existence of original, etc. may not be confirmed, a copy submitted to the JPO may be evidence. Which one to submit as evidence is at the discretion of a person who requests for examination of evidence: submission of the original, etc., submission of a copy which infers the existence of the original (a copy instead of the original is submitted), or submission of a copy itself.

In practice, it is roughly handled as follows:

A. A patent gazette, a patent register, a publication owned by the National Center for Industrial Property Information and Training (INPIT)

A copy is sufficient instead of the original since it is easy to compare the original with a copy.

B. Document distributed in large numbers such as books, magazines, academic journals, catalogues, etc.

It is preferable to submit the original (for example, a catalogue itself), but

if it is inconvenient to submit the original due to the large number of pages etc., a copy of the document is often submitted.

C. A design drawing, a specification, a transaction document such as an order sheet, a statement of delivery

It is preferable to submit the original (for example, a design drawing itself), when the original exists.

When it is inconvenient to submit the original due to the original is necessary for business, etc., a copy can be submitted. However, it is often required to submit the original ex officio or by a request of a party concerned.

D. Document such as a certificate, prepared for a demand or a request for the case

Usually, the original is required for submission.

(4) Publication

A publication refers to “a duplicate of documents, books and any other information transmission media equivalent to these for the purpose of publishing to the public by distribution” (the Second Petty Bench of Supreme Court of July 4, 1980).

(Court cases in which a document is considered a publication)

(Example 1) Specification ((2008 (Gyo-ke) 10180) Judgment of IP High Court, Jan 28, 2009)

(Example 2) Technical guidebook distributed from a manufacture to a service agent ((2009 (Gyo-ke) 10323) Judgment of IP High Court, June 29, 2010)

(Example 3) Catalogue attached with a real knitted fabric sample ((2013 (Gyo-ke) 10204) Judgment of IP High Court, Oct 15, 2014)

(5) Attachment of translation

When offering of documentary evidence by filing a foreign language document, a translation of a part of the document to be examined shall be attached to the document (Enforcement Regulations of the Patent Act Article

61(1), 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(5)(6), Rules of Civil Procedure Article 138(1)). Namely, if evidence is a foreign document, it is always necessary to attach a translation of the cited part of the document (a translation is submitted at the same time of submitting a copy of documentary evidence and a description of evidence).

The other party shall submit a document stating the opinion if having any opinion on accuracy of the submitted translation (Enforcement Regulations of the Patent Act Article 61(2), 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 138(2)).

(6) Use of an examination of witness, etc.

When the original, etc. cannot be submitted, or when a document is other than the followings, it is also possible to request an examination of witness at the same time for clarifying a creation of a document and a content of a certification.

A. A publication of which a date of distribution is clear

B. An official document certified by the government and public offices in which certified matters are jurisdiction matters

C. An official certification issued by a university or research institution where facilities and professional engineers are available

D. An official certificate of medical effect issued by a hospital where it is apparent that the medical drugs are used for medical treatments at the hospital, etc.

(7) Description of evidence

When submitting documentary evidence, "Description of evidence" (Form 1) clarifying a title, a date of creation, a name of a creator of document and

facts to be proved shall be submitted unless it is obvious from the descriptions of documentary evidence (Enforcement Regulations of the Patent Act Article 50(3), 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)). Since a description of evidence is practically filed with a demand for trial, a written reply, a written refutation, an oral proceedings statement brief etc., a description of evidence is often filed as attachment of those documents, not as an individual document.

“Description of evidence” is filed to the JPO and as many as the number of the other parties.

(8) Petition for order to submit a document (Patent Act Article 151, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4), Code of Civil Procedure Article 221, Enforcement Regulations of the Patent Act Article 61-2, 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 140).

When a document is owned by another person having an obligation to submit a document under the regulations of Patent Act Article 151 to apply mutatis mutandis of Rules of Civil Procedures Article 220, a party concerned may request (a petition for order to submit a document) a panel to issue a submission order under the provision of Code of Civil Procedure Article 223(1).

When filing a petition for order to submit a document, it is required to specify the document in a petition.

(Particulars to be clarified)

- identification of the document
- the purport of the document

- the person possession of the document
- facts to be proven by the document
- the cause of the obligation to submit the document

If there is any opinion on the petition, the other party shall submit a document stating the opinion to a chief administrative judge.

(9) Retention of presented document (Enforcement Regulations of the Patent Act Article 61-3, 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 141)

When administrative judges found it necessary to determine a petition for order to submit a document falls under the provisions of Code of Civil Procedure Article 220 (iv)(a)~(e), the administrative judges may have the owner submit such a document (Patent Act Article 151 → Code of Civil Procedure Article 223(6)), or the presented document may be temporarily retained if it is found necessary.

* Code of Civil Procedure Article 220 (iv) (summary)

(a) a document detailing the particulars with regard to a person in possession of the document would likely be subject to criminal prosecution or conviction

(b) a document concerning confidential information in connection with a public officer's duties

(c) a document detailing a fact that an attorney at law or a patent attorney, etc. learned in the course of duty and that shall not be exempt from the duty of silence

(d) a document prepared exclusively for the use of the person in possession

(e) documents related to the litigation of a criminal case

Transcribing a sound recording

(10) Document containing the transcription of a recording tape, etc. (Enforcement Regulations of the Patent Act Article 61-6, 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 144)

When offering of a document containing the transcription of a recording tape, etc. as documentary evidence, a party concerned or an intervenor shall submit a duplicate of the recording tape, etc. to the other party when the other party requests the duplicate (for example, the duplicate is often requested to confirm the consistency of the contents of the document and the recording tape).

(11) Clarification of reasons when the authenticity of creation of a document is denied (Enforcement Regulations of the Patent Act Article 61-7, 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 145, Patent Act Article 151, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56, 68(4), Code of Civil Procedure Article 228)

Creation of a document means to confirm the authenticity that a document is prepared on the basis of the intension of a specific person claiming that a party who submits the document is the author of that document (a holder of preparation of the document), thereby it provides a document with formal evidential power. When the other party denies the authenticity of the creation of a document, this equals to state that the document is a false document, and thus the reasons therefore shall be clear. A panel determines the creation of a document from the results of the reasons.

Even if the creation of a document is approved, it does not mean matters in the description and contents of documents are also approved the authenticity.

(12) Record pertaining to document, etc. to be used for comparison of handwriting (Enforcement Regulations of the Patent Act Article 61-8, 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), Patent Act Article 151, Code of Civil Procedure Article 229, Rules of Civil Procedure Article 146)

An original, transcript or extract of document to be used for comparison of handwriting or seal impressions shall be attached to a record.

(13) Articles equivalent to documents (Patent Act Article 151 → Code of Civil Procedure Article 231, Enforcement Regulations of the Patent Act Article 61-9, 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 147)

A drawing, a photograph, a recording tape, a video tape, a tally for one's shoes, a baggage tally, a boundary mark and other signs, etc. are not a document, but they express the thought of a creator even if they do not include characters or other symbols, or they do not express the thought of a creator but include characters or other symbols, and in that respect, they are common to a document. Therefore, they are examined by taking the same procedures as documentary evidence considering them as an article equivalent to a document ("quasi-document").

(14) Photograph, recording tape, etc. (Enforcement Regulations of the Patent Act Article 61-10, 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 148).

When requesting an examination of a photograph, a recording tape, etc. as evidence, the details of evidence shall be clarified in a description of

evidence such as a subject of photography, recording or video recording, and the date and time, a place, and a photographer or a recorder (creator). When a photography, a recording tape, etc. is actually submitted, it may play the tape or screen the video if necessary in the examination of evidence.

(15) Document explaining the content of recording tape, etc. (Enforcement Regulations of the Patent Act Article 61-11, 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 149)

A party concerned or intervenor who requests an examination of evidence such as a recording tape, etc., shall submit a document explaining the content of said recording tape, etc. if an administrative judge or the other party requests as such.

The other party shall submit a document stating the opinion to a chief administrative judge if there is any opinion on the explanation of the above document.

A recording tape, etc., offering of documentary evidence as a quasi-document is played to examine as evidence. In that case, it is preferable to submit a document in advance explaining the content of said recording tape, etc. by specifying the speaker and clarifying the speech content. A document explaining the content of recording tape, etc. is typically “a document containing the transcription of a recording tape, etc.” and the content and scope thereof is determined according to the necessity.

5. Witness (→35-01)

When a witness who is a third party and makes statements at a trial court the past facts and conditions recognized by the third party is used as means of proof, it is necessary to clearly indicate a name, occupation and address of the witness to specify the witness in a document requesting an examination

of a witness (a request for examination of witness (Enforcement Regulations of the Patent Act Article 58), a demand for trial, a written reply, etc.) and file with a statement of matters for examination of witness to the JPO and the witness and as many as the number of the other parties (Enforcement Regulations of the Patent Act Article 58-2).

6. Expert (→35-12)

When an expert who is a third party and makes statements at a trial court the opinions based on the relevant knowledge and experience for providing the supplement knowledge and experience with administrative judges, is used as means of proof, since an expert is given the qualification by a panel (Patent Act Article 151 → Code of Civil Procedure Article 213, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56, 68(4)), a party concerned does not always designate an expert but if a party concerned designates an expert (note), a name, age, occupation and address, etc. of an expert have to be clarified for specifying said expert in a request for expert opinion (Enforcement Regulations of the Patent Act Article 60(5), Form 65-19, Form 65-20).

Regardless of designation of an expert, it is necessary to submit a statement of matters for expert opinion with a request for expert opinion (Enforcement Regulations of the Patent Act Article 60(1)(6), Form 65-21, Form 65-22).

(Note) An expert designated by a party concerned is given the qualification as an expert when obtaining an agreement of the other party and acceptance of the panel who finds it appropriate.

7. Expert Witness

When an expert witness who is a third party and makes statements at a trial court the facts that an expert witness has learned based on the special knowledge and experience, the regulations on the examination of witness

shall be applied to the examination of expert witness (Enforcement Regulations of the Patent Act Article 60-7).

In a case of an expert witness, it is necessary to clearly indicate a name, occupation and address of the expert witness to specify the expert witness in a document requesting an examination of an expert witness and file with a statement of matters for examination of expert witness to the JPO and the witness and as many as the number of the other parties.

8. Examination of Parties

When there is no other means of proof or it is not sufficient to confirm the facts only with other means of proof, a party concerned himself, his legal agent, or a representative of a corporation or an organization that is a party concerned who states at a trial court the facts and conditions in the past recognized by himself, is used as means of proof supplementary, such procedures are equal to ones in the examination of witness (Enforcement Regulations of the Patent Act Article 59-2, 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)).

It is necessary to clearly indicate a name, occupation and address of a party concerned to specify a party concerned himself in a document requesting an examination of a party concerned and file with a statement of matters for examination of a party concerned to the JPO and the witness and as many as the number of the other parties.

It is found appropriate an intervenor is treated equivalent to a party concerned.

9. Inspection of Evidence (→35-06)

(1) When an administrative judge inspects properties and phenomena of an article, that is, an object for inspection by the action of the five organs of

senses, there are two places for inspection of evidence: the court inspection where an inspection is performed in a trial court or the out-of-court inspection where an inspection is performed out of a trial court.

When an object for inspection is submitted, an inspection is performed in a trial court of the JPO (the court inspection).

When an object for inspection is an article which cannot be submitted or when it is necessary, inspection of evidence is performed at a place where the article is located (referred to as the out-of-court inspection, field inspection or on-site inspection). In this case, a document requesting inspection of evidence (a request for inspection of evidence (Enforcement Regulations of the Patent Act Article 62, 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)), a demand for trial or appeal, a written reply, etc.) has to clarify a place where an object for inspection is located for specifying an object for inspection.

(2) It is necessary to indicate an object for inspection in requesting inspection of evidence (Enforcement Regulations of the Patent Act Article 62, 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 150), the regulations of Code of Civil Procedure regarding documentary evidence applies *mutatis mutandis* to the presentation or sending of an object for inspection (Patent Act Article 151 → Code of Civil Procedure Article 232(1), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56, 68(4), a part of Rules of Civil Procedure Article 151).

A party concerned who requests inspection of evidence shall submit drawings, or a model or a sample (drawings or explanatory notes shall be attached for models or samples.) necessary to specify an object of inspection

to the JPO and as many as the number of the other parties (Enforcement Regulations of the Patent Act Article 50(2), 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)).

(3) When inspection of evidence, a party concerned who requests inspection of evidence is required to give a briefing on an object for inspection, therefore, keep in mind whether the party concerned has prepared to give the briefing.

(4) An object for inspection and its model, sample, etc. are marked with Ken-Kou (Inspection A), Ken-Otsu (Inspection B), or Ken-Hei (Inspection C) depending on who requests inspection, i.e., a demandant, a demandee, or an intervenor respectively before the inspection nos. determined in order of submission.

(5) A request for inspection is often accompanied with a request for examination of witness or a presence of expert which should be performed at the same time and is often included submission of a sketch or a photo as evidence, please be aware that deficiencies in the procedures of those requests and submission on the premise of inspection of evidence.

10. Adoption and supplement of means of proof

(1) When there is a request to the effect that means of proof will be submitted later but no evidence is submitted after the considerable period of time, there is an example of a trial decision which was determined without ordering supplement of means of proof. The considerable period of time varies for the cases, but usually it is for 1-3 months.

(2) When the other party does not respond to an order of amendment of submission of evidence, the procedure shall be dismissed or the procedure shall be developed without accepting submission of evidence, either of which is determined by a panel.

(3) If supplement of means for poof changes the gist, the supplement is not sometimes accepted.

【Form 1】 【Sample of Description of Evidence】

Description of Evidence

Date:

To: Chief Administrative Judge

1. Trial No.

Invalidation ○○○○－○○○○○○○

2. Demandant

Address (domicile) ○-○ Kasumigaseki, Chiyoda-ku, Tokyo

Name (appellation) ▲▲ Company

Representative △△

3. Agent

(Identification No. 1 0 0 X X X X X X)

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Tel. 0 3 - ○○○○-○○○○

Fax 0 3 - ○○○○-○○○○

Name (appellation) Patent Attorney □□

4. Description of evidence

Exhibit	List of evidence	Original or Copy	Preparation Date	A person who prepared evidence	Facts to be proved
A-1	ABC001 Drawings of parts	Copy	Date	○○ Company Development Division ■ ■	Structure of ABC001 parts
A-2	Product catalogue by ○○ company	Original	Date	○○ Company Sales Division	Sales of ABC001 parts to unspecified large number of people
A-3	Order form	Original	Date	×× Company Procurement Division	Trading transactions of ABC001 parts
A-4	Invoice	Copy	Date	○○ Company Sales Division	Trading transactions of ABC001 parts

5. List of attached documents or articles

None

(Note) Evidence (Exhibit A-1, etc.) is usually filed as attachment with documents such as a written demand for trial.

(Revised December. 2020)