

35-01 P U D T

Procedures for Preparation for Examination of Witness, etc.

1. Planning for Proof, Arrangement and Clear Distinction of Facts Necessary to Be Proved (Factum Probandum) and Statements

(1) Arrangement of matters to be proved (facts to be proved) and evidence

A. Arrangement by a party concerned

When a request for an invalidation trial etc. is filed, the reasons for requesting a trial shall concretely identify the facts that are basis for the invalidation and shall concretely and clearly include the relationship between the facts (matters to be proved) and the evidence in a section of means of proof (Patent Act Article 131(2), Utility Model Act Article 38(2), Design Act Article 52, Enforcement Regulations of the Patent Act Form 62 Remarks 8). When an examination of evidence is requested, the relationship between the facts to be proved and the evidence shall concretely state in an offer of evidence, etc. (Enforcement Regulations of the Patent Act Article 57-3, 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)).

B. Arrangement by panel

Sometimes there are lots of matters to be proved and evidence submitted by a demandant and a demandee, however, “obvious facts” and unrelated facts to the case, etc. does not require finding by evidence and the evidence unrelated to the case does not require an examination of evidence.

Therefore, it is important for a panel to conduct a smooth and efficient examination of evidence by arranging, among the matters to be proved (facts to be proved) requested by a party concerned, which one is necessary in relation to the requisition facts and which evidence should be used for the matter for proving.

As a result of the arrangement, when the trial procedures have become different from the statement and request of the parties, it is preferable to obtain the consent of the parties in advance.

C. Acceptance or rejection of evidence

Acceptance or rejection of evidence may be determined ex officio including a range, a time, an order, etc. of examination of evidence.

However, a panel should not reject to examine evidence with any prejudgment that the evidential power of the evidence is insufficient. The following perspectives are useful for reviewing the acceptance or rejection of evidence.

(A) When facts to be proved are considered the same for multiple evidential materials, it is useful to have a party concerned confirm to that effect and restrict only major evidence.

(B) Means of proof has the following distinctive features and the proof making the most of its feature helps the efficient proceedings:

- documentary evidence is easy to examine and useful to determine the facts;
- inspection of evidence is easy to understand a constitution; and
- testimony of a witness is useful to understand the details of the facts and the interrelationships between many evidential materials.

(C) Regarding other means of proof are considered more appropriate than testimony of a witness or inspection of evidence, indicate that point to a party concerned who offers the evidence and encourage to add other means of proof and withdraw the inappropriate means of proof. On the other hand, it is efficient to find the facts by testimony of a witness if the matters may not be found by other than testimony of a witness (Therefore, before conducting an examination of a witness, it is preferable to complete other examinations of evidence).

D. Handling of indirect facts

In a case where a multiple indirect facts are stated for proving the existence of one concrete fact, when some of the indirect facts stated by a party

concerned are found to be unnecessary by an administrative judge, it is not necessary to review those indirect facts and examine the evidence related to those facts (Regarding this point, an administrative judge explains the reason to a party concerned who offers the evidence and asks to withdraw a request for examination of evidence).

(2) Review of matters to be proved and means of proof that are requested

A. When it is not clear the relationship between statements and evidence

A party concerned should, as described previously, specify the relationship between the concrete facts related to the statements and the evidence, but if the relationship is not clear, or it is obvious that there is no relationship, a panel orders an amendment or encourages a voluntary amendment to a party concerned (amendment of a request for trial. If inappropriate descriptions are significant, a panel also considers the request for trial shall be rejected by trial decision prior to an order of reply).

B. When there is insufficient statements or evidence

When it is clear a statement of a party concerned is lack of concrete facts (major facts) necessary for determination of legal requisition, a party concerned needs to compensate the insufficient parts of the statement on this point. Regarding a statement which is highly possible to need additional evidence to be supplied on auxiliary facts in the future, if those points are made early, this will lead to the shortening of the duration of the trial proceedings.

Moreover, when the concrete facts are not based on the evidence although the concrete facts made in the statement require the proof, submission of evidence shall be encouraged if necessary.

C. When there are unclear descriptions in a statement of matters for examination of witness, etc.

When testimony of a witness or inspection of evidence are requested, a “statement of matters of examination of witness” describing concrete contents of examination of evidence, and an “instruction of inspection of evidence”

describing matters for inspection of an object of inspection are submitted as attachment documents. Even if it does not mean the descriptions are not concrete, but it considers unclear, a panel orders amendment or encourages to amend voluntarily to a party concerned (→21-02).

(3) Arrangement and clear distinction between facts necessary to be proved and statements

Matters to be proved of a demandant or a demandee may include an evaluation of legality (determination on whether the facts satisfy legal requirements) or an evaluation of facts (determination on appropriateness or inappropriateness, or same or different, etc.). There is a risk of causing trouble or missing the points from the essential part of the dispute if an examination of evidence is conducted under such conditions. If a difference between the facts and statement is not clear, it could result in causing trouble in making a trial decision properly: it may generate a negative impact on making a trial decision by conducting an inappropriate examination such as asking a witness differences with the present invention, asking a witness whether the transaction is publicly worked, making a witness testify a pointless abstract concept (other than the fact that the witness has experienced).

In this case, it is important for a smooth and effective examination of evidence and useful for drafting a trial decision that a demandant and a demandee are suggested to distinguish and arrange facts necessary to be proved and a legal evaluation based on said facts, to indicate facts for matters to be proved, and to state in a separate document the factual evaluation and the legal evaluation based on said factual evaluation. As a result, it may sometimes become clear other facts to be proved and insufficient of evidence.

(4) Examination of evidence before an opportunity of a first reply is given

An examination of evidence is normally implemented after submission of a written reply of a demandee (a request for correction) and determination of approval of amendment of a reason for the request, namely, when matters to

be proved, evidence, and statements for both parties are all prepared. However, for example, in a case where a means of proof is substantially testimony of a witness and inspection of evidence, even if an opportunity of a reply is given to a demandee without examining those evidence, when it is difficult for a demandee to make a substantial refutation and rebuttal, it is possible to examine the evidence before giving an opportunity to reply.

In formal proceedings of a written demand for trial (reviewing the description requirements of “Reasons for demand”), it should consider whether to confirm matters to be proved by testimony of a witness and inspection of evidence and examine those evidence before an order of reply to a demandee.

2. Oral Proceedings and Examination of Evidence

For an inter partes trial conducted through oral proceedings in principle (Patent Act Article 145(1), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)), a party concerned needs to distinguish and arrange the facts necessary to be proved, evidence, and statements, and a witness needs to arrange what to know and what to prove during the oral proceedings. Later, the matters conducted in the oral proceedings may be submitted as a statement of matters for examination of witness and be presented to the other party for preparation of cross-examination, and then an examination of evidence may be initiated.

However, a problem arises if oral proceedings and an examination of evidence conduct on separate days, not only the procedures become complicated but also the duration of the proceedings becomes longer. Therefore, the followings are carried out in practice so that they may be conducted on the same day: to confirm and prepare both parties the matters to be examined of evidence by facsimile or e-mail, etc.; to initiate oral proceedings on the date of conduct; and to confirm between the panel and the parties on “the relationship between the facts necessary to be proved and

evidence, time required for an examination of evidence, and distinction between matters for an examination of evidence and those for oral proceedings conducting thereafter”, etc. and then follows suspension of the oral proceedings, examination of evidence, re-open of the oral proceedings, and termination of the oral proceedings.

An ex parte trial adopts in principal document proceedings (Patent Act Article 145(2), Design Act Article 52, Trademark Act Articles 56(1), 68(4)), and assuming that an examination of evidence such as an examination of a witness is conducted, oral proceedings may be accepted for the same reason as described above.

A panel determines whether to conduct oral proceedings and an examination of evidence on the same day considering the effectiveness and necessity, and then obtains a consensus between both parties.

3. Procedures in Advance of Examination of Witness

(1) Examination of witness by request

A. When a panel determines to accept and conduct a request for examination of witness, taking the following measures:

(A) Statement of matters for examination of witness (Enforcement Regulations of the Patent Act Article 58-2, Form 65-16)

a. when there is no submission, order to submit the statement by amendment

b. when there are deficiencies in the content, order amendment in this regard and submit the amended statement

c. when the required number of copies is insufficient, order an amendment to satisfy the shortage. The required number of copies is one copy for an appeal against examiner’s decision of refusal, and one copy for the JPO and the number of copies according to the number of witnesses and the other parties for other cases.

d. when an order of amendment is not met, a request for examination of witness is not adopted by determination of a panel, or even if the request is

accepted, it takes other measure such as issuance of the similar or other appropriate order without advancing the procedures. A request for trial/appeal is not rejected by a trial decision.

(B) When there are many witnesses by the request, a note is made with a name of a person to be examined and who is a party for the request.

(C) A panel instructs a trial clerk to issue a notice of advance payment for expenses required for examination of witness (a travel expense, a daily allowance, an accommodation fee for a witness. Hereinafter, referred to as "travel expenses, etc."). In an ex parte trial, an advance payment may be ordered for an examination of evidence (Patent Act Article 169(3), Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

(D) When conducting an examination of witness and oral proceedings at the same time in an ex parte trial, instruct a trial clerk accordingly. In an inter partes trial, when oral proceedings are not conducted at the same time, also instruct to that effect.

B. A trial clerk who is instructed under A.(C), taking the following measures after confirming a person requesting an examination of witness whether a witness charges or abandons the travel expenses, etc.

(A) When a witness abandons travel expenses, etc., the record thereof shall be kept after omitting a procedure of advance payment (At the end of an examination of witness, a witness is requested to submit an abandonment of travel expenses, etc.).

(B) When a witness requests travel expenses, etc., the measures are taken as follows:

a. Based on the descriptions of a request for examination of witness, a travel expense, a daily allowance, and an accommodation fee for a witness shall be calculated according to the Act on the Costs of Civil Proceedings (Patent Act Article 169(6), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1) 68(4)).

b. Necessary matters are entered into a book for receipt and payment of money on deposit, and a draft of a notice of demand for advance payment (Form 1) is prepared and served by "special delivery" (A type of specially delivered mail under Postal Act Articles 49) to a person who requests an examination of witness.

c. After keeping these records, confirm a payment of the advance payment and receive a notice of acceptance of deposit from an officer in charge of receipts and disbursements of cash other than annual revenue and expenditures, and then continuously bound it to the record.

d. A rubber seal showing the advance payment and a seal of a person who confirms the rubber seal are affixed on the book for receipt and payment of money on deposit.

C. A trial clerk takes the following procedures after the procedure B.

(A) A draft of a summons informing an oral proceeding date is prepared (Form 2, in case of no oral proceedings, a notice of date for an examination of evidence equivalent to Form 2) and served to both parties by "special delivery" after approval. If it is not able to serve, it is served by public notification (Designating a Date → 33-01).

(B) A writ of summons (Form 3) is prepared and after approval served to a witness by "special delivery" with a document describing examination matters (Enforcement Regulations of the Patent Act Article 58-3). However, when a party concerned requesting an examination of witness offers to accompany a witness, the writ of summons is not served. If it is not able to serve, the documents are continuously bound to the record.

(C) When the documents of (A) are served, a postal service report is sent, and this report is continuously bound to the record and circulated to a panel immediately.

D. When an examination of witness is no longer necessary to conduct after taking the procedure B., this notifies to a person who requests an examination of witness together with recording in a book for receipt and payment of money

on deposit. In this case, when the procedure C. has already completed, it also notifies to other parties and witnesses. If the notice is delivered not in time and a witness unfortunately appears in court, a court is opened to declare the extension of the date and pays a travel expense to a witness asking for payment.

(2) Examination of witness ex officio (→36-01)

The procedures and matters to be noted are equivalent to (1), there are differences in the following points.

A. A witness is selected and designated by a panel.

B. A panel or a trial clerk under the instruction of the panel prepares a statement of matters for examination of witness, and then proceeds (1) C.

4. Statement of matters for examination of witness

(1) When requesting an examination of witness, a statement of matters for examination of witness shall also submit to the JPO and witnesses and the other parties according to the number of witnesses and the other parties. However, if there is an unavoidable reason, the statement may be submitted within the period designated by a chief administrative judge (Enforcement Regulations of the Patent Act Article 58-2(1)).

(2) A statement of matters for examination of witness shall be stated individually and specifically as much as possible (Enforcement Regulations of the Patent Act Article 58-2(2)).

(Note) When an examination of evidence such as an examination of witness is conducted for an opposition to grant of patent case (Patent Act Article 120), or an opposition to registration of trademark case (Trademark Act Article 43-8 →Patent Act Articles 150, 151), it is handled equivalent to the examination of evidence in the above trial cases (→2.).

5. Procedures for payment of costs to a witness appeared in court

(1) A trial clerk prepares a notice of examination of witness describing the amount of a travel expense, a daily allowance and an accommodation expense which should be paid to a witness and submits to the Budget Unit of the Accounting Division by the day before the examination.

(2) A trial clerk enters necessary matters into an invoice and a transfer invoice respectively for a travel expense, a daily allowance and an accommodation expense, and asks to confirm the contents of the invoices to a witness who appears on the date of examination of witness. After confirmation, the witness enters a date and name into the invoices.

(3) When the examination of witness is ended, a trial clerk submits each invoice in (2) to the Budget Unit of the Accounting Division.

6. Preparation Procedures for Examination of Expert Witness, Expert and Parties

(1) The regulations concerning an examination of witness shall apply to an examination of expert witness including pre-procedures.

(2) The regulations of procedures for an examination of witness shall apply *mutatis mutandis* to summons of an expert, and the procedure for a travel expense, etc. of a witness shall apply to the procedure for expenses of an expert including a fee for an expert opinion and other necessary expenses for the expert opinion such as a travel expense, etc. See 35-12 for submission of a document including matters requesting an expert opinion and other procedures.

(3) The regulations concerning an examination of witness shall apply *mutatis mutandis* to an examination of parties themselves. However, since a person who is examined is not a witness, a travel expense, etc. do not have to pay in advance.

7. Procedures for Inspection

It is necessary to pay a travel expense, etc. of administrative judges and a trial clerk in advance when an inspection is conducted out of court (an inspection on the scene), not in court. See 35-06 and 35-07 for other procedures for inspection.

8. Witness in Court

In progression of the scheduled examination of witness, in a case where one of the parties requests to examine a witness in court about the points which remain unclear, when the other party agrees and an additional examination of the witness is considered to be supplementary with the examination already conducted, this request can be accepted.

On the contrary, when the other party does not agree, it is preferable not to accept this request unless it is apparent that the additional examination is supplementary since it could be thought that there may be missing parts in preparation of a counter examination.

9. Submission of Written Statements in Lieu of Examination

(1) Submission of written statements in lieu of examination

When a panel finds it appropriate, a panel may order submission of written statements in lieu of examination of a witness or parties themselves, or statement of an expert opinion (hereinafter referred to as “Examination in writing”). Patent Act Article 151 → Code of Civil Procedure Article 278, Enforcement Regulations of the Patent Act Article 58-17).

There is neither an oath nor a counter examination for an examination in writing, the evaluation of reliability should be sufficiently noted.

(2) Procedures of examination in writing

A. When proceeding an examination in writing, an administrative judge has the other party of a party concerned or an intervenor who requests the examination submit a written statement describing matters authorizing a reply in the statement.

B. A chief administrative judge determines a period of time for submission of written statements in lieu of examination by a witness.

C. A witness shall sign said written statements.

10. Examination Based on Communication Through Audio and Visual Transmissions (Patent Act Article 151→Code of Civil Procedure Article 204, Enforcement Regulations of the Patent Act Article 58-16)

(1) Examination under this system

This examination shall be conducted by examining a witness (parties themselves, an expert) who resides in a distant location using a video conference system (→37-02). The video conference system enables a person who resides in a distant location to communicate with another person while recognizing the conditions of each other by audio and sound transmissions.

(2) Opinion of parties

This examination is a new type of examination of evidence, and it is preferable to conduct after obtaining full understanding and hearing of the opinions of the parties in conducting the examination.

(3) Specific methods of use for a video conference system

A. Required equipment

For using the system, the following equipment is required. It is not necessary to install a specific software for a video conference system.

- Personal computer
- Internet connection (network line speed is ADSL or above recommended)
- Web camera
- Microphone and speaker

B. Procedures

(i) When time to use is fixed, an invitation mail is sent to an attendant's e-mail address. The invitation mail includes the date and time and invitation URL.

(ii) It is possible to access the invitation URL after the date and time of the conference shown in the invitation mail. Access the invitation URL and enter the conference room on the website.

C. It is also possible to proceed with the examination while using the facsimile, for example, by sending a statement such as a power of attorney.

D. When a video conference system is used, it is required to include the fact to use the system and a place where a witness, etc. has appeared in a trial record.

11. Measure for Protecting Witness in Examination of Witness

(1) Attendance (Patent Act Article 151 → Code of Civil Procedure Article 203-2, Enforcement Regulations of the Patent Act Article 58-15-2)

A chief administrative judge may allow a witness to be accompanied by a person whom it deems appropriate to relieve tension and anxiety of the witness and is unlikely to have an undue influence on the testimony of the witness, if it is found the witness is likely to cause significant anxiety and tension.

In case of taking this measure, a chief administrative judge shall ask opinions of parties themselves, an intervenor, and a witness. When taking said measure, a chief administrative judge shall include necessary information in a trial record.

(2) Shielding (Patent Act Article 151 → Code of Civil Procedure Article 203-3, Enforcement Regulations of the Patent Act Article 58-15-3)

When the witness is likely to feel pressure and whose peace of mind would be seriously harmed while testifying in the presence of parties themselves or the legal agent and when the chief administrative judge finds it to be appropriate, take a measure to set a shielding screen between a witness and the parties themselves or legal agent. Considering the nature of the case, a shielding screen may be set between a witness and the audience in court.

When taking said measure, a chief administrative judge shall ask opinions of parties themselves, an intervenor, and a witness. In case of taking said measure, a chief administrative judge shall include necessary information in a trial record.

(3) Video conference system (Patent Act Article 151 → Code of Civil Procedure Article 204, Enforcement Regulations of the Patent Act Article 58-16 etc.)

It is not limited of a case where a witness resides in a distance location, but when a person who, taking into account the nature of the case, is likely to feel pressure and whose peace of mind would be seriously harmed while testifying at the place where the chief administrative judge and parties concerned in the case are present for examination of the witness, and it is found to be appropriate, an examination may be made by a video conference system.

When taking said measure, a chief administrative judge shall ask opinions of parties themselves, an intervenor, and a witness, and have a witness appear at an appropriate place. In case of taking said measure, a chief administrative judge shall include necessary information in a trial record.

(4) Measure to have audiences leave court (Patent Act Article 151 → Code of Civil Procedure Articles 203-3(2), 204, Enforcement Regulations of the Patent Act Article 58-14)

In case of taking a measure to set a shielding screen between a witness and audiences and to use a video conference system for examination, when it is deemed that a witness feels pressure in the presence of a specific audience and is not able to make sufficient testimony, ask opinions of the parties and intervenors and have the audience leave from court while the witness testifies.

(Revised Dec. 2020)

Form 1

Notice of Advance Payment

Date:

Chief Administrative Judge, JPO

To Mr./Ms.

Regarding Invalidation No. 20XX-800XXX,
 an expenses and a fee (JP¥) for examination of witness (Mr./Ms.) shall
 be paid in cash in advance to an officer in charge of receipts and disbursements of
 cash other than annual revenue and expenditures an officer in charge of receipts and
 disbursements of cash other than annual revenue and expenditures at JPO within ()
 days from the date on which this notice is dispatched.

Two copies of duplicate of a statement of matters for examination made to the
 above witness which was previously submitted shall be submitted. The extension of
 the designated period of time shall not be accepted.

Details of Advance Payment

Witness	Amount
Total	

After the advance payment is made, when there is withdrawal of a demand for trial,
 withdrawal of opposition to grant of patent (opposition to registration of trademark)
 accompanied by a request for examination of witness, or withdrawal of request for
 examination of witness, please contact an officer in charge of receipts and
 disbursements of cash other than annual revenue and expenditures (the (Accounting
 Dept. of JPO) for return of the payment.

Form 2

Summons Informing Oral Proceeding Date

Date

Chief Administrative Judge, JPO

Agent for Demandant

Mr./Ms.

Agent for Demande

Mr./Ms.

Invalidation No. 20XX-800XXX

Demandant

Demandee

Regarding Patent No.○○○○○○○○ (Invalidation No. 20XX-800XXX) which is the case of the above party, since an oral proceedings date is scheduled to be on (Date), parties shall appear in court on the day.

An oral proceedings statement brief shall be submitted by (D/M/Y) afterwards.

A witness who is examined on the day is as below.

Witness (name)

Form 3

Witness Summons

Date

Chief Administrative Judge at JPO

Mr./Ms.

Invalidation No. 20XX-800XXX

Demandant

Demandee

JPO requests a witness to appear in trial court at JPO with this letter on (Date) to be examined as a witness regarding matters for examination of witness described in an attached sheet for the above case.

(If a witness does not meet the request without any reasonable grounds, a civil fine for less than ¥100,000 may be punished.)

(Revised Dec. 2020)