

35-08 P U D T
Preservation of Evidence

1. Significance

(1) Preservation of evidence is a trial procedure when a specific evidence which is likely to become impossible or difficult to be examined by waiting a general examination of evidence in a trial case, it is examined in advance and the results thereof are preserved (Patent Act Article 150, Article 151→ Code of Civil Procedure Article 234, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

(2) Generally, a date of examination of evidence is designated after conducting a demand for a trial and a reply, etc. and arranging matters to be proved and a point of issues in response to this and reviewing evidence that requires an examination. Therefore, it requires a certain amount of time from a demand for trial to an examination of evidence. However, it sometimes becomes impossible or difficult to conduct an examination of evidence for the reasons including death of a witness due to illness, etc., manipulation, concealment, destruction, loss or damage of matters to serve as evidence. If there are special circumstances like this, it is necessary to examine and preserve the evidence without due formalities as mentioned.

2. Procedure of Preservation of Evidence

Preservation of evidence is requested to a chief administrative judge when a trial has already been filed or Commissioner of the JPO when a trial has not been filed yet. A petitioner submits a written request for preservation of evidence stating a petitioner and the other party, facts to be proved, evidence, and reasons for preserving evidence and shall make a prima facie showing of the reasons for preserving evidence (Patent Act Article 150(2)(3), Utility

Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4), Enforcement Regulations of the Patent Act Article 50, 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), Enforcement Regulations of the Patent Act Article 64, Code of Civil Procedure Article 153).

(1) Identification of a petitioner and the other party

Each party's address and name shall be described. A petitioner is an interested party prior to the filing of a demand for trial, and once the trial is pending, a petitioner can be a demandant, a demandee or an intervenor (Patent Act Article 150(2)).

(2) Facts to be proved

The facts must be necessary for proof of statements of a petitioner.

(3) Evidence (→34-01, 35-06)

It is understood that a means of proof does not have any limitation, therefore, it may be any of a witness, an expert, a document, an object of inspection, or a party himself.

A. Witness: a witness is identified by an address and a name.

B. Expert: it is not necessary to identify an expert since an expert is designated by a trial panel.

C. Document: it is necessary to identify a date of creation, a name of creator, a title, a summary or outline of matters described and a name of a person who actually holds the document.

D. Object of inspection: it is necessary to identify a name, a content, and a location of the object. If an object belongs to a person other than a petitioner, it is also necessary to indicate an address and a name of the person since the object is presented after obtaining a consent of the person.

E. Party himself: it is equivalent to a witness.

When a means of proof is a witness or a party himself, matters for examination shall be clarified, when a means of proof is an expert, matters for expert opinion shall be clarified, and when a means of proof is an object of inspection, matters for inspection of evidence shall be clarified.

(4) Reasons for preservation of evidence

A situation shall be clearly described that an examination of evidence is made in advance otherwise it is likely to become difficult or impossible to use the evidence.

For example, when a witness has a limited life expectancy or a witness is a foreigner and expected to return home soon, etc., when there is only one expert and the expert has a similar situation as above (a party himself is the same as a witness), when it is fear of change of the original state of an object of inspection or a document, especially when it is fear of manipulation, concealment, destruction, etc. if evidence is a document, the reasons shall include necessity of the preservation based on a concrete situation.

(5) Prime facie showing of reasons of preservation of evidence

Prime facie showing shall be made by the evidence which is available for the examination immediately (Patent Act Article 151 → Code of Civil Procedure Article 188). In practice, something like a private report (proof) is often attached to the petition and testimony of a witness, etc. is limited to those present. Prime facie showing means an administrative judge reaches a conclusion that an existence of reasons for preservation of evidence is probable.

3. Determination of Preservation of Evidence

(1) The records for a petition shall be prepared and immediately circulated to a panel previously designated (→12-01) before a trial clerk conducts a formal examination under the circumstances that require urgent proceedings.

(2) Preservation of evidence shall be determined based on the following reasons: a petition is duly made and equipped with the requirements, the evidence belongs to a petitioner or a person who is responsible to submit the evidence, and there is prime facie showing of the reasons of preservation of evidence. An opposition may not be filed against the determination of preservation of evidence (Patent Act Article 151→Code of Civil Procedure Article 238).

(3) When evidence subject to preservation belongs to the other party or the third party, an order of submission or presentation of document is made in accordance with a determination of preservation of the evidence.

However, if a person possessing a document or an object of inspection refuses to submit (present) the evidence, an effect of the determination of preservation of evidence may not be achieved since the Patent Act shall not be applicable *mutatis mutandis* to the regulations related to penal provisions for non-compliance with orders to submit a document under Code of Civil Procedure (Code of Civil Procedure Articles 224, 225, 232(2)(3) and Patent Act Article 151). In addition, if an administrator of an installation place for objects of inspection refuses entry to the place, it is not possible to conduct an inspection. Even in this case, the same thing will be happened for the effect of the determination of preservation of evidence.

Therefore, a pane shall have an advance meeting with a petitioner concerning the method of the examination of evidence to avoid getting into the situation as described in making determination of preservation of evidence.

4. Preparatory Procedures Before Implementation of Preservation of Evidence

Preservation of evidence shall be generally determined within one month from a request is filed. After the determination, the date of examination of evidence shall be designated (→ 33-01). Preparatory procedures for an

examination of evidence shall be promptly conducted in the following order since it is also a short period from determination to implementation.

(1) Service of a certified copy of determination

When preservation of evidence is determined, a written determination shall be transferred to a trial clerk. After the trial clerk certifies the written determination, a certified copy shall be served to a petitioner and the other party (including an intervenor). See also (4) below for the time of service.

(2) Determination of the date and cost

A date of examination of evidence is determined after having a meeting with the panel to designate the date of examination of evidence immediately thereafter, and the cost required for the preservation of evidence is calculated. The cost includes travel expenses for 3~5 administrative judges, 2 trial clerks and witnesses for the examination, etc. See 35-01 for the detailed breakdown of the cost and procedures.

An advance payment for costs of preservation of evidence shall be requested to do so immediately by properly contacting with an agent by telephone, etc.

Especially when it is extremely urgent so that it cannot summon the other party, the examination may be implemented without summons of the other party (Patent Act Article 151 → Code of Civil Procedure Article 240).

The other party should attend the examination of evidence as much as possible otherwise precious testimony, etc. is not subjected to a cross-examination due to no counterpart, resulting in a weak evidential power, thereby the original purpose may not be achieved.

(3) Payment of costs

Costs of a witness when an examination of evidence is conducted out-of-court, an accounting official with money in custody of the Accounting Department issues a check which is received and delivered to a witness on site.

(4) Notice of the designation of date

A trial clerk drafts a notice of designation of date for on-site inspection of evidence (if only an examination of witness, a notice of date for examination of witness) and a summons of witness if an examination of witness also proceeds in parallel (→35-01, Form 3), and serves it to parties and witnesses after approval.

This service (→35-01 3.(1)C) should consider the time period by the date of examination of evidence.

The time period is short from the date requesting an examination of evidence to the date implementing an examination of evidence, thus, normally, documents such as a duplicate of a request for preservation of evidence, a certified copy of a written determination of preservation of evidence, a notice of designation of date for on-site inspection of evidence are collectively served.

(5) Procedures for a trip for inspection

When an advance payment for costs is made, the General Affairs Section is requested to prepare a written order of trip for inspection. In requesting a written order of trip, a memorandum is prepared including a name of officers in charge (3~5 administrative judges, 2 trial clerks), a case identification, a date and place of the inspection, a place of stay, transportation, and a name of advance payer and a date of advance payment.

(6) Consideration of inspection place and tools, etc.

The following points shall be considered with a petitioner of preservation of evidence (an agent).

A. Inspection place

A petitioner is asked to submit a rough sketch describing a direction from an arrival station as much as possible. It is preferable to ask convenience for transportation, a location of accommodation, etc.

B. Regarding permission of entering a building owned by the other party or the third party, or permission by the owner or administrator of an object of inspection

C. Tools deemed necessary on the day of inspection

(A) When an examination of witness is conducted in parallel, a space, desks, chairs, etc. for the examination

(B) When an inspection is conducted outside and likely to rain, tools for rain (such as a sheet)

(C) When an object of inspection is a building, etc., a ladder, etc.

(D) When a close-up photography is particularly required such as for a design case, request to an expert appropriately.

5. Implementation of Examination of Evidence

Since an examination of evidence under preserving the evidence is conducted according to the regulations of the original examination of evidence, it is similarly implemented to an examination of evidence, an inspection of evidence, etc.

6. Send of Records of Preservation of Evidence

When an examination of evidence is conducted for preservation of evidence, an administrative judge who has conducted the examination shall send the records concerning the examination to an administrative judge who has the records of this trial case (Enforcement Regulations of the Patent Act Article 65, 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 154).

7. Preservation of Evidence Before a Demand for Trial Is Filed

When an examination of evidence for preservation of evidence is conducted before a demand for trial is filed, a demandant shall indicate a case identification number of preservation of evidence, etc. in a written demand for trial.

(Revised Oct 2015)