

## **35-00 P U D T**

### **Examination of Evidence in General**

#### **1. Principle of Directness and Principle of Indirectness**

In the examination of evidence, a principle of directness refers to a situation where a panel to be made a trial decision examines evidence by their own, and a principle of indirectness refers to a situation where an administrative judge who is a part of the members of the panel (an authorized administrative judge) or an administrative judge who is not a member of the panel (a commissioned administrative judge) or an institution other than a panel examines evidence and a panel forms the conclusion based on the results of their report. In the former principle, a panel directly accesses evidence so that it is possible to form a fresh and accurate conclusion, whereas in the latter, a panel does not have an opportunity to directly access evidence, therefore, the former is considered superior to the latter.

Code of Civil Procedure is in principle adopts the principle of directness (Code of Civil Procedure Article 249(1)). As an exception, it is permitted an examination of evidence by an authorized administrative judge or a commissioned judge (Code of Civil Procedure Articles 185, 268) and the update of the prior arguments when a court judge is replaced (Code of Civil Procedure Article 249(2)) from the perspective of ensuring mobility of the proceedings and litigation economics.

The trial/appeal procedures in principle adopt the principle of directness, while an examination of evidence by an authorized administrative judge (→ 35-11) and commission to examination of witness by court (→ 35-03) adopt the principle of indirectness.

#### **2. Examination of Evidence, Factual Findings**

(1) For appropriate trial proceedings and its conclusion, the grounds and processes of “factual findings” (work to determine the existence of fact) shall be fair and reasonable. The evidence is required for finding a fact in principle, therefore in examination of the evidence, namely a procedure of an “examination of evidence”, it is also required to be fair and reasonable.

Factual findings using the results of illegal examination of evidence or ignoring the results of legal examination of evidence are both illegal. For the purpose of being guaranteed that there is no illegality in factual findings and enhancing the reliability on trials for parties concerned and third parties, materials for factual findings and reasoning process supported by these materials shall be clarified in a trial decision (for that reason, it is required to state “reasons” in a trial decision ((1979 (Gyo-Tsu) 134) Judgement of Supreme Court), Mar 13, 1984)).

(2) Regarding the existence of fact affecting the conclusion of proceedings, it usually happens that there is a dispute between the parties. The nature of the dispute is often rooted in the difference in evaluation of evidence such as testimony of a witness, descriptions in a document or an object to be examined.

Evaluation of evidence shall be finally determined by a panel. A panel shall not be wrongly influenced by the statement of the parties and shall understand and perceive testimony of witness, descriptions of documents, or objects to be examined to find a fact based on its freedom of personal conviction. However, it is needless to say that the evaluation of evidence should be along with the social common sense and experiences, and the technical common sense.

### 3. Clear Distinction Between Factual Findings and Legal Evaluation

(1) Trial proceedings follow the process below.

① Establishing an existence of concrete fact based on “evidence” submitted

for a trial (factual findings).

② Determining whether the concrete fact whose existence are established satisfy with the legal requirements regulated under the provisions of the Patent Act (Utility Model Act, Design Act, Trademark Act) (legal evaluation).

③ Leading conclusion of a certain administrative disposition (legal effect)

As such, the “existence of concrete fact (①)” and “whether they satisfy with the legal requirements (②)” are different issues. “Examination of evidence” is made to find the “existence of concrete fact (①)”.

(2) However, a request for examination of evidence by a party concerned is not sometimes distinguished “a fact to be proved” from “statements of legal effects”.

For example, a request for examination of evidence such that a “fact that the present invention is publicly implemented will be proved by testimony of a witness A” is legally inappropriate in that a “fact” of “publicly implemented” which is not a concrete fact, but legal requirements will be proved.

Administrative judges should, without being tossed about by such a request, understand what should be proved by a witness A is, for example “the fact a product XX is sold to B on (D/M/Y)”, but “whether or not the sales fall under ‘publicly implemented’” should be interpreted (determined) by the administrative judges from the results of the factual findings. The administrative judges make parties concerned be clear what is the concrete fact to be proved by an examination of evidence and make the parties concerned clearly distinguish them from statements of legal evaluation.

(3) As described, parties concerned shall state after distinguishing the following two: ① proving the existence of the concrete fact based on the evidence and ② the fact falls under the constituent features regulated by law (or vice versa, it does not fall under the constituent features). But, as described above, since evaluation of evidence and factual findings (①) are

to be determined by a free conviction of a panel, legal evaluation of said fact (②) is also a panel's exclusive prerogative and the panel shall not receive an undue influence on the statement of parties concerned in any determination.

#### 4. Multiple Means of Proof and Factual Findings

(1) Regarding multiple evidence is submitted for one concrete fact, and sometimes they are all examined. In this case, a panel shall conduct the consistent factual findings based on the multiple evidential materials obtained from the examination of evidence. In particular, when an examination of evidence is conducted on means of proof submitted by a party concerned who is responsible to prove a certain fact (evidence, Hon-sho) and means of proof denying the fact submitted by the other party (counter evidence, Han-sho), for establishing conviction of the administrative judges, it has become issues that a relationship between a fact shown by each evidence and possibility of the existence of counter fact shown by Han-sho.

(2) It should not determine a "fact is not acknowledged" immediately by the possibility of existence of counter fact. Even if there is a slight opportunity of existence of counter fact, when a panel has confident that there exists a fact to be proved to the extent that "the ordinary person" considers no reasonable doubt, as a result of examining all evidence comprehensively and reviewing the counter fact in light of empirical doctrine, the panel considers a "fact may be acknowledged" and makes a trial decision accordingly.

(Revised Oct. 2015)

## **35-01 P U D T**

### **Procedures for Preparation for Examination of Witness, etc.**

1. Planning for Poof, 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)

## **35-02 P U D T**

### **Guidelines for Trial Records of Examination of Evidence**

1. Trial records of examination of evidence are prepared by a trial clerk similar to trial records of oral proceedings (Patent Act Article 151→Patent Act Article 147(1), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

Matters to be described in the trial records of examination of evidence (Enforcement Regulations of the Patent Act Article 57-5, 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(5)(6)).

- (1) Trial number
- (2) Names of administrative judges and a trial clerk
- (3) Names of parties themselves, an agent, an intervenor, an interpreter, a witness, an expert those who appeared in court
- (4) Date/time and location of the examination of evidence
- (5) Open or close to the public of the examination of evidence. If it is not open, that effect and the reasons therefor
- (6) Summary of statements of a witness, parties themselves and an expert
- (7) Whether or not a witness, parties themselves and an expert swore under oath, and reasons for not having a witness and an expert swear under oath
- (8) Results of inspection
- (9) Matters to be described by order of a chief administrative judge or by request of a party concerned or an intervenor
- (10) Other necessary matters

2. A panel forms the conclusions by materials obtained by the results of

examination of evidence using a means of proof (→ 34-01), namely contents of testimony or statements, expert opinions, contents of evidential documents, results of inspection of evidence, therefore, the trial records of examination of evidence which includes those materials is an essential document.

### 3. Points to Be Considered

(1) A form of trial records of examination of evidence is as Form 1. The manner of preparation of the records is similar to trial records of oral proceedings (→ 33-04), and a means of proof such as a witness shall be clarified.

(2) A document, photography, recording tape, etc. (for example, CD-R, DVD-R), or any other objects that are found to be appropriate by an administrative judges (a panel) may be cited in trial records, and be attached to trial records as a part of said records (Enforcement Regulations of the Patent Act Article 57-7 → Article 56, Enforcement Regulations of the Utility Model Act Article 23(12), Enforcement Regulations of Design Act Article 19(8), Enforcement Regulations of the Trademark Act Article 22(5)(6)).

(3) The original, transcript or extract of documents used for the comparison of handwriting or an impression of seal shall be attached to trial records for proving authenticity of creation of documents (Enforcement Regulations of the Patent Act Article 61-8(1), Patent Act Article 151 → Code of Civil Procedure Article 229(1), Enforcement Regulations of the Utility Model Act Article 23(12), Enforcement Regulations of Design Act Article 19(8), Enforcement Regulations of the Trademark Act Article 22(5)(6)).

(4) When a statement of a witness, etc. is recorded in a recording tape, etc., this recording tape may be replaced with trial records of examination of evidence if it is permitted by a chief administrative judge (Enforcement Regulations of the Patent Act Article 57-6, Enforcement Regulations of the Utility Model Act Article 23(12), Enforcement Regulations of Design Act

Article 19(8), Enforcement Regulations of the Trademark Act Article 22(5)(6)). In this case, the recording tape becomes trial records about a statement part of the witness. A party concerned or an intervenor may state an opinion when it is permitted by a chief administrative judge.

A written statement of a witness, etc. shall be prepared when it is requested by a party concerned or an intervenor before a transcript of a trial decision is served (the statement is merely an explanatory material using as reference for understanding the contents of said recording tape).

When a demand for trial is withdrawn, however, it is not necessary to prepare this statement.

4. Trial records of examination of evidence varies in types such as trial records of witness, trial records of parties themselves, trial records of expert, trial records of inspection.

#### 5. Trial Records of Witness

(1) Fill prescribed matters in the items of a witness's name and address in Form 1, oath of the witness and a notice of penalty for false testimony from a chief administrative judge (Patent Act Article 151 → Code of Civil Procedure Article 201(1), A part of Rules of Civil Procedure Article 112 and so on), and whether other witnesses to be examined are in trial court. When an interpreter is present in court, this effect shall be entered in the form. If taking a measure for protecting a witness (→ 35-01 11.(1)~(3)), the followings shall be also entered in the form.

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

State that such an action is taken, and a name of the attendant and the relationship between the attendant and the witness.

B. Video conference system (Patent Act Article 151 → Code of Civil Procedure



Article 204, Enforcement Regulations of the Patent Act Article 58-16(1)(2), etc.)

State that such an action is taken, and a place where a witness has appeared.

### C. Measure of shielding

State that such an action is taken.

(2) When an examination of witness is made by request, enter examinations (questions) made in order (→ 35-04) and summary of the testimony (statements) of the witness.

When there are active interactions for limitations of the chief administrative judge on unprepared questions of parties and an objection against the limitation, it is often preferable a questions-and-answer style.

(3) A trial clerk and prepares a “draft of trial records” following (1) and (2), and a chief administrative judge complements or summarizes the “draft of trial records” if necessary and provides it for the trial clerk for reference in preparing trial records.

(4) In trial records, a trial clerk affixes the name and seal and a chief administrative judge affixes a seal of approval (Enforcement Regulations of the Patent Act Article 55(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(5)(6)).

When a chief administrative judge has difficulty affixing a seal of approval, an associate administrative judge shall affix a seal of approval while appending a supplementary note about the reason therefor. If both administrative judges have difficulty affixing a seal, a trial clerk includes the records to that effect (Enforcement Regulations of the Patent Act Article 55(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(5)(6)).

(5) Documents attached with trial records are shown below.

#### A. Oath with signature of a witness

When a witness may not sign, a trial clerk signs on behalf of a witness with a reason therefor and a witness presses a finger seal thereon.

B. When a chief administrative judge finds it appropriate, a note with a signature of a witness may cite as a part of trial records.

### 6. Trial Records of Parties Themselves

This case is similar to the item 5. except the following points.

A party concerned who swears under oath makes false testimony, different from a case of trial records of a witness, there is no sanction of imprisonment (civil fine of JPY100,00 or less).

### 7. Regarding Inspection and Copy of Trial Records Prepared by Recording Tape, etc.

“Trial Records” are provided in duplicate of a recording tape or a video tape.

### 8. Trial Records of Inspection

(1) Descriptions of trial records of inspection conducted in trial court are the same as descriptions in the item 5. and the item 6. In addition to a purpose of the inspection, the processes and results of the inspection may be included.

A. A purpose of inspection should be specified.

B. Depending on a purpose of inspection, the inspection is sometimes easily understood visually, and even in that case, do not omit necessary descriptions.

(2) Trial records of inspection of the scene shall include, besides (1), a place for inspection and an object for inspection, and shall require attached drawings to illustrate the object for inspection in principle. This is based on the request that an object of inspection should be identified objectively.

(3) Parties usually attend for inspection. In this case, it is requested opinions

or statements of both parties on the object of inspection, and a chief administrative judge inspects the object of inspection with other administrative judges, and they confirm the results.

When a chief administrative judge asks a question supplementary, since the question is asked to persons present on the scene, their address and name shall be described in the trial records.

(4) When there is a request of a witness in court (a witness on the scene) to explain an object of inspection, or a witness is examined ex officio, these procedures are processed according to the item 5.

(5) A result of the inspection shall include matters recognized and confirmed by a chief administrative judge based on the results of implementation of the inspection. when it is deemed necessary, a starting point, a direction, etc. are also included in the trial records in case of time, weather, a sketch, a photography, or a distance relationship, etc.

For a result of inspection, it is considered that a conclusion of a fact that can be immediately inferred from the inspection may be included.

(Revised December 2020)

Form 1

The First Trial Records of Examination of Evidence		
Trial No.	Invalidation No. 20XXX-800XXX	
Date		
Place and		
Public Availability	Open to the public at Trial Court of JPO	
Chief Administrative Judge	Mr. (Ms.)	
Administrative Judge	Mr. (Ms.)	
Administrative Judge	Mr. (Ms.)	
Trial Clerk	Mr. (Ms.)	
Parties, etc. Appeared in Court	Agent for Demandant	Patent Attorney
	Agent for Demandee	Patent Attorney
	Witness	
Evidence	As described below in the records	
	Trial Records of Witness	
Identification of Witness		
Name		
Address		
Occupation		
A chief administrative judge explains the purport of oath and notifies the punishment if a witness makes false testimony, and has a witness read a written oath and make an oath.		
Summary of Statement		
Agent of Demandant		
001	○○○○○○○○	
	.	
Chief Administrative Judge	Administrative Judge of JPO	XXXX
	Trial Clerk	YYYY

(Revised June 2019)

**35-03 P U D T****Commission for Examination of Evidence by Questioning**

1. An examination of evidence by questioning may commission a district court or a summary court (Patent Act Article 150(6), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)). This procedure is based on the principle of indirectness (35-00 1.) and there is no direct examination to a witness and facts are determined only by trial records of examination (→ 5.). Therefore, this procedure should be adopted only to an exceptional case such as shown in 2.

2. A panel shall determine whether to commission, however, the commission shall be adopted on a limited basis such as the following cases.

(1) When all of the following conditions are satisfied

A. An object of inspection exists on in a local area

B. An object of inspection is difficult to carry to the JPO

C. There is a condition that a panel is difficult to visit a local area

(2) When a witness lives in a local area and cannot endure the situation such as being an old age, delicacy of health, and there is also a condition of the above (1) C.

(3) When an examination of evidence shall be carried in the whole country or particularly many locations, and it is found to be difficult to collect all evidence to the JPO and to visit all local areas in terms of cost and time for a panel.

(4) When it is predicted that sufficient conviction may be obtained only by a record of commission for examination since a creation of document, etc. is quite simply.

3. Matters for examination shall be carefully determined so that sufficient

conviction can be obtained and note the following points in particular for addressing a disadvantage in the item 1.

(1) Order of a witness (an expert, parties themselves) to be examined (→ 35-04)

(2) Clarity of contents of matters to be examined and their order

(3) In a case where matters for examination which can be testified either positive or negative and the subsequent matters for examination change in either positive or negative of the previous question, it should be clarified the subsequent question is made based on either positive or negative testimony of the previous matters for examination.

(4) Even if a matter for examination is similar in content, it is also necessary to repeat it by putting it in the appropriate part in the matters for examination by changing the expression as necessary.

4. A trial clerk proceeds as shown below according to an instruction of a chief administrative judge either by request or ex officio.

(1) Cost calculation and advance payment

Similar to the preparation procedures of an examination of witness (→ 35-01), calculate two times of costs for summons before a court (parties themselves, a witness, an expert), a travel expense, a daily allowance and an accommodation fee for a witness, and ask a person who requests the examination to pay the costs in advance.

(2) Determination of matters for commission

Matters for examination shall be determined for an examination of witness and an object of expert opinion or an object of inspection shall be determined for an expert opinion or an inspection, and in addition a content of commission shall be determined.

(3) Preparation for a written commission

A. A written commission for examination of evidence in Form 1 shall be

prepared and sent to a court of addressee under the name of chief administrative judge.

In this case, the general venue of persons who are examined as a witness and an expert shall be searched and note to determine a court of addressee.

For this written commission for examination of evidence, when a cost for examination is transferred from the JPO, add Form 2, and when a court of addressee issues an order of advance payment, add Form 3 both as a postscript.

B. Attached documents and objects (an object of expert opinion, an object of inspection) are described in a written commission as attached documents or a list of attachments. When a court of addressee sends the JPO the trial records which clarifies the content of examination of evidence, the JPO requests the court to return the attached documents and objects to the owner thereof (→ Form 2 or Form 3).

C. Required number of copies of documents stating matters for examination, matters for inspection and a purpose of inspection shall be added in a written commission as additional attached documents.

D. Sending of cost

When a cost required for commission for examination is sent, ask the Accounting Division of the JPO to send the cost (remote payment) to an officer in charge of receipts and disbursements of case other than annual revenue and expenditures of a court of addressee.

E. When a document is removed from the records and attached to a written commission, a written statement is bound where the removed document was originally located, stating the reason that the document is removed and sent to a court for commissioned examination of evidence.

## 5. Handling of Trial Records

When trial records of examination is sent to the JPO after examinations from a court of addressee (→ 4. (3) B), the records shall be bound for record-



keeping. The returned attached documents and objects are also bound to the records, or either bound to the original place or kept in the original storage.

6. A panel can treat records of commission for examination as materials for determination, similar to records of examination of evidence, but there is a reason to be cautious in determining matters for examination (→3.) since a conviction should be obtained only from writing.

7. An examination may be conducted also by a member of a panel who is designated as an authorized administrative judge without commissioning a court of addressee (Patent Act Article 151→Code of Civil Procedure Article 195, Enforcement Regulations of the Patent Act Article 57, Coder of Civil Procedure Article 31, Authorized Administrative Judge →35-11).

Form 1

### Commission for Examination of Evidence

Date:

Addressed to: The Civil Division of Court

Trial and Appeal Dept., JPO

3-4-3 Kasumigaseki, Chiyoda-ku, Tokyo

Name of Chief Administrative Judge, JPO:

20XX, Trial No.

Address

Name of Demandant:

Address

Name of Agent:

Address

Name of Demande:

Address

Name of Agent:

For a Trial Case (        ) between the above parties, based on the matters  
for examination in a separate sheet, we would like to commission the  
examination shown below.

Note

Witness      Address:

Name:

## Form 2

Please consider the examination that becomes more details than the content described in matters for examination in a separate sheet, follows the order shown below, and is made as a witness does not predict what will be examined later.

1.

1.

Attached documents

1. Exhibit A-X

2. Exhibit B-X

Please return the above attached documents after used.

A cost for examination based on the following calculation is in the process of being transferred to the accounting section of the Court from an officer in charge of receipts and disbursements of cash other than annual revenue and expenditures of the JPO.

1. Cost for parties summons on a designated date	Yen
1. Cost for witness summons	Yen
1. Dily allowance of witness	
Travel expenses	Yen
Accommodation fees	Yen
1. Cost for service of documents to JPO	Yen
Total	Yen

## Form 3

Please issue an order of advance payment shortly for a cost for examination.

Please consider the examination that becomes more details than the content described in matters for examination in a separate sheet, follows the order shown below, and is made as a witness does not predict what will be examined later.

1.

1.

Attached documents

1. Exhibit A-X

2. Exhibit B-X

Please return the above attached documents when used.

A cost for examination based on the following calculation is in the process of being transferred to the accounting department of your government office from an accounting official with money in custody of JPO.

1. Cost for service of order of advance payment	Yen
1. Cost for parties summons to appear on a designated date	Yen
1. Cost for witness summons	Yen
1. Cost for service of documents to JPO	Yen
Total	Yen

(Revised June 2019)

**35-04 P U D T**  
**Order of Examination of Witness**

**1. Call of Incident, Roll Call**

On a date of examination of witness, a chief administrative judge shall call an incident, and confirm the attendance of parties and their agents by taking a roll call.

If a witness has a reason not to be able to appear in court on the designated date, a witness shall report that effect with clarifying the reason (Enforcement Regulations of the Patent Act Article 58-4, 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)).

**2. Establishing the Identity of Witness**

A chief administrative judge asks questions to a witness such as a name, age, profession and address after comparing a writ of summons for a witness brought by a witness appearing before court with the original. When a witness appearing before court does not bring a writ of summons or when a writ of summons is not necessary to submit, a report card of appearance of a witness, etc. shall be entered.

When the descriptions in a writ of summons for a witness brought by a witness or a report card of appearance of a witness, etc., are different from a written request for examination of witness, a witness or parties shall be explained immediately. A relatively large number of differences are occurred in addresses when a name of the town or a lot number has been changed or when a place of temporary residence or a business location are described as address. As a result, when a witness is approved as a witness to be examined,

the proceedings are conducted after taking necessary measures such as ordering parties to amend a request for examination of witness or instructing a trial clerk to include a content of clarification in trial records.

### 3. Recitation of Oath

(1) An oath of witness shall be made before an examination starts. When there are special reasons, however, an oath may be made after an examination (Enforcement Regulations of the Patent Act Article 58-5(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 112(1)).

(2) A chief administrative judge shall explain a witness before swearing under oath on a purport of oath, warning against punishment of false testimony (Patent Act Article 199, Utility Model Act Article 59, Design Act Article 72, Trademark Act Article 81) and cases where a witness may refuse to testify (Patent Act Article 151→Code of Civil Procedure Articles 196,197). Then, a chief administrative judge has all people in court stand up and has a witness recite the written oath containing a statement that “the witness swears to tell the truth according to the dictates of his/her conscience without hiding anything or adding anything” and sign this written oath (Enforcement Regulations of the Patent Act Article 58-5(2)~(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(5)(6), Rules of Civil Procedure Article 112(2)~(5)).

(3) When a witness is not able to recite a written oath, a chief administrative judge shall have a trial clerk recite the written oath (Enforcement Regulations of the Patent Act Article 58-5(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(5)(6), Rules of Civil Procedure Article 112(3)).

(4) If a witness is unable to communicate in Japanese, or is hard to hear or speak, and the court has an interpreter attend the examination (Patent Act Article 146→Code of Civil Procedure Article 154), said interpreter shall swear under oath as in the case of a witness (Patent Act Article 151→Code of Civil Procedure Articles 216, 201). If an interpreter makes a false interpretation, the crime of making a false interpretation is applied (Patent Act Article 199, Utility Model Act Article 59, Design Act Article 72, Trademark Act Article 81)

#### 4. Notification of Matters that Require Attention in Testimony, etc.

(1) (i) Speak clearly and slowly in testimony facing to a chief administrative judge, (ii) Speak only of his/her own experience and do not express his/her own opinions, (iii) Answer only what is asked, and (iv) A witness may refuse to testify about the personal confidentiality or against a witness himself/herself, but in this case the matters that require attention shall be notified such as being asked a reason for the refusal.

(2) When there are one or more than one witnesses, an examination is conducted in the predetermined order that is agreed with a person who requests the examination. If there is no prior agreement as to the order, the order shall be determined on the spot.

(3) A recording tape is usually used for a statement of a witness in the examination records. A chief administrative judge shall notify to that effect at the beginning.

#### 5. Separation of Witnesses

When there is one or more than one witnesses, an examination to witnesses is principally conducted separately and a chief administrative judge has the

witnesses to be examined later leave and wait in another room. If the chief administrative judge finds it necessary, however, the witnesses to be examined later may stay in court (Enforcement Regulations of the Patent Act Article 58-13, 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 120). When the chief administrative judge has the witnesses to be examined later stay in court, listen to opinions of both parties.

## 6. Order of Examination

An examination shall be conducted in the following order (Enforcement Regulations of the Patent Act Article 58-6, 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(5)(6), Code of Civil Procedure Article 202(1), Rules of Civil Procedure Article 113). When a chief administrative judge finds it appropriate, however, the chief administrative judge may change the following order after hearing the opinion of the parties (Enforcement Regulations of the Patent Act Article 58-6 (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(5)(6), Code of Civil Procedure Article 202(2)).

### (1) Direct examination

Examination by a party or an intervenor who requests an examination of witness on matters to be proved and related matters according to the matters for examination.

### (2) Counter examination

Examination on matters appeared on the direct examination and related matters and matters for credibility of testimony of a witness.



(3) Re-direct examination

Examination on matters appeared on the counter examination and related matters.

(4) Supplementary examination

Further examination by a party or an intervenor with permission of a chief administrative judge.

(5) Ex officio examination

A chief administrative judge may examine a witness personally whenever a chief administrative judge finds it necessary (Enforcement Regulations of the Patent Act Article 58-6(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(5)(6), Rules of Civil Procedure Article 113(3)).

An associate administrative judge may examine a witness after informing an administrative judge of that effect (Enforcement Regulations of the Patent Act Article 58-6(4), 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 113(4)).

(6) Simultaneous examination

A chief administrative judge, when finding it necessary such as contradicting the testimony or statements, may order a simultaneous examination of a witness and another witness (Enforcement Regulations of the Patent Act Article 58-11, 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(5)(6), Rules of Civil Procedure Article 118). When ordering a simultaneous examination, a chief administrative judge shall include that effect in the records. When

conducting a simultaneous examination, a chief administrative judge may examine the witnesses first.

## 7. Restriction of Question

A chief administrative judge may restrict questions of parties by request or ex officio, when a chief administrative judge finds it inappropriate that the question is made on a matter other than those specified in the above item 6. (1)~(3), or when the question falls under a prohibited question (→35-05 2.) (Enforcement Regulations of the Patent Act Article 58-7(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(5)(6), Rules of Civil Procedure Article 114(2)).

## 8. Opposition from Parties

When a party requests an opposition with regard to permission or non-permission of a chief administrative judge for an examination of witness (→ 6.(4)) or with regard to restriction of questions as described in the above item 7., a panel shall immediately determine to accept or reject the request, and this series of events shall be entered into the records of examination of witness (Enforcement Regulations of the Patent Act Article 58-10(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(5)(6), Rules of Civil Procedure Article 117(2)).

## 9. Examination of Parties

(1) An examination of parties follows the same order of examination of witness. However, if a party makes a false statement after swearing an oath, the person is subject to punishment by a civil fine, different from the case of

an examination of witness (Patent Act Article 202→Article 151, Code of Civil Procedure Article 207(1), Utility Model Act Article 62, Design Act Article 75, Trademark Act Article 83).

(2) A chief administrative judge has a responsible to have a witness swear an oath in principle in an examination of witness, while it is at the discretion of a chief administrative judge whether parties swear an oath in an examination of parties, (Patent Act Article 151 →Code of Civil Procedure Article 207(1)). In practice, a chief administrative judge determines whether to have parties swear an oath at the discretion after asking the parties themselves about an intention of the oath.

(3) If parties themselves to be examined do not have an agent, a chief administrative judge examines the parties themselves.

(4) Each party is the subject of the procedures, therefore, even if a party himself/herself is examined after the examination of other parties or witnesses, a party himself/herself may stay in court during said other parties or witnesses are examined (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(5)(6), Rules of Civil Procedure Article 127).

#### 10. Statement of Expert (→35-12)

(Revised December 2020)

## **35-05 P U D T**

### **Main Points of Examination of Witness**

#### **1. Presidency of the Proceedings of a Chief Administrative Judge**

A chief administrative judge initiatively presides over the proceedings including the following item 2. and ex officio (supplementary) examination to facilitate an examination of witness (Patent Act Article 138(2), Utility Model Act Article 41, Design Act Article 52, Trademark Act Article 56(1)).

A permission of a chief administrative judge is necessary for taking a photograph, writing stenography, audio recording, video recording or broadcasting.

#### **2. Prohibited Questions**

Questions shall be asked concretely and individually insofar as possible. A chief administrative judge shall take a measure to have a person who asks questions change the way of asking the questions, etc. if the questions are not a question-and-answer format but are conclusive and abstract manner, or the questions are made that a witness tells a story (Enforcement Regulations of the Patent Act Article 58-8(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), Code of Civil Procedure Articles 114, 115). The following questions (1) ~ (6) are prohibited (however, except a type of (1), this does not apply if “reasonable grounds” exist). A chief administrative judge may restrict questioning by request or his/her authority if a prohibited question is asked (Enforcement Regulations of the Patent Act Article 58-8(2)(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(5)(6), Code of Civil Procedure Articles 114, 115, Restriction of Questions (→ 35-04 7.), Opposition of Parties (→ 35-04 8.)

(1) Questions that insults or confuses a witness

(2) Leading questions

Leading questions are prohibited due to the risk of the content of testimony being manipulated by giving an unfair suggestion. However, guidance for the premise that is undisputed or guidance for memory recall has reasonable grounds and qualifies for effective proceedings.

(3) A question that is duplicate with a question being previously asked

However, when testimony that contradicts any previous testimony due to an obvious misunderstanding or oblivion, it is considered there are reasonable grounds.

(4) Questions asking for a statement of opinion

It is not allowed to ask mere opinions or impressions that are not facts, or opinions that need expert knowledge from a person without qualification (it is allowed for an expert witness). However, it is allowed to ask about determination on identity of persons or objects, handwriting, nature, ability, age, etc. Even if a witness states opinions (for example, easiness), not only are they often useless to prove factum probandum, but also a person who asks questions and a witness are likely to have unprofitable discussion, and as a result this tends to waste of time of the examination.

(5) Questions asking for a statement of facts that a witness has not directly experienced

This is a question for hearsay evidence, and it shall not be asked in principle. It is considered to have a reasonable ground if there are circumstances such as the death of the third party who has directly experienced said facts and the testimony is not available.

(6) Questions not related to points of issue

### 3. Smooth Progress of Examination of Witness

A chief administrative judge initiatively presides over the proceedings while paying attention to the following points to facilitate an examination of witness.

(1) A chief administrative judge encourages to promote an examination when an actual examination takes more time than originally scheduled.

(2) A chief administrative judge decides and notifies a conclusion to the parties in court or notifies a conclusion after the court is adjourned and a panel discusses in a waiting room, when the parties disagree about how to proceed the examination, etc. If a chief administrative judge may not determine due to unforeseen circumstances, the court is adjourned and a panel discusses immediately (If necessary, a panel inquires the concerned persons by telephone, etc. from a waiting room and draws a conclusion.)

(3) It is necessary to take a break once an hour or two (usually once every 45-90 minutes).

(4) A chief administrative judge shall interrupt the speech and give clear directions to the parties when they become an argument, their statements become redundant, or the content of the examination is unclear.

(5) When a person who asks questions approaches a witness for examination, a chief administrative judge encourages that person to examine from his/her own seat (Especially, it is perceived that the witness is uncomfortable).

(6) A chief administrative judge may have the specific audience leave from court during a witness makes statements after hearing an opinion of parties and intervenors for maintaining the order of the court, or for the reason that the witness may not make sufficient statements before the specific audience who intimidates the witness (Enforcement Regulations of the Patent Act Article 58-14, 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)).

(7) During opening of court, it is usually prohibited from photographing, stenographing, audio recording, video recording or broadcasting provided that they are allowed with permission of a chief administrative judge. If it is found a party or an audience who does such an act, a court clerk gives a notice “please do not take a picture as it will disturb the order of the court” and keeps the person from doing such an act or orders the person to leave the court (If there is a person who has already taken photos, leave this issue to a court clerk. Video recording, photographing or audio recording is possible before opening the court.)

#### 4. How to Testimony

(1) When a witness turns to a person who asks questions and testifies, the witness is urged to testify in facing the front (to the direction of a chief administrative judge).

(2) Since a statement of a witness should be based on memory of the witness, the statement shall be made orally in principle. However, a precise testimony may be obtained by referencing appropriate documents or by writing down drawings, figures, etc. in making statements in the case that the technical content is complicated, etc. The following examination method is accepted.

A. A witness may make statements based on documents with permission of a chief administrative judge (Patent Act Article 151→Code of Civil Procedure Article 203), and a person who asks questions may use documents, drawings, photographs, models, devices and any other appropriate articles (hereinafter referred to as “documents, etc.” in this section 35-05) with permission of a chief administrative judge for the examination (Enforcement Regulations of the Patent Act Article 58-9(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)). A document, etc. used for the examination should be the original or real, and if it has not

been examined as evidence, an opportunity of inspection of the document shall be given to the opposite party before the questions are made in principle. When a witness makes statements based on documents, etc., examination records shall include to that effect. Attachment of the presented documents to the records or if it is deemed necessary submission of a copy of the presented documents, etc. may be requested to the parties or intervenors.

B. A chief administrative judge may order a witness to take necessary actions such as writing characters, a numerical formula, a structural formula, schematic drawings, etc. when it is deemed necessary (Enforcement Regulations of the Patent Act Article 58-12, 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)). In this case, a witness shall add a name of machine, a name of parts and a brief explanation and never fails to sign on the writing.

(3) When making an audio tape, etc. a part of trial records, a document containing the transcription of the audio tape is prepared. It is preferable that the following points should be noted to facilitate preparation of the document containing transcription and to clearly understand the content of remarks from an audio tape or a document containing transcription.

A. A chief administrative judge states a name of a person who makes examination every time the person changes.

B. When a technical term or a professional academic term is used in testimony, a chief administrative judge has a witness make the statement clearly or repeat the statement in some cases.

C. A chief administrative judge has a witness identify the target specifically as much as possible when testimony includes a demonstrative pronoun such as “it”, etc. and it may make the target unclear.

## 5. Termination of Examination of Witness



If certain conviction has been obtained on matters to be proved and as a result, the scheduled remaining examinations has become unnecessary to conduct, the examination of witness shall be terminated at that point.

## 6. Others

(1) When a witness who is difficult to hear is given a question in writing, or a witness who is difficult to talk replies in writing, a chief administrative judge may have a trial clerk recite the document describing the question or the reply (Enforcement Regulations of the Patent Act Article 58-15, 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 122).

(2) When a commissioned administrative judge (→35-11) examines a witness, the commissioned administrative judge conducts the duties of an administrative judge and a chief administrative judge (Enforcement Regulations of the Patent Act Article 58-18, 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 125).

(3) A chief administrative judge may take various measures to protect a witness in an examination of witness (→35-01 11.)

(Revised December 2020)

## **35-06 P U D T**

### **Inspection**

#### **1. General Idea of Inspection**

Inspection is an examination of evidence where the nature or phenomena of things is directly inspected by the five senses of administrative judges and the result of the inspection is used as evidentiary materials. Inspection does not only involve the sense of vision, but also involves the sense of hearing, taste, smell, or touch as well. An object which is subject to inspection is an inspection object.

Inspection differs from oral or written evidence: the latter is evidence based on the statements or descriptions of someone's thoughts, whereas the former is what the panel obtains by the senses is provided to reference materials for the direct determination. Therefore, even if evidence takes the form of document, when descriptions of the document is not treated as a means of proof but the nature or condition, etc. of the document becomes grounds for forming a conviction of the panel, the evidence is not a document, but an object of inspection.

#### **2. Request for Inspection**

(1) Procedures of documentary evidence are applied *mutatis mutandis* (Patent Act Article 151→Code of Civil Procedure Article 232(1), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4), Rules of Civil Procedure Article 150, 151, →34-01 9.)

(2) A fact to be proved and an object of inspection shall be identified for requesting for inspection (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(5)(6)).

In identifying an object of inspection, the mark Ken-Kou (Exhibit A), Ken-Otsu (Exhibit B), or Ken-Hei (Exhibit C) is added prior to the number in order of submission. The mark is used depending on whether a person who requests the inspection is a demandant, a demandee, or an intervenor.

(3) An explainer who indicates and explains an object of inspection is requested to clarify an inspection part and a purpose of inspection. The clarification shall be to the point and thus in practice a “Written Indication and Explanation of Object of Inspection” (Form 1) shall be submitted in advance. On the day of inspection, a chief administrative judge asks for clarification as appropriate to the explainer again, so that the opposite party may sufficiently understand the object of inspection. A chief administrative judge asks the opposite party to make an adverse opinion and the party who offers evidence to clarify against the adverse opinion, if necessary.

(4) In a case of an out-of-court inspection, a location is always specified to identify the object of inspection. A person who requests for inspection is necessary to indicate and explain the object on that location. It makes sure that a location of the object of inspection is clearly indicated in a document seeking for inspection (a request for inspection (Enforcement Regulations of the Patent Act Article 62), a demand for trial, a written reply, etc.). When an object of inspection is kept in a facility managed by a third party, an agreement of that person shall be obtained in advance.

(5) Determine that an inspection is carried out either in court, or out of court (on-site inspection) (→ 34-01).

(6) Designation of the date of inspection is similar to designation of oral proceedings (→ 33-01).

### 3. Inspection

(1) In many cases, an inspection is conducted on the same day of oral proceedings regardless of before or after the submission period of a written reply. Therefore, since oral proceedings are conducted prior to an inspection, it is preferable to confirm the relationships between facts to be proved and an object of inspection with the parties, and to confirm the progress of the inspection. The progress of the inspection may be asked to discuss between the parties as appropriate.

(2) For inspection, it is deemed that there is no reason not to open the public except the following cases:

- A. when an inspection for undisclosed ex parte cases, or an inspection in a factory involving a trade secret,
- B. when an inspection may disturb public order or morality, and
- C. when an inspection may disturb an on-the-spot inspection.

(3) In inspection, an expert is ordered to attend an inspection in need of a special academic experiences, a request for examination of a witness or an expert is also file with an inspection, it is possible that an assistant for measuring or taking a photograph, or an engineer necessary for operating machine, etc. may be attended as a person involved in the case. A third party who attends an inspection for explanation of an object of inspection may be asked his/her opinion and explanation.

(4) When one of the parties or both parties do not appear in court, after confirming the attendance, an administrative judge notifies to the effect that a party A does not attend but an inspection will be conducted today. For example, in a case where an inspection is conducted ex officio, even if both parties do not attend, the inspection is conducted and trial records are prepared (Ex Officio Inspection → 8.)

(5) It is the most important issue how to describe a result of inspection in trial records. Therefore, a chief administrative judge explains a configuration specifically as instructing each part of the configuration and communicates precisely what a panel perceives so that a trial clerk can take the records easily.

#### 4. Note for Conducting Inspection Out of Court (On-Site Inspection)

(1) For an inspection conducting out of court, when initiating an inspection, parties, intervenors, and agents who should be appeared in court, and other people concerned (those who are describing in the above (3)) shall be confirmed. People other than the above shall be moved out of the way of inspection. People who disturb an inspection on the inspection site or enters the inspection site without any business shall be ordered to leave or be taken an appropriate measure. A placing and a condition of an object of inspection in a location and if necessary, a temperature, humidity, brightness, weather, etc. shall be observed.

(2) An example of items to carry for an out-of-court inspection includes documents related to the subject case, a written oath, an order of advance payment, a seal of a chief administrative judge, blank papers, writing tools, a map, a magnet, a tape measure, a protractor, a thermometer, a camera, and a sound/image recording device.

(3) Immediately after arriving on the spot, go to a location of an object of inspection, contact an administrator of the object of inspection and conduct a preliminary inspection of the inspection site in advance. Have a meeting with the administrator of the object of inspection beforehand for a well-prepared inspection. Therefore, take into consideration of the time for preparation as described above on departure.

#### 5. Examination of Expert or Witness After Inspection

This section is equivalent to 34-01, 35-01, 35-04, etc.

#### 6. Preparation of Inspection Records (→ 35-02 8.)

An administrative judge describes in the trial records that the results obtained by the inspection following to the explanation and perceived by the five senses. To clarify the statements of parties and the results of inspection, design drawings, work drawings, photographs, sketches, maps or other appropriate materials may be attached to the inspection records to constitute a part of the trial records. When an inspection is conducted with oral proceedings or an examination of witness, an identification of an object of inspection, a purpose of inspection, an indication and explanation of the parties, a process of inspection, results of inspection may also include in trial records without preparing an inspection record in a separate sheet.

(Reference) The Training and Research Institute for Court Clerks “Procedures and Records of Inspection of Civil Case” (Housou-kai, pp300-311, Dec. 1975)

In describing the results of inspection, please note the following points.

- (1) Results report an objective recognition of the panel at that time.
- (2) Results should be described “Itemized description” for each matter necessary to be proved or for each matter to be clarified by the inspection.
- (3) A factual conclusion that can be inferred from the inspection (in that sense, a determination is added) may be described.
- (4) Conclusion applying the laws must be absolutely avoided (this shall be made by administrative judges in making a trial decision).
- (5) Descriptions of a distance relationship should possibly clarify a base point and a direction.
- (6) Note that a priority issue is different by a feature of each case
- (7) Avoid original expressions and use common names for a name of an object.

(8) If sketches or photographs are used for explaining results of the inspection, it just means drawings are used instead of letters. Therefore, it never means something else, but they just provide results of inspection.

Hence,

A. It is preferable a distance relationship is described in a drawing but omitted in a text.

B. A distance relationship is in metric. A drawing on a reduced scale is described if possible.

If necessary, others are also possible to include such as a cross section view of drawing, a three-dimensional sketch.

C. When using photographs, it should be clear what is the subject, the date of shooting, the time of shooting, or the weather when needed, etc. for each photograph.

## 7. Advance Payment of Cost

For an out-of-court inspection, travel expenses and accommodation fees for the JPO's employees who conduct an inspection (a panel and a trial clerk) shall be paid in advance by a person who requests for an inspection, or a person found to be appropriate by a panel when an inspection is conducted ex officio.

## 8. Ex Officio Inspection

When an inspection is conducted ex officio, the results of the inspection shall be notified to the parties and intervenors, and an opportunity to present their opinions shall be given by designating a reasonable period of time (Patent Act Article 150(5), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

【Form 1】 【Sample of Written Indication and Explanation】

Written Indication and Explanation of Object of Inspection

Date

To: Chief Administrative Judge, JPO

1. Trial number

Invalidation 20xx-80xxxx

2. Petitioner of Inspection

Address (Domicile)

Name (Appellation)

(Representative)

3. Agent

Address (Domicile)

Name (Appellation)

4. Demandee

Address (Domicile)

Name (Appellation)

5. Purpose of Inspection

To clarify the structure/the shape/the number of articles.

6. Matters to Be Clarified from Inspection

To clarify Ken-Kou No.1 has the following structures.

(1) ~ is attached to ~ so that it can be opened and closed.

(2) A mounting structure of (1) is ~.

⋮

(m) A nameplate is attached to ~.

(n) The nameplate has the description of ~ thereon.

7. Person who Indicates and Explains the Object of Inspection

Name

8. Object of Inspection and its Location

Object of inspection Ken-Kou (Exhibit A) No. 1



## Location

### 9. Content of Indication and Explanation of Object of Inspection

A structure of Ken-Kou (Exhibit A) No. 1 will be explained along the following (1) ~ (n) with indicating the object of inspection.

(1) Explaining that ~ is attached to~ so that it can be opened and closed, and that it takes the state shown in “drawings and photographs ~” by opening and closing ~.

(2) ~

⋮

(n) ~.

### (10) List of attached documents

(1) Drawings, Photographs

(2) Written Indication and Explanation of Object of Inspection

A duplicate ~ copy/copies

( Revised December 2020 )

**35-07 P U D T****Inspection Conducting Out-of-Court and These Cases**

1. An out-of-court inspection (on-site inspection) includes the inspection for preservation of evidence. A general out-of-court inspection and an out-of-court inspection for preservation of evidence are the same except the following item 2. (→34-01 9. 35-06,35-08, 35-09). The procedures of the two inspections are the same.

2. The difference between the two inspections is to examine whether there is prima facie showing of the situation and its appropriateness in determining preservation of evidence since an out-of-court inspection for preservation of evidence requires prompt actions. Therefore, a preparatory procedure for a general out-of-court inspection is similar to a preparatory procedure for an out-of-court inspection for preservation of evidence (→35-08 4.) except matters concerning particularity of preservation of evidence.

3. Examples of Out-Of-Court Inspection

Invalidation 2004-35144 (Patent)

Invalidation 2003-35079 (Utility Model)

Invalidation 2003-35002 (Patent)

Opposition 2000-70703 (Patent)

Opposition H11 (1999)-73952(Patent)

(Revised Feb 2015)

## **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)

## 35-09 P U D T

### Actual Examples of Preservation of Evidence Cases

1. Petition Before a Demand for Trial Is Filed (→Patent Act Article 150(2), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4))

(1) Preservation of evidence case No. 1 of 1962 (Patent)

“Manufacturing Method of Instant Noodles”

▪ Gist of petition

A. A manufacturing method of the subject patent invention is a usurped application, and there is a risk that the right holder of the patent changes the manufacturing method implemented in the factory unless the evidence of such the method is preserved.

B. A request for an examination of witnesses (3 people) is filed for proving usurpation.

▪ A method for prima facie evidence

No written prime facie evidence is submitted but one of the witnesses is a foreigner who has a plan to return home soon and has applied the procedures for returning home.

▪ Decision

An examination is made only to a witness applying the procedures for returning home among the witnesses at a trial court of the JPO, and the petitions for other inspections and examinations of witnesses are not adopted.

Petition        July 11, 1962

Decision       August 14, 1962

Date            August 23, 1962

(2) Preservation of evidence case No. 1 of 1967 (Utility Model)

### “Foldable Legs for Furniture”

- Gist of petition

Sales of the object of inspection go back to the past, therefore it is difficult to clarify the facts after a request for an invalidation trial is filed.

- A method for prima facie evidence

A certificate of residence showing an age of a witness, etc. is submitted.

- Decision

The witness is not very old, and the evidence has already submitted to the JPO and there is no risk of loss. For this reason, a petition of preservation of evidence is not adopted.

### (3) Preservation of evidence case No. 1 of 1968 (Patent)

#### “Storage Tube”

- Gist of petition

An oscilloscope using storage tubes has been used for 4 and half years, and it is unknown when it is replaced with a new one.

- A method for prima facie evidence

A report stating the above circumstances is submitted by an employee of the affiliated company of a petitioner.

- Decision

Regarding the on-site inspection and the purchasing time, history, etc. of the oscilloscope, a petition of examination of witness filed by a research assistant of the university who is one of the users is adopted.

## 2. Petition During Pendency of a Trial Case

### (1) Preservation of evidence case No. 3 of 1964 (Utility Model)

#### “Phototypesetter”

- Gist of petition

There is some malfunction in the machine after using for years and the type of machine has become old. Therefore, the machine will be replaced with a new one soon.

- A method for prima facie evidence

A certificate of the owner of the machine stating the above conditions is submitted.

- Decision

A machine production number of the object of inspection, that of evidence for the related invalidation trial, and that of the certificate of the owner are all different. It is considered that it does not satisfy with substantial requirements for preservation of evidence, and the petition for preservation of evidence is not adopted.

#### (2) Preservation of evidence case No. 1 of 1968 (Utility Model)

##### “Bath Boiler”

- Gist of petition

It took 5 years after installation, thus there is a risk of disposal.

- A method for prima facie evidence

Some photographs showing the current conditions of the bath boiler are submitted. The time of installation is mentioned in a written acceptance of inspection of a company which is a proprietor of the company housing where the bath boiler is installed.

- Decision

A petition for the on-site inspection and an examination of 2 witnesses are adopted.

#### (3) Preservation of evidence case No. 2003-98001 (Patent)

##### “Multistage Compressor”

- Gist of petition

The object of inspection has been continuously used for 16 years. There is a risk if the object becomes unusable, it will be disposed immediately.

- Decision

Necessity of implementation of early inspection is accepted, and a petition of the on-site inspection is adopted.

(Revised Feb 2015)

**35-10 P U D T****Refund of Money on Deposit Deposited in Advance for  
Examination of Evidence**

1. When money on deposit deposited in advance (advance payment) becomes unnecessary for payment of costs required for examination of evidence

(1) Refund the deposit to a person who paid in advance in the following cases.

A. When a trial case is terminated by decision, when a demand for trial is withdrawn, and when an opposition to grant of patent (registration of trademark) with a request for examination of evidence, or a request of examination of evidence is withdrawn.

B. When a chief administrative judge decides that it is not necessary to examine the evidence thereafter even during the pendency of the trial case.

(2) When an examination of evidence is terminated and there is the balance even after making the required payment, the balance is refunded to a person who paid the deposit.

2. Non-refundable deposit (advanced payment) shall vest in the national treasury after 5 years has been passed from the day following the date of releasing from liability of money on deposit (Act on Money on Deposit, Article 1). The date of releasing from liability of money on deposit is determined by the earliest date among the following dates: a date of termination of a trial case by decision, a date of withdrawing a demand for trial, a date of withdrawing an opposition to grant of patent (registration of trademark) with a request for examination of evidence, or a date of withdrawing a request for examination of evidence (Act on Money on Deposit).

[Loss of right to refund money on deposit]

Article 1 Public funds and privately owned funds deposited by the government in accordance with Law, Cabinet Order, or Enforcement Regulation shall become the government income when the refund is not requested after five years have been passed in accordance with the calculation method on the left. However, the time period for loss of rights is separately determined by different laws, it shall comply with the applicable law.

(1) If there is the time for releasing from liability of money in deposit, the calculation will start from the next day of the release.

(2) If there is no specific time for releasing from liability of money in deposit, the calculation will start from the next day of the deposit.

(3) If it is not possible to request a refund due to a lawsuit, the calculation will start from the next day after the trial decision becomes final.

[Money on deposit and interest]

Article 2 Money on deposit is not subject to interest unless it is determined by Law, Cabinet Order or Enforcement Regulation, or contract.

[Not negotiable certificate of money on deposit]

Article 3 A certificate of money on deposit shall not be sold, bought, transferred, or pledged.

3. A clerical work for the above 2. is charged on a trial clerk.

(Revised Feb 2015)



**35-11 P U D T**  
**Authorized Administrative Judges**

When an examination of evidence or preservation of evidence in a trial case (Patent Act Article 150, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)) is conducted outside of the JPO and it is considered appropriate, a chief administrative judge may designate an administrative judge who assigned to examine evidence and preserve evidence from a panel (Enforcement Regulations of the Patent Act Article 57, 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)).

1. An authorized administrative judge is designated by a chief administrative judge (Enforcement Regulations of the Patent Act Article 57(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)).

2. An authorized administrative judge conducts, as an auxiliary body of a panel, an examination of evidence and preservation of evidence which should be originally conducted by a panel.

3. Dates of procedures conducted by an authorized administrative judge are designated by the authorized administrative judge (Enforcement Regulations of the Patent Act Article 57-2, 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(5)(6)).

4. An authorized administrative judge may determine matters to be included in trial records on an examination of evidence. A trial clerk may attach a copy of documents with the trial records of examination of evidence made by the authorized administrative judge (Enforcement Regulations of the Patent Act Article 61-4, 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)).

A system of authorized administrative judges adopts advantages of mobility and economy of a single trial system to the collegial system, thus, the system may not disturb the collegial system. Therefore, an authorized administrative judge conducts only a simple examination of evidence and preservation of evidence.

(Revised Oct 2015)

## **35-12 P U D T**

### **Expert Opinion**

1. Matters for Expert Opinion (Enforcement Regulations of the Patent Act Article 60, 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), Code of Civil Procedure Article 129).

(1) When a party or an intervenor requests an expert opinion, a party or an intervenor shall submit a document including matters requesting an expert opinion at the same time. However, when there is an inevitable reason, it is sufficient to submit the document within a period of time designated by a chief administrative judge.

(2) The other party shall submit a written statement to a chief administrative judge if the other party has an opinion on the submitted document.

(3) A chief administrative judge determines matters for expert opinion after consideration of the written statement by the authority of chief administrative judge or by request.

(4) A chief administrative judge shall send a document stating matters for expert opinion to an expert.

2. Petition for Recusation Against an Expert (→34-01 6.) (Enforcement Regulations of the Patent Act Article 60-2-2, Rules of Civil Procedures Article 130)(→59-01)

(1) A petition for recusation against an expert is principally made in writing (a document is in accordance with Enforcement Regulations of the Patent Act Article 48-2 (Form 64) by analogy of Patent Act Article 142).

(2) A petition for recusation is also possible to conduct orally in oral proceedings or an examination of evidence.

3. Oath of Expert (Enforcement Regulations of the Patent Act Article 60-3)  
(Similar laws or regulations: Rules of Civil Procedure Article 131)

(1) A written oath shall include a statement to the effect that an expert swears to give an expert opinion sincerely according to the dictates of an expert's conscience.

(2) It is also possible for an expert to submit a written oath to a chief administrative judge. In this case, it is also possible for a chief administrative judge to send a document to an expert including explanation on a purport of the oath and information on the punishment for false expert opinion.

4. Method of Statement of Expert (Enforcement Regulations of the Patent Act Article 60-4, Rules of Civil Procedure Article 132)

A chief administrative judge may have experts state the opinions jointly or individually.

5. Questioning of Expert (Enforcement Regulations of the Patent Act Article 60-5, Rules of Civil Procedure Article 133)

An expert may attend an examination of evidence and request a chief administrative judge to examine a witness or parties themselves, or ask questions to those directly with the permission of a chief administrative judge, if necessary for an oath.

6. Application of the Provisions Mutatis Mutandis (Enforcement Regulations of the Patent Act Article 60-6~8) (Similar laws and provisions: Rules of Civil Procedure Articles 134~136)

(1) Expert opinion

The provisions of an examination of witness shall apply *mutatis mutandis* to a writ of summons, a notice of nonappearance, an oath, a statement of opinions orally, and submission of a document in lieu of an examination.

(2) The provisions of an examination of witness shall apply *mutatis mutandis* to an examination of expert witness (an examination of the facts obtained through special academic experiences).

(3) The provisions of an expert opinion shall apply *mutatis mutandis* to commission of expert opinion except the provisions of an oath.

(Revised Oct 2015)