

58-10 PUDT

Commissioning of the Provision of an Expert Opinion by a Court

1. Outline of the System

When the Japan Patent Office is commissioned by a court to provide an expert opinion on the technical scope of a patented invention, the Commissioner of the Japan Patent Office shall appoint three administrative judges to provide an expert opinion on the matter (the Patent Act Article 71-2; the Utility Model Act Article 26; the Design Act Article 25-2; and the Trademark Act Article 28-2).

2. Content of Expert Opinion

An expert opinion basically encompasses the following points (1)–(3), as provided in the Patent Act Article 71-2; the Utility Model Act Article 26; the Design Act Article 25-2; and the Trademark Act Article 28-2:

- (1) Expert opinion on the technical scope of a patented invention or a registered utility model (the Patent Act Article 71-2 (the Utility Model Act Article 26))
- (2) Expert opinion on the scope of a registered design or a design similar thereto (the Design Act Article 25-2).
- (3) Expert opinion on the effect of a trademark right (the Trademark Act Article 28-2).

In any of the above cases, three administrative judges hold a collegial examination, and the chief administrative judge administers the clerical affairs.

3. Fees for Expert Opinion and Travel Expenses required for Exposition

(1) Basic idea

An expert opinion is provided pursuant to the provisions of the Code of Civil Procedure when required as part of the process of providing proof in a court, and the fees for the expert opinion are paid by a party to the case.

For reference: The Act on Costs of Civil Procedure

Obligation to Pay (Article 11), the Request for Travel Expenses by a Witness, etc. (Article 18), the Request for Travel Expenses by an Expositor, etc. (Article 19), and the Payment of Compensation for a Commissioned Examination (Article 20).

Accordingly, for an expert opinion provided by the Japan Patent Office, fees for the expert opinion and travel expenses for exposition thereof shall be paid pursuant to the provisions of the Act on Costs of Civil Procedure.

It is noted that when a judge of the court issues a commission ex officio to provide an expert opinion, a person designated by the court (a party to the case) pays the fees.

(2) Specific operation

A. Fees for an expert opinion are the same as those for an advisory opinion (i.e., ¥40,000 per case)(*).

(*) For calculation of fees, the expert opinion provided for one object(Object A) with regard to one patent right is defined as one case of expert opinion, and the fee for the one case is ¥40,000. Accordingly, when a request is made for an expert opinion on a combination of three Objects A, B, and C with respect to two patent rights, the number of cases of expert opinion is six (2 x 3), and the fee is given by the equation below:

$$¥40,000 \times 6 = ¥240,000.$$

B. When an exposition is requested on the provided expert opinion, fees paid by the court pursuant to the Act on Costs of Civil Procedure are appropriated for travel expenses. Therefore, travel expenses would not be paid by the Japan Patent Office.

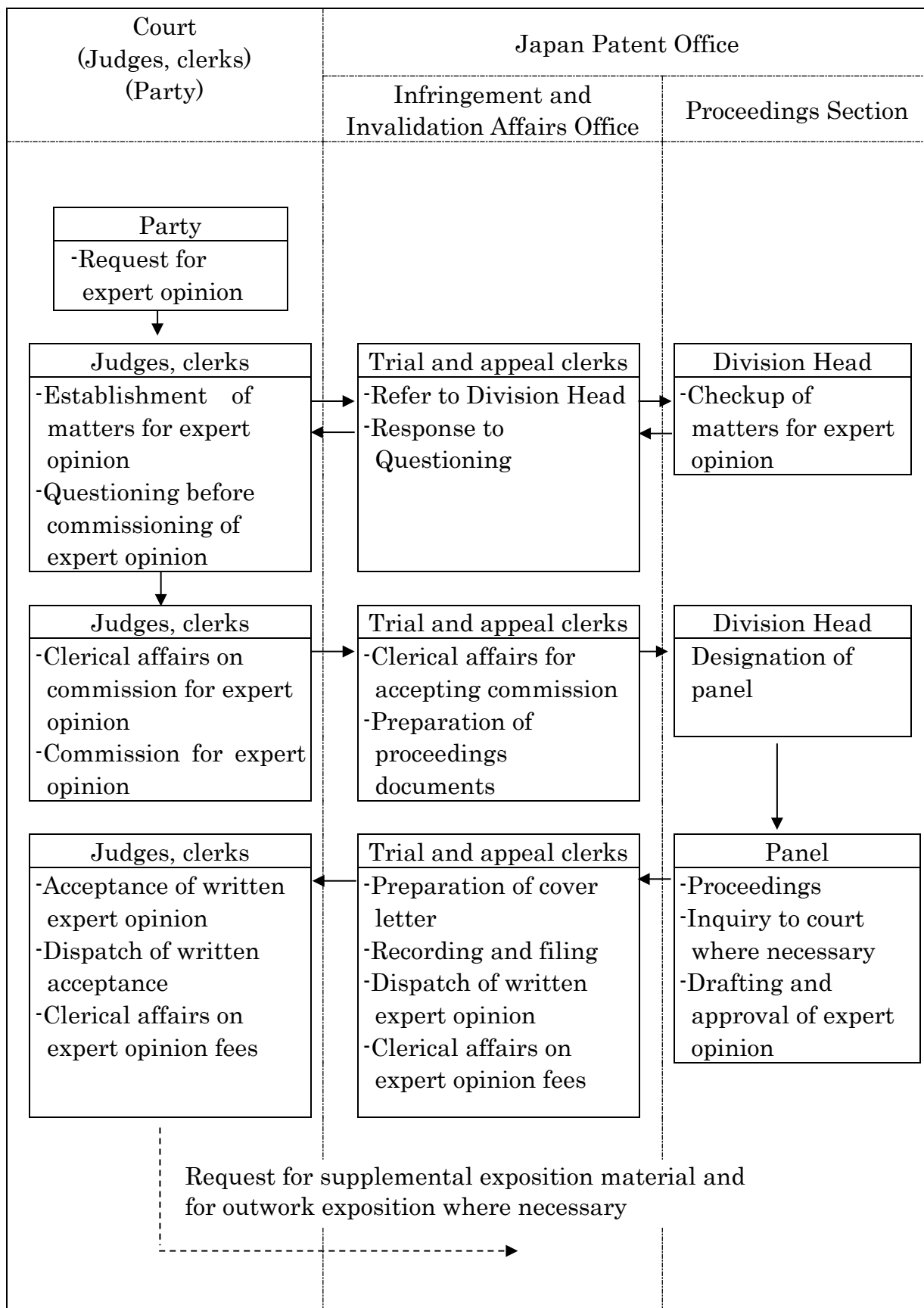
4. Management of Written Commission for Expert Opinion

A written commission for expert opinion are filed under relevant proceedings numbers.

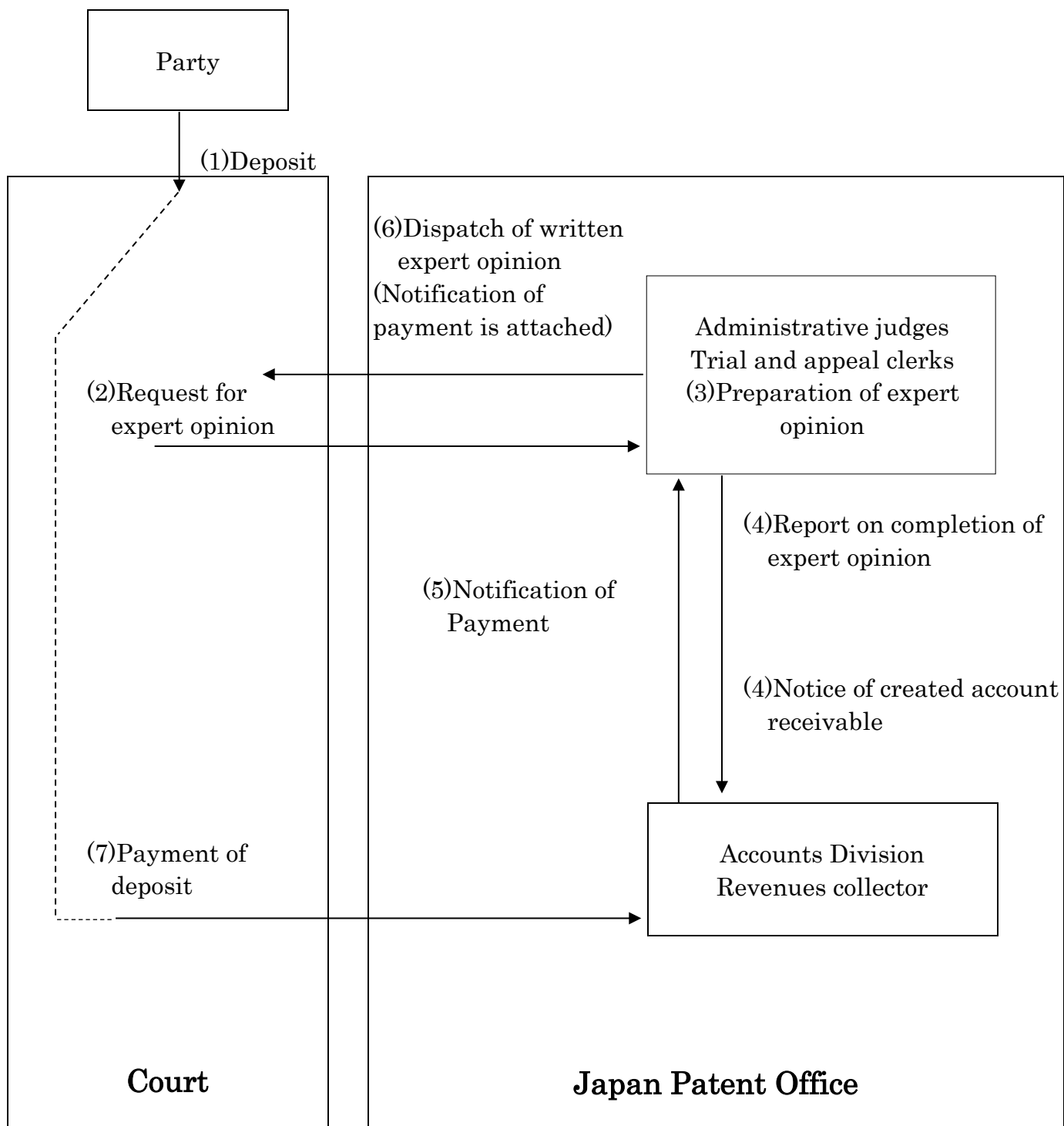
(Expert Opinion (Kantei) No. XXXX-99XXXX)

Year, Serial number in each year

WORKFLOW DIAGRAM CONCERNING EXPERT OPINION



WORK DIAGRAM CONCERNING EXPERT OPINION FEES



(Note) Numerals (1) to (7) designate the order of procedures, the same numeral indicating concurrency.

(Revised Jun.2019)