

# Rules of Procedures for Investigation under the Patent Act

(Rules of the Supreme Court No. 7 of April 22, 2020)

The Rules of Procedures for Investigation under the Patent Act are established as follows.

(Particulars to Be Contained in the Petition: Article 105-2 of the Act)

- Article 1 (1) A document under Article 105-2, paragraph (2) of the Patent Act (Act No. 121 of 1959; hereinafter referred to as the "Act") must contain a statement of the details of the measures to which the petition pertains, in addition to the particulars set forth in the items of that paragraph.
- (2) The details of the measures to which the petition referred to in the preceding paragraph pertains must be stated by clarifying the particulars for which an investigation is sought.
- (3) A party who files the petition referred to in the main clause of Article 105-2, paragraph (1) of the Act must send the document set forth in paragraph (1) directly (meaning direct delivery to the opponent; the same applies in Article 7, paragraph (4)) of the document referred to in paragraph (1).
- (4) If the opponent wishes to state opinions on the document referred to in the preceding paragraph, the opponent must submit a document stating their opinions to the court.

(Method of Filing a Petition for Assistance by a Court Execution Officer; Article 105-2-2)

- Article 2 (1) The petition referred to in Article 105-2-2, paragraph (3) of the Act must be filed in writing, except in cases of filing the petition on an appearance date.
- (2) When filing the petition referred to in the preceding paragraph, the petitioner must clarify the details of the particulars for which assistance is required and the reasons for needing the assistance.

(Method of Filing a Petition for Challenge; Article 105-2-3 of the Act)

- Article 3 (1) A petition for challenge to an investigator must be filed in writing, except in cases of filing the petition on an appearance date.
- (2) A prima facie showing must be made with regard to the grounds for challenge.

(Consultation on Particulars Necessary for Conducting an Investigation)

Article 4 On the date for oral argument or preparatory proceedings or on the

date for a scheduling conference, the court may hold a consultation with the parties, an investigator, and the court execution officer to whom an order is issued under the provisions of Article 105-2-2, paragraph (3) of the Act, with regard to the particulars necessary for conducting an investigation. The same applies to written preparatory proceedings.

(Notice of the Date and Place for Conducting Investigation; Article 105-2-4 of the Act)

Article 5 (1) When conducting an investigation, the investigator must specify the date and place for conducting the investigation and notify the court of the date and place.

(2) If the notice under the provisions of the preceding paragraph has been made, a court clerk must promptly notify the party under investigation of the date and place for conducting the investigation referred to in that paragraph.

(3) The provisions of Article 4, paragraph (5) of the Rules of Civil Procedure (Rules of the Supreme Court No. 5 of 1996) apply mutatis mutandis to the notice under the provisions of the preceding paragraph.

(Submission of an Investigation Report; Article 105-2-4 of the Act)

Article 6 (1) The presiding judge may have investigators prepare an investigation report (meaning the investigation report prescribed in Article 105-2-4, paragraph (1) of the Act; the same applies hereinafter) and submit it to the court jointly or individually.

(2) The presiding judge may specify a period within which an investigation report should be submitted, after hearing the opinion of the investigator.

(3) An investigation report must contain the following particulars:

(i) the name of the investigator;

(ii) indication of the documents, etc. (meaning the documents, etc. prescribed in Article 105-2, paragraph (1) of the Act) that are subject to the investigation;

(iii) the date and time of the commencement of the investigation and the date and time of its termination;

(iv) the place where the investigation was conducted;

(v) the names of any people who attended the investigation;

(vi) the particulars on which the investigation was ordered, and the details of the measures;

(vii) the investigation results; and

(viii) if assistance of a court execution officer was received, the name of the court execution officer, the date, time and place of the assistance received, and the details of the particulars for which assistance was received.

(Method of Filing a Petition for Non-Disclosure; Article 105-2-6 of the Act)

Article 7 (1) A petition under the provisions of Article 105-2-6, paragraph (2) of the Act must be filed in writing and by specifying the part of an investigation report which should not be disclosed.

(2) When filing the petition referred to in the preceding paragraph, the petitioner must also prepare an abridged edition by excluding the part that should not be disclosed from a copy of the investigation report, and submit it by attaching it to the document under the preceding paragraph.

(3) A document under paragraph (1) must contain a statement of the justifiable reason for not having all or part of the investigation report disclosed to the petitioner.

(4) A party who files the petition referred to in paragraph (1) must send the document under that paragraph and the abridged edition directly which is prepared by excluding the part that should not be disclosed from a copy of the investigation report and which is submitted pursuant to the provisions of paragraph (2).

(5) If the petitioner wishes to state opinions on the petition referred to in paragraph (1), the petitioner must submit a document stating the opinions to the court.

(6) When a ruling to decide not to disclose part of an investigation report as referred to in Article 105-2-6, paragraph (3) of the Act has become final and binding, the party who filed the petition referred to in paragraph (1) must, without delay, prepare an abridged edition by excluding the part specified by the relevant ruling as a part that should not to be disclosed from a copy of the investigation report, and submit that abridged edition to the court; provided, however, that this does not apply if the part specified by that petition as a part that should not be disclosed is identical to the part specified by that ruling as a part that has been decided not to be disclosed.

(Method of Making a Claim or Request for Inspection of an Investigation Report; Article 105-2-7 of the Act)

Article 8 (1) The claim referred to in Article 105-2-7, paragraph (1) of the Act or the request referred to in the second sentence of Article 91, paragraph (4) of the Code of Civil Procedure (Act No. 109 of 1996) as applied mutatis mutandis pursuant to Article 105-2-7, paragraph (3) of the Act must be made in writing.

(2) If an abridged edition prepared by excluding the part that should not be disclosed from the copy of the investigation report has been submitted pursuant to the provisions of paragraph (2) of the preceding Article or an abridged edition prepared by excluding the part that has been decided to not be disclosed from a copy of the investigation report has been submitted pursuant to the provisions of the main clause of paragraph (6) of that Article, the inspection or copying of an investigation report as referred to in Article 105-2-7,

paragraph (1) of the Act may be allowed by using the abridged edition thus submitted.

### **Supplementary Provisions**

(Effective Date)

Article 1 These Rules come into effect as of the date on which the provisions set forth in Article 1, item (iii) of the Supplementary Provisions of the Act Partially Amending the Patent Act (Act No. 3 of 2019) come into effect.

(Partial Amendment to the Rules for Fees and Expenses of Court Execution Officers)

Article 2 (1) The Rules for Fees and Expenses of Court Execution Officers (Rules of the Supreme Court No. 15 of 1966) are partially amended as follows.

The following Article is added after Article 3-2.

(Assistance for Investigation)

Article 3-3 The amount of fee for assistance (Article 8, paragraph (1), item (i)-3 of the Act) under the provisions of Article 105-2-2, paragraph (3) of the Patent Act (Act No. 121 of 1959) is 11,000 yen.

(2) If a court execution officer has attended the place where the assistance referred to in the preceding paragraph is to be provided, but has been unable to provide the assistance referred to in that paragraph due to grounds not attributable thereto (Article 8, paragraph (2), item (i) of the Act), the amount of the fee is 4,000 yen.

(3) The court that has ordered the assistance referred to in paragraph (1) may add an amount not exceeding the amount specified in paragraph (1) or the preceding paragraph respectively to the amount referred to in paragraph (1) or the preceding paragraph (if the provisions of Article 32 or Article 33 apply, the amount under these provisions are added), due to circumstances such as the status of the consultation on particulars necessary for conducting an investigation.

The phrase ", Article 3-3, paragraph (1)" is added after "Article 3-2, paragraph (1)" in Article 32 and Article 33, paragraph (3).

(Partial Amendment to the Rules for the Costs of Civil Proceedings)

Article 3 The Rules for the Costs of Civil Proceedings (Rules of the Supreme Court No. 5 of 1971) are partially amended as follows.

The phrase ", an investigator" is added after "an interpreter" in Article 7.

The following is added in the left-hand column of row (v) of Appended Table 2:

(i) petition for an order of an investigation under the provisions of the Patent Act (Act No. 121 of 1959).