

CHAPTER 3

EVIDENCE - CHECK

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3 EVIDENCE - CHECK

INTRODUCTION

3.01 In *inter partes* proceedings, the evidence has two functions; to support one side's statement of case and to answer the other side's statement of case and/or evidence. Basically it is information which is acceptable to prove or disprove any matter under enquiry.

3.02 In most proceedings before the comptroller there are usually three rounds of evidence, each to be filed within periods of six weeks. The timetable is usually as follows:

The claimants file evidence in support of their case, followed by evidence from the defendants in support of their case and in answer to the claimants' case. Finally, the claimants file evidence strictly in reply to the defendants' evidence.

3.03 However, in section 27 opposition proceedings, there is a difficulty since the patentee needs to justify his grounds of opposition. In other words, both sides have a substantial onus to discharge. As such, and in line with practice in the High Court, the timetable for filing evidence is reversed, that is:

The patentee should be invited to file evidence first, followed by evidence from the opponents in support of their case and in answer to the patentee's case. Finally the patentee should be invited to file evidence strictly in reply to the opponent's evidence.

3.03.1 Although in most cases this procedure should be followed, if circumstances justify it, the opponent may be invited to file evidence first. Alternatively the first two evidence rounds may be conducted in parallel or an extra evidence in reply round may be needed.

- 3.03.2 Whatever procedure is agreed, the party filing the evidence sends the original documents to the office and at the same time sends copies to the other party or parties to the proceedings.
- 3.03.3 Most evidence in proceedings before the comptroller is written. However occasionally artefacts are submitted, for example, a sample of the alleged prior art or a sample of the article in which design right is claimed. Case Officers should ensure that any artefacts submitted as evidence have been sent to the other party or alternatively that suitable arrangements have been made for the inspection of such artefacts.

FORMAT FOR EVIDENCE

- 3.04 The format of the evidence filed by the parties needs to be checked. The evidence before the comptroller should be in the form of affidavits, statutory declarations or witness statements, although oral evidence may be accepted if the HO thinks fit.
- 3.05 Affidavits, statutory declarations and witness statements should be headed by a title referring to the relevant Act, section of the Act, the patent or patent application number and the parties (eg **Patents Act 1977** IN THE MATTER OF an application by John Green to revoke United Kingdom patent number 2345678 in the name of FGH Limited under Section 72 of the Act).
- 3.06 Evidence in a foreign language may be filed. It should be annexed with a translation into English made by a qualified translator, with an affidavit made by the translator confirming that the translation is true. The three documents and any exhibits must be filed together.

Affidavit

3.07 An affidavit is a document that has been formally sworn or affirmed before someone authorised to administer oaths. It should commence with the words "I...(full name) of (address)... state on oath...." This is in accordance with the Civil Procedure Rules, Part 32 Practice Direction - Written Evidence.

3.08 Additionally an affidavit should:

- if the person is giving evidence in his professional, business or other occupational capacity, give the address at which he works, the position he holds and the name of his firm or employer
- give evidence in the first person (I, me and so on)
- have each paragraph numbered and as far as possible each paragraph should be confined to a distinct portion of the subject
- have each page numbered and where possible, should be bound
- express dates, sums and other numbers in figures not words

3.09 It should end with the jurat. This is a statement set out at the end of the document which authenticates the affidavit. The jurat should read: "Signed...(signature)". "Sworn at... (address, date)...before me...(signature of notary public)." The notary public's title should complete the affidavit, eg "A solicitor entitled to administer oaths." The jurat should be on the same page as the last page of written evidence and say where and when the affidavit was sworn. The affidavit must be sworn before a person independent of the parties or their representatives.

Statutory Declaration

3.10 A statutory declaration is a document that a witness signs and declares to be true in front of someone authorised to administer oaths. It should commence with the words "I...(name, address)...do solemnly and sincerely declare that....." in accordance with the Statutory Declarations Act 1835.

3.11 The jurat should consist of the words "Signed...(signature)." "Declared at...(address, date)...before me...(signature of notary public)." The notary public's title should complete the statutory declaration eg "A solicitor entitled to administer oaths." The jurat should be on the same page as the last page of written evidence and say where and when the statutory declaration was sworn.

Witness Statement

3.12 A witness statement is the equivalent of the oral evidence which that witness would, if called, give in evidence; it must include a statement by the intended witness that he believes the facts in it are true eg "I believe the facts in this witness statement are true". In practice, most evidence filed at the office is now in the form of witness statements.

3.13 A witness statement should be headed with the title of the proceedings. At the top right hand corner of the first page there should be clearly written:

- the party on whose behalf it is made
- the initials and surname of the witness
- the number of the statement in relation to that witness
- the identifying initials and number of each exhibit referred to
- the date the statement was made

3.14 The statement must, if practicable, be in the intended witness's own words, should be expressed in the first person and should also state:

- the full name of the witness
- his place of residence or, if he is making the statement in his professional, business or other occupational capacity, the address at which he works, the position he holds and the name of his firm or employer
- his occupation

- the fact that he is a party to the proceedings or is the employee of such a party if it be the case

3.15 Additionally, the statement should have each paragraph numbered and, as far as possible, each paragraph should be confined to a distinct portion of the subject. Each page should be numbered and, where possible, bound. All numbers, including dates, should be expressed in figures.

Defective Evidence

3.16 If any evidence does not comply with these rules, the party will be required to re-file the evidence in the correct format, usually within one month.

DOCUMENTS REFERRED TO IN EVIDENCE

3.17 All documents referred to in evidence should be filed in accordance with rule 112. If any have not been filed, the party should be asked to provide them accompanied by a second short affidavit, statutory declaration, or witness statement, whichever is appropriate. If necessary (see below) the documents should be exhibited.

EXHIBITS:

Affidavit

3.18 If the evidence is in the form of an affidavit, the documents should be exhibited. The minimal requirement is the signature of the notary public and the coded designation of that exhibit being entered on the front page of the document. However, usually this information is placed on a fly sheet together with a title. If such documents are not exhibited, the documents should be re-filed as exhibits preferably attached to a second short affidavit under rule 112.

Statutory Declaration

- 3.19 If the evidence is in the form of a statutory declaration, the documents referred to need not be exhibited under the Statutory Declaration Act 1835.

Witness Statement

- 3.20 If the evidence is in the form of a witness statement, the documents should be exhibited. An exhibit used in conjunction with a witness statement should be verified and identified by the witness and remain separate from the witness statement. Where a witness refers to an exhibit, he should state: 'I refer to the (description of exhibit) marked "...". With the Civil Procedure Rules, the same provisions apply to witness statements as they do to affidavits (see Civil Procedure Rules, Part 32 Practice Direction - Written Evidence).

DOCUMENTS PROVIDED FOR BUT NOT REFERRED TO

- 3.21 The evidence should be checked to ensure that all documents provided are referred to in the evidence. If any are not, the evidence should be queried with the party concerned. Alternatively, the matter may be referred to the HO dealing with preliminary matters.

UNSWORN EVIDENCE, SWORN EVIDENCE AND FAXING - DATE OF FILING

- 3.22 The practice is to accept as evidence filed on time:

- any faxed sworn evidence
- any unsworn evidence which has been filed by the due date.

Occasionally the party will need to be reminded that they should have filed the sworn version of the evidence. Usually the party will provide the sworn evidence within a few days of the unsworn version without the necessity of prompting.

DATE TRIGGERING NEXT ROUND OF EVIDENCE

- 3.23 The date on which the period of time commences for the filing of the claimant's evidence-in-chief is the date that the counter-statement is served by the office. The date of commencement of subsequent rounds of evidence is the date on which the sworn version of the previous round of evidence is sent to that party. Thus a faxed version of evidence will trigger the commencement on the date of faxing. When an unsworn version is filed, we wait for the sworn version to be sent to the other side; that then triggers the commencement.
- 3.23.1 In view of the fact that under the Patents Rules each evidence round is triggered automatically by the receipt from the other side of the relevant documents, the filing of an amended statement or counter-statement late in proceedings will impact on the evidence rounds. If an amended statement, for example, is received with evidence, the B2 should refer expressly to the suspension or extension of the evidence rounds so that each party is in no doubt about the position. The suspension or extension, however, must be "subject to any objection" since the B2 officer cannot implement this unilaterally.

ARRANGEMENT OF EVIDENCE IN FILE

- 3.24 The evidence is placed in a coloured binder, each document being separated by a divider. The claimants' evidence is placed in a green binder and the respondents' in a blue one. (Evidence filed in section 40 proceedings should be placed in red binders to indicate that the papers are confidential).
- 3.25 A typed list of the documents comprising the evidence should be prepared as a front page within the folder. The list should include in the title the names of the two parties, which party filed the evidence, whether the evidence is evidence-in-chief or evidence-in-reply, and the date of filing of the evidence. The list of documents should include a reference to the number or letter on the divider, whether evidence is an affidavit, statutory declaration or witness statement and

by whom it was submitted. The name of each exhibit and a short description of each exhibit should also be listed. The documents are flagged with coloured tags and a suitable description is added.

FINAL EVIDENCE - ARRANGEMENT OF HEARING

- 3.26 At the commencement of the final evidence round, the office will aim to arrange for main or substantive hearings for approximately four months later. The B2, once a letter has been sent requesting the final evidence, should pass the file to the Hearings Clerk to start the arrangements for the substantive hearing. The Hearings Clerk will send a further letter to the parties concerning arrangements for the hearing. (See Chapter 4 for further details).