

## CHAPTER 3

### EVIDENCE

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### 3 EVIDENCE

#### INTRODUCTION

- 3.01 In *inter partes* proceedings, the evidence has two functions; to support the statement of case and to answer the other side's allegations and/or evidence. Basically it is information which is acceptable to prove or disprove any matter under enquiry.
- 3.02 The usual procedure involves three rounds of evidence each of six weeks. However evidence may also be exchanged simultaneously by the parties. In this case the procedure will involve two rounds of evidence, each of six weeks (see 1.42 and 1.43).
- 3.03 In section 27 opposition proceedings, both sides have a substantial onus to discharge. As such, and in line with practice in the High Court, where evidence is filed sequentially, the usual procedure has been reversed, that is:
- 3.04 The patentee has been 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 has been invited to file evidence strictly in reply to the opponent's evidence.
- 3.05 Deleted
- 3.06 Whatever procedure is agreed, evidence will only be considered to have been filed when it has been received by the comptroller and it has been sent to the other parties to the proceedings (rule 80(3)).
- 3.07 Most evidence in proceedings before the comptroller is written. However occasionally physical exhibits 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 physical exhibits submitted as evidence have

been sent to the other party or alternatively that suitable arrangements have been made for the inspection of such exhibits.

**PECS:-** Where a physical exhibit is filed, see Chapter 1, paragraph 1.46.

## **FORMAT FOR EVIDENCE**

- 3.08 The evidence before the comptroller may be given in the form of witness statements, statement of case, affidavits, statutory declarations or in any other form which would be admissible as evidence in proceedings before the court . Oral evidence may be accepted if the HO thinks fit. (rule 87(1)).
- 3.09 A witness statement or statement of case may only be given in evidence if it includes a statement of truth (rule 87(2)).
- 3.10 Rule 87(3) states that the general rule for evidence is that it should be by witness statement unless the comptroller directs or any other enactment requires otherwise.
- 3.11 Affidavits, statutory declarations and witness statements need to comply with the requirements of Part 1 of Schedule 2 of the Rules unless the comptroller directs otherwise; so they need to be submitted on A4 white paper that is free from tears, folds or similar damage and the contents must be suitable for reproduction. Frames (lines surrounding matter) should not be used.
- 3.12 They should also include a heading 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).
- 3.13 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

3.14 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.

3.15 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 topic
- have each page numbered and where possible, should be bound
- express dates, sums and other numbers in figures not words

3.16 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

3.17 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.

3.18 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

3.19 A witness statement is a written statement signed by a person that contains the evidence which that person would be allowed to give orally. 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.

3.20 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

3.21 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

3.22 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

3.23 The burden for ensuring evidence meets the appropriate requirements rests with the parties. Consequently it is not necessary for the B2 to carry out a routine check of any evidence filed.

#### **DOCUMENTS REFERRED TO IN EVIDENCE**

3.24 Deleted

#### Exhibits:

#### Affidavit

3.25 If the evidence is in the form of an affidavit, any documents referred to 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 79.

### Statutory Declaration

- 3.26 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

- 3.27 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 "...". The provisions of the Civil Procedure Rules, apply to witness statements as they do to affidavits (see Civil Procedure Rules, Part 32 Practice Direction - Written Evidence).

### **DOCUMENTS PROVIDED BUT NOT REFERRED TO**

- 3.28 All documents provided should be referred to in the evidence.

### **EVIDENCE AND FAX FILING**

- 3.29 Where evidence is filed by fax and is of an acceptable quality, there is no need for the parties to file the original documents. However any party filing evidence by fax must make the original documents available on request (see also Chapter 16).

- 3.30 Any unsworn evidence filed by fax is taken as filed on time. However the party concerned will still need to file a sworn version of the evidence.

## DATE TRIGGERING EVIDENCE ROUNDS

- 3.31 The B2 should set the dates for the evidence rounds and should acknowledge receipt of any evidence filed (see annexes 9, 10 and 13 in Chapter 1)

**PECS:-** Letter is created and import using manual import (doc code is LETTER-LIT)

## ARRANGEMENT OF EVIDENCE IN FILE

- 3.32 Case Officers should ensure that any evidence scanned into PECS is OPI unless it relates to a section 40 application, a patent application that has not yet been published or is the subject of a request for confidential treatment under rule 53. In such cases, the evidence should be marked as NOPI.

**PECS:** - Any evidence should be annotated to show what it is and who has filed it eg 'Witness statement of XXXXXX'; 'Exhibit XXXX' etc.

## ARRANGEMENT OF HEARING

- 3.33 At the start of the final evidence round, the parties should be contacted in order to finalise arrangements for the hearing. The B2 should advise the hearings clerks accordingly. (See Chapter 4 for further details).

**PECS:** Minute to hearings team is created and imported using manual import (doc code is MINUTE-LIT)

Create and send message to hearings team. Message = PSM