Considerations When Applying for a Patent in Japan

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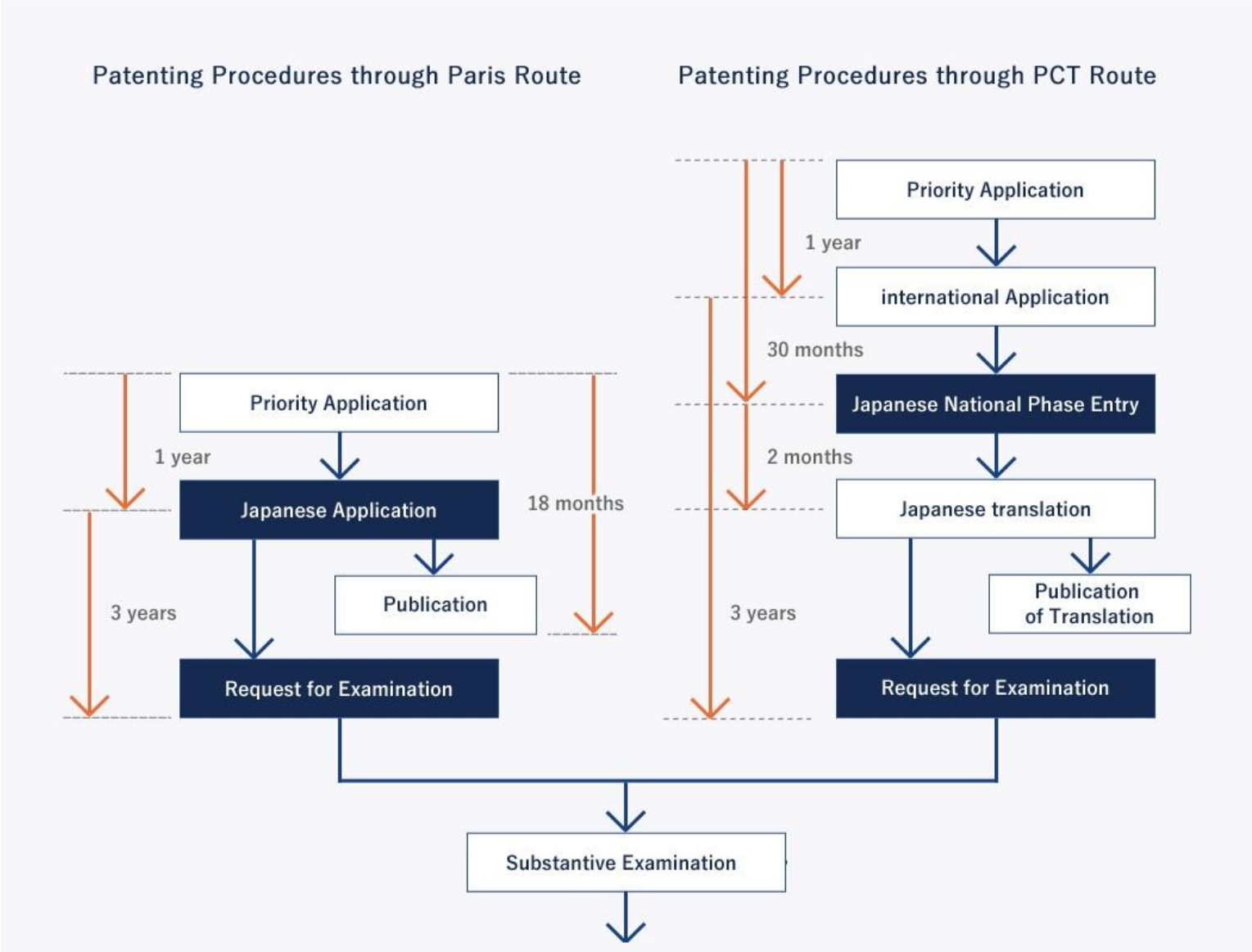
Applying for a Patent in Japan

Filing route from a foreign country to Japan

1. Paris Route
2. PCT Route
3. Direct Route (non-con)


Patenting Procedures through Paris Route
Priority Application
1 year
Japanese Application
18 months
3 years
Publication
Request for Examination
Patenting Procedures through PCT Route
Priority Application
1 year
international Application
30 months
Japanese National Phase Entry
2 months
Japanese translation
3 years
Publication of Translation
Request for Examination
Substantive Examination

Paris Route

The process for patent application via the Paris route is often considered simpler compared to the PCT route. The JPO permits patent applications in foreign languages, with the stipulation that translations should be provided within a period of 14 months from the priority date.

Note that requests for substantive examination must be filed within 3 years from the actual filing date of this application, not the priority date.

PCT Route

Petitions for national entry must be filed within 30 months from the International filing Date. There is no requirement to submit translations simultaneously. If a petition for national entry surpasses 28 months from the international filing date, a two-month window opens for the submission of the translation.

Requests for substantive examination must be submitted within 3 years from the international filing date.

In general, Japanese firms receive such instructions as follows from foreign firms. Are these instructions sufficient for PCT route ?

Dear ABC patent firm,

Please enter the national phase in Japan for the above-mentioned PCT patent application on or before the national phase entry deadline.

Please file a request for examination with the application if the examination procedure requires a request in your country.

Best regards,

Maybe OK.

Japanese firms will at least handle the necessary procedures.

However, how to proceed could be different depending on the Japanese firm, especially for PCT route.

Cost-focused? Time-focused? Simplicity-focused?

Based on the previous instructions, even if your client would like to reduce cost, the Japanese firm may proceed differently.

What should be considered for the PCT route

- A request for substantive examination does not need to be filed at the same time in order to file a petition for entry.

The timing of the examination request can be adjusted according to the client's needs. If the client wants to obtain the patent rights quickly, it would be better to request the examination early. In such a case, you may also ask the Japanese firm to file a PPH request. If time is not so important, your clients can take their time to consider amendments to the claims even after filing the petition for entry.

What should be considered for the PCT route

- The examination fee depends on the number of claims.

The examination fee where the international search report has been established by an International Searching Authority other than the JPO (under the PCT) is ¥124,000 + ¥3,600 per claim.

The number of claims is determined at the time of filing a request for substantive examination. Therefore, if there is a possibility that the number of claims may decrease due to voluntary amendments, it might be better to wait to file the request for the examination until the claims for the voluntary amendments are fixed.

What should be considered for the PCT route

- Translation does not need to be filed at the same time in order to file a petition for entry.

If cost is very important but time is not, you may ask the Japanese firm to start translation as slowly as possible. By doing so, if a client instructs you to apply in Japan just before the 30-month deadline, but soon after your client decides that obtaining patent rights in Japan is not necessary, you may be able to ask the Japanese firm to stop the translation work and to discount the translation fee.

If cost matters

Ask a Japanese firm to file

1. National document (petition for entry)
2. Translation

Later (after reviewing claims), ask to file

1. Voluntary amendments
2. Request for examination

Voluntary Amendment

Consider filing a voluntary amendment at the time of filing a request for examination instead of filing a translation of amendments under PCT article 19 or 34 even when the amendments have been filed during the international phase of the PCT, because

- If amendments under PCT article 34 have been filed twice during the international phase, the translation of the amendments must specify the basis of the amendments for all amendments, not just the most recent amendments. Therefore, the attorney fee would be increased.
- If you submit the translation of the Article 19 or 34 amendment and enter the national stage, and then decide to make a voluntary amendment, you may incur the translation cost for the amendment document again. Even if the translation of the Article 19 or 34 has not been filed, we can make the same amendments through the voluntary amendment.

Fee Reduction

If your client is not a large entity, it might be a good idea to include an instruction such as "If the applicant qualifies as a small or medium-sized entity, apply for the fee reductions." The examination fee is reduced to 1/2. In this case, including information about the applicant's industry field, number of employees, and whether they are dominated by large corporations can facilitate the process.

There are also fee reductions for start-ups and micro entities. For these entities, the examination fee is reduced to 1/3.

Small/Medium Entity Qualification

Industry	Manufacturing Construction Transportation Software/IT Services	Wholesale	Service Providers	Retail	Rubber Manufacturing	Hotel Business
1) Employees	300 or less	100 or less	100 or less	50 or less	900 or less	200 or less
2) Capital/Total Contribution (JPY)	300M or less	100M or less	50M or less	50M or less	300M or less	50M or less
3) Control	Not under control of large entity					

[1) OR 2)] AND 3) Satisfied → **Reduced to 1/2**

Fee Reduction

Since 2019, it has not been necessary to submit evidence to JPO. By stating in the remarks section of the request for examination that you "intend to receive a fee reduction" and you "intend to omit the submission of evidence," you can obtain the fee reduction.

Divisional Application

For a divisional application as well, there are matters that should be included in the instructions to the Japanese firm.

Article 50-2

If an examiner intends to issue a notice of grounds for rejecting a patent application ･･･ and these grounds for rejection are the same as the grounds for rejection in a notice ･･･ that involves another patent application ･･･, the examiner must also issue notice to that effect.

Divisional Applications

Notice of Article 50-2 should be avoided because the purpose of claim amendments after a decision of refusal must fall under one of the following:

- Canceling claims
- Narrowing claims in a limited way
- Correcting errors
- Clarifying alleged ambiguous recitations

You should instruct Japanese firms to make sure that all reasons for refusal would be resolved when filing a divisional application.

Note that Article 50-2 applies not only for the patentability (novelty, inventive step) rejections, but also other rejections, such as a unity of invention rejections and clarity objections.

Divisional Applications

Hypothetical Case

Patent application A

Claims 1-6

Claims 1-2 : Special technical feature A

Claims 3-4 : Special technical feature B

Claims 5-6 : Special technical feature C

The examiner will raise a unity of invention rejection under the reason that inventions according to claims 1-2 and claims 3-6 do not have the same or corresponding special technical features.

Divisional Applications

In response to the rejection, the client may instruct you as follows.

Patent Application

Claims 1-2 Original claims

Claims 3-6 Cancelled

Divisional Application B

Claims 1-4 Corresponding to original Claims 3-6

Does the article 50-2 apply?

Divisional Applications

YES

Even though the group of claims for comparison is different from the previous office action, the fact that inventions according to two groups of invention (original claims 3-4 and original claims 5-6) do not have the same or corresponding special technical features is the same.

The same things could happen regarding the clarity objections.

This could happen when the examiner did not examine claims 3-6 due to the unity of invention objection for original application A, and therefore the first Office Action against original application A did not mention that the same ambiguous term is included in claims 3-6.

Summary

What to consider when sending instructions

- Timing to file voluntary amendments
- Timing to file a request for substantive examination
- Ask for fee reductions
- Is it necessary to file a translation of an Article 19 or 34 amendment?

For divisional applications

- Check whether the same rejections against the parent application would apply to the claims of divisional application.

Thank you for your attention!!

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