

Comparison of Paris Route and PCT Route for Filing in Japan

There are numerous differences between filing patent applications in Japan using the Paris Route (priority application) and the PCT Route (national phase application). Several aspects of both routes are analyzed below to provide a clear picture regarding which route may be best for you.

A. Time in which filing must be made

The Paris Route: The Japanese application must be filed within one year after the original application (priority application) was filed in another country.

There is a foreign language application system which essentially allows the applicant to file a Japanese application in English, and thereafter submit a Japanese language document. This provides an additional two (2) months (14 months total) from the date the original application was filed in another country.

The PCT Route: An application may be entered into the Japanese national phase within thirty (30) months after the priority date of the PCT application. An additional two (2) months (32 months total) are permitted to submit the Japanese translation of the application.

B. Cost comparison

1. Filing Fees: The filing fees for both are the same, 14,000 yen (\$130). The filing fee for the foreign language application system is 22,000 yen (\$204).

2. Examination Fees

The PCT Route: 106,000 yen (\$981) + 3,600 yen (\$33) per claim.

The Paris Route: 118,000 yen (\$1,093) + 4,000 yen (\$37) per claim.

However, the cost for requesting an examination for a Paris Route application may be reduced in several cases including

1) If an International Search Report has been established by the JPO, 71,000 yen (\$657) + 2,400 yen (\$22) per claim.

2) If an International Search Report has been established by an ISA other than the JPO, 106,000 yen + 3,600 yen per claim.

The registration and the annual fees are the same regardless of which route is used.

Note: 108 yen = \$1 US (Rate as of January 2020)

C. Correspondence of Japanese translation

The Paris Route: The Japanese translation should substantially correspond to the original foreign language application. The submission of a "mirror translation", or an exact translation (such as that required by the USPTO) is not required in Japan. The Japanese version may be modified in order to conform to the Japan Patent Office (JPO) guidelines and practices, as long as it is obvious that the inventions specified in the Japanese translation and the original foreign language application are identical.

If it is deemed that the Japanese translation is beyond the scope of the original foreign language application, as the amendment must be supported by the Japanese application itself, an opportunity to amend the Japanese document is not always permitted. This can result in the introduction of a new matter and the loss of priority of the original foreign language application.

The PCT Route: The Japanese translation should substantially correspond to the original foreign language application. The submission of a "mirror translation", or an exact translation (such as that required by the USPTO) is not required in Japan. If it is deemed that the Japanese translation is beyond the scope of the original foreign language application, an OA will be issued and the applicant will be granted the opportunity to amend the Japanese application in order for the application to remain within the scope of the invention described in the original foreign language application.

The applicant should consider using the Paris Route if cost is a major factor, while use of the PCT Route allows the applicant time to prepare and some breadth in translating the original foreign language application into Japanese.

Please note that the above stated fees are the processing fees required by the JPO. Separate attorney's fees and translation fees are required to prepare a Japanese application for submission at the JPO.