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U.S. or India: Where to File for a Patent First?

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United States Patent and Trademark Office (USPTO) often is one of the favorite or lucrative destinations for the applicants for filing a patent application for various reasons, the prime reason being that usually the target as well as potential market of the invented product or process is U.S. Another major reason for interest in filing in U.S. is that U.S. patent laws permit broader spectrum of software patents compared to Indian Patent Law which says that software per se is not patentable till it has technical application. For all these reasons, at the time of filing for a patent, the biggest dilemma an inventor has is where to file for a patent first, in India or U.S.?

In this article, we will explore the advantages of filing in India first and consequences of filing in U.S. first if the inventor is a resident of India.

Filing in India first makes sense (U/S 39)

Before taking a decision on where to file first, it is essential to understand what does Indian Patent Law say about foreign filing. The issue is sensitive as well as critical and lack of expert legal advice on the same may have fatal consequences.

Accordingly to Section 39 (Residents not to apply for patents outside India without prior permission) of the Patents Act 1970, a person who is resident in India shall not make application for grant of patent outside India without:

1. Either taking Foreign Filing Permission (FFP) from the Controller of patents. This permission is usually granted by the Controller within 21 days and is required not only for foreign filing but also for filing a PCT application; or
2. Filing for a patent for the same invention in India and waiting for 6 weeks. Who is "Resident of India"?

The term "Resident of India" has not been defined in the Patents Act, 1970 but according to Income Tax Act, an individual can be termed as a 'Resident of India' if he stays for the prescribed period during a fiscal year i.e. 1st April to 31st March, either for:

1. 182 days or more; or
2. Has been in India in aggregate for 365 days or more in the previous four years.

Any person who does not satisfy these norms is termed as a 'Non-Resident'. A resident individual is considered to be 'ordinarily resident' in any fiscal year if he has been resident in India for nine out of the previous ten years and, in addition, has been in India for a total of 730 days or more in the previous seven years. Residents who do not satisfy these conditions are called individuals 'not ordinarily resident'.

Rational behind filing in India first

Main rational behind having Section 39 is to safeguard national defense and security. If the invention is relevant for defence purpose or atomic energy, the Controller shall not grant permission for foreign filing without the prior consent of the Central Government. Such application may impose Secrecy Directions

and the Controller may give direction for prohibiting or restricting the publication of such application if it appears to him that the invention in question falls in one of the classes notified to him by Central Government as relevant for defence purposes or the Controller himself considers it to be so. However, this section shall not apply in relation to an invention for which an application for protection has first been filed in a country outside India by a person resident outside India.

Do you lose anything by filing in India first?

It is a myth that by filing in India first and U.S. later, one loses on the date and that the date of filing in U.S. gets delayed. The fact is that even if you file for a patent in India first, you can file the same application in U.S. (as convention application) immediately after expiry of six weeks from the date of Indian filing. At the time of filing in U.S., you can claim priority date from your Indian filing as both India and U.S. are convention countries. Effectively, this means that even though you file in India first and U.S. later, the same date of priority can be maintained in USPTO as well. . In fact when priority is claimed from Indian filing, the applicant has to submit in USPTO, the priority document obtained from the Indian Patent Office.

Therefore, it actually does not matter where you filed first, but yes, it certainly is a better and a safe choice to either file for a patent in India first or take permission from the Controller for foreign filing.

Consequences of violating section 39

If a person makes or causes to be made an application for the grant of a patent in contravention of section 39, he shall be punishable with imprisonment for a term which may extend to two years, or with fine, or with both. Hence, it is important to either file application in India first or take FFP from the Controller of Patents. Conclusion

In the instances where the applicant is a resident of India, it is important to consider filing for a patent in India or taking permission for foreign filing from the Controller, before filing for a patent in a foreign country of PCT, the reason that violation of this provision can lead to fatal consequences.

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