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India: Foreign Filing Licenses – Timeline and Strategy

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Indian patent law does not permit the filing of patent applications outside the territory of India unless a patent application is filed in India first. The Patent office examines the application to ensure that it does not fall under the defence sector or has any relation to atomic energy. Under Section 39(1) of the Indian Patent Act, a foreign patent application can be filed only after six (6) weeks from the Indian filing if no secrecy directions are imposed by the Patent Office within that period.

The exception to this is the Foreign Filing License (FFL). The FFL is written permission from the Controller of Patents to file the patent application outside Indian Territory without filing a patent application in India first. The application for the FFL must be accompanied by a written description of the invention. The content of this description is subjective, but the idea is that it must cover the underlying conception of the invention. The purpose is for the Controller to determine that the invention will not fall under the defence or atomic energy sectors. If it does, then the Controller would need the prior consent of the Central Government to grant the FFL.

There has been much debate in relation to the time taken to obtain an FFL and understandably so, since obtaining a priority date is the main objective of the applicant. Rule 71 (2) of the Indian Patent Rules states that the Controller ordinarily shall dispose of a FFL within a period of twenty-one (21) days from the date of filing of such request provided that in case of inventions relating to defence or atomic energy, the period of twenty-one (21) days shall be counted from the date of receipt of consent from the Central Government. It is possible however, that this timeframe maybe extended.

It could be argued that if the purpose of filing a patent application in India first is to ensure that the inventive concept will not be used for defence or atomic energy purposes, then filing an application for a FFL with the description of the invention

could achieve the same purpose. Hence, if no response is received after the twenty-one (21) day period, the application for a FFL should be considered as disclosure of the subject matter to the Patent Office and the six (6) week limit be applied under Section 39(1). If no response to the application for a FFL is received within six (6) weeks, an international patent application should be allowed to be filed.

Unfortunately, the Patent Act only refers to the six (6) week limit pertaining to patent applications and not applications for a FFL and without further clarification from the Patent Office, it would not be advisable to file an international application without receiving the FFL.

Nevertheless, the Patent office lately has been very diligent in meeting the twenty-one (21) day deadline. Therefore, if the situation arises, where the twenty-one (21) day period has lapsed and no response has been heard from the Patent Office, the best strategy would be to file a provisional patent application in India and wait out the six-week mark to file an international application.

The content of this article is intended to provide a general guide to the subject matter. Specialist advice should be sought about your specific circumstances.

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