

INTERNATIONAL FILING OF PATENT APPLICATION

Routes of filing a Patent Application outside India

When a Patent Application is filed in a specific country, the rights for the invention are specific only to that particular country. Therefore, to get a protection in other countries, the Applicant needs to apply separately for Patent protection in other countries of interest. Following routes are available for filing a Patent outside India:

1. Direct Foreign Filing
2. Filing through Patent Cooperation Treaty (PCT)
3. Filing through Paris Convention

Direct foreign Filing

A person can directly apply for a Patent for a specific Country by filing a Patent Application in that particular Country directly. Generally, this has to be done by taking additional support of local Patent Attorneys. There are some exceptions to it, like Pro Se Inventor filing mode with US Patent Office. If the Applicant needs to file a Patent directly outside India (without filing an Indian Application first), then he needs to seek a Foreign Filing Permit from the Indian Patent Office, which is generally granted within approximately 6 weeks of filing such request. The costs of filing a Patent Application directly, vary from country to country.



Filing an Application through PCT route

PCT stands for Patent Cooperation Treaty, which came into existence in 1970. The purpose of this Treaty was to make it cheaper and easier to file for Patent in various countries which are the signatories of this Treaty. Currently, there are 153 signatory countries to the Patent Cooperation Treaty. This route has two phases. First one is the International Phase, which can be directly filed, however after taking Foreign Filing permit from Indian Patent office, or within 12 months from the filing of the Indian Patent Application. By filing the PCT international phase application, applicants designate all the member countries for prospective protection of his invention. However, the Applicant needs to file National Phase application within 30-31 months from the Priority date (India filing date or the PCT filing date, if PCT International Phase is filed directly) to enter into each of the countries of interest.

There are various steps that a PCT Application goes through during an International Phase. The same are listed below:

- 1. Filing:** An International Application is filed with Indian Patent Office or WIPO, complying with the PCT formality requirements. Along with the filing, the International Filing Fee, Transmittal Fee, and International Search Authority fee is to be paid.
- 2. International Search:** An “International Searching Authority” (ISA) is appointed by the Applicant, which is responsible for the identification of published patent documents and technical literature (“prior art”) which may have an influence on whether the invention is patentable or not, and establishes a written opinion on the invention’s potential patentability.



- 3. International Publication:** After the expiration of 18 months from the Priority date, the content of the International Application is disclosed worldwide.
- 4. Supplementary International Search (optional):** A second ISA identifies, at the request of the Applicant, the prior art which may not have been found by the first ISA.
- 5. International Preliminary Examination (optional):** One of the ISAs at the request of the Applicant, carries out an additional patentability analysis, usually on a version of the application which the Applicant amends in light of content of the written opinion.
- 6. National Phase:** after the end of the PCT procedure (International Phase), usually at 30 months from the earliest filing date of the initial application, from which priority is claimed, the grant of patents can be directly pursued before the national or regional Patent Offices of the countries in which the Applicant has opted entry of his Application.

Expenses incurred in filing a PCT Application

The approximate expenses for filing an International Application for an individual are at least INR 30,000, whereas for a company the same may shoot at least around 1.5 Lakhs.

Filing an Application through the Paris Convention

Under Paris Convention, an Applicant is able to extend his Patent Application filed in one of the Contracting State to other Contracting States within 12 months of initial filing of the Application. There are around 177 countries which are member to Paris Convention. Going



through the Paris Convention route is a required alternative to non-PCT member countries such as, for example, Argentina, Taiwan or Venezuela.

Expenses incurred in filing Patent Application through Paris Convention Route:

The expenses incurred in this route are dependent on the countries chosen by the Applicant, as each country has its own cost structure for Patent Procedures.

Deciding on which route to prefer

1. Filing an Application through the Paris Convention route is suitable for patent applicants having a limited funding and who are in need of a prompt application. Paris Convention filing is additionally useful in managing the nations where the particular nation isn't a signatory to the PCT. Therefore, if the Applicant has limited funding and needs to file a Patent in countries which are a signatory only to the Paris Convention, then it is required for him to go through the Paris Convention Route. Further, if the Applicant requires faster processing of the Application, then he should prefer the Paris Convention Route.
2. PCT helps to buy more time to enter in each country of interest, hence the investment can be pushed to later phases. Further, since there is a considerable time period, the same can be used to do more market research to identify countries of interest for protection.
3. As PCT provides a quick search for Patent Application, it gives a good indication on the fate of Patent application before entering into the National Phase of any country. Further, going through the PCT route enables the Applicant to amend the claims/specification under

Article 19 of PCT, under PCT Demand filing. This may help to structure the application appropriately before entering National Phase.

Flow chart to understand steps involved in PCT and Paris Convention

Routes:

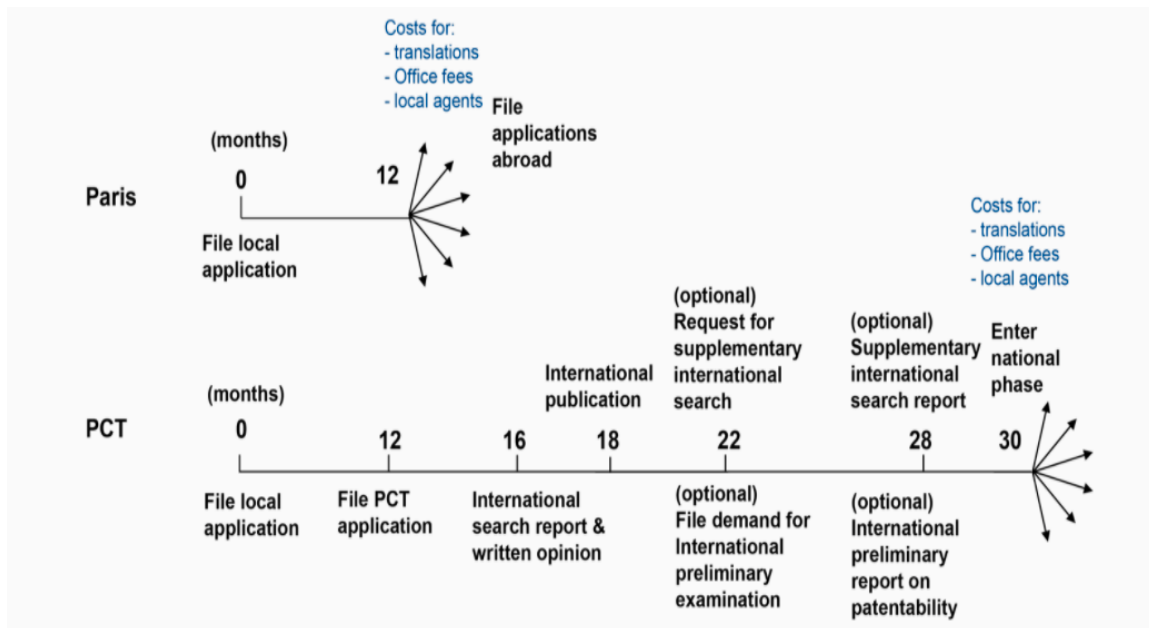


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