

Prosecuting an Israel Patent Application and Beyond

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1. General Information

- a. Language.** Patent applications may be filed in English, Hebrew or Arabic.
- b. Conventions.** Israel is a member of the Paris Convention and of the PCT. A National Phase Entry of the PCT into Israel must be submitted within 30 months of the earliest priority date. Late entry is permissible in some circumstances, although this should not be relied upon. Unlike some other jurisdictions, the Patent Office will examine priority rights, whether the claims are fairly based on the disclosure of the priority document and whether the priority document is, in fact, the earliest application.
- c. Obtaining a filing date and number.** On receiving a new application or national phase entry, the Patent Office checks compliance with various formal and procedural requirements and allocates a filing date and application number. The application number will become the Israel Patent Number, if and when a patent is granted.
- d. Excess pages Fee.** An official fee of ILS 252 (approximately US \$73) is payable at the time of filing for each batch of 50 pages in excess of 100 pages. This includes all pages except for sequence listings. If this fee is not paid on filing, it will be requested by the Patent Office soon after. While a filing date will be given even if this fee has not been paid, failure to pay the required fee will eventually lead to the application lapsing.
- e. File wrapper publication.** Patent application files are published for online public inspection at www.ilpatsearch.justice.gov.il/UI, with a list of such applications published periodically in the Patent Gazette. Note that all official correspondence with the Patent Office is in Hebrew and is therefore published in Hebrew. However, substantive arguments and amendments are normally in English.
- The dates of publication are:
- **For National applications** (not the Israel national phase of a PCT) -
18 months after either the application date or the Convention Priority date – whichever is earlier.
 - **For National phase applications of a PCT application** -
45 days after the date of national phase entry.
- f. Preventing file wrapper publication.** In the unlikely event that the applicant does not wish the application to be published, the only way to **prevent** publication is by abandoning the application within 7 days of issuance of a notice that the application is to be published.

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2. Prosecution

- a. **Overview.** Examination in Israel commences with the issuance of a **Notice Prior to Examination**. After a response is filed, the application is assigned to an Examiner.

NB Unless an accelerated examination request is filed (see section 3f below) examination is not requested, and no official fee is required in order to commence examination.

One or more **Office Actions** may issue, addressing formalities and/or substantive concerns based on prior art. When responding to a rejection concerning novelty or inventive step, it is generally advisable to use arguments similar to those used successfully in other jurisdictions, thereby to avoid possible file wrapper estoppel that may jeopardize the validity of patents in other jurisdictions.

There exist various mechanisms for **advancing** or **delaying** both the onset and the duration of examination, all as described below in section 3 below

A Notice of Allowance will issue upon the successful conclusion of the examination, informing the applicant of publication for Opposition three months following the Notice of Allowance. The date of publication is considered to be the date of Allowance. If no Opposition has been filed within three months of publication, a patent will issue, renewal fees then becoming due. See section 4 below for details.

- b. **Making amendments.** After filing of the application, and at any time prior to Allowance, the specification and claims may be amended. After Allowance and even after issue the specification and claims may be amended in a manner which does not broaden the scope of the claims. Advice may be sought on specific cases. Post-Allowance amendments are subject to opposition. Post-Allowance amendments are typically made during opposition proceedings and may result in strengthening the issued patent. Typographical errors may be corrected at any time.

Note that there is no practical advantage in amending the claims prior to the issuance of the Notice Prior to Examination. However, should the applicant wish to make an amendment to the specification, drawings or claims that adds new material, this should be made as early as possible since new matter, while not objected to, does not benefit from the filing or earlier priority date of the application, and will be post-dated to the date of submission.

Note that following examination, the Examiner may require the insertion of discussion of references cited during the course of examination, in the description.

- c. **Total Number of Claims.** There is no statutory limit to the total number of claims in an application, although the Examiner may limit the number of independent claims. Excess claims fees are discussed in the following paragraph.

- d. **Excess claims fees.** Notwithstanding the above (c), an excess claim fee of ILS 517 per claim (approximately US \$150) will be payable for each claim in excess of 50. Failure to pay the required

fee will delay examination. This should be borne in mind when considering amendments to the application. A direction to either pay for or cancel excess claims will normally be made in the first Office Action as a condition to continuation of the examination. We recommend a review both of a) the number of independent claims, and b) the total number of claims when preparing a response to the Notice Prior to Examination.

e. **Restriction to a Single Invention.** If the Examiner is of the opinion that there are claims to multiple inventions, the applicant will be required to elect one invention before commencement of substantive examination.

f. **Divisional applications.** Protection to cover the subject matter of claims withdrawn due to the requirement of the Examiner may be obtained by filing one or more divisional applications. Divisional applications may be filed until publication of the notification of allowance.

NB: The previous limitation which permitted the filing of a divisional on the basis of a parent application only, has now been lifted. A divisional application may therefore be filed based on any pending application, including a divisional.

g. **Non-Patentable Subject Matter**

(i) Claims directed to methods of therapeutic treatment of the human body are not patentable in Israel.

(ii) Claims directed to novel uses of existing substances are not patentable in Israel; however, if directed to a new method or process, they may be considered to be patentable.

(iii) Therapeutic treatments must be claimed according to the European-acceptable “composition for use in treatment” format. The form “a pharmaceutical preparation containing compound X for treating Y” is recommended for a “second-use” medical treatment claim. “Swiss-type” claims are not acceptable in Israel.

(iv) New varieties of plants or animals, except microbiological organisms not derived from nature, are not patentable in Israel. New varieties of plants may be protected under the Israel Plant Breeder’s Rights Law.

(v) Software, per se, and business methods are not considered as technological and are generally not patentable. Specific advice should be sought on a case by case basis.

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3. Examination

- a. Examination in Turn.** Applications are assigned to an examination group and are then examined in turn. On average, the Patent Office issues a Notice Prior to Examination within about 1-2 years after the application is filed. This depends on the application queue in the assigned examination group. When it appears that there is an unreasonable delay relative to the relevant examining group we may need to clarify the matter with the Patent Office.
- b. Notice Prior to Examination – Issuance & Response.** The following are details of the requirements and options for responding to the Notice Prior to Examination, together with a discussion of their ramifications.
- A. The applicant is required to submit to the Patent Office:**
- (i) A list of all prior art citations relied upon during examination, in matters of novelty and/or inventive step, in all jurisdictions in which a patent application for the same invention has been or is currently being searched or examined. We recommend disclosure of all cited references even if not specifically relied upon, as well as all documents listed in the USPTO ‘Notice of References Cited by Examiner.’
 - (ii) A separate list of all directly related prior publications known to applicant from any source, including those known from legal proceedings. [Note that this does not include unpublished documents].
 - (iii) Failure to bring relevant prior art to the attention of the Examiner might be used to challenge the validity of any issued patent during contentious proceedings. We therefore recommend submitting also complete copies of Information Disclosure Statements (IDS), and a list of other prior art of record.
- B. Document Copies and Listings:** The applicant must submit complete copies of all non-patent citations made against novelty and inventive step during prosecution as well as all non-patent citations listed in an IDS. Only a listing needs to be submitted when modified examination is requested. As copies must be submitted electronically, please send them to us on a CD or as e-mail attachments, or authorize us to obtain copies. (Translations of non-English documents are **not** required at the outset, although the Examiner is entitled to request an English translation or English-language equivalent subsequently.)
- C. List of Foreign Applications.** The applicant must submit a list of all patent applications in all other jurisdictions for the same invention.
- D. Earliest publication**
- (i) The applicant is required to inform the Patent Office of the **date of the earliest publication** of any application or patent for the same invention.
 - (ii) If the Israel application claims priority from an application which is itself a *divisional*, *continuation* or *continuation-in-part* application, the applicant is required to inform the Patent Office of the **date of the earliest publication of any application in the chain**.
- c. Third Party Submission of Prior Art.** Interested third parties are permitted to file lists and copies of references and publications thought to be relevant to examination of a patent application, up to two months after the applicant has responded to the **Notice Prior to Examination**.

If you have an interest in using this provision, please inform us of the relevant application so that we can watch for the issue of the Notice Prior to Examination.

d. Ongoing Duty of Disclosure. An ongoing duty of timely disclosure of prior art exists until allowance. It is recommended to continue to make significant prior art of record until grant (see below).

e. Prior Art Uncovered after Allowance. There is no obligation or mechanism to disclose prior art uncovered after allowance. However, if significant prior art potentially affecting questions of novelty and/or inventive step is uncovered after allowance, we recommend reviewing it for relevance to the question of patentability of the allowed claims. If, as a result of such a review, you have serious questions as to the patentability of the claims as allowed, a post-issuance amendment may be considered with a view to narrowing the claims. We will of course be pleased to assist you as required.

f. Advancing Examination

(i) Accelerated Examination by Applicant. The Patent Office provides for accelerated examination for those applicants needing patent protection as a matter of urgency. Application for accelerated examination includes a petition accompanied by an affidavit testifying to the reason for applying for accelerated examination, and payment of a fee. Acceleration is discretionary on the part of the Patent Office.

Acceptable reasons include, among others:

- Age or health of applicant.
- Unauthorized exploitation by third party or basis for suspicion of potential unauthorized exploitation by third party.
- Lapse of excessive time from filing date, or national phase entry date, relative to waiting period for other applications in same group.
- Public interest.
- Specific circumstances justifying acceleration, including potential financial loss by applicant.

If accepted, a petition for accelerated examination results in the immediate issuance of a Notice Prior to **Examination**, and the Examiner is then required to prioritize the application, responding immediately to submissions by the Applicant.

During accelerated examination, extensions for responding to an Office Action will not normally be available.

(ii) Accelerated Examination by Third Party. After publication of the application as first filed, an application may also be submitted by an interested third party to accelerate a patent application. As in (i) the application must be accompanied by an affidavit and fee. The affidavit must demonstrate:

- That examination in the regular order will cause the submitter to postpone development or manufacture of a product or process claimed in the patent application or,
- That there exists a lapse of excessive time from filing date, or national phase entry date, compared to waiting period for other applications in same group.
- Public interest.
- Specific circumstances justifying acceleration.

(iii) Green Inventions. An alternative route for acceleration is the requesting of “green” status for

the subject invention, which must be supported by a petition. Green status may be requested both for new applications and for those previously filed, if a Notice Prior to Examination has not yet issued.

(iv) The Patent Prosecution Highway. The Israel Patent Office (ILPO) is partner to bilateral PPH programs with various national offices. ILPO has joined other Intellectual Property Offices in a Global Patent Prosecution Highway (GPPH) arrangement (see <http://www.jpo.go.jp/ppph-portal/globalpph.htm>).

To apply for the PPH (or GPPH) Program in Israel, a request must be filed before substantive examination* begins in the Israel application. The claims in the Israel application should be amended to be identical or to sufficiently correspond to the claims that were allowed in the application in the Office of Earlier Examination (OEE). The Office Actions and the lists of references cited in the OEE application and all other relevant prior art, if any, must be submitted with the PPH request. There is no official fee for filing the PPH request.

*The onset of substantive examination is considered to be the issuance of a first substantive office action.

If the request is approved examination will commence as soon as possible. The Examiner will still conduct a full substantive examination, in addition to the formal examination, and is not bound by the examination in the OEE. Priority in treatment is given at all stages of the examination. However extensions are not available without leaving this route. It should be noted that PPH and GPPH are procedural tools to shorten waiting times without affecting substantive issues of examination. Maximum acceleration can often be achieved by use of the GPPH in conjunction with “modified examination” as detailed in paragraph 3g(ii) below.

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g. Types of Examination Available

- (i) **Substantive Examination.** Normal or substantive Examination commences with the issuance of a **Notice Prior to Examination** (see paragraph 4b above). In substantive examination the application is examined for novelty, inventive step and utility, as well as all matters of form and formality.

In the case of a Divisional Application, the Notice Prior to Examination is issued concurrently with the issuance of the official filing receipt, or immediately thereafter.

- (ii) **Section 17(c) (“Modified”) Examination.** Section 17(c) of the Patent Law provides that, upon request, and where a patent has been granted abroad for the same invention (a “corresponding” patent), the Israel application shall be deemed to comply with the requirements of novelty, inventive step, unity of invention, and enabling disclosure. The claims of the Israel application must be identical to claims in the corresponding granted patent. However, with the exception of unity of invention, all of these requirements may be challenged subsequently in opposition proceedings. The Examiner may also cite publications against the application if he has a reasonable justification, such as strong prior art not considered in the corresponding case. The Examiner will still search for prior applications in Israel which could invalidate the application.

Modified examination can be used to streamline applications whose examination has been accelerated under one of the PPH programs.

Although Section 17(c) is part of the Patent Law and has been very widely used, generally offering savings in both cost and time, it has not been tested in Court. Thus, particularly with respect to pharmaceutical patents and in other instances where litigation is likely, we advise careful consideration as to reliance thereon.

Please note the following:

- (a) **Modified examination** may be requested at any time prior to allowance, including in lieu of a substantive response to an Office Action. The start of substantive examination can be delayed by requesting a suspension, in order to enable request of modified examination based on the grant of a parallel patent abroad, provided that this suspension does not unreasonably prolong the pendency of the subject application in Israel. Suspension of examination, however, can only be requested after filing of a response to a Notice Prior to examination, and prior to the issuance of a first substantive office action.
- (b) Modified Examination is not a ‘rubber stamp’ procedure. A Supervisor may authorize an Examiner to reject a request for modified examination if it is felt that the claims granted in another jurisdiction do not overcome substantive issues of patentability or of there are other reasons rendering it ineligible for modified examination. This happens in approximately 10-25% of cases, depending on the technical field of the invention. If a request for modified examination is rejected it will proceed to substantive examination.
- (c) The granted patent must share a common priority with the Israel application and have been granted by one of the following patent offices: Australia, Austria, Canada, Denmark, the European Patent Office, Germany, Japan, Norway, the Russian Federation, Sweden, the United Kingdom and the United States.

A modified examination request can also be based upon claims of a PCT application held by the Written Opinion and/or IPRP to possess novelty and inventive step.

- (d) The specification, drawings and claims in the Israel application must be conformed to those allowed in **a single** granted patent, though the Israel application may have fewer claims than the granted patent. *Claims withdrawn to comply with this requirement may be made the subject of a divisional application. While a divisional application, should initially be filed within four months of restricting the claims, this period may be extended on payment of the requisite extension fees.*
- (e) The Applicant is required to submit a copy (printed or as a PDF file) of the granted patent.
- (f) It is often advisable to use the claims of an issued English language patent, when appropriate. We can advise on specific cases.
- (g) Modified examination is also applicable in the case of a divisional application.
- (h) Amendments should be sent to us by e-mail in MS-Word format with tracked changes shown. Local practice requires claims to be numbered consecutively starting with Claim 1.
- (i) In accordance with Circulars issued by the Commissioner of Patents, modified examination may also be requested if the claims conform to the claims in an eligible patent which are directed to methods of therapeutic treatment of the human body, *provided that* the claims (in the Israel application) are converted to Swiss-type claims or claims for compositions for treating disease X.

h. Notes on Examination

- (i) **Number of Office Actions.** There is no statutory limit to the number of office actions which may issue. Generally the applicant has four months to respond to an office action and the Patent Office permits filing a response up to six months after the initial deadline without prior request, upon payment of late fees (see **extensions**, below).

Five months after the initial deadline, a Notice Prior to Refusal will issue, setting a one month time limit for filing a response to the Office Action and payment of extension fees. If this is not done, the application will be refused.

- (ii) **Extensions.** In lieu of responding to a substantive Office Action by an Examiner by the due date, the following extensions are available:

For an application whose examination commenced before 27.3.2017, a maximum of 6 months of extensions are available for each substantive Office Action, provided that the accumulated total during the course of examination is not greater than 15 months. The six months of extensions available for responding to the Notice Prior to Examination are not included in the 15 months.

For an application whose examination commenced after 27.3.2017, a maximum of 4 months of extensions are available for each substantive Office Action, provided that the accumulated total during the course of examination is not greater than 12 months. The six months of extensions available for responding to the Notice Prior to Examination are not included in the 12 months.

In practice, if the applicant is uncertain as to how many months of extensions, or if less than the full period of extensions is required, we recommend filing a request for an extension at the time of filing the response to the Notice Prior to Examination or Office Action. If the full period

is to be requested, we recommend that this be filed in advance, so as to avoid issuance of a Notice Prior to Refusal.

- (iii) Suspension of Examination.** After submission of a response to the Notice Prior to Examination, but prior to the issuance of a first substantive Official Action, a suspension of examination may be requested for good cause. Typically, this will be done in order to suspend examination until the grant of a parallel patent to enable a modified examination request. A request for suspension must be accompanied by a reasoned statement explaining the reason for the request for suspension. If the request is approved, the applicant will be informed and the extension will be granted upon subsequent payment of monthly fees. It is recommended that a request for suspension be filed at the time of responding to the Notice Prior to Examination, if the applicant is interested in requesting a suspension.

Note that **the Patent Office will not suspend examination** if this has the effect of unreasonably extending the pendency of the application beyond the average pendency of other applications in the same field.

- (iv) Failure to Respond.** A Notice Prior to Refusal (PK10) will be issued one month prior to the maximum extension available at the relevant stage, unless a response to an outstanding office action has been filed, or an extension or suspension requested. This Notice requires response within one month from its date of issue.

NB On occasion, a Notice Prior to Refusal is issued in error. Unfortunately, this **requires** us to contact the Patent Office and ensure that they correct their records.

- (v) Notice of Refusal.** If a timely response is not filed within the time limit set forth in the Notice Prior to Refusal, a Notice of Refusal will issue shortly thereafter, indicating a final refusal of the application for patent. The only way to revive a patent application after issuance of a Notice of Refusal, is by filing a suitable request for revival, as soon as possible and within one year from the date of refusal. **This period can be extended if it can be shown that an extension is justified by the circumstances.**

Further guidance on this matter is available, on request.

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4. After Examination

- a. Publication for Opposition.** When the Examiner is satisfied that the claims are patentable and any objections concerning the specification or Figures that were raised have been responded to, a Notice of Allowance issues. The application will be published for Opposition purposes in the Official Gazette following payment of the issue fee.
- b. Opposition or Grant.** A Notice of Opposition to the granting of a patent may be filed by any party, at any time during the three month period immediately following the publication. If no such Notice is filed, a patent will be granted at the end of the three month period.
- c. Maintenance.** Renewal fees are due three months after the date of grant and at the end of the 6th (for years 7-10), 10th (for years 11-14), 14th (for years 15-18) and 18th (for years 19-20) years from the effective filing date.
- d. Patent Term Extensions.** Israeli Law provides for the extension of pharmaceutical patents under certain conditions. We will be happy to provide advice in this regard.

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