



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 Paris Convention application must be filed within 12 months of the earliest priority date, while 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 validity of a priority claim, whether the claims are fairly based on the disclosure of the priority document and whether the claimed priority document is, in fact, the earliest application.
- c. **Utility Models as basis for a Priority Claim.** Israeli Patent Law does not include Utility Models as exist in various jurisdictions (China, Germany, Spain, for example). However, as Utility Models are specifically included in Article 4 of the Paris Convention, in practice it is possible to use a Utility Model as a basis for a claim to Paris Convention priority.
- d. **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.
- e. **Excess pages Fee.** A fee of approximately \$ 75 (depending on the exchange rate at the time) 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 the 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.
- f. **File wrapper publication.** Patent application files are published for online public inspection at ilpatsearch.justice.gov.il/UI/MainPage.aspx, 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.
- g. **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.

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), **substantive examination commences in turn**, without submission of a formal request or payment of an official fee. 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, at which point renewal fees will become due. See Section 4 below for details. 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.
- b. **Making amendments.** After filing of the application, and at any time prior to Allowance, the specification, claims and figures may be amended either so as to correct obvious errors or to add matter, although all added matter will be post-dated to the date of amendment. 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 approximately \$ 150 per claim (depending on the rate of exchange at the time) is payable for each claim in excess of 50.

Failure to pay the required fee by the time of filing a response to the Notice Prior to Examination will delay the onset of substantive 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, as a condition to continuation of the examination, after filing a response to the Notice Prior to Examination and prior to the issuance of a first Office Action. 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.

NB If the Examiner considers there to be multiple claimed inventions, examination will commence on the first claimed invention **only**. Therefore, in a situation in which multiple claims sets are present, the applicant should amend the claims in the response to the Notice Prior to Examination (Paragraph 3b below) to ensure that the preferred set of claims appears first. A request to amend the order of the claims in response to an Office Action which includes a restriction requirement will be considered non-responsive, requiring the filing of a divisional application in order to reorder the claims.

- 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.

g. **Non-Patentable Subject Matter**

- (i) Claims directed to methods of therapeutic treatment of the human body are not patentable in Israel. However, claims relating to medical treatments of non-human animals are patentable in Israel. Methods of purely cosmetic and diagnostic procedures are also patentable.
- (ii) (ii) Claims directed to novel uses of existing substances are not patentable in Israel; however, if directed to a new method, process, composition, or device they may be considered to be patentable.
- (iii) (iii) Therapeutic treatments must be claimed according to the European (EPC 2000) format of, "compound X for use as a medicament". The form "a product X for treatment of Y" is recommended for a "second-use" medical treatment claim. Similarly, "a device for use in a method for treating disease Y" would be acceptable in Israel. "Swiss-type" claims are not acceptable in Israel.
- (iv) (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) (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.

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 one year after the application is filed, unless the application is a divisional, in which case it is normally issued within several days after filing the application.
- 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.

In response to the Notice Prior to examination, the applicant is required to submit the following 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.’ b. 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]. c. 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.
- ii. **Document Copies and Listings:** The applicant must submit complete copies of all non-patent citations made against novelty and inventive step during prosecution of all corresponding application. Only a listing needs to be submitted when modified examination is requested. These documents should be sent to us on a CD or as e-mail attachments, or we can obtain them for a charge. 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.
- iii. **List of Foreign Applications** The applicant must submit of a list of all patent applications in all other jurisdictions for the same invention.
- iv. **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. b. 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 advise.
- 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. Additionally, there is an option to request reexamination of the application based on the newly discovered reference.

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.
 - For a first filed application, request to accelerate examination so as to receive a search report for which a decision can be made to file in other countries.

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 wipo.int/pct/en/filing/pct_pph.html). Grant rates are high and the average time taken to grant a patent is much shorter than regular (non-PPH) applications.

To apply for the PPH 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 claims can be amended to comply with Israel Patent Law requirements (i.e. Method of Human Treatment claims can be amended). 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. Expedited handling occurs 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.

- f. **Types of Examination Available For all applications that have not yet entered substantive examination, it is possible to request issuance of Office Actions in English.**

- i. **Substantive Examination.** Normal or substantive Examination commences with the issuance of a first substantive office action. 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. All of the claims of the Israel application must be identical to at least some of the 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. A request for modified examination may be rejected, if the Examiner feels that the examination of the corresponding patent was not sufficiently rigorous, for example, if additional prior art is uncovered, or if a finding of novelty or inventive step was not fairly based, in the opinion of the Examiner and the examiner’s Supervisor. Modified examination can be used to streamline applications whose examination has been accelerated under one of the PPH programs.

Cautionary Note: 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.

- ii. Modified examination may be requested at any time prior to allowance, including in 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.

*If a request for modified examination is requested prior to issuance of a first substantive Office action, if the request is accepted, it will normally be sufficient to avoid substantive rejections based on lack of novelty and obviousness. However, if a request is filed in response to a substantive Office Action, it must be accompanied with substantive amendments/arguments showing how the claims overcome all rejections based on lack of novelty and obviousness. Failure to do so is liable to result in a rejection of the request and reissuance of the substantive Office Action.

- iii. 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 if 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.



- iv. 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.
- v. 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.*
- vi. The Applicant is required to submit a copy (as a PDF file) of the granted patent.
- vii. It is often advisable to use the claims of an issued English language patent, when appropriate. We can advise on specific cases.
- viii. Modified examination is also applicable in the case of a divisional application.
- ix. 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.

g. **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 four months after the initial deadline without prior request, upon payment of late fees (see *extensions*, below). Usually, three 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.** The following extensions are available for responding to Office Actions: **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. We recommend filing a retroactive request for an extension at the time of filing the response to the Notice Prior to Examination or Office Action.



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 Patent office will advise once examination is about to commence, and if at that point the applicant still wishes to suspend examination, they will need to pay the suspension fee. 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.

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.** Usually, 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.

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.



4. After Examination

1. **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.
2. **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 and issuance of a Certificate of Patent.
3. **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.
4. **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.