



# MEMORANDUM

## Modified Examination Procedure at the Israel Patent Office

### 1 Procedure Overview

In Israel, patent applications may undergo examination based on corresponding patents granted in selected foreign jurisdictions. This procedure, known as "Modified Examination," is governed by Section 17(c) of the Israeli Patent Law and typically expedites prosecution.

### 3 Conditions for Modified Examination

Modified Examination can be requested based on a single corresponding patent or two corresponding patents, provided the combined claims refer to a single invention, similar to PCT and EP practices.

To be eligible for Modified Examination, an Israeli application must meet the following criteria:

- The Israeli claims must be identical to those of the corresponding patent, with non-acceptable claims under Israeli law, such as omnibus or therapeutic method claims, removed.
- The Israeli application and corresponding patent must share a common priority date, which can originate from the Israeli application, the corresponding patent, or a third application from which both the Israeli application and the corresponding patent claim priority. In cases of multiple priority claims, examination is possible if the set of claims is supported by the common priority document.

### 2 Eligible Jurisdictions and Patent Types

The corresponding patent must originate from one of the following jurisdictions: Australia, Austria, USA, Germany, Denmark, UK, Russian Federation, Japan, EPO, Norway, Canada, and Sweden.

Notably, a US continuation or continuation-in-part (CIP) patent may qualify, provided no prior publication related to the same patent family occurred before the Israeli application's priority date.

### 4 Procedural Requirements

- Applicants must submit a copy of the corresponding patent, with an English translation if necessary.
- According to a strict interpretation of the law, the applicants for both the Israeli application and the corresponding application, which led to the grant of the corresponding patent, must be identical individuals or entities. While strict alignment of applicants between the Israeli and corresponding applications is preferred, exceptions exist, especially if the corresponding patent was granted or assigned to the Israeli applicant.
- Modified Examination can be requested with a reduced number of claims, provided the claims' dependency remains unchanged.
- Description and drawings of the Israeli application should match those of the corresponding patent or meet Israeli requirements.



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### 5 Examination Considerations

A patent granted via Modified Examination is presumed to meet various patentability provisions including:

**Novelty, Inventive Step, Unity of the Invention, Sufficiency of Disclosure and Support of the claims by the description.**

If the corresponding patent undergoes adverse proceedings such as opposition, revocation, re-examination, before the Israeli application's grant, notification to the Patent Office is required, potentially leading to the application returning to regular examination.

Following the submission of a request for Modified Examination, the Examiner maintains the authority to raise objections to the request on specific grounds. These special grounds may encompass instances where known prior art was not taken into account during the examination of the corresponding patent.

### 6 Strategic Considerations

Modified Examination expedites prosecution but may lead to alignment with restrictions from the corresponding patent, impacting the scope of the Israeli patent.

Third parties might challenge the validity of a patent granted via Modified Examination, but such challenges lack legal basis.

Applicants are advised against Modified Examination if relevant prior art wasn't considered during the corresponding patent's examination.

While Modified Examination can be requested at any stage before acceptance, it's typically recommended before substantive examination begins, often in response to an Official Notification Prior to Examination.