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Developments in Modified Examination

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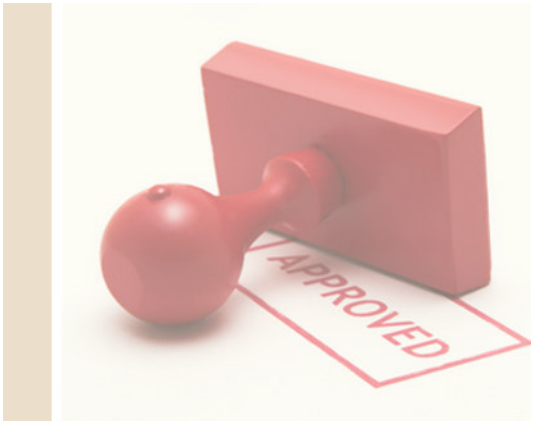

Applicants at the Israeli Patent Office (IPO) have the option to request that the acceptance of an Israeli patent application be based on its counterpart patent (*"corresponding patent"*) in Europe, USA and a number of other selected countries[1] (*"selected countries"*), as stipulated in Section 17(c) of our Patents Law. One of the main conditions established by Section 17(c) of the Law is that the Israeli application and the corresponding patent share the same priority.

The modified examination procedure has proved to be very successful in speeding up examination as well as reducing costs of prosecution of patent applications in Israel. Unlike modified examination in Australia, in Israel request for modified examination can be made at any time, even after one or more Office Actions have been issued.

For more details on modified examination, please review our memorandum on modified examination.

When requesting a modified examination, the claims of the Israeli application have to be made identical to those of the corresponding patent. However, in many cases, notably patent applications in the pharmaceutical industry, claims in other jurisdictions may be in a format unacceptable in Israel.

In particular, claims directed to a method for therapeutic treatment, which is an acceptable format in the USA for new indications of known active pharmaceutical ingredients, are not permitted in Israel under Section 7(1) of the Israeli Patents Law. The practice, therefore, has been to amend such claims to conform to the acceptable format and examiners usually allowed the application provided the scope is commensurate with that of the corresponding patent. However, there were exceptions.

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In Registrar's Circular Letter No. MN11 that came into effect in September of 2003, and Circular Letter No. MN70 that came into effect in January 2009, replacing the former Circular Letter with regard to new applications, the Registrar opened the door to requesting acceptance of an Israeli patent application also on the basis of a notice of allowance received in a selected country, for a patent application relating to the same invention. According to these two Circular Letters, the requirement is that the specification and the claims of the Israeli application need to be identical to those of the corresponding application.

Circular Letter No. MN70, clarifies that the above procedure may be used even in cases where the Israeli application and the corresponding foreign application do not share the same priority, i.e. where modified examination under Section 17(c) of the Patents Law cannot be requested, and formalizes the practice of examiners concerning claims for therapeutic methods, as noted above.

To summarize, modified examination can now be requested on the basis of a corresponding issued patent or allowed application in a selected country. The corresponding patent can be a patent or allowed patent application with a common priority or one relating to the same invention even without a common priority.

These amended directives are a further step in easing up the burden and costs for prosecuting a patent application in Israel and will hopefully assist in reducing the backlog of patent applications at the Israeli Patent Office.

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[1] The selected countries are: USA, Canada, Japan, European Patent Office (EPO), Austria, Denmark, Germany, Great Britain, Russian Federation, Norway, and Sweden.

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