



Reinhold Cohn

Gilat  
Bareket  
& Co.

Attorneys at Law

## The recording of the transfer of ownership in patents and patent applications

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### According to a recent decision of the Israel Deputy Patents Registrar, in certain cases it will be possible to record the transfer of ownership in patents and patent applications although the Israeli number of the patent or application is not specifically mentioned in the transfer documents

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In mid July 2010, the Deputy Registrar adjudicated a decision which updates the Israel Patents Office (ILPTO) policy concerning the recordal of transfer of ownership in patents and patent applications in cases where the transfer document does not specifically mention the application number or the patent number granted/filed in Israel.

The said decision was given pursuant to an oral hearing before the Deputy Registrar and his aide in four matters handled by our firm. These matters pertained to transfers of rights that had taken place in the past by an instrument identifying the priority documents which did not include the number of an application made in Israel and that for various reasons (such as transferor no longer existing) it was not possible to obtain a document signed by the transferor confirming the transfer while noting the Israeli number.

In an Office Administrative Order of May 2007 (Registrar's Circular M.N. 55), the Israeli Registrar specified the requirements of requests to transfer rights in a patent or patent application applied for in Israel. Section 1 to this Order regards transfer of title and sets forth the documents which need to be submitted to the ILPTO. Such listing includes an original deed of assignment stating the date of transfer, signature of transferor **and the Israeli number** of the patent or patent application.

This Order states that rights of any type (such as license, assignment or lien) will not be recorded without the specific mention of the Israeli number in the original document. In absence of such mention, the Order states that the request for recordal will be denied and the matter should be directed to the adequate court.

In view of said policy as was expressed in the Registrar's Circular M.N. 55, the four matters which were brought forth for hearing were rejected without review due to the lack of mention of an Israeli number.

The parties requesting the transfer were represented by **Mr. Asa Kling** a Partner at Gilat, Bareket & Co. and by **Mrs. Lihi Goldenberg**, an attorney at our firm. They presented oral arguments before the Deputy Registrar which pertained to both administrative and Patents laws.

In his decision, the Deputy Registrar accepted the argument that the Registrar's Circular M.N. 55 does not prevent the ILPTO from exercising discretion also in matters where the original transfer document does not mention the Israeli number and that in such cases the Registrar should flexibly exercise his administrative authority in reasonable measure. Effectively, although it may be a deviation from the internal administrative protocol expressed in the Registrar's Circular M.N. 55, such flexibility and measure in cases where it is found that the transfer document does present an actual transfer, such transfer will be recorded in spite the lack of specific mention of the Israeli number.



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During the hearing the Deputy Registrar examined the specific documents which were presented in each of the matters and stipulated with regards to each of them that the chain of transfers brought before him and proven by documents do indeed show the transfers actually took place. Therefore, the Deputy Registrar ordered that the transfers be recorded. The Deputy Registrar also noted that in extraordinary requests for recordal of transfer which uniquely do not abide the procedure set forth in the Registrar's Circular M.N. 55 and the regular procedure expected from an administrator of a public record, the fact of transfer may be shown by documents and certificates during an oral hearing.

Inter alia, the Deputy Registrar referred to the nature of the documents which may assist an applicant requesting recordal of a transfer in order to persuade the Registrar in such extraordinary cases, such as an affidavit made by transferor or signed by her corporate organ or authorized person.

It is well worth noting that the decision does not cancel the Registrar's Circular M.N. 55, although it indicates the updating of the ILPTO's policy to outright reject requests for recordal which do not include a document in which an Israeli number is specified. The unreasonable result of preventing the due recordal of a transfer which had transpired and gone into effect, has effectively been mitigated by a measure of reason and due process.

**Authors:**

**Adv. Asa Kling, Partner, Patent Attorney**

**Adv. Lihi Goldenberg**

Gilat, Bareket & Co., Attorneys At Law  
Tel. 972 3 5672000 Fax. 972 3 5669030  
[info@gilatadv.co.il](mailto:info@gilatadv.co.il), [www.gilatadv.co.il](http://www.gilatadv.co.il)

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