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Patent Eligibility of Software Related Inventions

January 1 , 2012

After about a year of uncertainty since the announcement of the previous Commissioner on the intention to issue examination guidelines relating to patent eligibility of software-related inventions, the new Commissioner, Adv. Asa Kling, finally issued, on January 12, 2012, the long awaited draft examination guidelines¹. There is a period of one month, until February 12, 2012, in which the public may submit comments to the draft. The new examination guidelines significantly relax the patent eligibility standards for software-related inventions and in fact bring them into closer alignment with those in other countries. The new guidelines are a welcome development, as for nearly 6 years the Israeli Patent Office adopted a negative approach with regard to granting patents for software-related inventions which involved “technical” features. This was in marked contrast to Israel’s world-leading position in the development and adoption of software-related innovations.

Patent eligible inventions are defined in Section 3 of the Patents Law². According to the new draft guidelines (which may be modified to some extent after receiving public comments)³, in order for an invention, either a product or process, to be patent eligible under said Section 3, the claimed product or process, or the outcome of a claimed process, must fall within a field of technology⁴, namely have a *concrete technological character*. For the purpose of arriving at a conclusion whether an invention has a *concrete technological character* it must be examined as a whole and it should bring about a contribution which must have concrete expression in a field of technology.

The draft guidelines provide also some assisting rules for determining *concrete technological character*; for example, if a claim has concrete expression beyond regular operation of a computer, then it embodies *concrete technological character*.

The new draft guidelines have further coped with a previous ill-conceived practice which has caused, so far, much frustration to applicants and practitioners when prosecuting “technical” software-related inventions. For instance, the tendency of some examiners was to reject software-related inventions on grounds that they are merely computational stages of a computer program, and, as such should be awarded only with copyright protection, even though the claimed invention was of pure technical character. Another common objection was that a computer program is merely an automation of a mental act, and as such is not eligible for patent protection. The draft guidelines emphasize also the practical side and provide 14 examples of how to apply the new rules.

It appears, thus, that the pendulum has swung once again in the right direction of far more permissive patentability criteria of software-related inventions.

To view an English translation of the commissioner’s announcement please [click here](#).

To view an English translation of the draft new examination guidelines please [click here](#).

To view the original instructions in Hebrew on the Israeli Patent Office website please [click here](#).

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¹ A full English translation of the Draft of Examination Guidelines can be found on our website at [this link](#).

² Section 3 of the Law, which defines a patent eligible invention reads: "An invention, whether a product or a process in any field of technology, which is new, useful, and susceptible to industrial application, and which involves inventive step - is eligible for patentability.

³ Although still in a draft form, given the fact that it was issued after receipt of some position papers from the public and a 'round table' discussion with representatives of the relevant public, we do not expect the final version of the guidelines to substantially differ from the draft.

⁴ See Section 3 of the Law in footnote No. 2.

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