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Online publications may now be cited against novelty of designs

Design

Israel - Reinhold Cohn Group

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A circular letter of the Israeli registrar of patents, trademarks and designs (Circular Letter MN 69, December 24 2008) has clarified the approach of the Patents, Trademarks and Designs Office with regard to the assessment of the novelty of a design.

Under Section 30 the Israeli Patents and Designs Ordinance, a design is eligible for registration if it is "new or original and has not been previously published in Israel". Therefore, the ordinance requires that the design be novel only in Israel.

Until now, the practice of the office has been to examine the novelty of the design based on prior publications in the Israeli Register of Designs. The effect of the publication of prior art on the Internet remained an open issue.

The circular letter clarifies that in light of technological advances, it is now possible to cite designs published on the Internet prior to the application for the registration of a design in Israel in order to contest the novelty of the design. Such citation requires evidence of the date of the online publication. By way of example, the circular letter provides that publications made on the websites of the Office for Harmonization in the Internal Market, the US Patent and Trademark Office, the World Intellectual Property Organization and other patent offices around the world shall be taken into consideration, as long as the publication date is specified.

However, the circular letter points out that it will be possible to rely on online publications only where the examiner is satisfied that the design in question has been published before the filing date of the application in Israel.

While the filing date of the application seems to be the only determining date under the circular letter, it may be assumed that where priority is claimed under the Paris Convention for the Protection of Industrial Property, the determining date will be the priority date under the convention, rather than the filing date of the national application.

In addition, the circular letter refers to Israeli case law on national and international jurisdiction over online publications. The circular letter also cites the Australian case of *Dow Jones & Company Inc v Gutnick* (194 ALR 433), in which it was held that the publication of a web article uploaded by a US publisher had occurred in Australia because it was available for viewing (and accessed by subscribers) in Australia.

In this respect, the circular letter states that the publication on the Internet of an article which is "freely accessible to the public in Israel" constitutes publication of this article in Israel. However, it does not specify which publications will be deemed to be freely accessible to the public in Israel. Nevertheless, the letter makes it clear that publications on the websites of the major patent offices around the world will be deemed to be accessible to the public.

The extent to which the 'local novelty' requirement will be affected as a matter of practice will largely depend on the office's assessment of the accessibility of online publications in Israel. In addition, it remains to be seen whether the approach taken in the circular letter will be followed by the courts.

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