

INTELLECTUAL PROPERTY

REINHOLD COHN GROUP

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Intellectual
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IP Law in Israel - Overview

Intellectual property (IP) is a key driver of the innovation-based Israeli economy. The IP laws are a combination of such which are a product of the original Israeli legislation and others that are amended and updated versions of British legislation during the British mandate over of Palestine (1920-1948).

Although there are no specialized IP courts in Israel, the courts are generally IP-friendly.

In respect of counterfeits for example, rights holders can enforce their IP right, with the availability of expeditious judicial interim relief and the possible assistance of governmental agencies such as the police and the customs authority.

Patents, designs and plant varieties

The Patents Law, 1967 is an original Israeli statute which incorporates such principles as the requirement for absolute novelty and has been amended to reflect Israel's international obligations such as the Patent Cooperation Treaty. The Patent Law was amended in 2011 and 2012. One of the recent substantial changes in the Patents Law was the introduction of early publication of patent applications. A patent application and its file wrapper will now be open for public inspection after a period of 18 months from the filing (or priority) date. The amendment also introduced the right to collect reasonable damages for infringements that occurred between early publication and publication of acceptance of the patent application.

On January 2014 the Patents Law was amended again and introduced a significant reform in the patent term extension (PTE) system.

The Law governing the protection of Industrial Designs in Israel is currently the Patents and Designs Ordinance of 1924 which is the amended British ordinance that supports old concepts such as local novelty; however, on July 13, 2015, a new Designs Bill passed its first reading in the Israeli Parliament. When finally enacted the new Designs Law will replace the old Ordinance and will modernize the designs protection in Israel. Some of the major provisions of the Bill are a new definition for a "product" encompassing graphic symbols and typographic typefaces, international novelty unregistered designs protection, grace period and provisions for Israel's accession to The Hague Agreement .

Rights in new plant varieties are governed by the Plant Breeders Law, 1973.

Trademarks, appellations of origin and trade secrets

The British Trademarks Ordinance, which was introduced in 1938, is the basic Law governing protection of trademarks in Israel. The ordinance has undergone several amendments primarily aimed at implementing Israel's international obligations under treaties and conventions such as the TRIPS Agreement (introducing legislative protection for well-known marks). Recent amendments were designed to ensure conformity with the Madrid Protocol. The British Merchandise Marks Ordinance, which has also been amended, provides for criminal liability for designating goods by a false commercial description or counterfeit trademark, providing additional protection to registered trademarks.

Appellations of origin and geographical indications are governed by the Protection of Appellations of Origin (Geographical Indications) Law, 1965.

The Commercial Torts Law, 1999 regulates the protection of trade secrets and also provides protection against passing off, false commercial description and other business-related torts having a bearing on IP litigation.

Copyright

Israeli law of copyright (including copyright protection of software) is governed by the Copyright Law, 2007. The provisions of the British Copyright Ordinance of 1924 regulate private copying of copyrighted works on blank tapes (recordable media other than for computer use). The protection of mask work rights derive from the Protection of Integrated Circuits Law, 5759 – 1999.

The neighboring rights of performers and broadcasters are addressed in the Performers and Broadcasters Rights Law, 5744 – 1984.

Israel's IP protection is further shaped by other statutes and regulations relevant to various specific aspects of IP protection as well as by a constantly evolving body of case law.

Online issues

The liability of online service providers, including the obligation to remove infringing materials, is an evolving issue. There are cases in which the courts have ordered local internet service providers to block access to internet sites that are located outside of Israel and to disclose the identifying details of infringing users. On the other hand, we also encounter cases in which the court refused to provide such an order in the absence of specific legislation. The matter is yet to be decided by the Supreme Court.

Administrative changes

Since 2009 the Israeli Patents and Trademarks Office has improved its computerized systems in line with the requirements of the Madrid system; it is possible to access the system for search purposes, filings of trademarks, issuance of certificates etc. Recently the use of the computerized system was extended to cover filings of oppositions, evidence and other adversary proceedings.

Under a newly signed agreement between the U.S. Patent and Trademark Office (USPTO) and the Israeli Patent Authority (IPA), as of October 1, 2014, the IPA was declared as an International Searching & Examining Authority (ISEA) for PCT applications filed at the USPTO. This reflects recognition by the USPTO of the quality of the search and examination conducted by the IPA.

The Global Patent Prosecution Highway (GPPH) is a new program that came into

effect on January 6, 2014 and is a way to accelerate procedures in one country based on favorable examination in another. The IPA is one of the 17 participating offices, that also include the USPTO and others, and, consequently, new accelerated procedures are now available to applicants of Israeli patent applications. Similarly, success in the examination of an Israeli application may be used to accelerate prosecution in other participating states.

Controversial Developments

Three-dimensional trademarks

In principle, the Trademarks Ordinance envisages the possibility of registering three-dimensional (3D) trademarks. On March 2015 the IPO issued a new Circular Letter which sets forth the current policy of IPO on the registration of 3D marks consisting of the configuration of products or their packaging. Accordingly a 3D shape of a product or packaging is to be examined like any other mark, in its entirety, and will be eligible for registration as a trademark in the event that such mark contains additional elements permitting the identification of the source of the goods, or upon demonstration, through evidence, of the following three cumulative criteria: The shape of the 3D mark serves as a trademark; The shape does not have an essentially aesthetic or functional role; and the shape has acquired a secondary meaning.

Loss of a trademark due to failure to register an authorized user

In Israel, trademark rights are acquired primarily through use; however, registration is key to acquiring the right to sue for trademark infringement (other than in the case of well-known trademarks), although an action for passing off may be available to the owner of an unregistered mark. Furthermore, registration of an authorized user is necessary for continuing validity of the registered owner's trademark lest the mark become susceptible to cancellation due to a three year period of non-use.

Patent protection of business methods and software

The recent practice of the Israeli Patent Office has been relatively conservative in that methods of doing business, as such, cannot be protected by Patents. With regard to software-related inventions, the applicable patentability standards are in a state of uncertainty. Generally speaking, the prospects of getting a patent for a software-related invention (other than a business method) are similar to those of the European Patent Office.

Parallel importation

The Law in Israel allows parallel importation namely the importation of genuine goods from a country in which they are legitimately marketed. This provides a route by which importer other than the one appointed by the rights owner (parallel importers) may import genuine goods into the country. In a recent case the Israeli Supreme Court has defined the scope of permissible use of registered trademarks by parallel importers, adopting a relatively liberal approach to parallel importation and to the freedom to use another's trademark in this context. Nonetheless, the Court imposed restrictions on the activities of the parallel importer inter-alia forbidding the creation of confusion as to endorsement by the trademark owner.

In conclusion, as can be seen, the various aspects of IP protection in Israel are based on a variety of laws and case law which have been and continue to be revised and updated to be in line with technological and international developments. Through its national legislation, and as a party to international treaties and conventions, Israel provides a safe and supporting environment for ensuring a real and effective priority to the protection of IP rights.



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Reinhold Cohn Group is the largest, earliest established and leading intellectual property (IP) firm in Israel offering premier expertise in filing, prosecution, renewals, protection, oppositions, opinions, due diligence, freedom to operate, enforcement, litigation, licensing, commercialization and evaluation, portfolio management and strategic counseling in all areas of intellectual property including patents, trademarks, designs, copyrights, enforcement, open source, plant breeders' rights, etc.

The Group is a full service IP firm and includes the patent attorney firm Reinhold Cohn & Partners and the law firm Gilat, Bareket & Co. Reinhold Cohn Group has a staff of about 250, amongst them over 70 are patent attorneys and attorneys at law. The expertise of the Group's attorneys covers a very wide range of technological and industrial disciplines. Reinhold Cohn Group takes pride in the diversity of its clients representing many Israeli companies as well as numerous multi-national corporations in Israel. The Group's clients include Fortune 500 companies, governmental entities, start-up companies, companies in advanced stages of research and development, private and institutional investors, scientists, entrepreneurs and inventors.

Reinhold Cohn Group and its team of professionals are internationally renowned for excellence and are continually ranked in the top tiers in leading international and local guides, such as: Managing Intellectual Property, Chambers & Partners, Legal 500, WTR1000, IAM 1000, IAM 300, Who's Who Legal, Expert Guides, BDI, and more.

Ilan holds a Ph.D. in Biology (1988) from the Hebrew University of Jerusalem. He has close to 30 years of experience in the field of patents and in other spheres of intellectual property;. Ilan gained extensive experience and expertise in transforming intellectual property assets, particularly patents, into a first tier, value-creating asset.

He is a member of the Board of Directors of several companies and also serves as a member of investment committees of venture capital funds, technological incubators and accelerators. For several years, Ilan has been personally recommended in leading international guides, such as Chambers & Partners , MIP IP Stars, IAM Patent 1000 and Expert Guides. Also Ilan is the only Israeli patent attorney who is ranked in the prestigious IAM300 patent strategists guide.

Daphna holds an LL.B. degree (1989) & CPA (1989), both from Tel Aviv University and is a licensed mediator since 1999. With over 20 years of extensive experience in the field of intellectual property, Daphna represents and advises prominent international and Israeli companies, including multinational, industrial and start-up companies, as well as government institutions, in a variety of matters. Daphna specializes in managing transactions, including licensing and commercial agreements, transactions related to start-up companies, venture capital, international transactions and additional commercial agreements related to technology. Daphna has been recognized and commended for several years in the prestigious IAM Patent 1000 guide.

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