INTELLECTUAL PROPERTY - ISRAEL

Request for comments on proposed amendments to Patent Law

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The Ministry of Justice and the Patent Office recently published a request for comments on purported expansive amendments to the Patent Law. Some of the proposed amendments are minor, while others represent radical changes to the existing legislation. Many of the proposed amendments, if carried through, may benefit foreign applicants, which are the source of most patent applications in Israel.

The deadline for filing comments was 7 April 2021. It remains to be seen how the process will develop. This article discusses the proposed amendments and the effect that they may have on the Israeli patent system.

Easing of regulatory burden

The proposed amendments follow a 2014 government resolution which provides that all government offices should reduce their regulatory burden. Accordingly, many of the proposed amendments clearly relate to reducing the regulatory burden which results from filing patent applications. For example, the request for comments asked applicants about the removal of the Patent Office requirement that parties must disclose any publications cited by any patent offices in other countries.

The request for comments also asked applicants about the introduction of a grace period, which would give parties one year following the first publication of their invention to file a patent application. Without a grace period, an inventor's patent rights can be undermined where, for example, they discuss their new research at a conference. Further, the request for comments asked applicants about the simplification of provisions relating to the requirements involved in publishing inventions in exhibitions (eg, the requirement that parties must advise the Patent Office in advance).

Further, the request for comments invited participants to opine on:

- the use of patents of addition (the equivalent of continuation patents in the United States); and
- whether applicants should be allowed to make material changes to patent applications.

It is important to find a balance between making processes easier for individuals and ensuring that systems operate successfully. Third-party certainty should also be considered.

The proposed amendments also covered various topics which do not relate to the easing of the regulatory burden, including the following.

Examination of biological molecules

The request for comments asked participants whether, in the context of applications for patent term extensions, biological molecules should be examined in the same way as chemical molecules. In particular, the request for comments asked whether the criteria for determining what constitutes a 'first registration', with the Ministry of Health approving the use of the material for medical purposes, should be the same for biological and chemical molecules. This is an issue because small changes to biological materials may be influential, whereas small differences to chemicals may have a less significant effect. Therefore, as well as examining the

molecule's structure, it may be the case that, for biological patent applications, the resulting change in activity should be examined as well.

Patentable subject matter

Sections 7(1) and 7(2) of the Patent Law provide that the following are unpatentable:

- methods of treatment for the human body; and
- plants and animals, except for micro-organisms that are not extracted from nature.

The request for comments asked participants whether these limitations should be altered in light of developments that have occurred since the Patent Law's enactment in 1967, including:

- the possibility of cloning animals (eg, Dolly the sheep);
- the growth in inventions which involve plants and animals as well as inventions made through biological processes, especially in the field of agriculture.

Sections 7(1) and 7(2) of the Patent Law are a residue of a provision in the Patents and Designs Ordinance 1924 – the law in force before the Patents Law – which held that immoral inventions were unpatentable. Therefore, the question indirectly put to participants was to what extent patentability requirements should still consider moral issues.

Biological material samples

The Budapest Treaty, to which Israel is a signatory, provides for the deposition of biological materials for the purpose of meeting the enablement requirement. Accordingly, where a party's invention is a living organism that is difficult to describe in a patent application, the party must deposit it in a recognised depositary. The recognised depositary authority will keep the organism alive and any interested party can request a sample thereof.

However, as the biological material may multiply, a party which obtains a sample of a living organism not only receives the information which it could obtain through examining a regular patent application but also information relating to the factory for its production. Pursuant to the Budapest Treaty, third parties must be able to access living organism samples after an application is granted, but the question remains whether and to what extent such organisms should be exposed to third parties during the period in which the application is pending.

Destruction of infringing products

The Patent Law contains no express provisions which allow the destruction of products that infringe another party's patent. The request for comments asked participants whether such provisions should be added with respect to patents that protect drugs.

Reliance on foreign patent office decisions

The request for comments asked participants to what extent the Patent Office should rely on applications that have been approved in another country. Israel is part of the Patent Prosecution Highway, an array of agreements which enable patent offices in different countries to advance the examination of applications that have already been approved elsewhere. Further, an additional Israeli provision enables the Patent Office to automatically accept patent applications that have been approved in another country. While this provision has enabled the Patent Office to clear a significant application backlog, the request for comments asked participants to what extent it remains necessary.

Other issues

The request for comments also invited participants to opine on:

- overlapping patent applications;
- third-party observation issues; and
- examinations by request.

Outstanding issues

Israel is one of the few countries to still use a pre-grant opposition system. This means that after the Patent Office examines and approves a patent, a period exists before the patent is granted in which other parties may file an opposition thereto. The opposition period may last several years. In most countries the patent is granted immediately following its examination and approval. This is an issue that the proposed amendments could have

addressed for the sake of harmonisation with other countries.

Another outstanding issue is the existence of a provision under which the grant of a patent is automatically halted where another party raises an appeal. The appeal procedure can take a long time and further complicates the system.

The request for comments invited participants to raise any topics that the proposed amendments did not address. Therefore, the Patent Office may still consider these issues.

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