

# **Patent Regulations (Application of the Patent Cooperation treaty), 5756–1996**

(As consolidated 2014)

[Prepared by WIPO]

Pursuant to my authority under section 194(8) of the Patent Law, 5727–1967 (Hereafter – the Law), and with the approval of the Knesset’s Constitution, Law and Justice Committee, I hereby enact the follow regulations:

## **Interpretation**

1. (a) In these regulations –

“The Treaty”, “Regulations under the Treaty”, “International Application”, “International Search Report”, “Preliminary Examination Report”, “International Searching Authority”, “Preliminary Examining International Authority”, and “International Office” – as defined under section 48A of the Law.

“Applicant” – an applicant who submits an international application;

“Priority Right” – as defined under section 10 of the Law.

(b) Any other term not defined under the Law shall derive meaning in accordance with the Patents Regulations (Office Practice, Rules of Procedure, Documents and Fees), 5728-1968 (Hereafter – Patent Regulations), which shall apply to any matter undetermined by these regulations.

## **Submitting an international application to a receiving office**

2. (a) An International Application shall be prepared in the English language and submitted to the Office as the receiving Authority in one of the following ways:

(1) On an A4 sized sheet, in one copy and in the manner provided under the Treaty.

(2) On a device used to store computer material, as directed by the Registrar. In this regard, “computer material” – as defined under the Computer Law, 5755–1995;

(3) Via the internet, as directed by the Registrar according to the Treaty, and after he was satisfied that the form of submission is consistent with information security requirements of the Ministry of Justice. The prescribed form of submission shall be published for public review on the Registrar’s website.

(b) An International Application shall include a petition, a description of the invention, one or more claims, drawings as needed and a summary.

### **Claiming a priority right in an international application**

2A. (a) an Applicant to the Office, acting as a receiving Authority, who claims a priority right on the basis that he had previously made claim to invention, he or whoever preceded him in right of ownership, by submitting an application for a patent in Israel, a member state, or that an International application had been submitted regarding the invention (in this regulation – a previous application), according to the Treaty, then he shall submit to the Authority the priority claim within 16 months from the date the previous application was submitted.

(b) Where a priority right had been claimed on the basis of a previous application, the applicant shall submit a copy of the previous application to the Office or the International Authority, in the following manner:

(1) A certified original copy of the previous application, or an electronic certified copy thereof, shall be attached where an International Application which had been submitted under regulation 2(a)(1).

(2) An electronic copy of the certified copy of the previous application shall be attached where an International Application had been submitted under regulations 2(a)(2) or 2(a)(3).

(c) Notwithstanding subregulation (b), where the previous application had been submitted in Israel, the applicant may request that the Office will transfer to the International Authority a certified copy of the previous application.

### **International Authorities**

3. The Registrar shall publish on the website enumerated in section 166A of the Law (Hereafter – the website) the names of the international Searching Authorities and the Preliminary Examination International Authorities under the Treaty, regarding an international application to the Office acting as a receiving Authority.

### **Form of submitting documents**

4. Any document submitted to the Office, acting as an a receiving Authority, as an International Searching Authority and as a Preliminary examination Authority shall be submitted in the form and manner and on the date prescribed under the Treaty.

5. Repealed.

### **Hearing on an objection to the decision of the Registrar that an international application includes more than one invention**

5A. a body made up of three examiners shall hear an objection to the Registrar's decision that an International Application includes more than one invention, pursuant to section 48L of the Law, and it may include the examiner whose decision is the subject of the objection.

### **Fees**

6. (a) A fee paid to the Office under these regulations shall be pay in New Israeli Shekels by making a deposit to the account of designated Office in the postal bank or through the government payment handling.

(b) The Office may require a certification of fee payment. With regards to a payment of fees to the Office under these regulations, and excluding the fees specified in subregulation (c), (d), (g), (i) and (k), the date of payment specified in the certification of the fee payment shall be considered the date of deposit in the account aforementioned in subregulation (a), provided that the deposit voucher or the aforementioned certification state the matter for which payment was made, and that the certification and fee payment was submitted to the Office within two weeks from the date they were requested.

(c) An applicant submitting an International Application to the Office, acting as a receiving Authority shall pay the International Authority, through the Office, the international filing fee in the rate prescribed by the international Authority, and within a month from the date of filing, pursuant to the Treaty.

(d) The applicant shall pay the international searching Authority of his choosing, through the Office, acting as a receiving Authority the search fees, in the rate prescribed by the searching Authority, and within a month from the date of filing, pursuant to the Treaty.

(e) The applicant shall pay the Office a delivery fee available for use by the Office. The delivery fee shall be paid on the date the international filing fee was paid, as aforementioned in subregulation (c).

(f) An applicant claiming a priority right, pursuant to regulation 2A, who is requesting a certified copy of a previous application consisting of a patent application submitted in Israel, shall pay the prescribed fee.

(g) An applicant who submitted to the Office an application to produce a preliminary examination report shall pay a handling fee, at a rate prescribed by the International Office, and a preliminary examination fee. The fees under this subregulation shall be paid within 22 months from the date of the priority right, or within a month of the date the preliminary examination application was submitted, whichever is later.

(h) An applicant who specified in an international application genetic sequences, and failed to submit them according to the provisions of the Treaty, and was requested to submit them to the Office for the purpose of producing an international Searching Report or a Preliminary Examination Report, shall pay the Office a late delivery fee, on the date prescribed in the request.

(i) Where the applicant is requested to pay an additional fee under section 48J(4) or section 48K(4) of the Law, he shall pay the Office, on the date prescribed in the request.

(j) Where a fee, out of the fees prescribed in subregulations (c) to (e) had not been paid, or not paid in full, the Registrar may request the applicant to pay the difference and he may charge him a late fee at a rate of half of the missing amount, or a rate equivalent to the delivery fee, whichever the highest, provided that the sum of the late fee to be paid is no more than half of the international application fee.

(k) Where a fee, out of the fees prescribed in subregulation (g) had not been paid, or not paid in full, the Registrar may request the applicant to pay the difference and he may charge him a late fee at a rate of half of the missing amount, or a rate equivalent to the handling fee, whichever the highest, provided that the sum of the late fee to be paid is no more than twice the sum of the handling fee.

(l) The fees enumerated under this regulation, which are prescribed or published by the International Office, shall be published on the website.

(m) The fees collected by the Office for the international Office or an International Searching Authority under this regulation shall be transferred to them, in accordance with the obligation of the Office under the Treaty.

(n) the fees for which no rate was prescribed under the Treaty shall be paid in accordance with the prescribed provisions in the second schedule of the Patent Regulations.

### **Conditions for returning an international application filing fee and a search fee**

6A. Where an International Application or an application to produce an international Search Report had been submitted, and the fees aforementioned in regulation 6(c) to (e), the following provisions shall apply:

(1) The International filing fee and the searching fee shall be returned to the applicant if one or more of the following applies:

(a) Regulation 11(1) of the Treaty stipulates the applicant shall not be subject to a international filing date.

(b) The application had been revoked or is considered to be revoked under the Treat's provisions, prior to the delivery of the copy of the registration of the international application to the International Office;

- (c) It is not possible to treat the claim as an international claim due to the fact the authorities prescribed in articles one and two of chapter six of the Law are in effect;
- (2) Without derogating from the provisions of paragraph (1) –
- (a) A search fee shall be returned to the application by the Office, acting as an international searching Authority of the International Application was revoked prior to the search;
- (b) A search fee shall be returned to the applicant by the receiving Authority where the application had been revoked or is considered to be revoked in accordance to the provisions of the Treaty, and prior to the delivery of the copy of the search for the application to the International Searching Authority.
- (c) Half of the search fee shall be returned to the applicant by the Office, acting as an international Searching Authority, if the examiner had used a search report, an international search report or a report in the format of international search report which preceded it, whether if it was conducted by the Office or another International Searching Authority or another International office, as defined under the Treaty.

### **Conditions for returning a preliminary examination fee and handling fees**

6B. where an application for producing a Preliminary Examination Report had been submitted, and the fees aforementioned in regulation 6(g), the following provisions shall apply:

- (1) The preliminary examination fee shall be returned to the applicant by the Office if it is not possible to treat the application for a Preliminary Searching Report due to any of the following reasons:
- (a) The international application of the Application to produce a Preliminary Examination Report has been revoked before the preliminary examination began.
- (b) The applicant was not entitled to submit the application to product a preliminary Examination Report to the Preliminary Search International Authority in Israel under section 48I of the Law;
- (c) The fee was not paid in full, or in part, and the applicant had not paid the missing sum after he had been requested to do so.
- (d) The applicant did not correct the application for producing a Preliminary Examination Report within the time allocated to do so;
- (2) The handling fee shall be returned by the Office if it is not possible to treat the application to produce a Preliminary Examination Report for one of the following reasons:

- (a) The application to produce a Preliminary Examination Report has been revoked before it was transferred to an International Authority from the Office;
- (b) The applicant was not entitled to submit the application to produce a Preliminary Examination Report to the Office under section 48I of the Law;
- (c) The application to produce a Preliminary Examination Report was submitted after the prescribed submission date.

### **Entry to the national stage**

7. (a) An international application designating Israel shall enter the national stage within 3 months from the date of the International application where a priority right is not claimed, or within three months from the date of the first previous application where an international claim is given priority right from a previous application; The date for entering the national stage shall be from the date the application was submitted to the Office or from the date the information which enable the locating of an international application was delivered. However, if the name of the applicant was not specified or the national fee was not paid, pursuant to section 48D of the Law, the date of entry to the national stage shall be the date in which the said requirements were fulfilled. Where an application had entered the national stage, the Office shall provide the application with a certification to that effect.

(b) On the date of entry to the national stage –

(1) The applicant shall fill out and submit the prescribed application form in two copies, including a translation of the name of the invention into Hebrew;

(2) The applicant shall perform the procedures enumerated in section 48D(b) of the Law; An authenticated English translation of the international application, pursuant to section 48D(b)(2), shall be submitted to the Office along alongside two copies of the international application, and two copies of authenticated translations for any submissions, in accordance with the Treaty, of amendments to the application, if the application was not in English. Where the international application was in English, an additional copy thereof shall be submitted to the Office and for any amendment to the application that was submitted, in accordance with the Treaty.

(3) The applicant shall notify the Office of his address for the purpose of delivering notifications in Israel and he shall submit to it an authorization to represent his as proxy, pursuant to regulation 17 of the Patent Regulations, the proxy so permitted.

### **Defects in entry to the national stage**

7A. (a) Where an application entered the national stage and one or more of the enumerated requirements in regulation 7(b) were not fulfilled, the Registrar shall notify the applicant of the defects found.

(b) The applicant may correct the defects for which a notification was given to him within three months from the date of the Registrar's notification as aforesaid in subregulation (a).

(c) The applicant shall attach to his application, at the request of the Registrar and within three months from the date of request, any additional documents specified in the request, including an International Search Report, a Preliminary Examination Report, priority right documents and their translations.

### **An application to renewed recognition in the date of an international application**

7B. (a) Where an international application was submitted to an International Office or a receiving Authority after the date prescribed in the Treaty, and a priority right was claimed from a previous application for an International application, the applicant may submit an application for a renewed recognition in the date of the first previous application (Hereafter – application for renewed recognition), provided that the International Application was submitted within 14 months of the date of the first previous application.

(b) The application for renewed recognition shall be submitted with attached justifications:

(1) to the Office acting as a receiving Authority – within two months from the date in which it is possible to submit an international application to the Office acting as a receiving Authority;

(2) to the Office acting as a national Authority – within a month from the date in which the application can enter the national stage under regulation 7(a).

(c) Where the Registrar is satisfied that the applicant took reasonable measures so that that the International Application enter the national stage in time, he shall approve the application for renewed recognition.

### **Application to extend the date of entry to the national stage**

7C. (a) an application for an extension of the date under section 48D(c) of the Law shall be submitted to the Office with attached justifications.

(b) Where the Registrar is satisfied that the applicant took reasonable measures so that that the application enter the national stage in time, he shall approve the application for extension.

### **Non-compliance with conditions**

7D. Where an applicant fails to correct the defects for which he received notice, as aforesaid in regulation 7A(a), or to attach the documents aforesaid in regulation 7A(c), or fails to submit an application for renewed recognition as aforesaid in regulation 7B or an application for an extension for the date of entry to the national stage as aforesaid in regulation 7C, he shall be deemed as if he did not remove the defects for which he received notice under section 20 and 21 of the Law.

### **Predating an examination of an application**

8. An applicant interested in requesting an examination of an application before the date an International Application enters the national stage, as aforesaid in regulation 7(a), shall submit an application pursuant to regulation 35 of the Patent Regulations after he fulfills the conditions of regulation 7.

### **Translation for the purpose of awarding priority right**

9. A person claiming priority right for an International Application, on the basis of a previous application which is not prepared in the English or Hebrew languages, shall submit an authenticated translation to Hebrew or English, within three months from the day in which he was requested to do so by the Registrar.

### **Restriction on the effect of the Patent Regulations**

10. (a) Regulation 11, 12, 19, 20(b), 21, 23 to 25 and 28 to 31 of the Patent Regulations, shall not apply with regards to an International Application.

(b) Regulation 8 to the Patent Regulations shall not apply with regards to the fee paid under regulation 6 of these regulations.

(c) The following provisions shall apply with regards to an International Application submitted to the Office acting as a receiving Authority, to an application to produce an International Search Report and an application to produce a Preliminary Examination Report:

(1) Notwithstanding the provisions of regulation 16 of the Patent Regulations, it may be possible to notify the Registrar of an address for delivery for the documents of the applicant, or for any person authorized to represent him before the national Office in the matter of the international application and through whom the international application was submitted. In this regard, "address" – including an e-mail address, if the recipient had asked to receive notifications via an e-mail address he provided. A notification delivered in the aforesaid e-mail, shall be deemed as if it was delivered to the recipient on the date and time of delivery as seen in the



internal clock of the IT system which is calibrated in accordance with the standard rules, unless proven otherwise;

(2) Notwithstanding the provisions of regulation 17 of the Patent regulations, power of attorney as aforementioned in the regulation shall be requested in these only:

(a) if the action is performed by a proxy whose information is not specified in the petition under regulation 2(b);

(b) Upon the submission of a notification on the fact of the revocation of an International application;

(c) Upon the submission of a notification of the fact of the revocation of the designation of an International Application to a certain national Office;

(d) Upon the submission of a notification on the fact of the revocation of a priority right claim;

(e) Upon the submission of a notification on the fact of the revocation of an application to produce a Preliminary Examination Report.

8<sup>th</sup> of Sivan, 5756 (May 26<sup>th</sup>, 1996)

David Libai  
Minister of Justice