Jornadas de estudio y actualización en materia de patentes
"Los Lunes de Patentes"

El modelo de utilidad como herramienta para la protección de invenciones también en el extranjero: ventajas y limitaciones

Barcelona, March 13, 2017

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Utility model origins
Henning Grosse Ruse –Khan, WIPO presentation in Kuala Lumpur

• With the German Copyright and Design Law of 1876, the question arose whether technical and/or functional features of products of practical use can be protected as designs.
• 1878, German Imperial Court (ROGH) denied protection on products of practical used. Only patents were available for protecting technical features or technical improvements.
• German Office had to reject many minor inventions when they were protected as patents.
• 1891 Gebrauchsmustergesetz (UM Law) entered into force for protecting this kind of inventions.
Utility model origins
Henning Grosse Ruse –Khan, WIPO presentation in Kuala Lumpur

• “The Utility Model Act got a warm reception from industry. Between 1891 and 1895, 55,173 utility models were registered, of which 51,202 came from Germany. As to patents, between 1877 and 1890, 187,218 patents were applied, 85,340 patents were granted, of which 85,242 came from Germany, 27,098 from abroad. While in the first year of full operation, in 1892, a total of 9,066 utility model applications were made, the figure had climbed to 21,432 in 1900, and 54,580 in 1910.”(Heath, 1998).

• Main features of original DE-UMs
  – Limited to new and innovative working tools for utilitarian purpose having a 3D form.
  – No substantive examination
  – Duration 6 years
  – Relative novelty, publications or domestic use
  – Lower inventive step level
Utility model origins
Henning Grosse Ruse –Khan, WIPO presentation in Kuala Lumpur

• Several modifications on German UM acts

  – Reichgesetz included machines as protectable as utility model.

  – Law revisions on 1986 and 1990 shifted from 3D requirement to utility requirement.

  – Bundesgerichthof 2006 abolished different inventive step level between UM and patents.
Utility model origins

• 1911, during the Washington revision, the right of priority for utility models was included in the Paris Convention.
Utility models throughout the world

• Utility model, a history of success:

1. Germany, 1891
2. Japan, 1905
3. Poland, 1924
4. España, 1929
5. Italy, 1934
6. Portugal, 1940
7. Taiwan, 1944
8. Brazil, 1945
9. Philipines, 1947
10. Korea, 1961
12. Uruguay, 1976
13. Australia, 1976
14. ...  
15. China, 1985
16. ...  
17. ...  
18. Russia, 1992
19. ...
Utility models throughout the world

More than 90 countries!

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World intellectual property indicators 2015

• 2015, 27% increase in UM filings in the world: 1,21 M filings.
• 2015, 7,8% increase in patent filings in the world: 2,9 M filings.
• 29,8 % UM filings increase at SIPO.
• Rarely filed abroad, resident application 99% of the filing share.
World intellectual property indicators 2015

Source: WIPO Statistics Database October 2016
World intellectual property indicators 2015

Source: WIPO Statistics Database October 2016
Historical revision of UM in the EU

• 1995 Green paper on UM of the Commission in the Internal marke.
• 1997 Directive to harmonize national protection systems
• 1999 Modified proposal of the Directive with 33 amendments.
• 2000 Suspension of the work on the Directive. Lack of agreement and Community Patent was given priority.
New actions by the EU Commission on UM\textsc{s}

- 2013: a study was commissioned on the economic impact of utility model legislation in selected EU countries or those not having such a figure.

- April 2015: Study on economic impact of the UM legislation in selected Member States.

- Object: helping the Commission for a potential harmonization and/or unitary protection via UM in the EU.
Study on economic impact of UM

• Countries analysed

  – **NO UM (EU):** Belgium, Netherlands, UK and Sweden

  – **UM (EU):** Germany, Austria, Denmark, Italy, Poland, Chzech Republik, Spain, Finland and France

  – **UM (WO):** Australia, Brazil, China, Japan and Republik of Korea
Study on economic impact... Questions to be answered

i. Main features of the reviewed UM systems.

ii. Problematic features vs. well working features

iii. How much and why are UM used.

iv. Are UM a tool for incremental innovation.

v. What actions are required at EU level with EU.
Main findings on the design of a UM system

1. No studies on UM economic impact.
2. UM systems useful for growing economies, but not for developed countries.
3. No UM system as such. Great differences between UM systems.
Main findings on the design of a UM system

4. UM system is a mixture of 6 parameters:
   - Lower level on novelty.
   - Lower level on inventive step.
   - No substantive examination.
   - Limitation on protectable matter.
   - Shorter duration vs. patents.
   - Legal safeguards prior to starting an infringement action.

5. Different systems are interrelated (patents, designs, UM), thus difficult to show a correlation between UM and economic impact.
Well working vs. Non working features

- **Novelty**: tending to absolute novelty.
- **Inventive step**: complex to have a suitable IS level. UM could be stronger than patents.
- **No substantive examination**: fear of lack of legal certainty if no examination. However, this problem could not be confirmed.
- **Duration limited vs patents**: shorter than patents.
- **Protectable subject-matter**: limitation on the protectable subject matter.
- **Legal safeguards before infringement actions**: prior art searches.
Main findings on usage and impact of UM in innovation

1. Lack of awareness at political level on UMs.
2. Lack of awareness of foreign UM systems, both companies and representatives. National use of UM systems.
3. Lost of advantages of UM over patents.
   - Increasing the IS level makes UM less interesting for “minor inventions”.
   - Similar costs vs. Patents.
Main findings on usage and impact of UM in innovation

4. Main advantages:
   – Speed for granting.
   – “Branch-off” of a pending patent.

5. No direct relation shown between UM systems and incremental innovation.

6. Barriers to widespread use: users feared of lack of legal certainty and UM thickets. However, this could not be confirmed.

7. Demand on UM: less than patents and decreasing.
Main findings on usage and impact of UM in innovation

8. UM systems used by private inventors and local SME.

9. UM system not useful for research sector. Long research before commercialisation and restrictions to protectable matter.

10. UM have a negative impact on economy if economical incentive is given. Low quality UM risk of early disclosure.
Recommendations to the EU Commission

1. No decision on unitary UM system at EU level.
2. Investigate and pursue a harmonisation approach.
3. Correct shortcomings in the patent system rather than via UM.
4. Promote know-how and awareness of UM protection.
5. Review economic incentive on UMs.
6. Involve the EU Commission at international level of UM system discussions.
Suggestions of the report to implement a UM EU system

1. **Novelty**: absolute.
2. **Inventive step**: same as patents or an intermediate level with safeguards such as limitation of the scope of protection to literal embodiments of the claims.
3. **Protectable matter**: same as patents but not methods and without shape limitation.
4. **Duration**: 10 years.
5. **Examination / Search**: no examination but compulsory prior art search non legally binding.
6. **Conversion P→UM**: conversion possible.
7. **Safeguards before abuses**:
   - Fines in case of abuses before the Court.
   - Limitation in claims and length of the application.
Utility models in the EU
Utility model in the EU
Analysed utility models outside the EU
Utility model duration in the EU

France 6 years
Greece 7 years
Utility model duration outside the EU

- 15 years, filing date or 7 from registration
- 10 years, filing date
- 8 years, filing date
UM protection restrictions vs. patents in the EU, LP 11/1986

No methods, no chem. or pharma products
Methods
Same as patents
UM protection restrictions vs. patents in the EU, LP 24/2015

No methods, no chem. or pharma products
No methods or pharma products
No methods
Same as patents
UM protection restrictions vs. patents outside the EU

- No methods, no chem. or pharma products
- Same as patents
Utility model novelty in the EU, LP 11/1986
Utility model novelty in the EU, LP 24/2015

- Absolute novelty
- Partial relative novelty

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Utility model novelty outside the EU
Utility model inventive step in the EU

- Same as patents
- Lower than patents
Utility model inventive step outside the EU
UM prior art search in the EU, LP 11/1986

- Compulsory search
- Optional search
- No search
UM prior art search in the EU, LP 24/2015

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UM prior art search outside the EU

- **Compulsory search**
- **Optional search**
- **No search**
UM substantive examination in the EU

- Compulsory examination
- Optional examination
- No examination

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UM substantive examination outside the EU
UM opposition in the EU

- 6 m after publication
- 3 m after publication
- 2 m after publication
- No opposition
- 6 m after grant

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UM opposition outside the EU

- Opposition after “certification”
- No opposition
UM independent claims in the EU
UM independent claims outside the EU

1 Independent claim

Many independent claims
Requirements before infringement action in the EU LP 11/1986
Requirements before infringement action in the EU LP LP 24/2015

Yes
No
Requirements before infringement action outside the EU
PCT national phase via UM in the EU
PCT national phase via UM outside the EU
Conversion of EP into UM in the EU

- Conversion Art. 77(3) EPC, 90(3) EPC
- Conversion Art. 77(3) EPC, 90(3) EPC, EP ref., withdr. or deemed to be withdr.
- Conversion Art. 77(3) EPC, 90(3) EPC, EP refused, withdr., deemed to be withdr. or revoked
Conversion EP into UM in ES

• Legal basis:
  – Art. 135(1)(b) EPC, Rule 155 EPC
  – Art. 13-15 RD 2424/1986

• Condition: European Patent application
  – has been rejected by the EPO,
  – withdrawn or
  – deemed to be withdrawn.
Conversion EP into UM in ES

Noting of loss of rights pursuant to Rule 112(1) EPC

The European patent application is deemed to be withdrawn under Rule 71(7) EPC.

With the communication under Rule 71(3) EPC dated 23.02.16 the applicant was invited
- to EITHER approve the text intended for grant and verify the bibliographic data by paying and filing respectively (R. 71(5) EPC):
  ☑ the fee for grant, including the fee for publication (paid on __________)
  ☐ the claims fee(s) (paid on __________)
  ☑ translations of the claims in the two other official languages of the EPO (received on __________)

- OR, in case of disapproval, to request reasoned amendments or corrections to the text intended for grant or keep to the latest text submitted by him (R. 71(6) EPC).

The requirement(s) was/were not fulfilled/not fulfilled in due time.
Conversion EP into UM in ES
EPO phase

• First a **communication of loss of rights** by the EPO.
• Conversion request must be filed before the EPO (Art. 135(3) EPC) within **3 months** from
  – Withdrawal.
  – Communication of the EPO application deemed to be withdrawn.
  – Decision of refusal.
• Pay corresponding **fee** at the EPO: 75€
• EPO informs the OEPM accordingly.
Conversion EP into UM in ES

Enclosed please find a request for conversion which was validly filed with the European Patent Office, accompanied by a copy of the files relating to the European patent application/patent.

The request for conversion was filed within three months after the European patent application had been withdrawn or after notification had been made that the application was deemed to be withdrawn, or after a decision had been notified refusing the application or revoking the European patent (R. 156(1) EPC).

The request specifies your country as Contracting State in which application of the procedure for the grant/registration of a national patent/utility model/utility certificate is desired.

Veuillez trouver ci-joint une requête en transformation présentée valablement auprès de l'Office européen des brevets et une copie du dossier de la demande du brevet européen/du brevet européen.

La requête en transformation a été présentée dans un délai de trois mois à compter soit du retrait de la demande de brevet, soit de la signification selon laquelle la demande est réputée retirée ou de la signification de la décision de rejet de la demande ou de révocation du brevet européen (r. 156(1) CBE).

Dans la requête, votre pays a été mentionné comme État contractant dans lequel le requérant entend que soit engagée la procédure de délivrance/inscription d'un brevet/modelle d'utilité/certificat d'utilité national.

A. Kerchols
Brigitte Kerchols
Conversion EP into UM in ES
OEPM phase

• Once the OEPM is informed by the EPO, it informs the applicant about the reception of request for conversion.
• Time limit for UM filing, 2 months from the OEPM communication.
• File a translation of the EP application or the modified text and pay the corresponding filing fee 63,68 €.
• It must be indicated that the application is a conversion!
UM *Branch off*

- Germany, Austria, Czech Republic, Bulgaria, Denmark, Slovakia, Estonia and Hungary.
- Possible to tailor the claims to the infringing product.
- Often EP/Pat application does not need to be abandoned.
- Same filing date as patent application.
- Time limit: normally 10 years.
Conclusions

1. Relevant differences between countries having UM systems.
2. UM normally used as priority filing.
3. Care must be taken prior to drafting an invention to be protected via a UM (duration, patentable matter).
4. UM can be a good tool to save difficult situations before the EPO (Conversion or Branch off).
5. An standard Inventive step approach would be desirable for UMs.
Thanks for your attention!
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