Lunes de Patentes

Los modelos de utilidad de los distintos sistemas de patentes como herramientas para una rápida consolidación de derechos de IP: cuestiones estratégicas y prácticas sobre protección de invenciones económicamente importantes - no solo de "invenciones menores"

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Barcelona, 26/09/2016

Problema

Situación que se presenta cuando, tras solicitar una patente, y en general después de divulgar su objeto, por ejemplo en una feria industrial o por la venta u oferta de una máquina, un producto o implementación pública de un método, aparece en un corto plazo un competidor que ofrece una solución no ya muy similar sino prácticamente igual, susceptible de infracción.

Si bien en muchos sistemas de patente nacionales o regionales se prevé un procedimiento acelerado de trámite, en particular en respuesta a la situación anterior, en la práctica en muy pocos casos se puede conseguir una concesión de la patente en un plazo inferior a dos años, desde la fecha de solicitud, y en general la concesión se obtiene sobre los tres años.

Las actuaciones de advertencia remitiendo al presunto infractor una copia de las reivindicaciones de la patente y dibujos en su caso, junto a evidencias de la fecha de solicitud son en muchos casos ineficaces.

Protección de la propiedad Industrial: Modelos de Utilidad

❑ Modelo de utilidad, definición/concepto

Invenciones con unas menores exigencias de actividad inventiva (“petty patents” o “innovation patents”). En ocasiones utilizadas para innovaciones con un dudoso o muy limitado valor e incapaces de satisfacer los requerimientos de patentabilidad.

Pero nada impide que se cubra mediante esta modalidad una invención fuerte, es decir con actividad inventiva equivalente a la de una patente, y dicha alternativa puede permitir la obtención de un derecho de exclusiva en un corto período de tiempo y eventualmente ser sustituido ulteriormente por una patente.

Introducción

- La configuración legal del Modelo de Utilidad no está sujeta a criterios de armonización internacionales → no existe en todos los países. Además hay diferentes concepciones procedimientos de tramitación.
- Los países en los que actualmente se reconoce el Modelo de Utilidad son los siguientes:

- ✓ Albania
- ✓ Angola
- ✓ Argentina
- ✓ ARIPO
- ✓ Armenia
- ✓ Aruba
- ✓ Australia
- ✓ Austria
- ✓ Azerbaiyán
- ✓ Bielorrusia
- ✓ Bélgica
- ✓ Belice
- ✓ Bolivia
- ✓ Botswana
- ✓ Brasil
- ✓ Bulgaria
- ✓ Chile
- ✓ China +
- ✓ Colombia
- ✓ Costa Rica
- ✓ la República Checa
- ✓ Dinamarca
- ✓ Ecuador
- ✓ Estonia
- ✓ Etiopía
- ✓ Finlandia
- ✓ Francia
- ✓ Georgia
- ✓ Alemania +
- ✓ Ghana
- ✓ Grecia
- ✓ Guatemala
- ✓ Honduras
- ✓ Hungría
- ✓ Indonesia
- ✓ Irlanda
- ✓ Italia
- ✓ Japón+
- ✓ Kazajstán
- ✓ Kenia
- ✓ Corea (del Sur)
- ✓ Kuwait
- ✓ Kirguistán
- ✓ Laos
- ✓ Lesoto
- ✓ Macau
- ✓ Malasia
- ✓ México
- ✓ Moldova
- ✓ Mozambique
- ✓ Países Bajos
- ✓ Nicaragua
- ✓ OAPI
- ✓ Panamá
- ✓ Perú
- ✓ Filipinas
- ✓ Polonia
- ✓ Portugal
- ✓ Rusia
- ✓ Sierra Leona
- ✓ Eslovaquia
- ✓ Eslovenia
- ✓ Sudáfrica
- ✓ España +
- ✓ Taiwán
- ✓ Tayikistán
- ✓ Zona Tánger
- ✓ Tonga
- ✓ Trinidad y Tobago
- ✓ Turquía
- ✓ Uganda
- ✓ Ucrania
- ✓ Emiratos Árabes Unidos
- ✓ Uruguay
- ✓ Uzbekistán
- ✓ Venezuela
- ✓ Vietnam +

Ventajas e inconvenientes de los Modelos de Utilidad sobre las Patentes

❖ **Ventajas:**

✓ Económicos. Particularmente aptos para pequeñas y medianas empresas.

✓ Concesión rápida. Inmediata protección a partir de la publicación o concesión del modelo de utilidad. Posibilidad de advertencia, petición de medidas cautelares o interposición de una demanda contra un posible infractor. De especial interés en el caso de lanzamiento de un producto en simultaneidad o próximo a la fecha de solicitud de una patente y aparición de copias serviles o no. Posible actuación múltiple en el país de origen (China, Vietnam, Taiwán) o en mercados importantes (Alemania).

✓ Posibilidad de cubrir una invención por partes (varios modelos de utilidad) o solamente una parte de la misma

✓ Cubrir pequeños avances tras el plazo de prioridad + divulgación de 1 invención -> menor nivel inventivo

✓ Alternativa a la solicitud de una patente divisional.

❖ **Inconvenientes**

✓ Plazo de protección menor – 10 años en general

✓ Desconocimiento del estado de la técnica → exige hacer una buena búsqueda.

✓ Ausencia de examen sustantivo

✓ Exclusión de ciertas invenciones (procedimientos/métodos) dependiendo del país

✓ Divulgación muy rápida de la invención (antes de los 18 meses clásicos para las patentes).Estado de la técnica para solicitudes de patente posteriores.

El sistema español de Modelos de Utilidad (bajo la Ley 24/2015)

Art. 137: Invenciones que pueden ser Protegidas como Modelo de Utilidad

1.Podrán protegerse como Modelos de Utilidad, de acuerdo con lo dispuesto en este Título, las invenciones **industrialmente aplicables** que, siendo nuevas e implicando actividad inventiva, consisten en dar a un objeto o **producto** una configuración, estructura o **composición** de la que resulte alguna ventaja prácticamente apreciable para su uso o fabricación.

2.No podrán ser protegidas como Modelo de Utilidad además de las **materias e invenciones excluidas de patentabilidad** en aplicación de los artículos 4 y 5 de esta Ley, las invenciones de procedimiento, las que recaigan sobre **materia biológica y las substancias y composiciones farmacéuticas**

Art. 139: Estado de la técnica

1.El estado de la técnica con referencia al cual debe juzgarse la novedad y la actividad inventiva de las invenciones protegibles como Modelos de Utilidad, será **el mismo que el establecido en el artículo 6.2 para las patentes de invención.**

El sistema español de Modelos de Utilidad (bajo la Ley 24/2015)

Art. 140: Actividad inventiva / Art.146

❖**Se mantiene el menor nivel de actividad inventiva**

▪Para su protección como Modelo de Utilidad, se considera que una invención implica una actividad inventiva si no resulta del estado de la técnica de una manera **muy evidente** para un experto en la materia – Favorece la defensa de actividad inventiva frente a acciones de nulidad.

❖**Se mantiene referencia a Art. 139.2 (6.3) / Art. 145.2 Ley 12/1986**

▪Las solicitudes presentadas antes pero publicadas después de la fecha de solicitud no pertenecen al estado de la técnica para evaluar la actividad inventiva.

Art. 144: Oposiciones a la solicitud / Art.149 1-3

❖**Plazo de dos meses desde fecha publicación**

❖**Motivos: además de requisitos legales para concesión:**

▪Falta de novedad, actividad inventiva, aplicación industrial o suficiencia descripción.

▪No se incluye falta de legitimación → Tribunales ordinarios.

❖**Modificación relevante**

▪Prórroga de dos meses adicionales para presentar pruebas o completar alegaciones.

El sistema español de Modelos de Utilidad (bajo la Ley 24/2015)

Art. 148: Contenido del derecho y ejercicio de acciones / Art.152

▪**Para el ejercicio de acciones encaminadas a dar efectividad a los derechos de exclusiva derivados de un MU** solicitando con posteridad a la entrada en vigor de la presente Ley será preciso que se haya obtenido o solicitado previamente, abonando la tasa correspondiente, el **IET** previsto en el Art.36.1 para las patentes, referido al objeto de título en el que se funde la acción. Así el IET en los Modelos de Utilidad no se realiza durante su procedimiento de concesión, sino en el marco del ejercicio de las acciones que dan efectividad a los derechos de exclusiva del Modelo de Utilidad.

El informe IET, una vez elaborado, será notificado al peticionario y puesto a disposición del público unido al expediente del modelo.

▪En el supuesto de que se presente una demanda antes de aportar dicho informe el demandado podrá pedir la **suspensión del plazo para contestarla** hasta que se aporte dicho informe a los autos.

Una vez solicitado el IET, y aunque éste no se hubiera aportado todavía, podrá instarse, de conformidad con lo previsto en la Ley y en la Ley de Enjuiciamiento Civil, la adopción de **medidas provisionales y cautelares,** siempre que éstas no consistan en la paralización o cesación de la actividad industrial o comercial del demandado en relación con el objeto protegido.

Modelos de Utilidad en Europa

Modelos de Utilidad – Europa

❖Países sin Modelo de Utilidad: **BE, CH, LU, NL, NO, UK, SE**

❖Países con Modelo de Utilidad:

- **ES** – nueva Ley de patentes
- Países con menor nivel de actividad inventiva, pero limitados a aparatos, invenciones tridimensionales: **FI, IT, PT**
- Países con el mismo nivel de actividad inventiva, y restricciones mínimas área técnica: **AT, DE, FR.**
- Países con menor nivel actividad inventiva, en todos los campos técnica: **DK, GR, IE.**
- Otros países**: HU, PL, SL, SK**

Modelos de Utilidad en Europa

- Presentaciones Modelo Utilidad en diversos países europeos 2013-2014 (WIPO) -

Año 2013

- **DE: 15.470**
- **IT: 2.678**
- **ES: 2.648**
- CZ: 1.731
- AT: 763
- FI: 480
- FR: 480
- DK: 200
- GR: 27

Año 2014

- **DE: 14.741**
- **ES: 2.712**
- **IT: 2.497**
- CZ: 1.493
- AT: 748
- FI: 450
- FR: 424
- DK: 185
- GR: 33

A European Utility Model

In 2013 the European Commission – DG Internal Market and Services undertook a study on the economic impact of Utility Model (UM) legislation in selected EU Member States. The study analysed nine European countries with a UM system in place, as well as four countries without a UM system and five countries outside the EU with a UM system

In the final report published on April 2015 it was found that UM systems in Europe have lost much of their supposed ability to protect ‘minor inventions by small inventors’.

Rather, the UM has **turned into an auxiliary tool** of savvy IP professionals, who use it in specific national contexts to **overcome shortcomings of the patent system**.Overall awareness of UMs outside this group of IP professionals was low.

A European Utility Model

Final report April 2015

The main commonly agreed upon reason to take out UMs is speed, which makes the UM particularly attractive for industries with short product life cycles and for enforcing pending patents via branched off utility models (in countries where such an option is available).

The main barriers and risks associated with UMs are lack of legal certainty, potential abuse of the system and unclear (net) costs. While it was not possible to conclusively gauge the impact of UMs on innovation, considerable insights were found on impact mechanisms, the success factors and the risks of introducing a UM system at European level (first project from 2004) – a topic on which the interview partners in Europe were considerably divided.

The German System

Current System of UM Protection

❖The German UM system is primarily a **registration system** without substantive examination;

❖The applicant can choose to apply for a **search report** by the Patent Office which lists all relevant published documents for judging the application against the state of the art in the relevant field of technology;

❖In practice, the **patent office examines whether the application covers unprotectable subject matter** and rejects an application if it does;

❖**Act of registration** has effect of granting the exclusive UMRs;

❖**Rights granted** include the right to exclude others from making, using, offering for sale, selling or importing/possessing for such purposes the protected UM or goods containing UM;

❖**Exceptions and limitations** exclude from utility model protection:

•**Acts and private nature**, not taken for a commercial purpose;

•**Experimental uses** in relation to the protected UM;

•Certain acts performed by a **prior user** of the UM in good faith;

•The use of the protected subject matter if so ordered by the state (**government use**);

•**Compulsory licenses** are available in case of public interest;

The German System

Current System of Utility Model Protection

Remedies against UM infringements

❖Infringer must **cease infringing activity**: In this regard, **injunctive relief** is the main procedural remedy;

❖Negligent or purposeful infringement leads to **damage claims;**

❖Other Remedies include **destruction of infringing goods and equipment** used in the production of these goods;

❖Comprehensive obligations to **disclose information** about the origin and chain of production of infringing goods, as well as, further documents;

❖Wilful utility model infringements on a commercial scale are a **criminal offense** and subject to criminal proceedings;

Jurisprudence related to a Utility Model

According to the jurisprudence of the German Federal Supreme Court “method”, however, has been interpreted in a very narrow sense and has been limited to manufacturing methods and working methods. For example, the German Federal Supreme Court decided that a claim directed to a signal sequence for a computer program does not constitute a method claim (Federal Supreme Court decision – Signal sequence ([Signalfolge], GRUR 2004, 495). Applying a substance as part of a new medical indication was likewise considered not to be a method and, in particular, a claim in this regard was ruled not to be a use claim (FSC decision – Pharmaceutical product utility model [Arneimittelgebrauchsmuster], GRUR 2006, 135).

The Court also decided that so-called “means plus function” claims do not define a method (BGH X ZB 23/07 Telekommunikationsanordnung [Telecommunications system]). Claims worded such as these can therefore define devices by means of their functions.

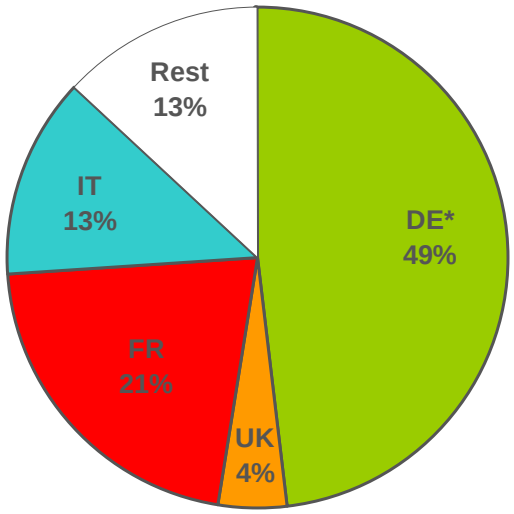
Utility Model Litigation in Germany

Germany hosts more patent litigation cases than all other EU (and EPC) member countries combined.

Leading European Courts:

- **Düsseldorf (DE)**
- **Paris (FR)**
- **Mannheim (DE)**

Patent Litigation in Europe

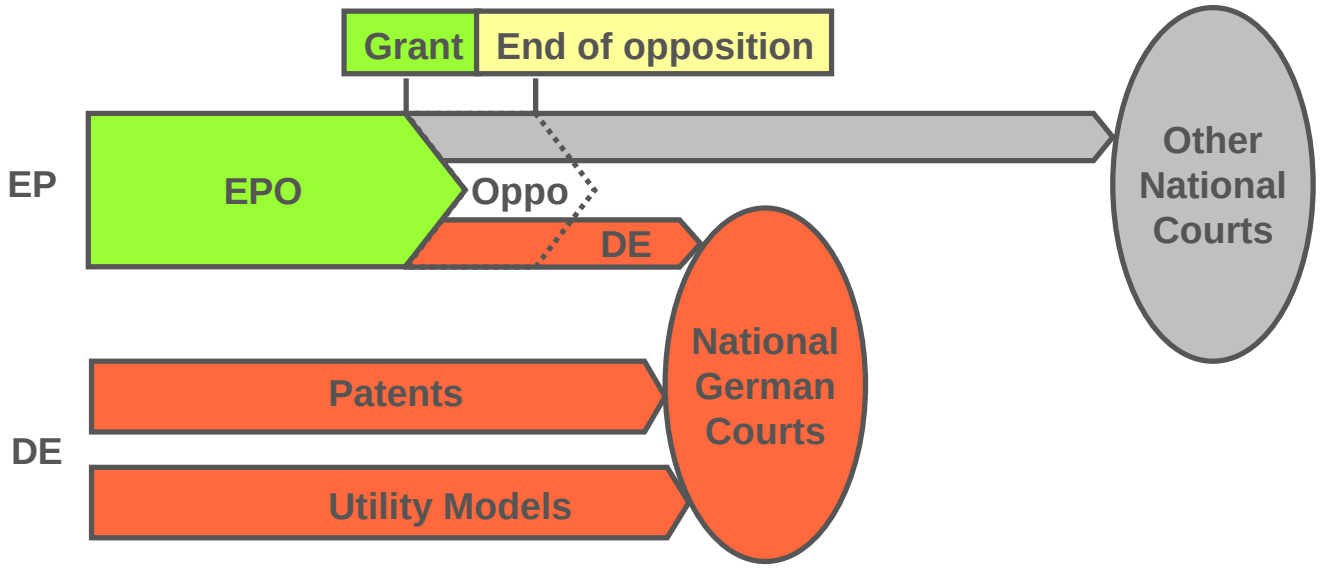


Source: D. Harhoff „*Economic Cost-Benefit Analysis of a Unified and Integrated Patent Litigation System in Europe*“, LM University Munich, MARKT/2008/06/D

***DE: without nullity actions**

Utility Model Litigation in Germany

Coexistence of the systems



Costs

Infringement Action - First Instance (District Court)

Value in Dispute	Attorney at Law and Patent Attorney	Court Fees	Reimbursement for Winning Party	Total Cost Risk
75.000	6.000,00	1.968,00	6.000,00	13.968,00
125.000	7.155,00	2.868,00	7.155,00	17.178,00
250.000	10.260,00	5.268,00	10.260,00	25.788,00
500.000	14.980,00	8.868,00	14.980,00	38.828,00
750.000	18.730,00	11.118,00	18.730,00	48.578,00
1.000.000	22.480,00	13.368,00	22.480,00	58.328,00
2.500.000	44.980,00	26.868,00	44.980,00	116.828,00
Utility Model First Instance annulation Action				
1.000.000	8.992,00	300,00	8.992,00	18.284,00

A case study: from Grünecker - Jens Koch and Dr. Ulrich Blumenröder

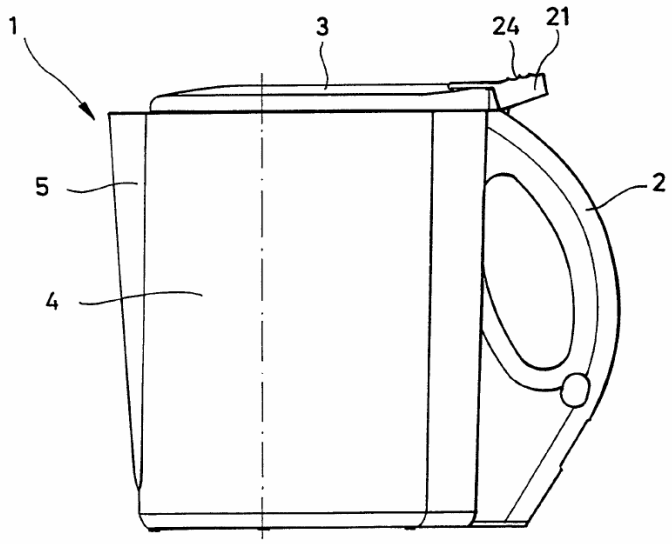
- Patent (WO,EP or DE) application is pending and not yet granted but valid for Germany.
- Search result and/or office action is positive.
- Infringing embodiment appears on market.

Problem:

- Patent application cannot yet be enforced.
- DE/EP procedure towards grant may take long time.
- Competitor might gain substantial market share.

The Situation => The Invention

The Good



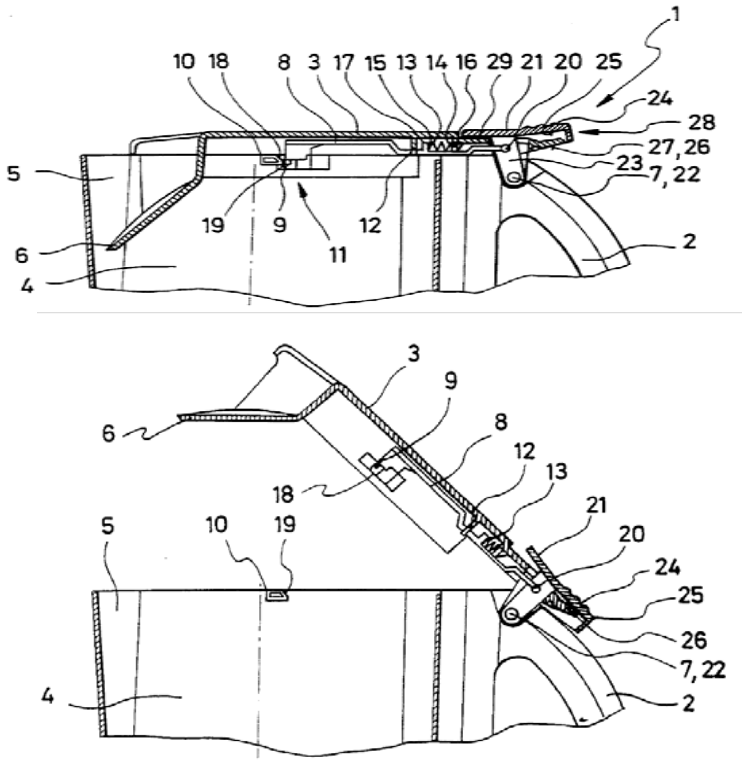
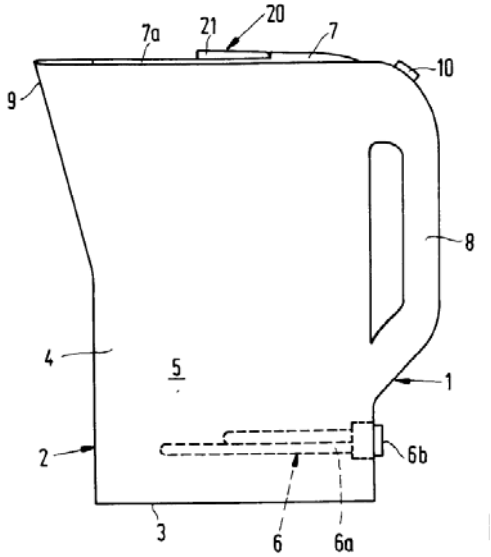


FIG. 4

The Situation => Prior Art



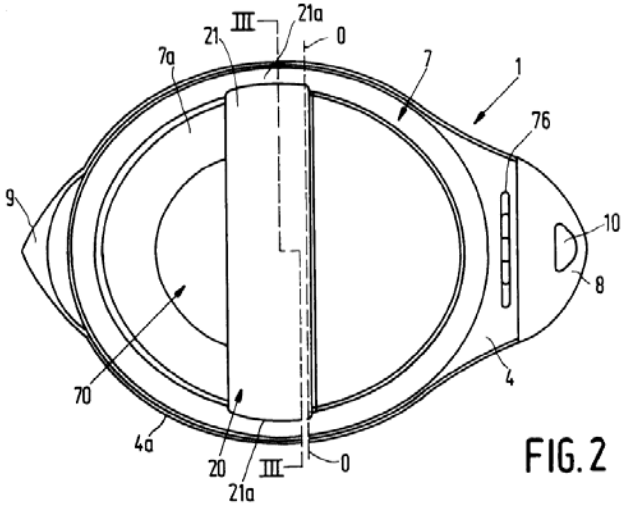


FIG. 2

The Situation => The Patent Application

The Good

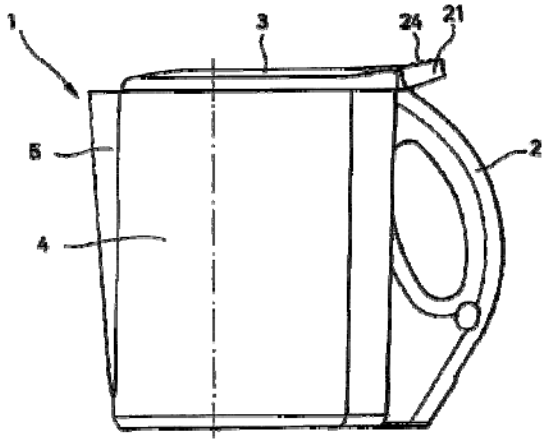
Claim 1:
Electric kettle comprising

a **pot (1)**,

a **handle (2)** similar to a beer mug,

a **lid (3)** pivotable about a **pivot axis (7)** between a closed and an open position,

a **locking device (8)** to lock the lid in its closed position and further comprising

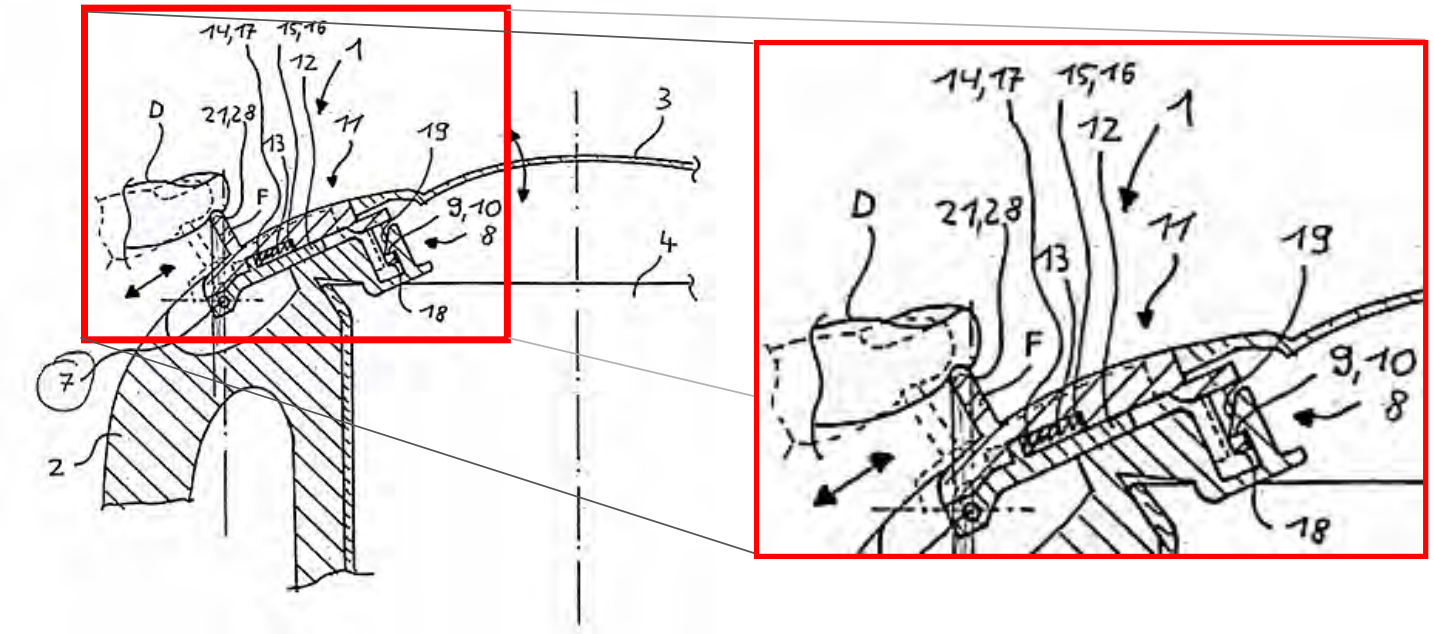


an **operating means (21)** for moving the locking device between a locked position, in which the lid is locked, and an unlocked position in which the lid is movable from its closed to its open position,

characterized in that

> **the operating means (21)** is located at a position close to the pivot axis and close to the handle such that it can be operated by the thump of a hand of a person holding the handle (2).

The Situation => Infringing Embodiment



Applicant's Problem

- Bad infringer appeared on the market.
- Patent Application cannot yet be enforced.
- EP procedure towards grant may still take long time.
- Bad infringer might gain substantial market share.
- A fast remedy to stop infringer is needed.

Assessment of Infringer

Upon study of patent application:

- Infringement of claims as on file is expected.
- Very similar technology compared with patent application.
- It is only an application, no injunctive relief available.
- Application may not proceed to grant at all.
- Procedure to grant will take time.
- Infringer considers to attack Patent in case of grant.

Applicant's Options

Possible actions of the applicant to improve his situation:

- File request for accelerated examination.
- Waiting for grant of Patent.
- Branching off Utility Model.

Applicant's Considerations

The Good

- Approaching the infringer in a soft manner by requesting reasons why he is ignoring his Utility Model (Low risk of cost).
- Approaching the infringer in a firm manner by requesting to cease and desist from infringing and demanding compensation as well as information on his customers etc.
- Filing law suit in case of no satisfactory response.
- Filing law suit against infringer right away without prior contact.
- Trying to obtain preliminary injunction.

= > Utility Model owner opts for warning letter in this case with request for undertaking.

Assessment of Infringer

The Bad

Upon receipt of warning letter further considerations are made:

- Utility Model is believed to be invalid.
- No injunctive relief to be feared on basis of claims of Utility Model.

= > Request for Undertaking is rejected.

Applicant's Decision

The Good

Filing of Infringement Suit

General Considerations:

- Watch your back.
- Forum Shopping.
- Selection of Defendants.

Applicant's Considerations

The Good

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Applicant's Decision

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General Considerations:

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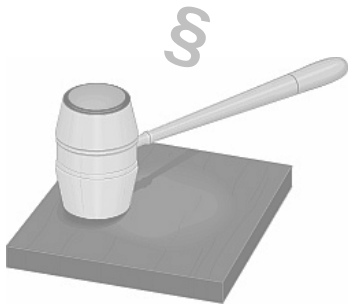
Contents / Service of Suit

Infringement Suit comprises:

- Requests against Infringer

Injunctive relief	Destruction
Accounting	Recall
Damages	Reimbursement of Costs

- Detailed assessment of infringement situation.
- Detailed assessment of validity of the enforced claim based on search result and/or office action of corresponding Patent application.
- Suit is to be filed with specialized civil court.



=> The Court receives Infringement Suit and serves on defendants.

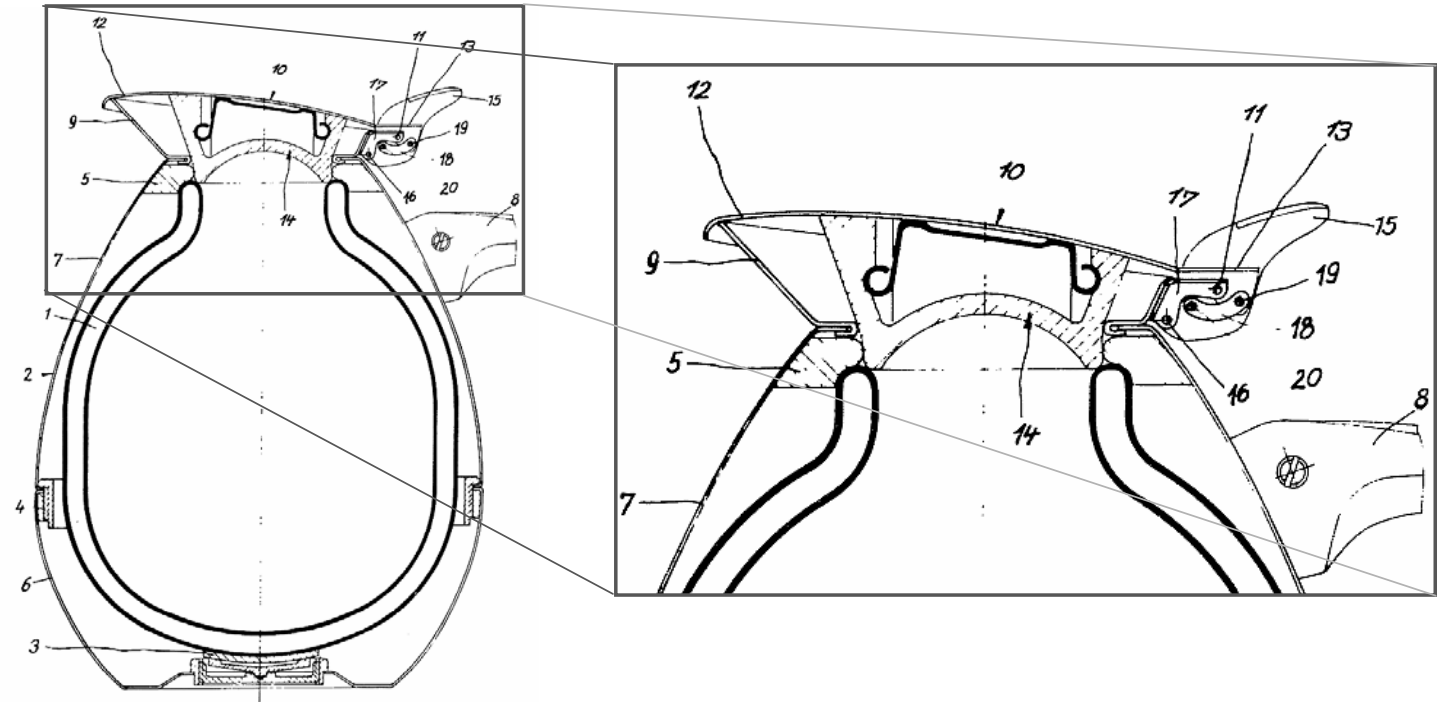
Considerations of Infringer

- Infringer receives Suit.
- Evaluation of Infringement Allegation.
- Evaluation of Validity Allegation:
  - Conducting search for Prior Art.

    Upon finding relevant Prior Art:
    - Infringer can file annulation Action against Utility Model with German Patent and Trademark Office.
    - Infringer can file motion with infringement court to stay infringement proceeding.

Infringer's Prior Art

The Bad



Reaction of Infringer in Court

The Bad

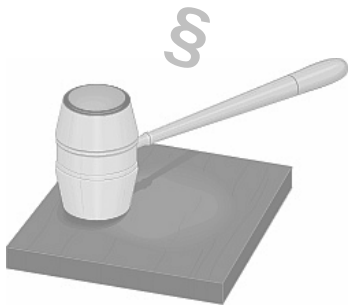
- Filing of Nullity action against Utility Model with the German Patent and Trademark Office.

Response to Infringement Suit arguing:

- No Infringement.
- Utility Model is invalid, thus Infringement Suit should be stayed.

Court's Reaction

Court stays proceedings in reaction to new Prior Art and waits for decision of German Patent and Trademark Office.



Reaction of Applicant

The Good

In annulation action: Utility Model owner defends Utility Model.

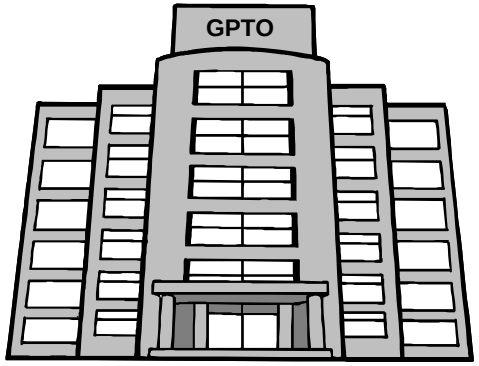
New claim 1 with new features from dependent claims and description.

Electric kettle comprising
a **pot (1)**,
a **handle (2)** similar to a beer mug,
a **lid (3)** pivotable about a **pivot axis (7)** between …,
a **locking device (8)** to lock the lid …
an **operating means (21)** for …,
characterized in that
the operating means (21) is located at ….,

and in that the **locking device** comprises a **spring loaded locking claw (18)** slidably held in the lid (3) for engagement with the pot for locking the lid (3).

Reaction of Patent Office

Utility Model is maintained in restricted form in the first instance.



Reaction of Applicant

The Good

Patent applicant / Utility Model owner

- Submits new claim 1 with court and restricts Infringement Suit to new claim.

- Submits the new Prior Art to the proceedings of the corresponding Patent application in order to obtain granted Patent over new Prior Art.

- Asks the court to resume the Infringement Suit.

Reaction of Infringer

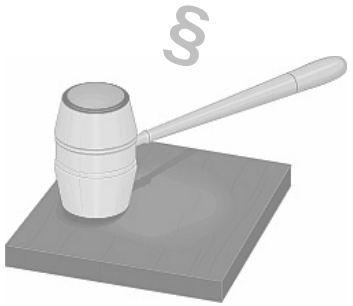
The Bad

Infringer

- Appeals decision of Patent Office to the Federal Patent Court.
- Submits appeal to infringement court asking for continuation of stay.

Reaction of Court

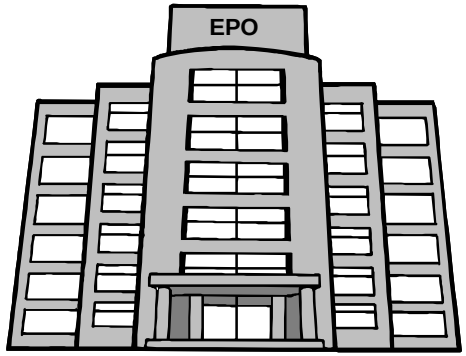
Court resumes law suit.



European Patent Office

TJA PATENTS

The EPO suddenly grants a European Patent based on new claim.



Reaction of Applicant

The Good

Introducing the European Patent with a new motion into the infringement proceeding.

Reaction of Infringer

The Bad

Infringer (concerned):

- Filing of Opposition with EPO.

- Submitting opposition to infringement court asking to continue stay in light of opposition.

Reaction of Applicant

The Good

Applicant (happy):

- Files Motion for Preliminary Injunction.

- Argues that
  - Infringement is clear.
  - Validity is clear.
  - Situation has altered in light of decision by EPO allowing decision as preliminary injunction proceeding.

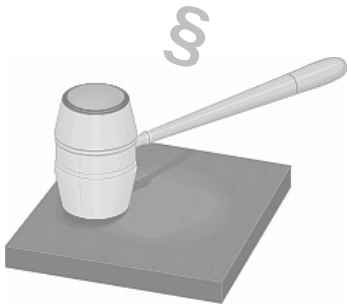
Court

Dismisses motion for preliminary injunction.

→ Motion should have been filed upon decision of German Patent Office.

Resumes infringement proceedings and:

- Dismisses Motion to stay proceeding.
- Finds for Infringement of Utility Model and European Patent.



Problem of Infringer

The Bad

Appeal can be filed.

But: Execution of First Instance decision is possible.

Costs

For Infringement Suit and annulation Action each

- Costs are determined based on so called value in dispute.
- Loosing party has to reimburse winning party for costs of Infringement Suit and annulation Action respectively.

Timeline

Time Effort

- Duration of Infringement Suit about 1,5 years until first instance decision and varies from court to court.
- Duration of annulation Action about 1 year for first instance decision.

Summary

- **Branching-off a Utility Model** allows enforcement a claim while keeping the corresponding Patent pending and leaving the competition uncertain.
- For a German Patent application the request for examination can be deferred up to 7 years while the claim can be enforced with a branched-off Utility Model.
- A Utility Model is registered very soon and allows speedy enforcement of a claim; **time efficient.**
- The case law regarding amendments to claims of Utility Models is very much in favor of the Utility Model owner.
- It is possible to branch-off several Utility Models of one Patent application and tailor each Utility Model to a specific infringing embodiment.
- A narrow claim directed to a specific infringing embodiment is hard to invalidate; Utility Models are **cost efficient.**
- They cover the German market and thereby largest marked in Europe.

Japan Utility Model Patent

1) The Utility Model application issues wihout substantive examination
2) The application issues in 6-8 months
3) There is no diference between Patent and Utiliy Model registration
4) They cover machines, devices (shape, construction or combination of articles), products and articles
5) A utility model Technological Assesment shall be prepared by a Patent Office Examiner (technological evaluation: novelty and inventive step). After this the owner cannot file a patent application based on the utility model registration.
6) The owner of a utility model can enforce the right only after issuing a warning by presenting the Technological Assesment.

Chinese Utility Model Patent

- A Chinese utility model is granted very fast (usually within 6-8 months from filing date), so earlier protection is guaranteed with the patent certificate.

- A Chinese utility model is not substantially examined, so no search or examination for inventive step will be taken.

- No method or function claim is allowed in Chinese utility model application.

Article 2 utility models mean new technical solutions proposed for the shape and structure of a product, or the combination thereof, which are fit for practical use. (Patent Law.)

- Only preliminary examination is conducted. A search for prior art may be taken in some rare cases.

Article 40.- If no reason for rejection is discerned after preliminary examination of a utility model or design patent application, the patent administration department under the State Council shall make a decision on granting of the utility model or design patent right, issue a corresponding patent certificate, and meanwhile register and announce the same. The utility model patent right and the design patent right shall become effective as of the date of announcement. (Patent Law.)

Chinese Utility Model Patent

Possibility to file both invention patent and utility model in China

- Is possible to file both in china on the same day claiming foreign priorities under Paris Convention. But you can keep only one if both are granted.

Article 9.- Only one patent can be granted for the same invention. However, where the same applicant applies for a utility model patent and an invention patent with regard to the same invention on the same day, if the utility model patent acquired earlier is not terminated yet and the applicant declares his waiver of the same, the invention patent may be granted. (Patent Law.)

File both invention patent and utility model in China from a PCT application

- No either invention patent or utility model could be filed in China from a PCT entry.
- It is only possible to file both from a direct application instead of a PCT entry.

Chinese Utility Model Patent

Duration for a Chinese utility model patent:

- 10 years

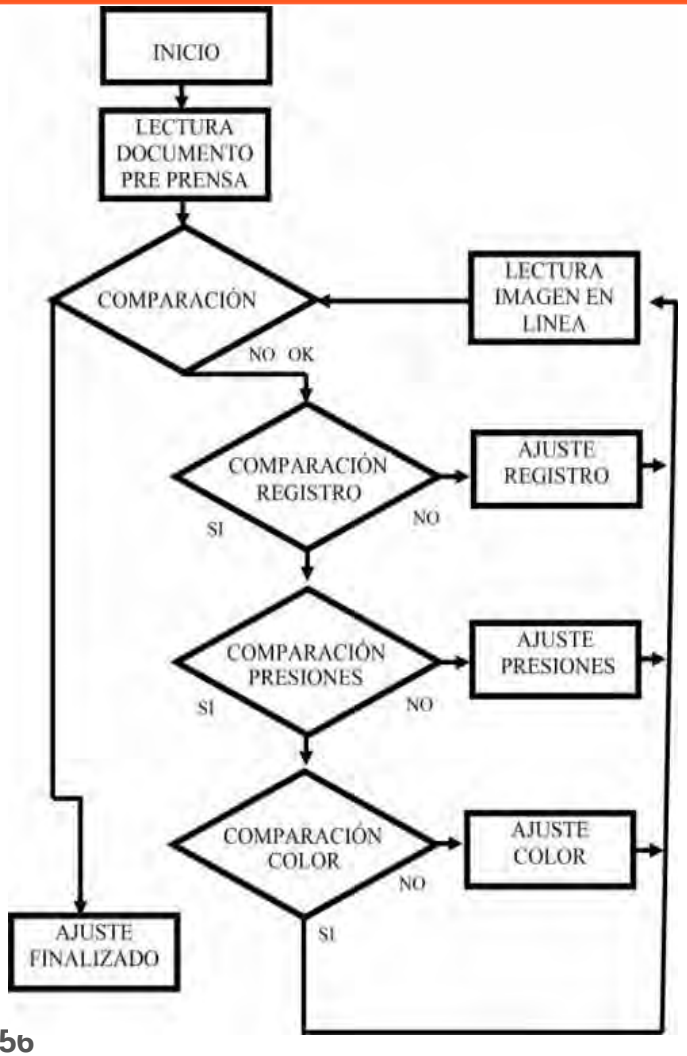
Article 42.- the duration of the invention patent right shall be 20 years and that of the utility model patent right and of the design patent right shall be ten years respectively, all commencing form the date of application. (Patent Law.)

We can start proceeding before a Court on the basis of an utility model to enforce it. However, the Patent Assessment Report is required. It would be issued by SIPO while you apply for it

- A patent right assessment report is needed when filing complaints about Patent infringement at the court or local Patent office.

Article 61.- If a dispute over patent infringement involves an utility model patent or a design patent, the people's court or the administration department for patent-related work may require the patentee or the interested parties to present a patent right assessment report prepared by the patent administration department under the State Council through searching, analyzing, and assessing the relevant utility model or design, which shall serve as evidence for trying or handling the patent infringement dispute. (Patent Law.)

Case study 1: from TJA



- First filing: Spanish Patent nº ES 2395182. Filing date: 12/08/2011
- German Utility Model nº 202011109630.4. Grant date: 27/02/2012
- PCT application nº WO 2013/024185. Filing date: 09/08/2012
- Mexican Patent nº Mx/a/2014/001478. Grant date: 21/10/2015

Case study 2: from TJA

- First filing: PCT application nº WO 2009/030783. Filing date: 07/09/2007
- European Patent nº EP 2193731 B1. Grant date: 10/09/2010
- Japanese Patent nº JP 4796661. Grant date: 05/08/2011
- Chinese Patent nº CN 101652090. Grant date: 24/07/2013
- US Patent nº US 8,558,149. Grant date: 15/10/2013

Case study 3: from TJA

- First filing: Spanish Utility Model nº ES 1074566. Filing date: 11/04/2011
- PCT application nº WO 2012/140289. Filing date: 11/04/2012
- Japanese Utility Model nº 2014-600006. Grant date: 19/03/2014
- European Patent nº EP 2698084 B1. Grant date: 22/07/2014
- Chinese Utility Model nº CN 203468274. Grant date: 11/04/2012
- US Patent nº US 9,451,844. Grant date: 27/09/2016

Case study 4: from TJA

- First filing: Spanish Utility Model nº ES 2292357. Filing date: 31/08/2006
- German Utility Model nº 202007010049.3. Grant date: 20/09/2007
- PCT application nº WO 2008/025861. Filing date: 20/02/2007
- Japanese Patent nº 5065392. Grant date: 17/08/2012
- Chinese Utility Model nº CN 101534683. Grant date: 29/06/2011
- European Patent nº EP 2057922 B1. Grant date: 26/02/2014

Strategies I

❑ Simultaneous filing

- There is the obvious advantage that as registration of the utility model there is full protection. The proprietor cannot only seek injunctive relief but demand damages – and this is even if the proprietor is unaware of the infringement.
- A utility model is published right away. Diligent third parties find it and do not infringe. Even after publication a patent application does not deter possible infringers as much as a utility model (which gives rise to immediate injunctive relief and damages).
- In case an infringer gets on the market, no drafting, filing, waiting for registration is needed (although we manage to obtain registration in about 6 weeks, sometimes 2 weeks).

❑ Filing under priority

- Same as simultaneous filing but results achieved at a later date.

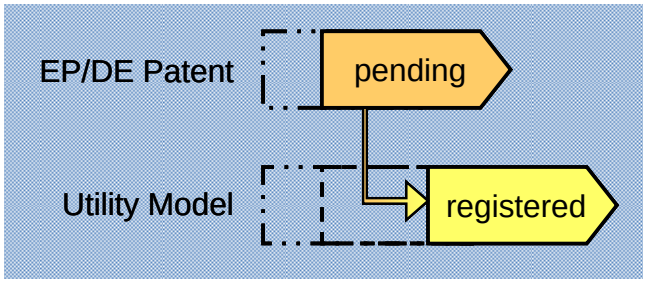
❑ Branching off

✓ In case of branching off the proprietor will only obtain damages once he or she has taken note of the infringement and of course branched off.

✓ In case of branching off you can tailor the utility model (within the disclosure of the publication) to cover the infringement. Thus, it will look nice in court.

Strategies II

- Utility model can be branched off a pending Patent application WO, EP or DE which is valid for Germany.
- Time limit: Two month after the end of the month in which the corresponding Patent application was still pending with the office.
- Maximum lifetime: 10 years from filing of corresponding Patent application.
- No examination, however, a search is possible.
- No method claims.
- Provides the same rights as a Patent.
- Registered within three month.
- Very favorable case law regarding amendments and restricted enforcement of Utility Model.
- It is possible to branch of several Utility Models each with a specific scope of protection.



Strategies III

There are some disadvantages.

a)Of course costs are an issue (although not too significant).

b)Early publication of the invention might be disadvantages in case of ongoing development.

c)More a psychological problem: In case of branching off you can tailor the utility model (within the disclosure of the publication) to cover the infringement. Thus, it will look nice in court.

You cannot do that with a utility model already registered.

The problem is only a psychological one (and not a real one) since you can tailor the motion in the infringement court as needed for the infringing variant. In this case you can file a suit with a motion which combines for instance claims 1, 3 and 7 and two further features from the specification (of course if being disclosed in combination!). The precedent is “Momentanpol”.

Gracias

Barcelona 26/09/2016