

QUESTION 83

Legal and economic significance of protection by utility models

Yearbook 1985/III, page 314

Q83

Executive Committee of Rio de Janeiro, May 13 - 18, 1985

Question 83

Legal and Economic Significance of Protection by Utility Models

Resolution

AIPPI, having taken note of the Working Committee's report,

I. Looks favourably on the examination of the question of setting up a utility model system for the following reasons:

1. Utility models can encourage inventors to protect technical developments with a lesser inventive step than that necessary for a patent and to obtain protection both at a lower cost and more quickly.

Consequently, they are of particular interest to small and middle-sized industries and can promote technical development in developing countries.

2. Utility models can fill a gap in the protection for inventions which occurs when the requirements relating to inventive step for patents mean that certain inventions which do not comply with those requirements cannot be protected. Moreover, this form of protection prevents the patent system from being devalued by being applied to minor technical inventions.

And it prevents other types of Intellectual Property, such as designs and copyright, from being distorted away from their main objectives, in order to protect articles which are really technical (not artistic).

3. And when a utility model is applied for at the same time as a patent, it may, if national law so permits, give the inventor protection during the prosecution time of the patent application when the latter gives no effective protection. This has a particular advantage when the patent application has been published so that the invention has been revealed to competitors.

II. AIPPI appreciates the difficulties involved in relation to setting up a new system of protection by utility models, and that any utility model system which is set up must benefit society as a whole.

III. And decides to continue its study on the basis of the reports of the National Groups, the Summary Report and its discussions during its meeting.

* * * * *

Question 83

Legal and Economic Significance of Protection by Utility Models

Resolution

Yearbook 1986/VII, pages 201 - 203
33th Congress of London, June 8 - 14, 1986

Q83

A. AIPPI favours establishing a utility model system for the following reasons:

1. Utility models can encourage inventors and investors to invest in and protect technical developments which do not fulfil the requirements for patentability and to obtain protection both at a lower cost and more quickly.

Consequently, utility models are of particular interest to small and medium-sized industries and can promote technical development in developing countries.

2. Utility models can fill a gap in the protection for inventions which occurs when the requirements relating to inventive step for patents mean that certain inventions which do not comply with those requirements cannot be protected. Moreover, this form of protection prevents the patent system from being devalued by being applied to minor technical inventions.

It also prevents other types of intellectual property, such as designs and copyright, from being distorted away from their main objectives, in order to protect articles which are really technical (not artistic).

3. When a utility model is applied for at the same time as a patent, it may, if national law so permits, give the inventor protection during the prosecution time of the patent

application when the latter gives no effective protection. This has a particular advantage when the patent application has been published so that the invention has been revealed to competitors.

B. AIPPI appreciates that any utility model system which is established must benefit society as a whole.

AIPPI therefore declares itself in favour of introducing utility model systems under the following terms and conditions:

1. Subject Matter to be Protected

Utility models should protect at least three dimensional articles but, although it should be left to the national laws to include other subject matter, there can be good reasons to extend the protection to all patentable subject matter specifically where a substantive examination is carried out.

Such protection should not, however, protect more than it is possible to protect by means of a patent.

Subject matter covered by utility models shall not be precluded from patent protection.

2. Prerequisites for a Valid Utility Model

a. Novelty.

b. Furthermore an additional requirement, chosen by national law, which preferably should be: the result of a creative effort ("schoepferischer Schritt", "apport créatif") in the sense of going beyond the state of the art but being less than the inventive step necessary for the subject of a patent.

c. Written description and one or more claims.

3. Grace period

The same international grace period as for patents, calculated back from the priority date.

4. Disclosure

The disclosure of the subject matter of the utility model should be as complete in describing the embodiments as for patents.

5. Examination

There must at least be an examination as to formal requirements, i.e. compliance with formal regulations and with the definition of subject matter.

The utility model need not be the subject of substantive examination before grant or registration.

But after grant or registration, there should at least be the possibility of obtaining a search report from an official agency at the request of either a third party or the proprietor.

In infringement proceedings the proprietor must always produce such a report.

If there is substantive examination it shall be carried out so as not to detract from the objects set out in paragraph A above.

6. Cancellation

Provision for complete or partial cancellation procedure at the request of third parties.

7. Duration

Not less than 5 years from the national filing date and, if not exposed to substantive examination, not more than 10 years from the national filing date.

8. Scope of Protection

The scope of protection shall be as determined by national law but shall not exceed the following:

The extent of the protection shall be determined by the terms of the claim(s). Nevertheless, the description and drawings serve to interpret the claim(s).

9. Effect and Remedies

Same as for patents, as determined by national law. However, no remedy shall be available before publication.

10. Multiple Protection for the same Subject Matter

Patent and utility models may be allowed to supplement each other provided, however, that an infringer is not in a worse situation as a consequence of overlapping protection, and provided that patents and utility models filed on the same day do not invalidate each other.

11. Co-existence of Utility Models and Designs

Utility Models and Designs can co-exist in relation to the same article.

* * * * *