

PROMOTING THE USE OF THE UTILITY MODEL SYSTEM AND INDUSTRIAL DESIGN SYSTEM, FOR INNOVATION AND TECHNOLOGICAL DEVELOPMENT FOR SMES: COUNTRY EXPERIENCE

- Theme 4 -

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Regional Workshop on the use of Utility Models and Industrial Designs for Small and Medium-sized Enterprises (SMEs) in ARIPO Member States

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Presentation Outline

- Utility Models
- Design registrations
- Concluding remarks

Utility Models protection

Background ...1

□ Background

- **German Law of June 1, 1891:** German Patent Law till 1978 required an invention must not only be new but also represent a technical step forward in the art [*for patent protection*]
 - Not patentable - minor inventions such as those relating to tools and implements (practical and useful, but did not represent a technical step forward)
 - **1910 Washington revision of the Paris Convention** recognized utility models as a species of industrial property
 - **By 1975** – protection recognised in Brazil, Germany, Italy, Japan, the Philippines, Poland, Portugal, South Korea, Spain and Taiwan
 - In Japan – a lower measure of inventiveness than for patents (i.e. utility model protection where failed to convince examiner of sufficient degree of inventiveness)
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□ Major Differences between Patents and Utility Models (one or more)

- Standard of invention required
- Basis on which novelty is assessed
- Whether examination is required (and consequent speed of grant of an enforceable right)
- Costs
- Duration of protection.

Utility Models protection

Background 2

COUNTRY	PERIOD OF PROTECTION	EXAMINATION
Australia (Innovation Patent)	8 years	NO
Brazil, Chile, Mexico, Poland	10 years	Yes
China, Denmark, Finland, Germany, Spain, Turkey, Peru	10 years	No
Belgium, Netherlands (both called short term patent),	6 years	No
France (Utility Certificate)	6 years	No
Korea, Malaysia (Utility Innovation), Portugal, Philippines	15 years	Yes
Japan	15 years	No
Zanzibar	10 years	

Utility Models protection

Utility Certificate - Tanzania

❑ Similar to the patent

- less stringent patentability requirements
- new and industrial applicability

❑ No examination

❑ Expires without any possibility of renewal at end of 7th year

PART XVI UTILITY CERTIFICATES (ss 73-75)

73. Applicability of provisions relating to patents

(1) Subject to section 74, the provisions of Parts I to XV and XVII shall apply, *mutatis mutandis*, to utility certificates or applications as the case may be.

(2) Where—

- the right to a patent conflicts with the right to a utility certificate in the case referred to in section 14(3);
- a patent and a utility certificate are interdependent within the meaning of section 54; or
- recidivism is alleged having regard to section 70,

the said provisions shall apply as if the word "patent", wherever it occurs, were replaced by the words "patent or utility certificate".

[s. 72]

74. Special provisions relating to utility certificates

(1) An invention is eligible for a utility certificate if it is new and industrially applicable.

(2) Sections 8 and 10 shall not apply in the case of inventions for which utility certificates are requested.

(3) Section 27 shall not apply in the case of applications for utility certificates.

(4) Utility certificates shall be registered in a separate part of the register.

(5) A utility certificate shall expire, without any possibility of renewal at the end of the seventh year after the date of the filing of the application.

(6) Section 39(1), (2) and (6) shall not apply in the case of utility certificates.

(7) In proceedings under section 64, the court shall invalidate the utility certificate on any of the following grounds—

Utility Models protection

Utility Certificate - Zanzibar

□ Similar to the patent

- less stringent patentability requirements
- New, involves sufficiently inventive step and industrial applicability

(3) A utility model shall be considered as involving a sufficiently inventive step if, having regard to the differences and similarities between the claimed utility model and the prior art as defined in subsection (2) (b) of this section the utility model does not result in a common manner from the prior art relevant to a person having ordinary skill in the art.

□ 10 year duration

□ Background

- **TRIPS Agreement Article 25 & 26**
- protection of independently created industrial designs that are new or original
- not new or original if they do not significantly differ from known designs or combinations of known design features
- protection shall not extend to designs dictated essentially by technical or functional considerations
- ...at least 10 years protection

Industrial Design Registration

Background ...2



Example with a toothbrush

A new shape applied to toothbrush which produces a new visual appearance on the article.



Contd.



Industrial Design Registration

The Case of South Africa

- ❑ Aesthetic features
 - New and not common place
- ❑ Design applied to article of manufacture
 - pattern, shape, configuration or combinations thereof
 - features necessitated by the function which the article to which the design is applied, is to perform
 - includes an integrated circuit topography, a mask work and a series of mask works

Aesthetic (Part A) - features which appeal to and are judged solely by the eye, irrespective of aesthetic quality



Functional (Part F) - shape or configuration – features necessitated by function which article to perform

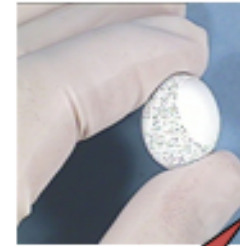
10 / 15 years of protection

Industrial Design Registration

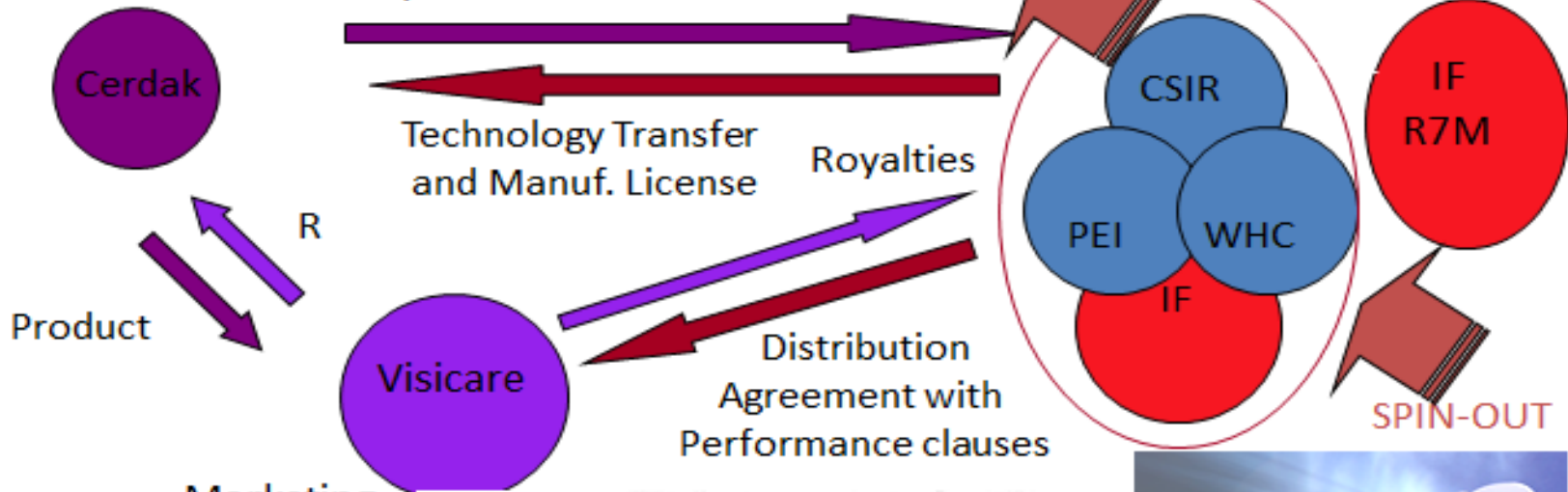
The Case of South Africa - Eyeborn

Patents, design registration, trademark

Manufacturing



IP development, protection



Marketing and distribution



EYEBORN

Industrial Design Registration

The Case of South Africa - South African case law

Neutral citation: *Bayerische Motoren Werke Aktiengesellschaft v Grandmark International* (722/12) [2013] ZASCA 114 (18 SEPTEMBER 2013)

Coram: BRAND, NUGENT, CACHALIA and WALLIS JJA and SWAIN AJA

Heard: 26 AUGUST 2013

Delivered: 18 SEPTEMBER 2013

Summary: Designs Act 195 of 1933 – designs for replacement parts of motor vehicles – whether aesthetic designs – Trade Marks Act 194 of 1993 – descriptive use.

Industrial Design Registration

The Case of South Africa - BMW South African case law

- ❑ (BMW) a German corporation that designs motor vehicles - proprietor of various designs (A1989/0062, A1998/0064, A1998/0065, and A1998/0056) in terms of Designs Act 195 /1993
- ❑ Designs for components of particular models of BMW vehicles – a bonnet, a grille, a headlight assembly, and a front fender
- ❑ Registered as “aesthetic designs” in Class 12; Part A of Register
- ❑ Grandmark International (Pty) Ltd – the respondent – imports and distributes motor vehicle components manufactured mainly in Taiwan
- ❑ S14(5) – no protection of functional features without aesthetic appeal
- ❑ s 14(6) excludes from protection of a registered functional design any feature of pattern, shape or configuration of an article that is in the nature of a spare part for a machine, vehicle or equipment

"The emphasis is on external appearance, but not every external appearance of any article constitutes a design. There must be in some way a special, peculiar, distinctive, significant or striking appearance – something which catches the eye and in his sense appeals to the eye."

Concluding Remarks

The Case of South Korea

The intellectual property system was an important catalyst for the development of indigenous technology by Korean companies, several of which have become global market leaders. Korea's spectacular transformation from a poor farming economy in the 1960s with a per capita income of less than US \$100 to a highly industrialized country with a per capita income of US \$12,000 today, resulted from a systematic economic and trade development policy that included incentives for technological innovation and the development of domestic intellectual property assets.

Chulsu Kim, Integrating Intellectual Property into the National Development Policy: the Korean Experience, keynote address at WIPO/ KIPO Ministerial Conference on Intellectual Property for Least Developed Countries

Concluding Remarks

- ❑ Utility Models important step in use of intellectual property system
 - Increase in domestic use of IP system (*adapt with caution*)
 - Tool to facilitate minor and incremental technological innovation, especially by small and Medium Enterprises (SMEs)
 - Examining and non-examining
 - Duration range 6 – 15 years

- ❑ Design Registration
 - Features of appearance
 - Lost cousin of patents – underutilised
 - Not exclusive - can also cover a patentable invention
 - Easy to enforce compared to patents

Thank You