



Policy Aspects for legislative implementation of Utility Models

WIPO Regional Seminar on the Legislative, Economic and Policy Aspects of Utility Models Protection System

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Different system of Utility Model protection

- **Three Dimensional Regime** → the protectable invention must be embodied in a three dimensional form
- **Patent type regime** → same requirements to obtain a patent. Differences at level of examination (only formal for UM) and sometimes at the level of a “less stringent” inventive step required.

Example of three dimensional type regime (1)

- JAPAN : *Articles 3 of the Utility Model Act No. 123 of 1959 as last amended by Act No. 55 of 2006*

- *Article 3 (Conditions for Utility Model Registration)*

(1) A creator of a device that relates to the shape or structure of an article or combination of articles and is industrially applicable may be entitled to obtain a utility model registration for the said device (...)

Example of three dimensional type regime (2)

- INDONESIA : *Articles 6 and 104 of the Patents Law No. 14 of 2001*

- *Article 6*

Any Invention in the form of a product or device, which is novel and possesses practical use values because of its shape, configuration, construction, or component may be granted a legal protection in the form of a Simple Patent.

Example of patent type regime

- MALAYSIA : *Sections 17 of the Patent Act of 1983 as last amended in 2006*
- *Section 17. Definition.* For the purposes of this Part and any regulations made under this Act in relation to this Part, “utility innovation” means any innovation which creates a new product or process, or any new improvement of a known product or process, which is capable of industrial application, and includes an invention.

Main features of Utility Models (1)

Substantive criteria

- The conditions for granting UM are less stringent than those of patents:
 - Novelty may be “universal”, “relative” or “local”
- UM may, in some countries, be limited to certain fields of technology and available only for products (not for processes. Above all in three-dimensional regime type)

Article 22 of the China Patent Law

Article 22. Any invention or utility model for which patent right may be granted must possess novelty, inventiveness and usefulness.

- **“Novelty”** means that the invention or utility model shall neither belong to the prior art, nor has any entity or individual previously filed before the date of filing with the patent administrative department under the State Council an application on an identical invention or utility model which was recorded in patent application documents or other gazette patent documents published after the said date of filing.
- **“Inventiveness”** means that, compared with the prior art the invention has prominent and substantive distinguishing features and represents a marked improvement, or the utility model possesses substantive distinguishing features and represents an improvement.
- **“Usefulness”** means that the invention or utility model can be made or used and can create positive results.

The “prior art” referred to in this Law refers to any technology known to the public before the filing date of the patent application in China or abroad.

Example of different items excluded from UM protection

■ *DOMINICAN REPUBLIC*: Article 51 of the Industrial Property Law No. 20-00 of 08/05/2000

■ *Article 51.-* Items Excluded from Protection as Utility Models

The following cannot be the object of a patent for utility model:

- a) procedures.
- b) chemical, metallurgical or any other kind of substances or compounds.
- c) items excluded from protection by invention patent invention pursuant to this law.

Main features of Utility Models (2)

Granting procedure

- Procedures for granting UM are generally faster and simpler than for patents:
 - only formal examination
 - voluntary substantive examination
- Acquisition and maintenance fees generally lower than those applicable to patents

Main features of Utility Models (3)

Duration of protection

- Shorter than that given to patents
 - Between 6 and 15 years (Malaysia: 20 years).
 - Most commonly 10 years (China, Costa Rica, Indonesia)
- Kazakhstan, Kyrgyzstan and Belarus: 5 years, renewable for other 3 years
- Thailand, Portugal and Romania: 6 years, renewable for two periods of 2 years each
- Japan: 3 years, renewable for 3 years

Utility Models: a surfboard-carrying device (1)

Nick Kent, an Australian citizen, looked for a new way to carry to longboard to the beach: board bags not always ideal because they can be stolen or they get full of sand*



sling-type surfboard carrier

* case study from <http://www.ipaustralia.gov.au/understanding-intellectual-property/case-studies/?doc=innovation-patent&view=Detail>

Utility Models: a surfboard-carrying device (2)

- **Boardsling**, a simple, heavy-duty strap that hooks around the surfboard and can be slung over a shoulder. The Boardsling is effective and ergonomic: it prevents the board bouncing and avoids jarring and other injuries.
- The Australian IPO granted to the Boardsling an **innovation patent** because, while useful and innovative, it did not meet the higher inventive threshold required for a standard patent

Policy considerations related to UM (1)

Should a country introduce a Utility model system?

■ Pros

- encourage local innovation (SMSEs)
- protection of valuable inventions otherwise not protectable
- revenue to governments (fees)
- source of valuable information
- reduction of incentives for industry to lobby for the inclusion of minor inventions in the patent regime → inventions to public domain after a shorter period of time

Policy considerations related to UM (2)

■ Cons

- more inventions on private control. Are they taken from the public domain?
- risk that UM will be used above all by foreign companies. Does experience show different?
- risk of use of UM to cordon off areas of research. Is the Patentable subject matter constraint for any multilateral treaty?
- uncertainty about the quality of the UM. What role might the IP/judiciary play?

THANK YOU!

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