

What is a utility model and how could it help your business?

Utility models offer similar IP protection to patents, in that they protect how an invention works, rather than how it looks or how it is branded. Typically they do not last as long as patents, but are quicker and cheaper to obtain, and have more relaxed novelty rules - sometimes they are not examined at all.

Because they are so quick to obtain, utility models can provide an attractive alternative (or addition) to patents for those wanting to build an IP portfolio on a budget. They can also be a useful solution for inventions which might otherwise be difficult to protect - perhaps because they have been disclosed already, or because they only make a minor improvement to an existing product.

Where are utility models available?

Utility models are not well known in the UK and USA, as neither the UK nor USA operates a utility model system. Many countries around the world do, however, and utility models can provide an effective route for protecting an invention in those countries.

In Europe, utility model systems (or similar schemes such as "petty" or "short term" patents) operate in the following EPO countries (EU countries in bold): Albania, **Austria, Bulgaria, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy** (including **San Marino**), **Romania, Poland, Portugal, Slovakia, Slovenia, Spain**, and Turkey.

Utility model systems also exist in many other key jurisdictions around the world, notably Australia, China, Japan, South Korea, Mexico and Russia. In total around 110 countries currently offer some type of utility model protection, including the 17 African countries that subscribe to the OAPI patent. If you have a particular country in mind, just ask.

What is the difference between a utility model and a patent?

The main differences between a utility model and a patent lie in the less stringent requirements for registering a utility model. Whilst the requirement for "novelty" (i.e. the invention being new) must always be met, the subject of a utility model sometimes may be obvious, or at least more obvious than would be allowed in the case of an equivalent patent. This means that a utility model can sometimes be used to protect an innovation with only a small advance in functionality or performance, which may not meet the stricter registration criteria for a patent.

Occasionally utility models also have different, more relaxed, rules on which earlier publications

are considered relevant for assessing novelty. For instance a few countries will grant utility protection for inventions which only have local novelty (i.e. have already been disclosed somewhere in the world, but not in that country), whereas absolute novelty (i.e. no disclosure anywhere in the world) is usually required for patents.

Grace periods for prior disclosures are more prevalent for utility models - of the 110 countries in which utility model protection is currently available approximately half allow some sort of grace period where the invention is deliberately disclosed by the applicant prior to filing. Utility models can thus provide a way to protect an invention that cannot be patented due to a prior disclosure. As a word of caution however, some grace periods run prior to the **filing date** of a utility model, rather than prior to the priority date - it is therefore important to consider utility protection earlier rather than later if an invention has been disclosed, as local filings may be appropriate.

Other notable differences between patents and utility models are:

- The term of protection for utility models is usually shorter than for patents. It varies from country to country, but is usually between 6 and 10 years, without the possibility of extension or renewal.
- In **most** countries where utility model protection is available, Patent Offices do not carry out a full novelty and inventiveness examination prior to registration. This means that the registration process is often significantly simpler and faster, taking, on average, six months. However, it can mean that some sort of examination must be completed later on, if the granted utility model is to be enforced against an infringer.
- In some countries, utility model protection can only be obtained for certain fields of technology and only for products but not for processes.
- In some countries that allow utility model protection, a utility model must be chosen as an alternative to a patent while in others it can be obtained in addition to a patent.



What next?

Please contact your usual Barker Brettell attorney for further information.