

What is a utility model?

A utility model is similar to a patent in that it provides a monopoly right for an invention. However, utility models tend to be much cheaper to obtain, the requirements for grant of a utility model are usually less stringent and the term is shorter.

Not all countries grant utility models. However, countries granting utility models (or similar/equivalent rights with a different name) do include Germany, France, Spain, Italy, Japan, China and Australia.

What does a utility model give you?

Like a patent, a utility model provides its owner with the right to prevent others from exploiting the claimed invention without the owner's consent, in the geographical area for which the utility model was granted. Usually, the same relief available for infringement of a patent is available for infringement of a utility model.

What are the differences between a utility model and a patent?

For a patent to be granted, the invention must be both novel and inventive over the prior art. However, for utility models, the prior art that is available for the assessment of novelty is often more limited (so-called "absolute" novelty is not always required, for example) and an inventive step either is not required or has a considerably lower threshold.

Whereas a patent provides protection for up to 20 years, a utility model provides protection for a shorter term, usually between seven and 10 years.

Usually, utility model applications are not examined before grant, so there is not the same level of presumed validity as with a patent. However, because of this, utility models are granted much more quickly, the average time being around six months.

This also means though that utility models are published much more quickly than patent applications, which are not published until 18 months after their priority date.

Utility models tend to be much cheaper to obtain and maintain than patents.

In some countries, there is a grace period for utility models for an inventor's own disclosures, which is not usually available for patents.

Not all inventions that can be patented can be protected by utility models and the requirements vary from country to country. Most countries will only grant utility models for products but not for methods or processes.

Why are utility models useful?

There are a wide variety of situations in which a utility model may be useful.

Because the novelty and inventive step requirements are less stringent than those required for patents, utility models can be useful for incremental inventions where only a small change has been made and which might not meet the inventive step requirements for a patent.

Due to the shorter term of protection, utility models can be useful for products with a relatively short commercial life.

The lower costs associated with utility models mean that they can be particularly useful for SMEs.

If an inventor has already published the invention, meaning that a patent for it cannot be obtained, in some countries, such as Germany, there is a grace period for an inventor's own disclosures so it may still be possible to obtain a utility model.

Since utility models are usually granted much more quickly than patents, they can be useful if the owner is aware of an infringement and needs a granted IP right quickly, to enforce against an infringer.

Where can you get a utility model?

Utility models (or similar/equivalent rights with a different name) are available in Albania, Angola, Argentina, ARIPO (African Regional Intellectual Property Organization), Armenia, Aruba, Australia, Austria, Azerbaijan, Belarus, Belize, Brazil, Bolivia, Bulgaria, Chile, China (including Hong Kong and Macau), Colombia, Costa Rica, Czech Republic, Denmark, Ecuador, Egypt, Estonia, Ethiopia, Finland, France, Georgia, Germany, Greece, Guatemala, Honduras, Hungary, Indonesia, Ireland, Italy, Japan, Kazakhstan, Kuwait, Kyrgyzstan, Laos, Malaysia, Mexico, OAPI (Organisation Africaine de la Propriété Intellectuelle), Peru, Philippines, Poland, Portugal, Republic of Korea, Republic of Moldova, Russian Federation, Slovakia, Spain, Taiwan, Tajikistan, Trinidad & Tobago, Turkey, Ukraine, Uruguay and Uzbekistan.

However, utility models are not available in the United Kingdom or the United States.

How do you apply for a utility model?

Utility model applications can be filed at the patent offices of any of the countries or regions listed above.

Like a patent application, an application for a utility model contains a description, claims and drawings.

A utility model may claim priority from an earlier patent or utility model application.

It is also possible to use a PCT application as the basis for a utility model application in the national phase.

Can you convert a patent application to a utility model?

Many countries allow the conversion of a patent application into a utility model application. However, in some countries there is a time limit for doing so.

If a patent application is refused, some countries allow the patent application to be converted into a utility model within a certain period after the refusal.

In some countries, conversion can even occur shortly after a patent has been granted.

Can you have a patent and a utility model for the same invention?

This depends on the country.

In Germany, for example, it is possible to obtain and keep both a patent and a utility model for the same invention. If a utility model is branched off from a patent application, the patent application can continue to be prosecuted to grant as well.

However, in other countries, such as Japan and China, only a single right for the same invention is allowed to remain in force.

What happens after grant?

Usually, renewal fees are due annually or every few years to keep the utility model in force. However, in some countries no renewal fees are required and utility models are simply granted for a fixed term.

Further advice

If you would like any further advice please contact us at Dehns using the details below.



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