PATENTANWÄLTE
SCHUSTER, MÜLLER & PARTNER

UTILITY MODELS

Utility models, like patents, are technical protective rights, i.e. a technical background must form the basis of the protection request. The utility model act (GbrMG) also rules in §1 (1) that only inventions are protected as utility models.

However, as there is no definitively generally valid definition of the term “invention”, in §1 (2) the GbrMG also explicitly excludes non-technical innovations such as discoveries, scientific theories, mathematical methods, aesthetic creations, plans, rules and methods for intellectual activities, games, social activities, programmes for data processing systems, the reproduction of information and biotechnological inventions from utility model protection.

§1 (1) GbrMG also states that the invention must satisfy the statutorily required protection prerequisites, i.e. it must be new, based on an inventive step and be commercially usable in order to obtain a sustainable utility model.

An invention is considered as new if it does not form part of the prior art. Information about the prior art is obtained by way of searches (see patents), whereby it should be taken into account that the prior art prejudicial as to novelty can also be produced by the inventor himself. Therefore, even if some inventors or the applicant might find it difficult, an idea should be kept to oneself until the date of application if possible. However, here the inventor encounters a peculiarity of utility model law, namely the so-called grace period within which a description or use of the invention by the applicant or his legal predecessor is not prejudicial as to novelty. However, this is limited to six months, i.e. after an own action prejudicial as to novelty the invention on which it is based can still be registered as a utility model within six months.

In addition to the novelty requirement the invention must differ from the prior art through an inventive step. A prerequisite for this qualitative requirement is that the invention must not be evident in an obvious manner to a person skilled in the relevant technical field from the prior art. Here too the inventor has an advantage in comparison with a

patent: in the assessment of the inventive level of an invention applied for as a utility model §1 (1) GebrMG refers to a so-called inventive step the invention must exhibit. The formulation which differs from the inventive activity of a patent allows the conclusion to be drawn that a lesser level of inventiveness is sufficient for a utility model.

For the registration of a utility model the invention must be commercially usable, i.e. it must be able to be produced or used in some kind of commercial field (including agriculture).

Another common feature between a utility model and a patent is that an application fee is payable and an application form has to be completed (electronically or in paper form) to which an application text is added. The application text must be formulated just as carefully as in the case of a patent application as through it the invention should be disclosed so comprehensibly and extensively that a person skilled in the art can implement it. The application text consists of a description of the prior art and of the invention and the protective claims. The invention can be explained in more detail by means of a drawing or one or more examples of embodiment. Above all, however, the correct wording of the claims is very important as it is through them that the protective scope and thereby also the value of the invention are primarily determined. In order to not to make any fundamental errors here which would allow a competitor to circumvent the protective right, the collaboration of a patent agent is advised.

The effect of a utility model in respect of third parties is the same as in the case of a patent. It consists in the sole authority of the utility model proprietor to use the subject matter. Every commercially active third party is therefore forbidden from producing the product, offering it for sale, marketing, using it or for said purposes, either importing it into the country in which the law is applicable, or owning it. However utility model protection cannot be obtained for processes (manufacturing, working, usage processes).

In contrast to a patent the duration of protection of a utility model is limited to ten years from the date of application.

A further difference lies in the course of proceedings until the applicant has the document in his hand. Whereas within seven years of the patent application that requests an examination the applicant must initiate the patent granting procedure, in the case of a utility model such a comprehensive examination of protectability of the invention for which the utility model is requested before its registration does not take place. A utility model is thus also registered if one or more of the above protection prerequisites are not present. However, in this case a protective right is not produced, but simply an apparent right from which no rights can be derived at any time. This uncertainty with regard to the protectability of a utility model can be reduced through a search voluntarily applied for at and conducted by the German Patent and Trademark Office (DPMA) and subsequent evaluation of the thus determined prior art by the applicant. It is therefore sensible to submit an official search request along with the application. Through the official search the applicant obtains a search report relating to the determined German and foreign documents which sets out the view of the DPMA regarding the assessment of the protectability of his/her invention.

However, a great disadvantage of this utility model only being examined from a formal point of view (e.g. completeness of the documents) consists in the fact that even if a search request has been submitted, the “examination of legal validity” is often only carried out as part of a deletion request to a court by a competitor. But in general a deletion request is submitted to the DMPA.

The utility model is also known as the “patent’s little brother”, which is also reflected in the fact that in the event of licensing the licence fees for a utility model are often only half as much as for a patent. However, the lack of official examination proceedings does not only conceal disadvantages. The positive consequence is a time saving, so that the time between the date of application and registration of the utility model is very short at approximately three to six months. With registration of the utility model the applicant has a fully enforceable protective right available.

During its period of validity maintenance fees must also always be paid in advance for utility models. As of the third year prolongation fees are payable for utility models for a further three years (4th to 6th year of protection) and then twice for two years at a time (7th and 8th year of protection and 9th and 10th year of protection). The prolongation

fees also increase progressively. A comparison of the annual fees for the first ten years of a patent with the entire validity of a utility model shows that the maintenance fees for utility model due its entire period of validity are only approximately EUR 350,000 less than for a patent.

The official fees must be paid on time as otherwise the utility model application will be considered to be withdrawn or the utility model expires.

PATENTANWÄLTE
SCHUSTER, MÜLLER & PARTNER

OFFICE STUTTGART

Wiederholdstraße 10
70174 Stuttgart
Germany
Telephone: +49 (711) 2229940
Fax: +49 (711) 22299444

OFFICE MAGDEBURG

Olvenstedter Straße 15
39108 Magdeburg
Germany
Telephone: +49 (391) 4005372
Fax: +49 (391) 4005373

OFFICE HEILBRONN

Weipertstraße 8-10
74076 Heilbronn
Germany
Telephone: +49 (7131) 7669640
Fax: +49 (7131) 7669649