



GERMAN UTILITY MODEL
THE UNDERRATED INTELLECTUAL PROPERTY RIGHT



MURGITROYD

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INTRODUCTION

In Germany the utility model is an unexamined, technical IP right having a duration of a maximum of 10 years:

- Can protect technical products, apparatus and substances.
- Cannot protect processes and biotechnological inventions.
- Registration has the effect of creating an exclusive right for the holder corresponding to a granted patent.
- Third parties are prohibited from making, selling, marketing or using the subject matter of the utility model, and from importing for those acts.
- The holder can require the infringing party to pay compensatory damages, to desist from the infringement, and to provide information on the extent of the infringement.



OUTLINE

- Prerequisites
- Application
- Effect of the utility model
- Cancellation procedures
- Enforcement
- Summary



PREREQUISITES

- Protectable subject matter
- Novelty
- Inventive step
- Industrial applicability



PROTECTABLE SUBJECT MATTER

- Technical products, apparatus and substances
- Exclusion
 - Non technical matter
 - Biotechnological inventions
 - Methods
- Exception from exclusion: second medical use claim is considered not to be a process (“pharmaceutical product utility model”)



WAYS TO GET A UTILITY MODEL

- Direct filing with / without priority
- National phase entry
- Branch-off



APPLICATION

- Request
- Application fee (no claim fees)
- Applicant (no declaration of inventor needed)
- At least 1 claim
- Description
- Possibly drawings
- Translation (3 months after filing; PCT national phase on filing)



PRIORITY

- Priority based on previous patent or utility model (12 month period)
- Priority based on foreign design possible (6 month period) for technical features



EXHIBITION PRIORITY

- Exhibition priority: if the invention has been presented at certain trade fairs up to 6 months before the filing date
- Accumulation with grace period of 6 months for own publications possible



NATIONAL PHASE ENTRY

- Entry within 30 month deadline in Germany
- Combination with patent application possible
- Translation needed on national phase entry
- No claim fees (in contrast to Patent)



BRANCH OFF (§5 GebrMG)

Utility model has effective filing date of the pending patent application from which it is branched off

Requirements:

- Pending patent application designating Germany (i.e. pending international, European or German patent application)
- Deadline: within 2 months from the end of the month in which processing of the patent application or any opposition procedure, if any, is terminated
- Same invention
- Same applicant
- Until 10 years after application date of patent application



BRANCH OFF - ADVANTAGES

- Fast protection (against infringement activities during grant proceedings in Germany) -> flanking protection
- Adaptation of the wording of the claims to the infringing product
- Fall-back position for patent (different prior art, different definition of novelty)
- Alternative to a costly divisional application
- Possible after grant of a patent during opposition



REGISTRATION

- Only formal examination
- Very fast (within days)
- Amendments of description and drawings not possible after registration
- Documents become prior art
- Restricted claims can be filed after registration



PUBLICATION / POSTPONING PUBLICATION

- Publication after formal examination by the GPTO (typically a matter of several weeks)
- Protection is provided after publication
- Publication of a utility model constitutes prior art (e.g. for a further patent application for a development that is based on the same subject matter of the utility model)
- Upon request publication of the utility model can be postponed for up to 15 months from the filing date. However, protection only commences with publication of the utility model.



DURATION

- The maximum term of protection of a German utility model is 10 years after the end of the month of filing
- Renewal fees after 3, 6 and 8 years (exception for branch-off applications)



SEARCH

- Registration without substantive examination (i.e. as to novelty, inventive step and industrial applicability)
- Search request possible and highly advisable before enforcing the utility model



EFFECTS OF THE UTILITY MODEL

- Exclusive right for the holder corresponding to a granted patent.
- Third parties are prohibited from making, selling, marketing or using the subject matter of the utility model.
- The utility model holder can require the infringing party to pay compensatory damages, to desist from the infringement, and to provide information on the extent of the infringement.
- Dependent on validity of the utility model (risk of compensation of damages)



CANCELLATION PROCEEDINGS

- First instance - Utility model division at the German PTO
- Second instance - German Federal Patent Court (BPatG)
- Effect of cancellation *ex tunc*
- Proceedings similar to nullity actions for patents
- Effect in civil procedures



GROUNDS FOR CANCELLATION

- Lack of protectability (§§ 1 to 3 GebrMG, i.e.
 - "wrong" subject matter,
 - lack of novelty,
 - lack of inventive step,
 - lack of industrial applicability
- Validly protected prior rights
- Non-entitled filing



NOVELTY

- Definition of novelty differs from the definition of novelty regarding patents
- Not novelty destroying:
 - Oral disclosure
 - Use abroad (i.e. not within the territory of DE)
 - Prior rights
 - Grace period for own publication (6 month)
- No assessment of novelty upon registration



INVENTIVE STEP

- Even though the codes are legally different, assessment of inventive step is the same as the assessment of inventive step for patents
- No assessment of inventive step upon registration



CHARACTERISTICS

- Possibility of amendment of the claims during cancellation proceedings
- Decision on validity and on costs
- Decision open for appeal



COSTS

- Losing party bears the costs for the proceedings based on the amount in dispute
- Exceptions:
 - Immediate acknowledgment of the cause of action: the applicant bears the cost
 - Withdrawal of the request: the applicant bears the costs
 - No need to adjudicate: decision on costs based on reasonable discretion
- No reimbursement for double representation (attorney at law and patent attorney)



ENFORCEMENT OF A UTILITY MODEL

- Enforcement at patent chamber of civil courts
- Thorough searches should be conducted to make sure that your application actually meets the requirements applying to effective IP rights. Otherwise you may not invoke any rights based on the utility model registration
- The validity of a German utility model can be assessed upon request during infringement proceedings by a Civil Court (unlike a German patent or German part of a European Patent)
- Interlocutory injunction possible, however validity of the utility model has to be confirmed



- Low official fees
- Fast protection
- Different definition of novelty (e.g. relevant prior art, grace period)
- Alternative to an expensive divisional application
- Utility model branch-off
- Maximum term of protection of 10 years
- Limitation to technical products, apparatus and substances
- Unexamined IP right
- Fast application (prior art for further developments)



**THANKS TO THE
AUDIENCE!**

Dr Ben Grau
German Patent Attorney
T. +49 (0)89 3090 71100
E. ben.grau@murgitroyd.com

Graham Murnane
Director, Patents
T. +44 (0)141 307 8400
E. graham.murnane@murgitroyd.com