

How can Utility Models provide protection to subjects with smaller levels of “inventiveness”?

Vítor Sérgio Moreira, Patent Engineer at Inventa International, provides a case study on utility models in Angola, Brazil, Mozambique and Portugal.

Several countries allow protection of subject matters by means of Utility Models, which are generally considered as inventions having a smaller level of inventiveness. Usually, the utility models are examined by the Patent Offices according to simpler and accelerated procedures than that related to a patent application.

The utility models play an important role in developing countries, wherein this kind of protection aims to provide a significant level of protection to applicants that develop new products having some level of inventiveness. The provision of utility models also allows an initial easier use of benefits comprised in the patent system. However, some fully developed countries, as Germany, still maintain utility models in their patent system.

This study aims to compare the legal aspects of utility models in some Portuguese speaking countries, namely Angola, Brazil, Mozambique and Portugal. We also present some data related to the filing of utility models in most of the abovementioned jurisdictions. Moreover, some challenges and advances referred to substantive examinations, namely the inventiveness requirement, by the respective Patent Offices are presented.

Angola

Utility models are protected in Angola according to Industrial Property Law No. 3/92 of February 28, 1992. The article 15 of said IP Law defines a utility model as “[a]ny new arrangement or form obtained in or introduced into objects such as tools, work implements or utensils that improve or increase the conditions for their use and their



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usefulness”. Furthermore, the subject matter shall meet the novelty criteria, considering that “[p]rotection shall be granted exclusively to the particular new form that makes it possible to increase and improve the utility and utilization of the objects for which it is intended”.

Brazil

The IP National Law No. 9.279, of May 14, 1996 of Brazil also provides protection of inventions by utility models. According to its Article 9, “an object of practical use, or part thereof, shall be patentable as a utility model if it is susceptible of industrial application, presents a new shape or arrangement and involves inventive act, resulting in functional improvement in its use or manufacture.” In comparison with patent protection, the Brazilian Law states in its Article 8, that “an object of practical use, or part thereof, shall be patentable as utility model if it is susceptible of industrial application, presents a new shape or arrangement and involves inventive act, resulting in functional improvement in its use or manufacture”.

The term of a utility model in Brazil is 15 years as from the filing date.

Mozambique

Utility models are also protected in Mozambique, according to provisions of the Industrial Property Code (Decree No. 47/2015 of December 31, 2015), wherein a utility model is “an invention that gives an object or part thereof a configuration, structure, mechanism or layout resulting in a functional improvement in its utility or manufacture”.

The national Law of Mozambique allows that

a patent application may be converted in a utility model, provided that the applicant request said change before a substantive examination. A regional patent application, filed before African Regional Intellectual Property Organization (ARIPO), may be converted into a utility model in Mozambique, provided that the regional patent application was refused or withdrawn.

Concerning the patentability requirements, the article 97 of the national IP Law of Mozambique defines that "every invention which involves a significant inventive step and has an industrial application is eligible for protection as a utility model, with the exception of pharmaceutical and agro-pharmaceutical". Moreover, "an invention shall be deemed to have a significant inventive step if it functionally improves the utility of an object or its manufacture", according to Article 98 of the same Law.

Mozambique provides a faster and simpler prosecution of utility models applications, as is explicit in Article 101 of the national IP Law.

The duration of the utility model shall be 15 years from its filing date.

Portugal

The Portuguese IP Law also allows the protection of inventions by utility models. Regarding the patentability criteria, the invention shall have to be novel and have industrial applicability. Moreover, the invention is required to have an inventive step, wherein the invention must meet one of the following requisites:

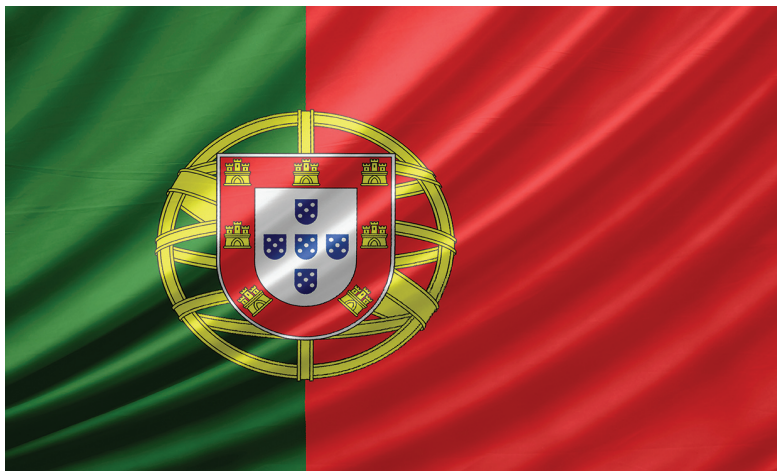
- a) The invention must not be an evident result from the prior art;
- b) The invention must present a practical or technical advantage for preparation or use of the product or process concerned.

Portugal also included an article in its IP National law stating that the prosecution of a utility model is simpler and accelerated than that related to a patent application. The duration of the utility model shall be until 10 years from its filing date.

Résumé

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Vitor is a Patent Engineer at Inventa International. His solid background in Chemical Engineering enables him to take care of all patent procedures in several areas of expertise, such as pharmaceutical, oil, petrochemical and biotech industries.



A provisional patent application may be converted in a non-provisional patent application within one year from its filing date and, simultaneously, may result in a utility model application. Moreover, the European Patent Convention and the IP Portuguese Law provide the opportunity to convert a withdrawn or refused European patent application into a patent or a utility model application in Portugal.

Examining of the patentability criteria

A utility model shall be granted, when the subject matter meets the following patentability criteria: 1) industrial application; 2) novelty; and 3) "inventiveness step". The two first requisites are usually objective and do not raise any peculiar debate over them.

On the other hand, the "inventiveness step" has not a common definition among the countries evaluated. The Patent laws of Angola and Mozambique link the "inventiveness step" to functional improvement in the utility or manufacture of the object, wherein this wording does not use any expressions related to the requisite inventive step, that must be met by a patent application. Cabo Verde employs in its Patent Law the very same expression "inventive step" for utility models and patents of inventions. The Portuguese patent law sets a mixed approach, referring to a practical or technical advantage regarding the preparation or use of the product or process concerned, whereas also refers to the possibility of solving a prior art problem by means of a non-evident approach, which also may be related to a higher level of inventiveness, pertinent when referring to a patent application.

Therefore, some Patent Offices and the applicants may be faced with an unclear approach related to the examination of utility models, regarding the "inventiveness step" requisite. This challenge may be highlighted when a patent examiner normally deals with both patent and utility models applications, wherein the self-incorporation of a person skilled in the art may be impaired, leading to ununiformed decisions, which contributes to

“Mozambique allows that a patent application may be converted in a utility model.”

the decrease of the quality of the substantive Office actions.

The Brazilian Patent Law provides some approaches that are able to mitigate these effects. Initially, its Patent Law defines the "inventiveness step" as an "inventive act, resulting in functional improvement in its use or manufacture". Furthermore, the Brazilian Patent Office has established a technical division comprised of examiners that are responsible for examining solely utility models. Besides, the Brazilian Patent Office published specific guidelines for examining utility models applications (Resolution INPI no. 85, April 9, 2013), wherein the different approaches when addressing a patent application and a utility model application are clearly defined.

The "inventive act" is illustrated with several examples and it is recommended that the examiner considers only the closest prior art document, in order to avoid an improper combination of prior art documents to raise objections against the inventive act. On the contrary, the motivated combination of teachings found in two or more prior art documents by a person skilled in the art may be a normal approach, when raising objections against fulfilling the inventive step of a patent application.

Some data related to filing of utility models

We have gathered some data regarding the number of filings of utility models in Angola and in Mozambique, after consulting the respective Official IP Bulletins published in 2019, which are illustrated in the table below, wherein it is possible to observe a small share, which is not statistically reliable, related to utility models. Anyway, the profile of the patent applicants is quite different between these two countries, wherein about 70% of the patent applicants in Mozambique are residents and only 1% of the patent applicants in Angola are residents.

According to the official statistics provided by the Portuguese Patent Office¹, in 2019 227 patent applications, 84 utility models, 569 provisional patent applications and 20 PCT entries in National phase were filed. The share of utility models is 9,3%

Patent and Utility Models applications

	Sum of patent applications publications	Sum of utility models applications published	Utility Models (%)
Angola	88	1	1.1
Mozambique	44	3	6.4

and about overall 78% of the mentioned filings are from residents.

According to the official statistics provided by the Brazilian Patent Office², in 2018 24,851 patent applications and 2,589 utility model applications were filed. The share of utility models is 9.4% and 96.4% of the utility model were filed by residents.

Conclusion

The utility models may be a relevant kind of protection for the applicants that have just initiated their use of the patent system and/or have developed products that might not meet the inventive step requisite of a patent application.

The Patent Offices shall publish rules and guidelines regarding the substantive examining of utility models, as Brazilian Patent Office did, to properly distinguish the approaches followed when a utility model or a patent application is examined. These guidelines will be helpful to increase the quality of the decisions of the Patent Offices, besides making clear to the applicants the applicable rules.

Previously to creating guidelines, some Patent Offices, namely the Angolan and the Mozambican Patent Office, may initially face the challenge referred to let the benefits

provided by the utility models and patent applications be better known for the residents of the respective countries.

- ¹ https://inpi.justica.gov.pt/Portals/6/PDF%20INPI/Estatisticas%20de%20propriedade%20industrial/Relat%C3%B3rios/Relat%C3%B3rios%20de%202019/Relat%C3%B3rio_Estat%C3%ADstico%20Anual%202019%20.pdf?ver=2020-04-27-140134-987
- ⁽²⁾ https://www.gov.br/inpi/pt-br/acesso-a-informacao/pasta-x/boletim-mensal/arquivos/documentos/indicadores-de-pi_2019.pdf

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